

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 43

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** TERUHISA KAMACHI, and TATSUSHI NASHIDA

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Appeal No. 2004-0373  
Application 08/939,064

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Heard: April 29, 2004

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Before HAIRSTON, KRASS and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-12, which are all of the claims pending in the present application.

The claimed invention relates to the display of information on a display in which a main window and a sub-window are used. When a user repositions the sub-window with respect to the main window, a distance between the main window and sub-window is

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determined and compared with a predetermined reference value. If the determined distance is within the predetermined reference value, the sub-window is automatically repositioned to be immediately adjacent to the main window.

Claim 1 is illustrative of the invention and reads as follows:

1. An image display processing apparatus for displaying in a single display window a main window for displaying main information and a sub window for displaying accompanying information associated with said main information, said sub window having a height and width independent of a height and width of said main window, the image display processing apparatus comprising:

a display position moving means for moving said sub window from a first position, at which said sub window is initially displayed, to a user-specified position; and

an automatic arrangement changing means for automatically moving said sub window to a position adjacent to said main window when said user-specified position is such that a distance between said sub window and said main window is less than a preset predetermined value, with the height and width of the sub-window remaining independent of the height and width of the main window.

The Examiner relies on the following prior art:

Elliott et al. (Elliott)	5,621,904	Apr. 15, 1997 (filed Jan. 24, 1995)
Santos-Gomez	5,771,042	Jun. 23, 1998 (filed Jul. 17, 1996)
Liles et al. (Liles)	5,880,731	Mar. 09, 1999 (filed Dec. 14, 1995)

Claims 1-12, all of the appealed claims, stand finally rejected under 35 U.S.C. § 103(a). As evidence of obviousness,

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the Examiner offers Elliott in view of Santos-Gomez with respect to claims 1, 2, 5-7, and 10, and adds Liles to the basic combination with respect to claims 3, 4, 8, 9, 11, and 12.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs<sup>1</sup> and the Answer for the respective details.

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in

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<sup>1</sup> The Appeal Brief was filed September 13, 2002 (Paper No. 33). In response to the Examiner's Answer mailed December 18, 2002 (Paper No. 34), a Reply Brief was filed February 24, 2003 (Paper No. 35), which was acknowledged and entered by the Examiner in the communication dated April 1, 2003 (Paper No. 37).

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claims 1-4. We reach the opposite conclusion with respect to claims 5-12. Accordingly, we affirm-in-part.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825(1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d

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1443, 1444 (Fed. Cir. 1992).

With respect to independent claim 1, Appellants' response to the obviousness rejection asserts a failure by the Examiner to establish a prima facie case of obviousness since proper motivation for the Examiner's proposed combination of references has not been set forth. After reviewing the arguments of record from Appellants and the Examiner, we are in general agreement with Appellants' position as stated in the Briefs.

Our review of the Elliot and Santos-Gomez references reveals that, in our view, they offer fundamentally different approaches to the problems associated with rearranging windows on a display. In the system described by Elliott, windows which have opened in an overlapping configuration are automatically moved away from each other if room exists on the display to display them separately in a non-overlapping manner. In Santos-Gomez, on the other hand, a user manually moves windows on a display until they are within a predetermined distance from each other at which point they are automatically "snapped" in place adjacent to each other.

We recognize that the Examiner's supposed rationale (Answer, page 9) for the proposed combination of Elliott and Santos-Gomez is to provide user control of the windows display in Elliott. We

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fail to see, however, how or why the artisan would be motivated to add a user control of the windows display in Elliott when Elliott's primary reason for providing automatic window movement is to relieve the user of the inconvenience of manually moving windows from an overlapping configuration. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F. 2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). In our view, given the disparity of problems addressed by the applied prior art references, and the differing solutions proposed by them, any attempt to combine them in the manner proposed by the Examiner could only come from Appellants' own disclosure and not from any teaching or suggestion in the references themselves.

For the reasons discussed above, since the Examiner has not established a prima facie case of obviousness, the 35 U.S.C. § 103(a) rejection of independent claim 1, as well as claims 2-4 dependent thereon, is not sustained.

Turning to a consideration of the Examiner's 35 U.S.C. § 103(a) rejection of claims 5-7 and 10, we note that, while we found Appellants' arguments to be persuasive with respect to the obviousness rejection of claims 1-4, we reach the opposite

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conclusion with respect to claims 5-7 and 10. While we remain convinced, for all of the reasons discussed supra, that the Examiner has not established proper motivation for the proposed combination of Elliott and Santos-Gomez, our review of the disclosure of Santos-Gomez reveals that this reference alone discloses all that is claimed in claims 5-7 and 10.

We note initially that we do agree with Appellants' comments (Reply Brief, page 2) that the windows in Santos-Gomez lose their independence when connected since, as described at column 7, lines 29-33, the windows must be disconnected in order to be resized independently. However, in contrast to previously discussed independent claim 1 which requires that the height and width of the main and sub-windows retain their independence after being automatically moved to an adjacent position, independent claims 5 and 6 require only that the main and sub-windows are automatically moved ". . . without altering a height or a width of said sub-window." As illustrated in Figures 2 and 3 of Santos-Gomez, when a user moves a workspace sub-window 34 to within a predetermined distance of the main window 32, the windows are automatically "snapped" into place in a connected arrangement without altering the height and width of the main and sub-windows. While it is true that in this connected arrangement the main and sub-windows lose their independence from one another

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allowing them at some future time to be simultaneously resized using the created single control separator, such a non-independent window resizing arrangement is not precluded by the language of claims 5 and 6. Similarly, with respect to appealed claims 7 and 10, we find the teaching in Santos-Gomez of aligning the various corners of the workspace windows (e.g., column 6 , lines 47-63) as clearly contemplating the use of horizontal as well as vertical predetermined distance values.

In view of the above discussion, it is our view, that the Elliott reference is not necessary for a proper rejection under 35 U.S.C. § 103(a) of claims 5-7 and 10 since Santos-Gomez appears to disclose all that is claimed. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).<sup>2</sup> Accordingly, the Examiner's obviousness rejection of claims 5-7 and 10 is sustained based on Santos-Gomez alone.

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<sup>2</sup>The Board may rely on less than all of the references applied by the Examiner in an obviousness rationale without designating it as a new ground of rejection. In re Bush, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961); In re Boyer, 363 F.2d 455, 458, n.2, 150 USPQ 441, 444, n.2 (CCPA 1966).

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Lastly, we sustain the Examiner's 35 U.S.C. § 103(a) rejection of claims 8, 9, 11, and 12 based on the combination of Santos-Gomez and Liles. We find no error, and Appellants' have provided no arguments to convince us of any error, in the Examiner's stated position (Answer, pages 5 and 6) as to the obviousness of applying the virtual reality and avatar teachings of Liles to the teachings of Santos-Gomez.

In summary, with respect to the Examiner's 35 U.S.C. § 103(a) rejection of appealed claims 1-12, we have sustained the rejection of claims 5-12, but have not sustained the rejection of claims 1-4. Therefore, the Examiner's decision rejecting claims 1-12 is affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

Errol A. Krass	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
Kenneth W. Hairston	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
Joseph F. Ruggiero	)	
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