

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(2) is not binding precedent of the Board.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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte NAOHISA KAWAGUCHI,  
YASUHIRO IIJIMA  
and KAZUMI SAITO

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Appeal No. 1997-1584  
Application No. 08/353,375

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ON BRIEF

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Before THOMAS, BARRETT and RUGGIERO, Administrative Patent  
Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of  
claims 1-24, all of the claims in the present application. An  
amendment after final rejection filed August 1, 1996 was  
approved for entry by the Examiner.

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The claimed invention relates to a desired region specifying system in an image editing apparatus. A desired region from among a plurality of overlapping regions can be selected by using a signal generator such as a stylus pressed against a display screen with a predetermined amount of force.

Representative claim 1 is reproduced as follows:

1. A desired region specifying system in an image editing apparatus comprising:

position information generating means for generating position information including x-y coordinates of a point on a display;

region selecting information generating means for generating region selecting information to select a desired region from among a plurality of regions which overlap in said point;

a region management table for storing positions of the regions to be displayed, the upper and lower relationships among the regions, and displaying methods for displaying the regions;

region selecting means for selecting, based on the position information generated by the position information generating means and the region selecting information generated by the region selecting information generating means, a desired region to be edited from among the plurality of regions, wherein a first region overlapped by a second region at said point such that there is no visible indication of said first region is selectable by said region selecting means;

a data storage for storing data to be displayed on a display unit; and

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display control means for reading the data stored in the data storage, and for displaying the data stored in the data storage in accordance with the displaying methods stored in the region managing table;

the region selecting information generating means including analog signal generating means for generating an analog signal, the analog signal being used to select the regions from overlapping regions.

The Examiner relies on the following prior art:

Takahashi et al. (Takahashi)	4,263,592	Apr.
21, 1981		
Kimura	4,710,595	Dec. 01,
1987 Saki et al. (Saki)	4,965,558	Oct.
23, 1990		
Roberts et al. (Roberts)	5,237,647	Aug.
17, 1993		

(Filed Oct. 28, 1991)

Claims 1-24 stand finally rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner offers Saki in view of Kimura with respect to claims 1 and 8-12, adding Roberts with respect to claims 2-4 and 15-21, and Takahashi with respect to claims 5-7 and 22-24. Roberts and Takahashi together are added to the combination of Saki and Kimura with respect to claims 13 and 14.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief and Answer for the

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respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, the arguments in support of the rejection and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Brief along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the 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 claims 1-24. Accordingly, we affirm.

Appellant has indicated (Brief, page 6) that, for the purposes of this appeal, claims 1-24 will stand or fall together. Consistent with this indication, Appellants have directed and limited their arguments to claim 1, the sole independent claim on appeal. Accordingly, all the claims

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before us 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). Therefore, we will only consider the rejection against independent claim 1 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 of going forward then shifts to Appellants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. 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, 1051, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by Appellants have been considered in this decision. Arguments

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which Appellants could have made but chose not to make in the Brief have not been considered [see 37 CFR § 1.192(a)].

With respect to representative independent claim 1, the Examiner, as the basis for the obviousness rejection, proposes to modify the image retrieval system disclosure of Saki by relying on Kimura to supply the missing teaching of utilizing an analog signal generator to select a desired region from overlapping regions. In the Examiner's view (Answer, page 4), the skilled artisan would have found it obvious to substitute the analog signal generating stylus of Kimura for the pointing device of Saki to provide a high precision determination of detected coordinates.

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Appellants' arguments in response, aside from a general assertion at page 11 of the Brief, do not attack the combinability of Saki and Kimura but, rather, focus on the assertion that neither reference discloses the region selection operation as claimed. In particular, Appellants assert that, contrary to the claimed invention in which an analog signal invisibly scrolls through pages not visible under a visible top page, Saki, the primary reference relied upon for this feature, provides a visible indication of the location of a page to be selected.<sup>1</sup>

After careful review of the Saki and Kimura references in light of the arguments of record, we agree with the Examiner's position as stated in the Answer. We note that the relevant portion of representative independent claim 1 recites:

wherein a first region overlapped by a second region at said point such that there is no visible indication of said first region is selectable by said region selecting means; . . .

We agree with the Examiner's analysis that Saki's Figure

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<sup>1</sup> In attempting to distinguish over the Saki reference, Appellants' arguments at pages 11 and 12 of the Brief use the terminology "pages" rather than "regions" as claimed.

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2a representation of the depth dimension of various documents D1-D4 includes a visible indication of the top page but no visible indication of any hidden page, page number, or indicia thereon, intended to be selected under the top page. As pointed out by the Examiner (Answer, page 9), if there was a visible indication of the page, page number, or indicia thereon, to be selected in Saki, the user would be able to immediately drag the pointer to the page to select it rather than pointing to only the approximate page location as explicitly taught by Saki.

In a related argument at page 11 of the Brief, Appellants contend that, contrary to their single-step selection of overlapping regions, Kimura discloses a two-part selection procedure.<sup>2</sup> We find such a contention to be unfounded since it is not commensurate with the scope of representative claim 1. It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification,

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<sup>2</sup> In making this argument, it is apparent that Appellants' reference to Kimura, rather than Saki, was inadvertent.

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and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Moreover, limitations are not to be read into the claims from the specification. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993), citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Although Appellants are correct that Saki's page selection procedure involves two steps (i.e., approximate page selection followed by sequential scrolling to select the intended page), there is nothing in the language of appealed claim 1 that limits the selection procedure to a single step.

In view of the above discussion, it is our view that the Examiner's prima facie case of obviousness with respect to representative independent claim 1 remains unrebutted by any convincing arguments offered by Appellants. Accordingly, the rejection of claim 1 under 35 U.S.C. § 103 is sustained. Since, as noted above, Appellants have grouped claims 1-24 as standing or falling together, claims 2-24 fall with claim 1 in accordance with 37 CFR § 1.192(c)(7). Thus, it follows that

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the decision of the examiner to reject claims 2-24 under 35  
U.S.C. § 103 is also sustained.

In conclusion, we have sustained the Examiner's rejection  
of all of the pending claims under 35 U.S.C. § 103.

Therefore, the Examiner's decision rejecting claims 1-24 is  
affirmed.

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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	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
LEE E. BARRETT	)	)
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JOSEPH F. RUGGIERO	)	
Administrative Patent Judge	)	

JFR:hh

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