

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

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BERTRAND M. GROSSMAN and CLIFFORD A. PICKOVER

Appeal No. 1996-4148
Application No. 08/327,085

ON BRIEF

Before FLEMING, HAIRSTON and DIXON, ***Administrative Patent Judges***.

FLEMING, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-20, all of the claims pending in the present application.

Appeal No. 1996-4148
Application No. 08/327,085

The invention relates to apparatus and methods for manipulating multiple windows or icons on a computer graphical interface (figure 2, numeral 130). Images (figure 2, numerals 245, 246) representative of a function to be performed on a system, are each presented on a separate page (specification, page 3, lines 23-26; figure 2, numeral 210). These pages are arranged within the interior of a carrousel (specification, page 3, lines 14-15; figure 2, numeral 150) rendered on the graphical interface, with one edge of each page attached to the axis (numeral 230) of the carrousel (numeral 150) and the page extending radially outward from the axis. Only the images of a subset of the pages (numeral 210) in the carrousel (numeral 150) are fully exposed for viewing within the carrousel at any given time. The pages are rotated around the axis (numeral 230) within the carrousel icon to change the subset of pages containing the viewable images.

The method relates to arranging images of selectable items (figure 2, numerals 245, 246, 250) on a display screen and selecting the images for operation of the represented items. Each item is represented as a separate representative

Appeal No. 1996-4148
Application No. 08/327,085

image on a page (numeral 210) and the pages are arranged into a three dimensional icon (numeral 150) with one edge of the pages attached to a common axis (numeral 230) in the middle of the icon (numeral 150). The pages are rotated about the axis within the

icon to change the subset of pages containing the viewable images. An item for operation on the system is chosen by selecting an image representing that item from the viewable subset of pages.

Independent claims 1 and 18, which are the sole independent claims rejected, are reproduced as follows:

1. An apparatus for showing a plurality of video displays comprising:

a. a graphical interface capable of rendering a three dimensional perspective of an object;

b. a plurality of video displays set in a carrousel rendered on said graphical interface, each display presented on a page within the carrousel, each page having a page boundary, and the boundary of the page having an axial edge facing the center of the carrousel with the page extending radially outward from the axial edge; and

c. an axis at the center of the carrousel to which the axial edge of each page is attached so that the video display on a subset of one or more of the pages are fully visible for viewing within the carrousel on the interface while the remainder of the video displays are not.

Appeal No. 1996-4148
Application No. 08/327,085

18. A method for arranging images of selectable items on a display screen of a system and selecting the images for operation of the represented items on the system comprising the steps of:

- a. representing each of the selectable items as a separate representative image on a page;
- b. arranging the pages into a three dimensional icon with one edge of the pages attached to a common axis in the middle of the icon and the pages with only a subset of one or more of the images viewable at a given time;
- c. rotating the pages around the axis within the icon to change the subset of pages containing the viewable images; and
- d. choosing an item for operation on the system by selecting an image representing that item from the viewable subset.

The Examiner relies on the following reference:

Kreitman et al.	5,303,388	Apr. 12,
1994		

Claims 1-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kreitman et al.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Brief¹, and the Examiner's Answer² for the respective details thereof.

¹ The Brief was received June 28, 1996.

² The Examiner's Answer was mailed August 20, 1996.

Appeal No. 1996-4148
Application No. 08/327,085

OPINION

We will not sustain the rejections of claims 1-20 under 35 U.S.C. § 103.

The Examiner has failed to set forth a **prima facie** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings

or suggestions. **In re Sernaker**, 702 F.2d 989, 995, 217 USPQ 1, 6

(Fed. Cir. 1983). "Additionally, when determining obviousness,

the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." **Para-**

Ordinance Mfg. v. SGS Importers Int'l, Inc., 73 F.3d 1085,

1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), **cert. denied**, 117 S.Ct. 80 (1996)

Appeal No. 1996-4148
Application No. 08/327,085

citing W. L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), **cert. denied**, 469 U.S. 851 (1984).

On pages 4-6 of the brief, Appellant argues that Kreitman et al. fails to teach Appellant's claimed limitations. In particular, Appellant argues that Kreitman et al. fail to teach that the informational images are on pages within a carousel, as claimed in Appellant's claim 1, and that there is no teaching in the prior art that would suggest to those skilled in the art to substitute, or how to substitute, a carousel for the cube of Kreitman et al.

Appellant further argues that the geometric configurations of Kreitman et al. limit the number of faces and informational images by increasing cluttering and confusion as they proliferate, whereas Appellant's carousel configuration allows

any number of images to be displayed without cluttering the screen with representational shapes.

Appellant also argues that if it were obvious to one

Appeal No. 1996-4148
Application No. 08/327,085

skilled in the art to replace the cubic display of Kreitman et al. with a carrousel because of the benefits of the carrousel display, why did Kreitman et al. not suggest a carrousel display. Appellant further notes that the assignee³ of Kreitman et al. is known for its use of graphic displays.

In the final rejection⁴ the Examiner points to column 1, lines 31-35 of Kreitman et al. which provides ". . . icons are generally considered to be more visually and logically appealing to users than text. For example, an icon which depicts a file folder instantly tells the user that this object may contain multiple documents." The Examiner then states that an icon which depicts a file folder is an example of the carrousel element of claim 1. At page 8 of the final rejection the Examiner asserts "[c]hanging from a polygon shape (or any other shape) into a carrousel would have been obvious to one skilled in the art at the time the present invention was made because a carrousel can

³ Apple Computer, Inc.

⁴ Paper No. 5, at pages 3-4.

Appeal No. 1996-4148
Application No. 08/327,085

fulfill the rotation function more effectively."

In the answer, the Examiner argues that the lack of disclosure of the carousel format of display by Kreitman et al. is not indicative of its nonobviousness. In the answer⁵, the Examiner argues that the rotation and visibility of information pages of a carousel are the key features of the present invention, and that rotation and visibility are disclosed by Kreitman et al. Lastly, in the answer the Examiner asserts

". . . the basic issue is whether fanciful or arbitrary "looks" of an otherwise functionally equivalent icon renders the claim patentable. It is the position of the examiner that such is a matter of design choice."

The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." **In re Fritch**, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), **citing In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not be

⁵ At page 6.

Appeal No. 1996-4148
Application No. 08/327,085

established using hindsight or in view of the teachings or suggestions of the

inventor." **Para-Ordinance**, 73 F.3d at 1087, 37 USPQ2d at 1239,

citing W. L. Gore & Assocs., 721 F.2d at 1551, 1553, 220 USPQ

at

311, 312-13. In addition, our reviewing court requires the PTO to make specific findings on a suggestion to combine prior art references. **In re Dembiczak**, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

On page 7 of the brief Appellant addresses method claim 18 and contends that Kreitman et al. does not disclose the claimed pages containing display images being arranged into a three dimensional icon with one edge of the pages attached to a common axis in the middle of the icon, and the pages being rotated around the axis within the icon. The Examiner did not specifically address this claim or this argument.

As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is

Appeal No. 1996-4148
Application No. 08/327,085

the claim." *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998).

Turning first to Appellant's claim 1, we note that the claim recites at section (b), ". . . a plurality of video displays set in a carrousel . . ., . . . each display presented on a page within the carrousel . . ., the boundary of the page having an axial edge facing the center of the carrousel with the page

extending radially outward from the axial edge" Claim 1,

at section (c), provides ". . . an axis at the center of the carrousel" Thus, Appellant's claim 1 requires a carrousel held display of pages attached to a common axis in the middle of the carrousel, and the rotation of the pages around the axis within the carrousel.

Claim 18 recites ". . . representing each of the selectable items as a separate representative image on a page . . ., arranging the pages into a three dimensional icon with one edge of the pages attached to a common axis in the middle

Appeal No. 1996-4148
Application No. 08/327,085

of the icon . . . , . . . rotating the pages around the axis within the icon to change the subset of pages" Thus, Appellant's claim 18 requires arranging the pages into a three dimensional icon with the pages attached to a common axis in the middle of the carrousel, and the rotation of the pages around the axis within the icon to change the subset of pages.

The Examiner's citation of column 1, lines 31-35 of Kreitman et al. as a basis for the statement that an icon which depicts a file folder is an example of the carrousel element of claim 1, is not well taken. As this disclosure by Kreitman refers only to icons which depict a file folder, it is devoid of any statements or indications that a carrousel carries the icon, and clearly

provides none of the specific carrousel and page structure recited in claim 1.

The Examiner's assertion that changing from a polygon shape (or any other shape) into a carrousel would have been obvious to one skilled in the art at the time the present invention was made because a carrousel can fulfill the rotation function more effectively fails to show why the

Appeal No. 1996-4148
Application No. 08/327,085

carrousel's greater effectiveness would obviate its use in place of the polyhedrons taught by Kreitman et al.

We agree with the examiner's position that the lack of disclosure of the carrousel format of display by Kreitman et al. is not indicative of its nonobviousness. Simply because a single reference does not disclose an embodiment which may be obvious therefrom is not evidence of nonobviousness, as, *inter alia*, it is not the objective of patents to present all obvious variations of a disclosed invention.

The argument by the Examiner that the rotation and visibility of information pages of a carrousel are the key features of the present invention, and that rotation and visibility are disclosed by Kreitman et al. is noted. However, even assuming *arguendo* that these are "key features of the present invention," these features are pertinent to the pages of

the carrousel, and no carrousel or pages in a carrousel are disclosed by Kreitman et al.

In addition, the Examiner asserts that the basic issue is

Appeal No. 1996-4148
Application No. 08/327,085

whether fanciful or arbitrary "looks" of an otherwise functionally equivalent icon renders the claims patentable, and that is the position of the examiner that such is a matter of design choice. The Examiner's position appears to be that the use of icons placed on pages of a rotatable carousel as claimed rather than the rotatable geometric configurations, such as cubes, pyramids or other polyhedrons disclosed by Kreitman, would merely be a matter of design choice. This bald assertion is made without evidentiary basis, and ignores the functional differences between the rotating carousel and rotating polyhedron.

Upon a review of the Kreitman et al. reference relied upon by the Examiner, we fail to find any explicit showing, or any suggestion or reason to have the carousel structure replace the cubical, pyramid or other polyhedron structure of Kreitman et al., or any evidence that one skilled in this art would recognize that rotatable carousels and polyhedrons are art recognized substitutes.

We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a

Appeal No. 1996-4148
Application No. 08/327,085

prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a *prima facie* case. *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984); *In re Knapp-Monarch Co.*, 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); *In re Cofer*, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966). Furthermore, our reviewing court states in *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785, 788 (Fed. Cir. 1984) the following:

The Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), focused on the procedural and evidentiary processes in reaching a conclusion under Section 103. As adapted to ex parte procedure, Graham is interpreted as continuing to place the "burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under section 102 and 103." *Citing In re Warner*, 379 F.2d 1011, 1020, 154 USPQ 173, 177 (CCPA 1967).

Therefore, we will not sustain the rejection of claims 1-20 under 35 U.S.C. § 103 as being unpatentable over Kreitman et al.

Appeal No. 1996-4148
Application No. 08/327,085

We have not sustained the rejection of claims 1-20 under
35 U.S.C. § 103. Accordingly, the Examiner's decision is
reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
JOSEPH L. DIXON)	
Administrative Patent Judge)	

MRF:lbg

Appeal No. 1996-4148
Application No. 08/327,085

LOUIS J. PERCELLO
INTELLECTUAL PROPERTY LAW DEPARTMENT
IMB CORPORATION
P.O. BOX 218
YORKTOWN HEIGHTS, NY 10598