

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte TOMOSHI HIRAYAMA

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Appeal No. 95-4629  
Application 07/831,953<sup>1</sup>

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ON BRIEF

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Before THOMAS, KRASS, and CARMICHAEL, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed February 6, 1992.

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Appellant has appealed to the Board from the examiner's final rejection of claims 1 to 9, which constitute all the claims in the application.

Representative claim 1 is reproduced below:

1. A display apparatus for displaying a window image thereon, the window image having an image area, the display apparatus comprising:

(a) a display for displaying the window image at a selected position of the display, the display having a visible area;

(b) a coordinate data input device for choosing the selected position by pointing to a window display area so as to display the window image on the display;

(c) a memory for storing the window image;

(d) a controller for supplying the window image from said memory to said display; and

(e) correction means for correcting the selected position of said window image if the window image protrudes from the visible area of the display, wherein if the window image is displayed on the window display area chosen by the coordinate data input device, said correction means corrects the position of the window image so that the image area of the window image is displayed in the visible area.

The following references are relied on by the examiner:

Norwood  
1991

5,063,600

Nov. 5,

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Borland, Quattro® Pro User Manual, p. 235-250; 1989

Microsoft® Windows 3.0 User Manual, p. xi-xvi, 20-22, 46, 157,  
and 494; 1990

Claims 1, 2, 5 and 6 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Microsoft®. All claims also stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Microsoft® in view of Borland as to claims 1, 2, 5 and 6. As to claims 3, 4, and 7 to 9, the examiner relies upon Microsoft® in view of Norwood.

Rather than repeat the positions of the appellant and the examiner, reference is made to the briefs and the answers for the respective details thereof.

#### Opinion

Generally for all the reasons expressed by the examiner in the answers, and for the additional reasons presented here, we will sustain all three prior art rejections of all the claims on appeal. To round-out the examiner's detailed analysis of the claimed invention and appellant's arguments, we add the following.

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Our study of the briefs and the answers leads us to conclude there is an undercurrent of dispute between the examiner and the appellant as to what the claims on appeal really recite. Inasmuch as appellant's arguments focus only upon the correction means clause of claim 1 on appeal and that corresponding clause and the detecting means clause of independent claim 5 on appeal, we focus upon these portions of these respective claims. As alluded to by the examiner in the answers, there is recited in each independent claim two different conditions, each of which may be answered in the affirmative or negative. The first question with respect to claim 1 is whether an image is even displayed at all on a window display area chosen by a coordinate data input device. If this question is answered in the negative, there is no correction means clause operative in the claim. Assuming it is answered in the positive, there still may be no correction means operative in the claim since the correction means clause is merely for correcting a selective position of a window if the window image "protrudes from the visible area of the display." Thus, even if a window image is displayed in the

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display area it may not protrude from the visible area of the display, thus causing the correction means clause to be inoperative or not needed in the context of the overall claimed invention. Even still, the function of the correction means is that it "corrects the position of the window image so that the image area of the window image is displayed in the visible area." This language of the correction means clause of independent claim 1 on appeal is more explicitly recited in both the correction means and detection means clauses of independent claim 5 on appeal, with the same end result when the same claimed "conditions" are followed through, that is, answered in the positive or the negative.

From our review of the disclosed invention, it appears that independent claim 1 is apparently directed to focus on the disclosed "first aspect" of the disclosed invention. However, the scope of claim 1, as noted by the examiner, is much broader than appellant's arguments appear to obtain. Initially, we observe that there is no automatic correction that occurs which is plainly an intent of the disclosed invention. Secondly, the function of the correction means is

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merely to correct the position of the window image so that the image area of the window image is displayed in the visible area. What is disclosed is the correction means is operative such that the effective display area of the window is wholly displayed within the display screen. Note the specification as filed at page 3, lines 5 to 10 and at page 22, lines 8 to 12. A similar aim is expressed in the Amendment to the top of page 16 of the specification as filed where a correction means is operative in such a manner as to permit the image 84L to be displayed "substantially in whole." Similar language is expressed at page 17, where the correction means is operative such that the image is displayed "at substantially the center of the display screen 8 correctly" at lines 10 and 11.

It is believed that the second independent claim 5 on appeal is intended to cover the disclosed "second aspect" of the disclosed invention. Appellant's remarks at the middle of page 4 of the principal brief on appeal indicate that as to independent claim 5 the above-noted language refers to the situation where the user intentionally wishes to have the icon image protrude from the visible display area. At page 3 of

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the specification as filed the "second aspect" of the invention it is stated at lines 14 through 18 that "when the position pointed by the coordinate input device is out of the tolerance range of the protrusion of the window, the display position is corrected or not corrected depending on the condition." This aspect is more specifically described at page 22, lines 16 to 21 where it is stated that "since the display position is corrected or not corrected on the basis of the condition when the display position designated lies outside of the tolerance range, the user can operate the window display apparatus in accordance with the user's own intention and the window display apparatus can be operated more conveniently."

When the subject matter of the last two paragraphs of this discussion have been considered against the claimed invention, it is noted that there is no statement in independent claim 1 or 5 as to any correction being automatically effected and in any manner such as that the window image would be wholly displayed within the display screen or substantially centered. Moreover, at least as to

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the invention intended to be recited in independent claim 5 and its most dependent claim, claim 9, there is no statement of any tolerance range and whether a given image display position is within or without this tolerance range as related to any conditions recited. These considerations are all significant because they widen the breadth of applicability of prior art against the present claims. The examiner has taken full advantage according to the reasoning that we understand from the answers to this wider-scoped language of the claims. Appellant's arguments are therefore not coextensive with the actual recited conditional language of the claims and therefore do not show a full appreciation of the breadth of the subject matter set forth in the claims on appeal.

As to the first rejection of claims 1, 2, 5 and 6 under 35 U.S.C. § 102 as being anticipated by Microsoft®, we add to the examiner's view our view as to the showing at page xii the image showing of two windows overlapping each other. The statement below these two depictions indicates to the user that "to review a spreadsheet and a report from two separate applications, you change the size of their windows so that

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they can fit side by side on the desktop." This showing clearly shows that a given window image may "protrude from" a visible area of the display such as to be overlapped by another window closer to the user. The statement that the size of them may be changed so that they may fit side by side operates as a clear teaching of the correctability of them to the extent claimed, with such a corrected version shown at page xiii. From the user's perspective, to display the images side by side is an operational or conditional feature within the Windows software, which feature may be chosen or may not be chosen by the user.

Furthermore, the teaching at the bottom of page 21 of Windows indicates that controls exist to change the size and to move Windows, to maximize and minimize their size by use of a mouse, a coordinate data input device, noted by the examiner in the Answer. As to the protrusion feature, we also note the teaching at page 22 of Microsoft®, which indicates that the scroll bars allow parts of a document to be viewed when the entire document won't fit within the window. Therefore, when

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portions of the document protrude from the visible area, horizontal and vertical scroll and size change correction means exist wherein the document may be completely or wholly viewed in a normal sense within the display area.

All of this is to say that there are many more teachings within the Microsoft® Windows disclosure relied upon by the examiner other than the sizing grid variation at page 157 the discussion of which we fully agree with as basis for correctability to the extent recited in independent claims 1 and 5 on appeal. Appellant's arguments are misplaced to the extent appellant argues that the examiner has ignored limitations in the claims on appeal, as must surely be apparent in light of our extensive initial discussion in this opinion. Furthermore, following the examiner's reasoning, if the grid lines feature is activated as the examiner argues from the teaching at page 157 of Windows, it is operative under all conditions, that is, whether or not an image protrudes or not. Therefore, if an image does protrude it is operative to the extent claimed. The examiner has not rewritten the claims to cover the cited references but in fact

has interpreted the breadth of the claims on appeal and applied the reference's teaching to this broad language.

We turn next to the rejection of the same claims, claims 1, 2, 5 and 6 under 35 U.S.C. § 103 in light of the collective teachings of Microsoft®, in view of Borland. Clearly, Borland is designed to operate in a Windows environment such as set forth in the Microsoft® reference relied upon initially by the examiner. What Borland does add to the Microsoft® is additional teachings that are particular to Borland but also which enhance upon basic Microsoft® features. The zoom, tile, stack and move/size optional window features first introduced at page 237 of Borland's reference also contain additional options to which the user may obtain and directly relate to the correctability and the conditional operability from a user's perspective of features that affect the Window images and their relationship to each other and the size of any one of them. For example, the tile display feature is stated at the bottom of page 239 to automatically, once activated by the user, reposition and resize the displayed windows as necessary giving the windows equal room on the screen. The ability of

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the user to move a window by dragging it with a mouse has been explicitly noted at the top of page 242 of Borland, which feature is already present in Windows.

As to the last stated rejection, that of claims 3, 4 and 7 to 9 under 35 U.S.C. § 103 in light of the collective teachings of Microsoft®, in view of Norwood, appellant does not traverse the combinability of Norwood with Microsoft®, within 35 U.S.C. § 103. Norwood's discussion at column 3 beginning at line 19 indicates that combined flat panel displays and screen tablets with an attached pen were known in the art to Norwood. Such is relied upon by Norwood at column 9 beginning at line 51.

The selective correctability to the extent claimed and to the extent argued appears to have been met by the teachings of the art relied upon as argued by the examiner and as additionally pointed out by us from additional teachings and showings from the references relied upon by the examiner. The selective dragability of any icon or movability of any displayed window by the user is an inherent part of the disclosed invention as well as each of the three references

relied upon by the examiner. From our perspective, it also appears in passing that the subject matter of claim 1 in the correction means clause reads upon appellant's admitted prior art since there is no requirement of this claim that the image be automatically substantially centered or wholly displayed within the display screen since the claim does not recite any of these particulars. Indeed, the function of the correction means to merely position the window image so that the image area of the window image is displayed in the visible area is broad enough to permit the movement of a window by a user and still "protrude" beyond the display screen since the entire or whole image is not recited to be displayed in the claim. This understanding is derived from our earlier study of the subject matter of independent claims 1 and 5 on appeal and appellant's recognition at pages 1 and 2 of the disclosed invention as to how the prior art figures operate. As to claims 1, 5 and 9 on appeal, clearly, from the normal use of the system shown in prior art Figures 1 to 4, the user may optionally or conditionally choose to allow the display of a protruded image from the display screen to remain or it may be

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slightly moved or moved in its entirety. Still, an image may never need to be repositioned because it may never protrude from the display screen at all as an alternative condition to the normal usage of appellant's prior art Figures 1 to 4. In such a case, there would be no operative condition to correct anything, which again is within the ambit of the subject matter of the claims on appeal.

We further observe in passing that claims 2 to 4 and 6 to 8 are respectively identical, are not argued in the briefs and read on appellant's prior art Figures 1 to 4 and their corresponding specification discussion.

We believe that the examiner has provided evidence of reasonable equivalent means performing the claimed functions, to the extent broadly recited. The examiner's and our own analysis of the prior art relied upon by the examiner add further understanding of this and the wide scope of the claims.

Our own analysis provided more insight of the disclosed and claimed invention than do appellant's brief and reply brief. The dissent would require appellant to read the claim-

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narrowing specification into certain portions of the claimed invention without invoking In re Donaldson, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994) (in banc) and 35 U.S.C. § 112, sixth paragraph. Our opinion points out that the claims are much broader than a reasonable view of the corresponding disclosure, that is, of what appellant regards as his own invention as he disclosed it. The dissent would appear to burden appellant with a narrow interpretation of the claims that the record does not reflect appellant desires to invoke.

The dissent's reference to the correction means operating where the user intentionally wishes to have the icon image protrude from the "visible area of the display" is only reflective of the "second" aspect of the disclosed invention and the subject matter of claims 5 to 9 and not of claims 1 to 4. The "visible area of the display" is not defined in the claims as the edge of the display device as the dissent seems to say, and it is also not recited as a means.

In view of the foregoing, the examiner's rejection of claims 1, 2, 5 and 6 under 35 U.S.C. § 102 is affirmed as is

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the rejection of claims 1 to 9 under 35 U.S.C. § 103.  
Accordingly, the decision of the examiner is affirmed.

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

AFFIRMED

JAMES D. THOMAS

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Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
ERROL A. KRASS	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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CARMICHAEL, Dissenting

I dissent. The examiner has based the rejections on an unreasonably broad interpretation of the claims.

Claims undergoing examination are given their broadest reasonable interpretation consistent with the specification.

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*In re Donaldson*, 16 F.3d 1189, 1194, 29 USPQ2d 1845, 1850  
(Fed. Cir. 1994) (in banc). A means-plus-function element is  
limited to the disclosed means and equivalents. *Id.*; 35  
U.S.C. § 112, sixth paragraph.

In the present case, appellant argues that the correction  
means, as disclosed in the specification, operates where the  
user intentionally wishes to have the icon image protrude from  
the visible area of the display, and operates to correct the  
position of the icon depending on the occurrence of a first or  
second condition. Appeal Brief at 4. The examiner ignored  
those limitations. That is contrary to what the Federal  
Circuit intended in *Donaldson*.

The recited means refers to the "visible area of the  
display." The examiner relies on the Borland reference, which  
has windows overlapping within the visible area of the  
display. While the overlapped portion of a window becomes  
invisible in Borland, it does not thereby protrude beyond the  
edge of the display device as disclosed in the specification  
and required by the claims.

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The examiner's combination does not reach these ignored limitations. Therefore, I would reverse.

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	)	BOARD OF PATENT
JAMES T. CARMICHAEL	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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Philip M. Shaw

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