The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD R. HARRISON, ALYSON R. MILLER,
JAMES W. LUNDELL and CINDY L. MERRILL

Appeal No. 2004-0945
Application No. 09/605,929

ON BRIEF

Before FLEMING, SAADAT and NAPPI, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-15, which are all of the claims pending in this application.

We reverse.

BACKGROUND

Appellants' invention is directed to scrolling multiple frames that make up a web page display. According to Appellants, using conventional mechanical scrolling devices creates ambiguity

as to which frame should be scrolled (specification, page 2). The present invention provides for a scroll device which automatically scrolls the displayed frames wherein the frame that has reached its end does not scroll anymore while the other frame continues to scroll until its end is reached (specification, page 4).

Representative independent claim 1 is reproduced as follows:

1. A method comprising:

receiving a command to scroll each of a first frame for display in a first display window and a second frame for display in a second display window, said first and second frames having a beginning and an end, at least one of said frames being larger than its window;

scrolling each frame in its window in response to said command;

determining when the beginning or end of one of said frames is displayed in its window; and

automatically stopping the scrolling of a frame when its beginning or end is displayed while continuing to scroll the other of said frames.

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Gillick et al. (Gillick)	5,530,455	Jun. 25, 1996
Onda et al. (Onda)	5,877,760	Mar. 2, 1999

Claims 1-3, 5-9, 11-13 and 15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Onda.

Claims 4, 10 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Onda in view of Gillick.

We make reference to the answer (Paper No. 10, mailed October 22, 2003) for the Examiner's complete reasoning, and to the appeal brief (Paper No. 9, filed August 1, 2003) for Appellants' arguments thereagainst.

OPINION

With respect to the 35 U.S.C. § 102 rejection of claims 1-3, 5-9, 11-13 and 15, Appellants argue that Onda does not disclose or suggest continuing to scroll one of the frames while stopping the scrolling of the other frames (brief, page 4). Appellants further point to the portions of Onda relied on by the Examiner, wherein the horizontal scrolls 300a, 300b and 300c are scrolled synchronously (col. 15, lines 1-6), and assert that none of the frames continues to scroll when the others reach their end (id.). Appellants further argue that the vertical scrolls 500a, 500b and 500c of Onda (col. 15, lines 14-22) are controlled independently and do not automatically stop the scrolling of one frame while continuing to scroll the other frames (id.).

In response to Appellants' arguments, the Examiner attempts to support the anticipation rejection by interpreting claim 1 as including two separate commands, each for scrolling one of the

first and the second frames (answer, page 4). The Examiner further asserts that using the first command, scroll 500a of Onda is used to scroll frame 300a to its end as a second command is used to scroll a second frame 300b using scroll 500b while the scrolling of the first frame is stopped (answer, page 5).

We find the Examiner's arguments presented in the answer, which is a departure from the position stated in the final rejection (paper 5, mailed April 9, 2003),[1] unconvincing and based on an unreasonable claim interpretation. Onda relates to scrolling different windows displaying parts of vertically long data wherein the display windows may be scrolled synchronously in the horizontal direction, but not in vertical direction (abstract and col. 15, lines 23-32). We agree with Appellants that none of the horizontal scrolls 400a, 400b and 400c, although synchronously scrolled, continues scrolling while stopping the other frames since the widows show different rows of the same data and reach their end (the rightmost column) at the same time (Figure 12). Therefore, even considering the arguments the Examiner made in the final rejection, scrolling neither of the

[1] "Given the scenario that the frames are scrolled horizontally, it is clear in Onda's reference that the scrolling of the frames is stopped when their beginnings or ends are displayed. It is not logical to continue the scrolling of the other frames, since the frames have already reached their beginnings or ends." (Final rejection, pages 4 & 5.)

horizontal scrolls can be equated to the claimed automatically scrolling while stopping the other frames.

Additionally, vertical scrolls 500a, 500b and 500c, as recognized by the Examiner (answer, page 5), scroll the windows independently and cannot perform the step of "automatically stopping the scrolling of a frame when its beginning or end is displayed while continuing to scroll the other of said frames," as recited in claim 1. We also remain unconvinced that the claim requires two separate commands for scrolling each of the first and second frames. As "[t]he starting point for any claim construction must be the claims themselves," Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999), we start with the words recited in claim 1. Considering the limitations of "receiving a command to scroll" and "scrolling each frame ... in response to said command," we find no plausible way to read claim 1 onto independently controlled vertical scrolls of Onda.

A rejection for anticipation under section 102 requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. See Atlas Powder

Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

As argued by Appellants, the Examiner has not established that the vertical scrolls of Onda necessarily provide for automatically stopping the scrolling of one frame while scrolling of the other frame is continued. Similarly, other independent claims 7 and 13 include the limitation of automatically stopping the scrolling of one frame while continuing the scrolling of the other frames. Thus, Onda cannot anticipate claims 1, 7 and 13 and accordingly, the rejection of claims 1-3, 5-9, 11-13 and 15 under 35 U.S.C. § 102 over Onda is not sustained.

Regarding the 35 U.S.C. § 103 rejection of claims 4, 10 and 14, we note the Examiner’s failure to provide any teaching or suggestion in Gillick to overcome the deficiencies of Onda discussed above. Based on our determination that Onda does not teach the invention of base claims 1, 7 and 13, the rejection of dependent claims 4, 10 and 14 based on Onda and Gillick cannot be proper. Accordingly, we do not sustain the § 103 rejection of claims 4, 10 and 14 over Onda and Gillick.

CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1-3, 5-9, 11-13 and 15 under 35 U.S.C. § 102 and rejecting claims 4, 10 and 145 under 35 U.S.C. § 103 is reversed.

REVERSED

MICHAEL R. FLEMING Administrative Patent Judge	)	
MAHSHID D. SAADAT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ROBERT NAPPI Administrative Patent Judge	)	

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