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The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
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Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD E. BERRY,
SUSAN F. HENSHAW, and
DAVID J. ROBERTS

Appeal No. 95-4356
Application 08/133,821¹

ON BRIEF

Before JERRY SMITH, FLEMING, and TORCZON, Administrative
Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed October 7, 1993.
According to appellants, this application is a continuation of
Application 07/888,223, filed May 26, 1992.

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This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 16-27, which constitute all the claims remaining in the application.

The disclosed invention pertains to a method and apparatus for enabling a computer user to make input selections more easily on the display menu of a graphical user interface. Specifically, the invention is directed to the manner in which a selected icon interacts with objects which are assigned to the icon.

Representative claim 16 is reproduced as follows:

16. A method for object oriented menu selection, the method comprising the steps of:

assigning an icon to each of a plurality of objects, each of said objects having a type designation;

displaying each of said assigned icons in a window menu bar;

accepting user selection of one of said icons;

testing said selection to determine an assigned object as the one of said plurality of objects assigned said icon; and

sending a message to the assigned object.

The examiner relies on the following references:

Berry et al. (Berry)	4,789,962	Dec. 06, 1988
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in support of the rejections and the evidence of obviousness relied upon by the examiner as support for the obviousness rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that claim 16 particularly points out the invention in a manner which complies with 35 U.S.C. § 112. We are also of the view that the collective evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claim 16. We reach the opposite conclusion with respect to claims 17-27. Accordingly, we affirm-in-part.

We consider first the rejection of claim 16 under the second paragraph of 35 U.S.C. § 112. The examiner's rejection states the following:

In claim 16, at lines 8-9, the applicant has claimed "testing said selection to

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determine an assigned object as the one of said plurality of objects assigned said icon." However, it is unclear to the examiner what the applicant means by "to determine an assigned object as the one of the plurality of objects assigned said icon." Should the claim be read as "testing said selection to determine an assigned object from the one of the plurality of objects assigned said icon?" Clarification is required. [answer, page 5].

Appellants argue that "one skilled in the art would understand the claimed step as requiring a determination of which object was assigned the icon selected by the user" [brief, pages 8-9].

The general rule is that a claim must set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure as it would be by the artisan. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed in light of the specification. Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

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We agree with appellants that the artisan having considered the specification of this application would have no difficulty ascertaining the scope of the invention recited in claim 16. The objected to step appears to reasonably recite that an assigned object is determined based on an icon selected by the user. Therefore, the rejection of claim 16 under the second paragraph of 35 U.S.C. § 112 is not sustained.

We now consider the rejection of claims 16-27 under 35 U.S.C. § 103. Appellants have indicated that for purposes of this appeal the claims will stand or fall together in four groups, each headed by one of the four independent claims. Consistent with this indication appellants have made no separate arguments with respect to any of the claims within each group. Accordingly, all the claims within each group will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Accordingly, we will only consider the rejections against independent

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claims 16, 17, 20 and 24 as representative of all the claims on appeal.

As a general proposition in an appeal involving a rejection under 35 U.S.C. § 103, an examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

With respect to independent claim 16, the examiner has pointed out the teachings of Fleming, has indicated the perceived differences between Fleming and the claimed invention, and has provided reasons as to how and why Fleming would have been modified and/or combined with IBM and the IBM Guide to arrive at the claimed invention [answer, pages 3-5]. In our view, regardless of the ultimate accuracy of the

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examiner's position, the examiner has, therefore, at least satisfied the burden of presenting a prima facie case of obviousness. That is, the rejection would be sustained if appellants chose not to respond to the rejection on the merits. The burden is, therefore, upon appellants to come forward with evidence or arguments which persuasively rebut the examiner's prima facie case of obviousness. Appellants have presented several arguments in response to the examiner's rejection. Therefore, we consider obviousness based upon the totality of the evidence and the relative persuasiveness of the arguments.

With respect to independent claim 16, the examiner's initial rejection seemed to suggest that the various action titles of Fleming, such as File, View and Help, could be replaced by an icon bar such as taught by IBM. Appellants responded that the substitution of icons for the action titles in Fleming does not result in the present invention because the "claimed invention includes icons for a 'plurality of objects' not as a replacement for textual labels as taught by [IBM]" [brief, page 12]. The examiner's response to this

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argument is to point to the up and down arrow icons and icon 45 of Fleming as teaching the multiple icons representing different objects [answer, page 6]. Appellants have not responded to this interpretation of the prior art in meeting the invention of claim 16.

In our view, the major cause of the dispute between the examiner and appellants results from a difference in claim interpretation. The examiner is giving the claims what he considers to be the broadest reasonable interpretation consistent with the disclosed invention. The examiner views each icon of Fleming (sizing icons 29 and icon 45) as being assigned to an object. The examiner also views each selection of one of these icons as resulting in a message to open an object associated with the selected icon [answer, pages 6-7]. Appellants, on the other hand, interpret the claims in light of the disclosure, and they essentially are reading disclosed aspects of the invention into the claims. Thus, many of appellants' arguments are not commensurate in scope with the invention as interpreted by the examiner or when the claims are given their broadest reasonable interpretation.

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As a general rule, claims are to be given their broadest reasonable interpretation during prosecution. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969). It is improper to narrow the scope of the claim by implicitly reading in disclosed limitations from the specification which have no express basis in the claims. See Id. When interpreting a claim, words of the claim are generally given their ordinary and accustomed meaning, unless it appears from the specification or the file history that they were used differently by the inventor. Carroll Touch, Inc. v. Electro Mechanical Sys., Inc., 15 F.3d 1573, 1577, 27 USPQ2d 1836, 1840 (Fed. Cir. 1993). Where an inventor chooses to be his own lexicographer and to give terms uncommon meanings, he must set out his uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change. Intellicall, Inc. v. Phonometrics, Inc., 952 F.2d 1384, 1388, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992). We have carefully reviewed the disclosure in this application, and we can find no specific

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definition of the terms used in claim 16 which would justify giving the claimed terms an interpretation different from the normal interpretation. In light of the above discussion, we agree with the examiner that Fleming broadly teaches that selection of an icon on the menu bar results in a message being sent to the object assigned to that icon. We do not agree with the examiner, however, that the sizing icons of Fleming can be considered to be icons which are assigned to an object. In our view, the only icons which meet the step of assigning an icon to each of a plurality of objects are the icons such as icons 45 and 51 in Fleming. We are also of the view that the icon bar in IBM would not have suggested the step of displaying icons assigned to an object in a window menu bar as recited in claim 16. Nevertheless, our interpretation of claim 16 does not require that there be a plurality of icons within a single menu bar.

Fleming teaches at least two objects such as "Folder-Project X" and "Chart-Chart 1" each of which has an icon assigned

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to it (icons 45 and 51, respectively). Although icons 45 and 51 are not displayed on the same menu bar in Fleming, claim 16 does not require this limitation. The icons 45 and 51 in Fleming are selected, tested and a message is broadly sent to the assigned object as recited in claim 16. In our view, claim 16 is broad enough to be suggested by the teachings of Fleming taken alone so that IBM and the IBM Guide are considered unnecessary to meet the invention as recited in claim 16.

Appellants argue that Fleming et al. "do not teach an ability to have multiple icons representing different objects nor do they teach replacing the action list pull-down menus with object invocation via a message" [brief, page 11]. As noted above, however, Fleming does teach a plurality of objects each of which has an assigned icon as recited in claim 16. We also agree with the examiner that claim 16 is not limited to the replacement of action list pull-down menus with object invocation via a message.

For all the reasons discussed above, we consider the invention of claim 16 to be sufficiently broad that it would

have been suggested by the graphical user interface of Fleming. Therefore, we sustain the rejection of claim 16 as unpatentable over the teachings of Fleming, IBM and the IBM Guide.

We now consider the rejection of independent claims 17, 20 and 24 as unpatentable over the teachings of Fleming, IBM, the IBM Guide and Berry. Appellants argue that each of claims 17, 20 and 24 recites the display of an action submenu in response to selection by the user of a designated object. The examiner has cited Berry to teach the display of an action submenu. Appellants argue that the help screen display of Berry is not an action submenu as claimed.

On this latter point, we agree with appellants. The help screens of Berry are merely informational and do not offer the user action choices. Claim 17 recites that the action submenu has a list of selectable actions. The help screens of Berry clearly do not have selectable actions. Claims 20 and 24 simply recite the display of action submenus in response to selection of a designated object. An action submenu can broadly be defined as a menu which offers the user

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a selectable action. Even using this broad definition, the Berry help screens cannot be viewed as action submenus.

Since we agree with appellants that the help screens of Berry cannot suggest the action submenus as recited in independent claims 17, 20 and 24, and since the examiner has not given a satisfactory response to this argument, we do not sustain the rejection of claims 17-27 as formulated by the examiner.

In summary, we have not sustained the rejection of claim 16 under the second paragraph of 35 U.S.C. § 112, but we have sustained the rejection of claim 16 under 35 U.S.C. § 103. We have not sustained the rejection of claims 17-27 under 35 U.S.C.

§ 103. Accordingly, the decision of the examiner rejecting claims 16-27 is affirmed-in-part.

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

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