

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte AKIRA MASUDA

Appeal 2008-2464
Application 10/304,975
Technology Center 3700

Decided: September 8, 2008

Before TONI R. SCHEINER, DEMETRA J. MILLS, and ERIC GRIMES,
Administrative Patent Judges.

GRIMES, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a system and method for operating application software. The Examiner has rejected the claims as indefinite and anticipated by the prior art. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

BACKGROUND

The Specification discloses a “so-called electronic white-board is becoming a very popular device” for teaching (Spec. 1). Such systems have

the drawback, however, of requiring students to approach the whiteboard in order to use it (*id.* at 2-3). The Specification discloses “a remote operation system for remotely operating application software projected onto a screen” that allows students to operate the application projected on the screen without leaving their desks (*id.* at 3).

DISCUSSION

1. CLAIMS

Claims 1-7 are pending and on appeal. Claims 1 and 7 are representative and read as follows:

1. A remote operation system for remotely operating application software projected onto a screen comprising:
a computer;
a projector that projects pictures onto a screen, the pictures produced by application software installed on said computer;
a first terminal; and
a plurality of second terminals;
wherein said first terminal includes a selector that selects one of said plurality of second terminals and allows said selected terminal to operate said application software, said second terminal includes a position indicator that designates a position by moving a pointer on a screen and operates said application software in accordance with said first terminal’s allowing said second terminal to operate said application software.

7. A remote operation method for remotely operating application software projected onto a screen comprising the steps of:
projecting onto a screen pictures produced by application software installed on a computer;
selecting one terminal from a plurality of second terminals by a first terminal;
allowing said selected terminal to operate said application software by said first terminal;
operating application software by moving a pointer on a screen with said selected second terminal; and

projecting operation of said second terminal onto a screen.

2. DEFINITENESS

Claims 1-7 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite. The Examiner concludes that the claims are indefinite because the “screen” in the phrase “position indicator that designates a position by moving a pointer on a screen” could be interpreted two ways: “One way is that the screen that a projector projects pictures [onto] is different than the screen that shows the pointer moving. The other way is that the screen that shows the pointer moving is represented on the same screen as the pictures.” (Ans. 3-4.)

We will reverse this rejection. It is true, as the Examiner points out, that the claim language encompasses moving a pointer on the screen that the projector projects pictures onto, as well as moving a pointer on a screen that is distinct from the one the projector projects onto. That a claim encompasses multiple embodiments, however, just makes it broad, not indefinite. “[B]readth is not to be equated with indefiniteness.” *In re Miller*, 441 F.2d 689, 693 (CCPA 1971).

3. ANTICIPATION BY MORGAN

Claims 1-7 stand rejected under 35 U.S.C. § 102(b) as anticipated by Morgan.¹ Morgan discloses a computerized teaching system (Morgan, abstract). The Examiner finds that the disclosed system meets all the limitations of the instant claims (Ans. 6-8).

¹ Morgan, U.S. Patent 5,596,698, issued Jan. 21, 1997.

Appellant argues that Morgan's system does not meet the limitation of claim 1 that the "first terminal includes a selector that selects one of said plurality of second terminals and allows said selected terminal to operate said application software" that generates the picture that the projector projects on a screen (App. Br. 6).² That is, Appellant argues that

the fact that each student can operate his or her own terminal in the system of the '698 patent, is not the same as the first terminal selecting one of the second terminals, wherein the second terminal can then operate the application program on the main computer. Such a system is not disclosed by the '698 patent.

(*Id.*)

We agree with Appellant that the Examiner has not adequately shown that Morgan discloses a system or method that meets all the limitations of the instant claims. Morgan discloses a teaching system using pen-based computers, which Morgan refers to as "Teach-Pad computers" (Morgan, col. 3, ll. 28-32). Morgan discloses that the TeachPad computers are used by both the teacher and students (*id.* at col. 5, ll. 30-35) and that a teacher's version of the TeachPad might support an external screen interface for a large video monitor (*id.* at col. 8, ll. 65-67), which is reasonably interpreted as a projector that projects pictures onto a screen.

The Examiner concludes that the limitation of claim 1's "wherein" clause is also met:

[the] first terminal includes a selector that selects one [of] said plurality of second terminals (column 3 lines 63-65) and allows

² "Appeal Br." refers to the Appeal Brief filed July 23, 2007, which the Examiner has treated as a Reply Brief (see the communication mailed Oct. 25, 2007).

said selected terminal to operate said application software (the examiner views this limitation as the student participates in the course/lesson), said second terminal includes a position indicator that designates a position by moving a pointer on a screen (use of stylus 14 on screen 12) and operates said application software in accordance with said first terminal's allowing said second terminal to operate said application software (the examiner views this limitation as the student working on the course/lesson).

(Ans. 6-7.)

We do not agree with the Examiner that Morgan's disclosure at column 3, lines 63-65, meets the requirements of claim 1's "wherein" clause. That passage of Morgan reads as follows: "The TeachPad computer **10** prompts the student to respond and/or interact with the process" (Morgan, col. 3, ll. 63-65). The cited passage says nothing about a first terminal (i.e., the teacher's TeachPad) selecting a second terminal (i.e., a student's TeachPad) and allowing it to operate application software.

We also disagree with the Examiner's interpretation that the claim language regarding the second terminal "operat[ing] said application software" is met by the student participating in the course/lesson. Claim 1 recites application software that produces pictures that are projected onto a screen, and a selector that selects one of a plurality of second terminals and "allows said selected terminal to operate said application software." That is, the claim language requires that the student's TeachPad (the second terminal) operate the application software that produces the pictures projected onto the screen by the projector.

We agree with Appellant that the Examiner has not adequately shown that Morgan's system meets the limitations of the "wherein" clause of claim

1. Claim 7, the only other independent claim, also requires that a second terminal operate the application software the produces the pictures projected by the projector. Because the Examiner has not shown that the prior art system and method meet all the limitations of the claims on appeal, we reverse the rejection of claims 1-7 as anticipated by Morgan.

4. ANTICIPATION BY LEE

Claims 1-7 stand rejected under 35 U.S.C. § 102(b) as anticipated by Lee.³ The Examiner finds that Lee's computer-based teaching system meets all the limitations of the instant claims (Ans. 4-6). With regard to the limitation of claim 1 requiring a "projector that projects pictures onto a screen, the pictures produced by application software installed on said computer," the Examiner points to Lee's disclosure at column 3, lines 50-54:

The TV input module **30** is a board which allows a computer to receive television signals via either antenna or cable and convert those signals into image signals which can be displayed on all or part of the display **16**.

(Ans. 4.)

Appellant argues that the projector recited in claim 1 "is directed to a discrete projector that is a different device from a computer or workstation used by the students" (App. Br. 5). Appellant argues that "the cited disclosure does not anticipate a projector located on the network, as the recited disclosure merely discloses that the student workstations have a TV receiver board for receiving TV signals, not for projecting any images onto a remote screen from a separate projector." (*Id.* at 5-6.)

³ Lee et al., U.S. Patent 5,788,508, issued Aug. 4, 1998.

We agree with the Examiner that Lee meets all the limitations of claims 1 and 7. Lee discloses a computer-based teaching system in which each student is provided with a workstation that can include, among other components, a CPU, keyboard, display, and TV input module (Lee, col. 3, ll. 10-14; Fig. 1). “All of the student workstations are in constant communication with a teacher’s workstation” via a local area network, or LAN (*id.* at col. 4, ll. 1-3). The teacher’s workstation can download programs to individual students’ workstations depending on their progress on a given lesson (*id.* at col. 5, ll. 17-43).

Thus, Lee’s system includes a computer (the CPUs in each of the workstations), a first terminal (the keyboard at the teacher’s workstation), and a plurality of second terminals (the keyboards at the students’ workstations). Appellant does not dispute that Lee’s system meets these limitations of claim 1.

With respect to the “projector” limitation of claim 1, the Examiner relies on a definition of “projector” as “an optical instrument for projecting an image upon a surface” (Ans. 9). The Examiner reasons that a “CRT (cathode-ray tube) is the basis of . . . the standard microcomputer display screen. As a result, the display 16 [of the student workstations] is the ‘projector that projects pictures onto a screen, the pictures produced by application software installed on a computer’” (*id.*).

We agree with the Examiner that the display of each of the student workstations in Lee’s system is reasonably interpreted to include a CRT that is a “projector” that projects pictures onto a screen (i.e., the screen of the computer monitor). Lee states that the display “can be a conventional VGA

monitor” (Lee, col. 3, l. 24). The pictures displayed on the screen are produced by application software on the student’s CPU (*id.* at col. 6, ll. 12-14). When the teacher’s workstation downloads a specific assignment to a selected student’s workstation (*see id.* at col. 5, ll. 31-43), it is acting as a first terminal selecting a second terminal and allowing it to use the application software that produces the pictures projected by the projector (CRT) onto a screen (the screen of the computer monitor in the student workstation).

“[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.” *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000). However, “while it is true that claims are to be interpreted *in light of* the specification . . . , it does not follow that limitations from the specification may be read into the claims. . . . It is the *claims* that measure the invention.” *Sjolund v. Musland*, 847 F.2d 1573, 1581-82 (Fed. Cir. 1988). We agree with the Examiner that Lee meets all the limitations of instant claims 1 and 7 when they are given their broadest reasonable interpretation. The claims do not require the recited projector to be distinct from or remote from the computer or workstation used by the students.

Appellant also argues that “both Claims 1 and 7 allow the ‘second terminals’ i.e. the student terminals to control the images projected on the screen by the projector. This limitation is not met by Lee” (App. Br. 6).

This argument is not persuasive. As discussed above, the images projected by the CRT onto the screen in the computer display at each of the student workstations are produced by the software on the computer (CPU) at

each workstation. Lee discloses that the student at each workstation operates the program and therefore controls the images projected on the screen at that workstation (*see* Lee, col. 6, ll. 4-14).

We affirm the rejection of claims 1 and 7 as anticipated by Lee. Claims 2-6 fall with claim 1 because they were not argued separately. 37 C.F.R. § 41.37(c)(1)(vii).

SUMMARY

We reverse the rejection of claims 1-7 as indefinite and as anticipated by Morgan, but we affirm the rejection of claims 1-7 as anticipated by Lee.

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

AFFIRMED

Ssc:

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