

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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HISASHI NEGISHI and SATOSHI MIYAGAWA

Appeal No. 2000-2148
Application No. 08/935,704

HEARD: Apr. 16, 2002

Before KRASS, BARRY, and BLANKENSHIP, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

The examiner rejected claims 1, 2, 4-15, 17, 18, and 20-37. The appellants appeal therefrom under 35 U.S.C. § 134(a). We affirm.

BACKGROUND

The appellants' invention concerns file management. A computer using a windows-type operating system represents files as icons on a graphical user interface ("GUI"). Such an operating system allows a user to work with computer programs and files. File operations available to the user include deleting and moving a file. The user deletes a file by using the

computer's mouse to drag the file's icon to a trash area on the GUI. He moves the file by dragging its icon to a destination directory with the mouse. Unfortunately, a user may mistakenly delete a file necessary for executing a particular program or move it somewhere it cannot be found by the program. When such a mistake involves a file needed by the operating system, the latter may stop working.

The invention seeks to prevent a user from mistakenly destroying a file structure. Specifically, when the user tries to drag a "necessary" file to a trash area or different directory, the invention displays a line connecting the necessary file with a file that uses the former. The line alerts the user that these files are related so that he does not mistakenly delete or move the necessary file.

A further understanding of the invention can be achieved by reading the following claim:

29. A method for graphically displaying a file and operating the file, comprising:

outputting signals for producing a display with a line connecting an image of a first file and an image of a second file to indicate a relation between the first file and the second file when the second file

is operated, the first file using the second file when the first file is executed.

Claims 1, 2, 4-15, 17, 18, and 20-37 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent 5,754,179 ("Hocker") in view of U.S. Patent 5,295,242 ("Mashruwala").

OPINION

After considering the record, we are persuaded that the examiner did not err in rejecting claims 1, 2, 4-15, 17, 18, and 20-37. Accordingly, we affirm.

At oral hearing, the appellants' attorney explained that there were two points of contention, viz., (1) whether the references would have been combined and (2) whether the combination would have suggested the claimed invention. Rather than reiterate the positions of the examiner or appellants *in toto*, therefore, we address the two points of contention.

I. Combination of the References

The examiner asserts, "it would have been obvious . . . to combine Mashruwala's teaching of displaying connecting lines

between related object for indicating interrelationship of the objects to Hocker. Motivation of the combining is for providing a distinguishable graphical indication of the objects' relationship (Hocker's col. 3, lines 3, lines 28-29), a clear and easy to monitor representation of the object relationship (Mashruwala's col. 1, line 61 - col. 2, line 2)." (Examiner's Answer at 5.) The appellants argue, "[n]o suggestion of monitoring (whether easily or with difficulty) a 'representation of the object relationship' has been found in *Mashruwala et al.*" (Reply Br. at 3.)

"Whether motivation to combine the references was shown [is] a question of fact." *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348, 53 USPQ2d 1580, 1586 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); *Monarch Knitting Mach. Corp. v. Sulzer Morat GMBH*, 139 F.3d 877, 881-83, 886, 45 USPQ2d 1977, 1982, 1985 (Fed. Cir. 1998)). "[T]he question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" *In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting *Lindemann Maschinenfabrik GMBH v. American Hoist &*

Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)). “[E]vidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. . . .” *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617 (citing *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996); *Para-Ordnance Mfg. v. SGS Imports Int’l, Inc.*, 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995)).

Here, a motivation to combine the references flows from the references themselves. Hocker’s invention “allows [a] user to rapidly determine the interrelatedness of icons on graphical user interfaces.” Abs., ll. 1-2. More specifically, “[u]pon selection of an icon, . . . all other icons to which the selected icon may be related are graphically highlighted.” *Id.* at ll. 2-5. Although the primary reference discloses that embodiments of such graphical highlights “**might** include icon: brightness, outlining, font, shading, color, size, shape, and/or animation,” col. 4, 42-43 (emphasis added), the disclosure is not exclusive. To the contrary, Hocker invites “alternative embodiments,” col. 6, l. 1, including “other graphical means.” Col. 3, l. 29.

Mashruwala would have suggested such an alternative embodiment or other graphical means. Specifically, "[a] first connector connecting the first icons and second icons is displayed representing the relationship between the first and the second class of factory objects." Abs., ll. 6-8. The secondary reference also discloses advantages flowing from displaying line to represent relationships between objects. Specifically, "[o]ne of the objects of the present invention is to provide a clear representation of the organization of objects . . . for access and manipulation by a user. Another object of the present invention is to provide a system which clearly illustrates to a user the organization. . . ." Col. 1, ll. 61-66.

Because using Mashruwala's graphical line to represent relationships between Hocker's files would have provided a clear representation of the organization of the files for access and manipulation by a user and would have clearly illustrated to the user the organization of the files, we find that the prior art as a whole would have suggested combining teachings of the references.

II. Obviousness of the Claims

The examiner asserts, "Hocker et al (Hocker) teach a method for indicating interrelationship between icons wherever information on the relatedness of icons is desired (col. 1, lines 62-67)," (Examiner's Answer at 4), and also relies on "Mashruwala's teaching of displaying connecting lines between related object for indicating interrelationship of the objects. . . ." (*Id.* at 5.) The "[a]ppellants admit that the prior art references cited by the Examiner indicates [sic] that it was known in the art at the time of the invention to detect relationships between files upon receiving user input indicating selection of one of the files and displaying lines between icons representing objects (not files) in a graphical interface," (Appeal Br. at 3), but argue, "the 'references only provide a patchwork of teachings that can be combined to meet the recited limitations only by filling in the gaps after reading the application.'" (*Id.*)

"Analysis begins with a key legal question -- *what is the invention claimed?*" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). Claims that are not argued separately stand or fall together. *In re Kaslow*,

707 F.2d 1366, 1376, 217 USPQ 1089, 1096 (Fed. Cir. 1983) (citing *In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979)). Also, "the Board must give claims their broadest reasonable construction. . . ." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000). "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)).¹

Here, the appellants stipulate, "[c]laims 1, 2, 4-15, 17, 18 and 20-37 stand or fall together." (Appeal Br. at 2.) Therefore, claims 1, 2, 4-15, 17, 18, 20-28, and 30-37 stand or fall with representative claim 29. For its part, claim 29

¹ "The PTO broadly interprets claims during examination of a patent application since the applicant may 'amend his claims to obtain protection commensurate with his actual contribution to the art.'" *In re Yamamoto*, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984) (quoting *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550 (CCPA 1969)). "This approach serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified. Applicants' interests are not impaired since they are not foreclosed from obtaining appropriate coverage for their invention with express claim language." *Id.* at 1571-72, 222 USPQ at 936 (citing *Prater*, 415 F.2d at 1405 n.31, 162 USPQ at 550 n.31).

specifies in pertinent part the following limitations:

"outputting signals for producing a display with a line connecting an image of a first file and an image of a second file to indicate a relation between the first file and the second file when the second file is operated, the first file using the second file when the first file is executed." At oral hearing, the appellants' attorney stipulated that the obviousness of the final phrase of claim 29, viz., "the first file using the second file when the first file is executed," was not contested. Giving the representative claim its broadest reasonable construction, therefore, the limitations merely require displaying a line that connects an image of a first file and an image of a second file to indicate a relation therebetween when the second file is operated on.

Having determined what subject matter is being claimed, the next inquiry is whether the subject matter is obvious. "'A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.'" *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)

(quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, as mentioned regarding the combination of the references, upon selection of an icon, Hocker graphically represents all other icons to which the selected icon may be related. When Mashruwala's line was used to represent the relationships between the primary reference's files, the combination of teachings would have suggested displaying a line that connects an icon of first file and an icon of a second file to indicate a relation therebetween when the second file was selected. Therefore, we affirm the rejection of representative claim 29 and of claims 1, 2, 4-15, 17, 18, 20-28, and 30-37, which fall therewith.

CONCLUSION

In summary, the rejection of claims 1, 2, 4-15, 17, 18, and 20-37 under § 103(a) is affirmed. Our affirmance is based only on the arguments made in the briefs. Arguments not made therein are neither before us nor at issue but are considered waived.

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

ERROL A. KRASS)	
Administrative Patent Judge)	
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