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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte Eli Beit-Zuri, James Berney, Martine Freiberger, Pamela Thompson, and Michal Anne Quakenbush

Appeal No. 2006-2177
Application No. 10/127,152

ON BRIEF

Before HAIRSTON, KRASS, and BARRY, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

A patent examiner rejected claims 1-33. The appellants appeal therefrom under 35 U.S.C. § 134(a). We affirm.

I. BACKGROUND

The invention at issue on appeal concerns graphical user interfaces ("GUIs"). GUIs allow users to interface with software applications operating on electronic devices. Some GUIs include a list of selectable titles. (Spec. at 1.) Figure 1 of the appellants' specification, for example, shows a GUI 100 for an application having more than eighteen available options. Tabs for a first nine options fit across the screen; a second row of tabs offers another nine options. (*Id.*)

The number of tabs that can fit across the screen depends on the length of the descriptive titles contained therein. As rows of tabs are added, the vertical space on the screen is usurped. As the display becomes more crowded, moreover, it becomes increasingly difficult to view the available options. (*Id.* at 2.)

Accordingly, the appellants' GUI allows a user to navigate within a browser of an electronic device via a scrolling "ribbon." (*Id.* at 4.) The user scrolls the ribbon to the left or right by clicking on left or right arrows or by clicking on a grab bar beneath the ribbon and dragging it to the right or left. When the user then clicks on the desired title in the ribbon, his selection is highlighted and corresponding data appear on the screen. (*Id.*)

A further understanding of the invention can be achieved by reading the following claims.

23. A user interface, comprising:

> a scrolling navigational ribbon displaying a first portion of a first plurality of descriptive text titles providing a means for accessing a first set of user-selectable information, said scrolling navigational ribbon displayed on a display screen of an electronic device, wherein said scrolling navigational ribbon is separate from a main display portion of the user interface;
>
> a left button and a right button displayed adjacent to said scrolling navigational ribbon providing a means for horizontally scrolling said navigational ribbon to the left and to the right, respectively; and

a grab bar displayed below said scrolling navigational ribbon providing a means for also scrolling said navigational ribbon.

25. A user interface as described in Claim 23 wherein said electronic device is a personal digital assistant.

Claims 1, 2, 5, 6, 12, 13, 16, 17, 23, 24, 27 and 28 stand rejected under 35 U.S.C. § 103(a) as obvious over David Siegel ("Siegel), *Creating Killer Web Sites*, and U.S. Patent No. 6,678,891 ("Wilcox"). Claims 3, 4, 14, 15, 25 and 26 stand rejected under § 103(a) as obvious over Siegel, Wilcox, and U.S. Patent Pub. No. 2003/ 0046401 A1 ("Abbott"). Claims 7- 11, 18- 22, and 29-33 stand rejected under § 103(a) as obvious over Siegel, Wilcox, and Yahoo! ("Yahoo"), http://web.archive.org /web/ 19981212034238/www.yahoo.com.

II. OPINION

Our opinion addresses the claims in the following order:

- claims 1, 2, 5, 6, 12, 13, 16, 17, 23, 24, 27, and 28
- claims 7- 11, 18- 22, and 29-33
- claims 3, 4, 14, 15, 25 and 26.

A. CLAIMS 1, 2, 5, 6, 12, 13, 16, 17, 23, 24, 27, AND 28

"When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the

ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately." 37 C.F.R. § 41.37(c)(1)(vii) (2005).

Here, the appellants argue claims 1, 2, 5, 6, 12, 13, 16, 17, 23, 24, 27, and 28, which are subject to the same ground of rejection, as a group. (Appeal Br. at 6-14.) We select claim 23 as the sole claim on which to decide the appeal of the group. "With this representation in mind, we focus on the points of contention between the examiner and the appellants." *Ex parte Gordon*, No. 2003-1371, 2004 WL 4978920, at *8 (B.P.A.I. 2004).

1. Navigational Ribbon Separate from Main Display Portion

The examiner finds, "The screenshots provided of Siegel show an interface where the print section is **distinctly separate** from the rest of the display." (Examiner's Answer at 25.) The appellants argue that "it is not even clear that the thumbnails in the bottom image on page 223 of Siegel are in a scrolling ribbon **separate from a main**

display portion of the user interface. Siegel does not state whether only the thumbnails scroll or if the entire display above the scroll bar scrolls." (Appeal Br. at 12.)

"In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the representative claim at issue to determine its scope. Second, we determine whether the construed claim would have been obvious." *Ex Parte Massingill*, No. 2003-0506, 2004 WL 1646421, at *2 (B.P.A.I. 2004).

a. Claim Construction

"Analysis begins with a key legal question — what is the invention claimed?" *Panduit Corp. v. Dennison Mfg. Co*., 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "[c]laims must be read in view of the specification, of which they are a part." *Markman v. Westview Instruments, Inc.,* 52 F.3d 967, 979, 34 USPQ2d 1321, 1329 (Fed. Cir. 1995) (en banc).

Here, claim 23 recites in pertinent part the following limitations: "a scrolling navigational ribbon displaying a first portion of a first plurality of descriptive text titles providing a means for accessing a first set of user-selectable information. . . ." For its part, the appellants' "Figure 3 is an exemplary computer screen shot illustrating a display window 300 of a user interface with a scrolling navigational ribbon 310 according

to an embodiment of the present invention." (Spec. at 13.) The Figure shows that the ribbon 310 is "separate" from the rest of the contents of the window 300 in the sense of being a distinct element thereof. Reading the representative claim in view of the Figure, therefore, the limitations merely require a scrolling area that is a distinct element of a display window.

b. Obviousness Determination

"Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious." *Massingill*, at *3. The question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently. . . ." *In re Zurko*, 258 F.3d 1379, 1383, 59 USPQ2d 1693, 1696 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995)).

Here, it is uncontested that Siegel teaches a scroll area. To wit, the appellants admit that the reference "shows thumbnail icons and a scroll bar at the bottom of the figure at the bottom of page 223." (App. Br. at 11.) We find that this figure depicts the thumbnail icons and scroll bar as a distinct element of the "Elliott/Advertising – Print

Portfolio" display window. We also agree with the examiner's finding, (Examiner's Answer at 25), that because the area of the scroll bar is limited to that of the thumbnail area, which is labeled "print" rather that the entire screen, the thumbnail icons and scroll bar are "separate" from the rest of the window shown in the figure.

2. Descriptive Text Titles

The examiner finds, "Wilcox teaches an interface for cable television that contains a scrollable component (Wilcox Figure 5, 120) comprising scrollable navigational elements that can be text, image or combination thereof (column 21, lines 63-67). . . ." (Examiner's Answer at 19.) He further finds, "The combination [of teachings from Siegel and Wilcox] would allow a system to not only display images but also display text in a scrollable navigation ribbon to a user. . . ." (*Id.* at 19-20.) The appellants make the following arguments.

> Siegel describes a user interface for displaying artwork on a marketing services website. At the bottom of p. 223, Siegel shows a row of thumbnails. The thumbnails are not descriptive text titles of user-selectable information in a navigational ribbon. Instead, clicking on a thumbnail would appear to simply display the corresponding image. Each thumbnail is simply a miniature version of its corresponding image, not a descriptive text title of user-selectable information. The intended purpose of the user interface shown in Siegel is to display thumbnails of images that when clicked display the corresponding image. To modify the thumbnails of Siegel to no longer function as thumbnails, as suggested by the Examiner, would clearly be counter to the intended purpose of Siegel.

(Reply Br. at 6.)

a. Claim Construction

"[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324, 72 USPQ2d 1209, 1211 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)). Furthermore, "[t]he transitional term 'comprising' . . . is inclusive or open-ended and does not exclude additional, unrecited elements or method steps." *Georgia-Pacific Corp. v. U.S. Gypsum Co.*, 195 F.3d 1322, 1327, 52 USPQ2d 1590, 1595 (Fed.Cir. 1999) (citing M.P.E.P. § 2111.03 (6th ed.1997)). "A drafter uses the term 'comprising' to mean 'I claim at least what follows and potentially more.'" *Vehicular Techs. Corp. v. Titan Wheel Int'l, Inc.,* 212 F.3d 1377, 1383, 54 USPQ2d 1841, 1845 (Fed.Cir. 2000).

Here, claim 23 further recites in pertinent part the following limitations: "a scrolling navigational ribbon displaying a first portion of a first plurality of descriptive text titles providing a means for accessing a first set of user-selectable information. . . ." Giving the representative claim the broadest, reasonable construction, the limitations require that the scrolling area includes text. Because the claim uses the term

"comprising," however, it does not preclude the scrolling area from also including images.

b. Obviousness Determination

"The presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact." *In re Gartside*, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). A suggestion to combine teachings from the prior art "may be found in explicit or implicit teachings within the references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved." *WMS Gaming Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999) (citing *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998)).

Here, as explained regarding the first point of contention, we have found that Siegel teaches a scrolling area that includes thumbnail images. As noted by the appellants, "Each thumbnail is simply a miniature version of its corresponding image." (App. Br. at 6.) Because the versions are miniatures, we find that it can be difficult to discern what the full image represents from merely its associated thumbnail. For

example, we are unable to discern the contents of most of the thumbnails shown "at the bottom of the figure at the bottom of page 223." (App. Br. at 11.)

For its part, Wilcox "provides a set of on-screen interface components which may be used in various combinations and arrangements to provide an easy-to-use consumer interface." (Col. 2, ll. 22-25.) "FIG. 5 illustrates, in wire frame format, three of the basic interface components of the present invention the screen, category item and menu item. . . ." (Col. 2, ll. 58-60.) "The category item 112 type of node contains a list of category item icon nodes 120 (see FIG. 5) representing categories of items for the viewer 12 to choose from, such as drama or sports (e.g., see FIG. 8). The list of category item nodes is rendered as a series of choices in a list which the viewer may scroll to the left or right using the input device 13." (Col. 19, ll. 29-35.) The secondary reference teaches that "the category item nodes may be represented by an image (e.g., see FIG. 9), by text only, or by a combination of image and text (e.g., see FIG. 8)." (Col. 19, ll. 64-66.) For our part, we find that those skilled in the art would have known that representing an item by both an image and text would have made the item easier to identify than an item represented only by an image.

Because images represented by the thumbnails of Siegel are difficult to discern, Wilcox teaches that items may be represented by an image and text rather than just an

image, and representing an item by image and text would have made the item easier to identify than an item represented only by an image, we find that the teachings of the references and the ordinary knowledge of those skilled in the art would have suggested including text in a scrolling area. We are unpersuaded by the appellants' argument, moreover, that adding text to a scrolling area "would clearly be counter to the intended purpose of Siegel." (Reply Br. at 6.) To the contrary, we find that such an addition would not have impeded the ability of a thumbnail to represent and to be used to select a full-sized image. Therefore, we affirm the rejection of claim 23 and of claims 1, 2, 5, 6, 12, 13, 16, 17, 24, 27, and 28, which fall therewith.

B. CLAIMS 7- 11, 18- 22, AND 29-33

Rather than arguing the rejection of claims 7- 11, 18- 22, and 29-33 separately, the appellants rely on their aforementioned arguments. (Appeal Br. at 15.) Unpersuaded by these arguments, we also affirm the rejections of these claims.

C. CLAIMS 3, 4, 14, 15, 25 AND 26

The appellants argue claims 3, 4, 14, 15, 25 and 26, which are subject to the same ground of rejection, as a group. (Appeal Br. at 14-15.) We select claim 25 as the sole claim on which to decide the appeal of the group. "With this representation in mind, rather than reiterate the positions of the examiner or the appellants *in toto*, we

focus on the point of contention therebetween." *Ex parte Morris*, No. 2005-0439, 2005 WL 4779247, at *3 (B.P.A.I. 2005).

> The examiner makes the following findings.
>
> It would have been obvious to one of ordinary skill in the art, having the teachings of Siegel, Wilcox and Abbott before him at the time of the invention was made, to modify the scrollable area taught by Siegel to include text titles of Wilcox and the dynamic interface of Abbott, in order to obtain a system that is able to be displayed on multiple types of electronic devices without modification. One would have been motivated to make such a combination because the desired ability to display a common interface regardless of the device type as taught by Abbott.

(Examiner's Answer at 4.) The "[a]ppellants' argument . . . is that one of ordinary skill in the art would not have been motivated use a PDA to display high resolution images as in Siegel at the time of Appellants' invention, not that the images could not be displayed on a PDA." (App. Br. at 15.)

1. Claim Construction

Claim 25 recites in pertinent part the following limitations: "said electronic device is a personal digital assistant." Giving the representative claim the broadest, reasonable construction, the limitations require displaying the aforementioned window on a personal digital assistant ("PDA").

2. Obviousness Determination

By not disclosing the type of device on which it displays its "Elliott/Advertising – Print Portfolio" window, (p. 223), we find that Siegel invites the use of any type of electronic device. For its part, Abbott "relates generally to computer user interfaces, and more particularly to various techniques for dynamically determining an appropriate user interface. . . ." (¶0002.) The latter reference teaches displaying user interfaces on "computers, network devices, internet appliances, **PDAs**, wireless phones, pagers, electronic organizers, television-based systems and various other consumer products. . . ." (¶0035 (emphasis added).)

Because Siegel invites the use of any type of electronic device, and Abbott discloses displaying a user interface on a PDA, we find that those skilled in the art would have been motivated to employ a suitable device, including a PDA, to display Siegel's window. Therefore, we affirm the rejection of claim 25 and of claims 3, 4, 14, 15, and 26, which fall therewith.

III. CONCLUSION

In summary, the rejections of claims 1-33 under § 103(a) are affirmed.

"Any arguments or authorities not included in the brief or a reply brief filed pursuant to [37 C.F.R.] § 41.41 will be refused consideration by the Board, unless good cause is shown." 37 C.F.R. § 41.37(c)(1)(vii). Accordingly, our affirmance is based only on the arguments made in the briefs. Any arguments or authorities omitted therefrom are neither before us nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1367, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.") No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

KENNETH W. HAIRSTON Administrative Patent Judge	)	
ERROL A. KRASS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
LANCE LEONARD BARRY Administrative Patent Judge	)	

ROBERT C. KOWERT
MEYERTONS, HOOD, KIVLIN AND GOETZEL, P.C.
P. O. BOX 398
AUSTIN, TX 78767-0398