

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SACHI MIZOBUCHI and EIGO MORI

Appeal 2008-5121
Application 10/328,193
Technology Center 2600

Decided: January 14, 2009

Before JOSEPH F. RUGGIERO, MAHSHID D. SAADAT,
and SCOTT R. BOALICK, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 2-4 and 6-23. Claims 1 and 5 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

Appellants' invention relates to a touch screen user interface which replaces the conventional single touch of a stylus on the surface of a touch screen with the drawing by a user of a pattern, such as a circle, adjacent to or otherwise associated with a desired selected object. According to Appellants, the disclosed line-based or stroke based approach, as opposed to the conventional point-based technique, increases object selection reliability as well as facilitating the selection of multiple objects. (Spec. 2:14-22).

Claim 2 is illustrative of the invention and reads as follows:

2. A method to operate a touch screen user interface, comprising:
forming a stroke that encloses an area that contains at least a portion of at least one displayed object that represents data; and
selecting the at least one displayed object, where forming the stroke further comprises extending the stroke to a functional object, and activating the functional object with the at least one selected displayed object.

The Examiner relies on the following prior art reference to show unpatentability:

Moran	US 5,784,061	Jul. 21, 1998
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Claims 2-4 and 6-15 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Moran.

Claims 16-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Moran.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs and Answer for the respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to

make in the Briefs have not been considered and are deemed to be waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

ISSUES

- (a) *Under 35 U.S.C § 102(e), does Moran have a disclosure which anticipates the invention set forth in claims 2-4 and 6-15?*

The pivotal issues related to anticipation before us are whether the Examiner erred in interpreting Moran as disclosing (i) the extension of a formed stroke to a functional object, (ii) the automatic continuation of a stroke that does not totally enclose a defined area, and (iii) the indication of whether a displayed object is contained wholly or partially within a determined area.

- (b) *Under 35 U.S.C § 103(a), with respect to appealed claims 16-23, would one of ordinary skill in the art at the time of the invention have found it obvious to modify Moran to render the claimed invention unpatentable?*

The pivotal issue related to obviousness before us is whether the Examiner erred in finding that a modification of Moran to represent objects as icons representative of data containing files would result in Appellants' claimed invention.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence:

1. Moran discloses the operation of a touch screen user interface in which a formed stroke 502 is used to enclose a plurality of displayed objects A, B, C which can be selected. (Moran, col. 8, l. 65 through col. 9, l. 11; Figures 5 and 6).

2. Moran also discloses (Figure 5) that displayed objects are contained wholly within an area determined by a formed stroke.

3. Moran discloses that the displayed objects can be icons, such as a container icon, which can be moved, copied, or deleted. (Moran, col. 3, ll. 11-16).

4. Moran also discloses that icons can be used to represent files, documents, or applications. (Moran, col. 2, ll. 54-56).

5. Moran discloses that a container icon can be used to represent a collapsed subset of a list of documents (Moran, col. 13, ll. 9-65; Figures 31-36).

PRINCIPLES OF LAW

1. ANTICIPATION

It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citing *Minn.*

Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 1565 (Fed. Cir. 1992)). “Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

2. OBVIOUSNESS

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 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore,

“‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”

KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

35 U.S.C. § 102(e) REJECTION

Claims 2, 7, and 12

Appellants contend that the Examiner erred in interpreting the Moran reference as disclosing the claimed limitation of extending a formed stroke to a functional object and activating the functional object with a selected displayed object. According to Appellants (App. Br. 13-19; Reply Br. 5-8), there is no disclosure in Moran that corresponds to the claimed functional object, let alone any description of extending a stroke that encloses a displayed object to the functional object to activate the functional object.

We agree with Appellants. The Examiner has taken the position (Ans. 3 and 6) that Moran's displayed objects, specifically directing attention to the container icon 3602 illustrated in Moran's Figures 32 and 36, are functional objects since they can be moved, copied, or deleted (Moran, col. 3, ll. 12-15). We do not find, however, any disclosure in Moran that would support the Examiner's conclusion that any of the displayed objects in Moran correspond to what Appellants have described as functional objects in their disclosure (e.g., Spec. 7:12 through 8:3, Figures 3A and 3B).

Also, we find that even assuming, *arguendo*, that Moran's container icon could be construed as a functional object, Moran does not provide for extending *to* the functional object, i.e., the container icon, a formed stroke that encloses a selected object as claimed. Even further, we find no disclosure in Moran of any activation of the functional object with the selected displayed object, a feature specifically set forth in each of appealed claims 2, 7, and 12.

In view of the above discussion, since Appellants have shown that the Examiner erred in concluding that all of the claim limitations are present in the disclosure of Moran, we do not sustain the Examiner's 35 U.S.C. § 102(e) rejection of appealed claims 2, 7, and 12.

Claims 3, 4, 8, 9, 13, and 14

We also do not sustain the Examiner's anticipation rejection, based on Moran, of appealed claims 3, 4, 8, 9, 13, 14 which include the feature of automatically continuing a formed stroke that does not totally enclose an area of a displayed object so that the area is totally enclosed by the stroke. In addressing the claimed feature, the Examiner directs attention (Ans. 3) to the portion of the disclosure at column 8, lines 33-37 of Moran which provides a description of an ink stroke as well as makes reference to conventional rectangle generation operations found on graphical user interfaces. We do not find, however, anything in this cited portion of Moran, nor elsewhere in the Moran reference, which would correspond to the claimed automatic stroke continuation feature.

We recognize that the Examiner, in the responsive arguments portion of the Answer at pages 6 and 7, has expanded upon the stated position by asserting that the automatic detecting of the pen movement in Moran with the simultaneous displaying of the stroke on the screen effectively results in an automatic continuation of the stroke until a selected display area is enclosed. Even if we assume the Examiner's line of reasoning has merit, however, such a conclusion does not address the claim language which precedes and modifies the automatic continuation clause. As pointed out by Appellants (Reply Br. 9), such claimed modifying language requires that the

formed stroke does not define an area that is enclosed by the stroke, a feature which, when combined with the automatic continuation feature, we do not find taught or suggested by Moran.

Claims 6, 10, 11, and 15

Although we found Appellants' arguments to be convincing in showing error in the Examiner's anticipation rejection, based on Moran, of previously discussed claims 2-4, 7-9, and 12-14, we reach the opposite conclusion with respect to claims 6, 10, 11, 15. With respect to independent claims 6 and 11, directed to the feature of indicating whether a displayed object is contained wholly or partially within a display area encompassed by a formed stroke, the Examiner directs attention (Ans. 4 and 7) to the illustration in Figure 5 of Moran which depicts displayed objects A, B, and C contained wholly within an area encompassed by formed stroke 502.

Appellants' arguments in response contend that the Examiner has improperly focused on the presence of the alternative language "or" in the claimed phrase "**indicating whether at least one displayed object is contained wholly or partially within the determined area...**" According to Appellants (App. Br. 23-25; Reply Br. 23-25), the significant feature of independent claims 6 and 11 is that an indication is made *whether* a displayed object is wholly or partially within an enclosed area, i.e., a determination that requires the consideration of both wholly and partially enclosed conditions.

We do not find Appellants' arguments to be persuasive. We find no error in the Examiner's interpretation of the language of independent claims 6 and 11 which, as presently written, are set forth in alternative language

format, i.e., a requirement that a displayed object is contained wholly *or* partially within an enclosed area. With this in mind, we agree with the Examiner that the illustration in Figure 5 of Moran, which shows displayed objects wholly within an area enclosed by a formed stroke, satisfies the claimed requirements since at least one of the two alternative conditions is satisfied.

In view of the above discussion, since Appellants have not shown any error in the Examiner's finding that all of the claimed limitations are present in the disclosure of Moran, the Examiner's 35 U.S.C. § 102(e) rejection of independent claims 6 and 11, as well as claims 10 and 15 not separately argued by Appellants, is sustained.

35 U.S.C. § 103(a) REJECTION

We note, initially, that independent claims 16 and 20 are similar to previously discussed claims 2, 7, and 12 in setting forth limitations directed to the extension of a formed stroke to a functional object. The functional object activation feature of claims 2, 7, and 12 is further limited by requiring that the selected displayed object takes the form of an icon that represents at last one data containing file.

In addressing the requirements of independent claims 16 and 20, the Examiner has applied the Moran reference in an obviousness rejection. The Examiner takes the position (Ans. 5) that, since Moran discloses (col. 2, ll. 54-56) that graphical icons can be used to represent files, the ordinarily skilled artisan would have found it obvious to include data file representative icons in a selected displayed object group.

Appellants' arguments in response (App. Br. 27-29; Reply Br. 27-29) mirror those made with respect to claims 2, 7, and 12 which contend that Moran has no disclosure of the extending of a formed stroke to a functional object and activating the functional object with a selected displayed object, which arguments we found to be persuasive of error in the Examiner's position. We find, regardless of the correctness of the Examiner's position with respect to the obviousness of representing data files with graphical icons, Appellants' arguments to be equally persuasive with respect to independent claims 16 and 20 for all of the previously discussed reasons.

In view of the above discussion, since Appellants have shown the Examiner erred in concluding that the Moran reference supports the obviousness rejection, we do not sustain the 35 U.S.C. § 103(a) rejection of independent claims 16 and 20, nor of claims 17-19 and 21-23 dependent thereon.

CONCLUSION

Based on the findings of facts and analysis above, we conclude that, with respect to the 35 U.S.C. § 102(e) rejections, Appellants have shown that the Examiner erred in rejecting claims 2-4, 7-9, and 12-14, but have not shown that the Examiner erred in rejecting claims 6, 10, 11, and 15. We further conclude that Appellants have shown the Examiner erred in rejecting claims 16-23 for obviousness under 35 U.S.C. § 103(a).

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DECISION

The Examiner's decision rejecting claims 2-4 and 6-15 under 35 U.S.C. § 102(e) and claims 16-23 under 35 U.S.C. § 103(a) is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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