

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte SCOTT L. SHWARTS  
and DAVID R. DUNHAM

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Appeal No. 97-1223  
Application No. 08/147,143<sup>1</sup>

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ON BRIEF

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Before JERRY SMITH, BARRETT, and BARRY, Administrative Patent Judges.

BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the final rejection of claims 1-18 and 31-40. The appellants filed an amendment after final rejection on February 6, 1996, which was denied entry. We affirm-in-part.

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<sup>1</sup> The application, now entitled "Tool Set for Navigating Through an Electronic Book," was filed November 3, 1993.

BACKGROUND

The invention at issue in this appeal relates to personal digital assistants (PDAs). A user can store "electronic books," e.g., lists of telephone numbers, in a PDA. The invention helps a user "navigate" through such a book. More specifically, it allows him to determine where he is located within the book, what other material is available in the book, and how to get to other locations in the book.

Claim 1, which is representative for our purposes, follows:

1. A method of controlling the display of an electronic book on a display screen of a hand-held stylus-based computer having a processor connected to the display screen, a memory connected to the processor, one or more buttons, and a stylus, the method comprising:

opening a book package which contains the electronic book and which resides, at least in part, in the memory of the computer;

displaying a view of a current page of the electronic book on the display screen, the view including at least one navigation button;

displaying a navigation dialog box on the display screen when the navigation button is selected by interaction of the stylus with the display screen, the navigation dialog box having at least a bookmark button and a return to menu button;



OPINION

In reaching our decision in this appeal, we considered the subject matter on appeal and the rejections and evidence advanced by the examiner. We also considered the appellants' and examiner's arguments. After considering the record before us, it is our view that the evidence and level of skill in the art would

not have suggested to one of ordinary skill in the art the invention of claims 1-18, 32-34, and 39-40 but would have suggested the invention of claims 31 and 35-38. Accordingly, we affirm-in-part.

We begin our consideration of the obviousness of the claims by finding the references to represent the level of ordinary skill in the art. See In re GPAC Inc., 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995) (finding the Board did not err in concluding the level of ordinary skill in the art was best determined by the references of record); In re Oelrich, 579 F.2d 86, 91, 198 USPQ 210, 214 (CCPA 1978) ("[T]he PTO usually must evaluate ... the level of ordinary skill solely on the cold words of the literature."). Of course, every patent application and reference relies to some extent upon knowledge of persons skilled in the art to complement that which is disclosed therein. In re Bode, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977). Persons skilled in the art must be presumed to know something about the art apart from what the references disclose. In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962).

We next recall that in rejecting claims under 35 U.S.C. § 103, the patent examiner bears the initial burden of establishing a prima facie case of obviousness. A prima facie case 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. If the examiner fails to establish a prima facie case, an obviousness rejection is improper and will be overturned. In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). With this in mind, we analyze the examiner's rejections.

#### Rejection of Claims 1-13 and 39

Regarding independent claim 1, the examiner notes Capps teaches a pen-based computer system comprising a CPU, ROM, RAM, mass storage, display, and button area. (Examiner's Answer at 3.) He admits Capps does not teach a return to menu button. (Id. at 4.) Based on Soviero's depiction of a menu button and the examiner's assertion that a table of contents is inherent to a book, the examiner concludes it would have been obvious to design a return to menu button in Capps so

that a user can sample various topics included in the electronic book in any desired order. (Id.) In response, the appellants argue that none of the references suggest displaying a menu button in a navigation dialog box together with a bookmark button. They urge that although Soviero teaches a menu button, nothing in the reference suggests that actuating the button will display a page listing book destinations. (Appeal Br. at 11.)

We find that the references would not have suggested the steps of displaying a navigation dialog box and displaying a menu page of claim 1. The claim recites in pertinent part the steps of "displaying a navigation dialog box ... having at least a bookmark button and a return to menu button; ..." and "displaying a menu page in the electronic book when the return to menu button is selected ..., the menu page listing one or more destinations within the electronic book which can be reached by selecting a corresponding destination from the menu page." (Appeal Br. at 16.)

Soviero primarily describes Apple Computer's Newton PDA. The reference briefly predicts that Sharp's OZ-9600 electronic organizer would be forthcoming. Regarding the OZ-9600, Soviero depicts a "MENU" button on the organizer's screen. P. 48. The reference offers no description of the function of the button.

Slate discloses PenBook™ software. According to the reference, PenBook™ is electronic book software that behaves like a paper book while using the power of high performance computers. P. 1. Slate notes the software permits a user to create bookmarks, which let him "zip" to frequently-used sections of a document. P. 2. The reference depicts a menu bar, which includes a "Bookmark" command. P. 3.

Comparison of the claim language to the references' teachings evidences the references would not have suggested the claimed displaying of a navigation dialog box. The claimed navigation dialog box features a bookmark button and a return to menu button. Capps teaches neither a navigation dialog box, bookmark button, nor return to menu button.

Although Soviero teaches a MENU button, it does not accompany the button with a bookmark button or place it in a navigation dialog box. In contrast, the MENU button stands-alone.

Although Slate teaches the "Bookmark" command, it does not accompany the command with a return to menu button.

Comparison of the claim language to the references' teachings also evidences the references would not have

suggested the claimed displaying of a menu page. The claimed menu page is displayed when the return to menu button is selected. As aforementioned, neither Capps nor Slate teaches a return to menu button. Although Soviero teaches a MENU button, it is unclear what contents are displayed when the button is selected. Thus, it is uncertain whether it performs the function of the claimed return to menu button. For the foregoing reasons, the examiner failed to show the references would have suggested displaying a navigation dialog box or displaying a menu page as in independent claim 1 and its dependent claims 2-13 and 39. Accordingly, we find the examiner's rejection of these claims does not amount to a prima facie case of obviousness. Because the examiner has not established a prima facie case, the rejection of claims 1-13 and 39 is improper. Therefore, we reverse the rejection of the claims 1-13 and 39 under 35 U.S.C. § 103.

#### Rejection of Claims 14-18 and 40

Regarding independent claim 14, the examiner makes a blanket obviousness rejection. Claim 14 is rejected "per the rationale of claims 1-3 as it applies to menus." (Examiner's

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Answer at 6.) The rejection lacks analysis. The examiner  
fails to map the

claim language to the disclosures of Capps, Soviero, or Slate. There is no indication of what language is missing from any of the references. In addition, the examiner omits an explanation of the proposed combination of the references or why one of ordinary skill in the art would have been motivated to form the combination. In response the appellants observe the discussions regarding menus in the cited art describe, at best, basic features unrelated to the suite of navigation features of the claimed invention. (Appeal Br. at 14.)

We find the references would not have suggested the step of displaying a browser of claim 14. The claim recites in pertinent part the steps of "displaying a browser ..., the browser listing a plurality of subjects contained in the book, the browser also indicating in which of said subjects the current page resides ...." (Appeal Br. at 18.)

Comparison of the claim language to the references' teachings evidences the references would not have suggested the claimed displaying a browser. The claimed browser features an indicator 276, which shows where a user is

located with respect to subjects in an electronic book.  
(Spec. at 15.) Neither Capps, Soviero, nor Slate suggests such an indicator. For the foregoing reasons, the examiner failed to show the references would have suggested displaying a browser as in independent claim 14 and its dependent claims 15-18 and 40. Accordingly, we find the examiner's rejection of these claims does not amount to a prima facie case of obviousness. Because the examiner has not established a prima facie case, the rejection of claims 14-18 and 40 is improper. Therefore, we reverse the rejection of claims 14-18 and 40 under 35 U.S.C. § 103.

#### Rejection of Claims 31 and 35-38

We begin our consideration of the obviousness of claims 31 and 35-38 by recalling that during patent examination, pending claims must be given their broadest reasonable interpretation. Limitations from the specification are not to be read into the claims. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993); In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969). With this in mind, we address the appellants' arguments.

Regarding claim 31, the appellants generally argue that Capps, Soviero, and Slate fail to suggest the sixth and seventh

elements (i.e., the last two elements) of the invention. (Appeal Br. at 9-11). Admitting that Slate teaches the creation of bookmarks and the use of a pull-down menu entitled Bookmarks, they specifically argue Slate does not have a navigation button for displaying a navigation dialog box. (Appeal Br. at 10.)

Giving claim 31 its broadest reasonable interpretation, we find the claimed invention does not define over the references. The references would have suggested the claim's sixth and seventh elements. These suggestions will be addressed seriatim.

The sixth element of claim 31 specifies "means for marking one or more of the pages in the book by interaction of the stylus with the display screen, those pages that have been marked having associated bookmark buttons displayed in a navigation dialog box appearing on the display means when a navigation button is selected ...." (Amendment A at 6.) The appellants admit Slate allows users to place bookmarks at various pages in an electronic book. (Appeal Br. at 6.) The

reference's creation of bookmarks would have suggested the claimed "means for marking one or more of the pages in the book by interaction of the stylus with the display screen, ...." Once created, Slate's bookmarks permit a user to tap a stylus to "zip" to frequently-used sections of a document.

P. 2.

A user accesses the bookmarks through a pull-down menu.  
P. 3. The pull-down menu would have suggested "those pages that have been marked having associated bookmark buttons displayed in a navigation dialog box appearing on the display means when a navigation button is selected ...." One of ordinary skill in the art would have understood the pull-down menu must contain an icon or name of each bookmark with which the user can interact to "zip" to the section marked by the bookmark. The icon or name would have suggested a bookmark button. One also would have understood the pull-down menu appears when a user select the "Bookmarks" command.<sup>3</sup> The command would have suggested the navigation button.

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<sup>3</sup> This understanding is reflected in the operation of the bookmarks in the well known and Netscape web browser.

The seventh element of claim 31 specifies "navigation means for changing the current page to a marked page and displaying it when a bookmark button associated with the marked page is selected from the navigation dialog box by interaction of the stylus with the display screen."

(Amendment A at 6.) As aforementioned, Slate's bookmarks permit a user to tap a stylus to "zip" to marked sections. One of ordinary skill in the art would have understood that when a user "zips" to a marked section, the current page is changed to the marked page. Therefore, we find the references disclose the sixth and seventh elements of claim 31.

Regarding claim 35, the appellants observe the discussions regarding menus in the cited art describe, at best, basic features unrelated to the suite of navigation features of the claimed invention. (Appeal Br. at 14.) This assertion is irrelevant. Giving the claim its broadest reasonable interpretation, we find that the claimed invention does not define over the references.

The claim specifies a browser as follows:

a browser represented by a browser window displayed on the display means, the browser window listing a plurality of subjects describing sections of the contents of the electronic book, wherein the first page of a section described by a subject is selected when that subject is selected from the browser window. (Amendment A at 7.)

The references would have suggested the claimed browser. Soviero's notepad screen is a browser window for the entire contents of its PDA, i.e., the PDA's electronic book. A plurality of subjects, e.g., Who, What, and When, are listed pictorially (i.e., by icons) along the bottom of the window. Who describes an address book; What describes a to-do list; and When describes a calendar. When one of the subjects is selected from the widow, the first page of the section described by the subject is selected. For example, pressing "Who" takes a user to the first page of the address book. P. 46. One of ordinary skill in the art would have understood the dedicated function buttons 64 of Capps to operate in the same manner. Therefore, we find the references would have suggested the browser of claim 35.

Regarding claim 36, giving the claim its broadest reasonable interpretation, we find the claimed invention does not define over the references. The claim specifies in pertinent part "means for displaying on said display means handwritten notes marked on the display means with said stylus." (Amendment A at 7.)

The references would have suggested the means for displaying handwritten notes. Capps recognizes an "ink object" entered into a PDA. The object is a note handwritten with a stylus. The PDA preferably displays the handwritten note. Col. 7, ll. 39-46. Soviero similarly displays handwritten notes, e.g., "Clean this up . . .," "Schedule This . . . ." P. 46. Slate features a "Mark-up" mode wherein a user can add notes in his own handwriting. P. 2. Therefore, we find the references would have suggested the means for displaying handwritten notes of claim 36.

Regarding claim 37, giving the claim its broadest reasonable interpretation, we find that the claimed invention does not define over the references. The claim specifies in

pertinent part a "handwriting recognizer for recognizing and converting handwriting on the display screen into at least one predetermined format." (Amendment A at 7.)

The references would have suggested the handwriting recognizer. As aforementioned, Capps recognizes a handwritten words entered into a PDA. It converts the note from a handwritten ink object I, fig. 4a, to a word object W in a predetermined format. Fig. 4b. Therefore, we find the references would have suggested the handwriting recognizer of claim 37.

Regarding claim 38, giving the claim it broadest reasonable interpretation, we find that the claimed invention does not define over the references. The claim specifies in pertinent part "a page number dialog box displayed when a page number button is selected, the page number dialog box having a field in which a page number handwritten with the stylus is recognized by the handwriting recognizer, wherein the means for specifying one of said plurality of pages as the current page specifies the page having the recognized page number as the current page." (Amendment A at 7.)

The prior art would have suggested the page number dialog box and means for specifying. Slate teaches a "Find" dialog box, which is displayed when a user scrawls "F" on the screen. The dialog box has a field in which text entries are recognized. P. 2. Similarly, the use of "Go To" dialog boxes in personal and portable computers to facilitate moving to a specific page was old and well known in the art at the time of the invention. A user would generally type the number of a page to which he wanted to move into the Go To dialog box to jump to the page. Official notice is taken thereof. As

aforementioned, Capps recognizes handwriting entered into a PDA. At the time the invention was made, therefore, it would have been obvious to one having ordinary skill in the art to which the invention pertains to combine the handwriting recognizer of Capps with the dialog boxes of Slate and the prior art as a whole to permit entry of page numbers in handwriting to obtain the claimed invention as specified in claim 38. The motivation to have done so would have been to replace a bulky keyboard with a small stylus, which is central to the ideas of a PDA. Therefore, we find the prior art would have suggested the page number dialog box and means for specifying of claim 38.

#### Rejection of Claims 32-34

Relevant to claim 32, the examiner concludes it would have been obvious to define a bookmark to convey the content of the marked page using text or image so that the user has a better idea of the information book marked and can traverse easily to the various pages that are book marked. (Examiner's Answer at 9.) In response the appellants observe there is no teaching in the references whatsoever directed at providing a

miniature representation of the marked page. (Appeal Br. at 13.)

We find the references would not have suggested the representation of bookmarks of claim 32. The claim recites in pertinent part "the bookmark buttons are represented in the navigation dialog box as miniature copies of the pages with which they are associated." (Appeal Br. at 6.) Comparison of the claim language to the references' teachings evidences that the references would not have suggested the claimed representation. As aforementioned, one of ordinary skill in the art would have understood Slate's bookmarks to be represented by an icon or name. Neither representation, however, would have suggested a miniature copy of a page. For the foregoing reasons, the examiner failed to show the references would have suggested representing a bookmark button as in claim 32. Accordingly, we find the examiner's rejection of this claim does not amount to a prima facie case of obviousness.

Relevant to claim 33, the examiner notes Capps teaches scroll buttons 66a and 66b. (Examiner's Answer at 5.) We find the references would not have suggested the button of claim 33. The claim recites in pertinent part "the navigation dialog box includes a button which when selected changes the current page to the page that had most recently been displayed before the current page."

Comparison of the claim language to the references' teachings evidences the references would not have suggested the claimed button. Capps scroll buttons are not located in a navigation dialog box. The references would not have suggested such a location. For the foregoing reasons, the examiner failed to show the references would have suggested the button of claim 33. Accordingly, we find the examiner's rejection of this claim does not amount to a prima facie case of obviousness.

Regarding claim 34, the examiner rejects the claim under the same rationale used to reject claims 1-13 and 39. (Examiner's Answer at 7.) We find the references would not

have suggested the menu page button of claim 34. Claim 34 recites in pertinent part "the contents of the electronic book include one or more menu pages which provide navigational assistance within the electronic book, the menu page immediately preceding the current page becoming the current page when a menu page button in the navigation dialog box is selected ...." (Amendment A at 6.)

Comparison of the claim language to the references' teaching evidences the references would not have suggested the claimed menu page button. The claimed menu page is displayed when the menu page button is selected. Neither Capps nor Slate teaches a menu page button. Although Soviero teaches a MENU button as aforementioned, it is unclear what contents are displayed when the menu button is selected. Thus, it is unclear whether it performs the function of the claimed menu page button. For the foregoing reasons, the examiner failed to show the references would have suggested the menu page button of claim 34. Accordingly, we find the examiner's rejection of this claim does not amount to a prima facie case of obviousness. Because the examiner has not

established a prima facie case, the rejection of claims 32-34 is improper. Therefore, we reverse the rejection of claims 32-34 under 35 U.S.C. § 103.

We end our consideration of the obviousness of the claims by concluding we are not required to raise or consider any issues not argued by the appellants. Our reviewing court stated, "[i]t is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art." In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991).

37 C.F.R. § 1.192(a), as amended at 60 Fed. Reg. 14518 (Mar. 17, 1995), was controlling when the appeal brief was filed. Section 1.192(a) stated as follows.

The brief . . . must set forth the authorities and arguments on which the appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief may be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

Also at the time of the brief, 37 C.F.R. § 1.192(c)(8)(iv) stated as follows.

For each rejection under 35 U.S.C. 103, the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument shall explain why the references, taken as a whole, do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not properly be combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of this paragraph.

In summary, section 1.192 provides that just as the court is not under any burden to raise or consider issues not argued by the appellants, the Board of Patent Appeals And Interferences is also not under any such burden.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-18, 32-34, and 39-40 under 35 U.S.C. § 103 is reversed. The examiner's decision to reject claims 31 and 35-38 under § 103 is sustained.

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

AFFIRMED-IN-PART

JERRY SMITH	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
LEE E. BARRETT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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LANCE LEONARD BARRY	)	

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