

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MARK A. MALAMUD,  
JOHN E. ELSBREE,  
and DAVID A. BARNES

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Appeal No. 1998-2674  
Application 08/329,724<sup>1</sup>

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HEARD: January 16, 2001

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Before BARRETT, RUGGIERO, and BARRY, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1-9, 20, and 21. Claims 10

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<sup>1</sup> Application for patent filed October 26, 1994, entitled "Information Cursors," which is a continuation of Application 08/054,564, filed April 28, 1993, now abandoned.

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and 19 stand allowed. Appellants do not appeal the final rejection of claims 11-18.

We reverse.

#### BACKGROUND

The invention is directed to an information cursor for displaying information relating to a visual object displayed on a video display to which the information cursor points.

Claim 1 is reproduced below.

1. In a data processing system having a video display and an input device, a method, comprising the steps of:

(a) displaying objects on the video display, said objects including an information cursor with a pointing portion for pointing to locations on the video display and an information portion for displaying information that is displayed in a selected relative position with respect to the pointing portion;

(b) in response to a user using the input device, positioning the information cursor so that the pointing portion of the information cursor points to one of the objects that is displayed and the information portion is in the selected relative position with respect to the pointing portion; and

(c) displaying currently undisplayed information on the video display about the object to which the pointing portion of the information cursor points in the information portion of the information cursor.

The Examiner relies on the following prior art:

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Steele et al. (Steele) 5,169,342 December 8, 1992

Matthies, Balloon Help Takes Off, Power Tools, Power Programming, MacUser, December 1991 (5 pages, no page numbers).

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Matthies.

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Matthies.

Claims 3-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Matthies and Steele.

Claim 20 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Steele. This is a new ground of rejection added in the Examiner's Answer.

Claim 21 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Steele. This is a new ground of rejection added in the Examiner's Answer.

We refer to the Final Rejection (Paper No. 9) and the Examiner's Answer (Paper No. 17) (pages referred to as "EA\_\_") for a statement of the Examiner's position, and to the supplemental Appeal Brief (Paper No. 16) (pages referred to as "Br\_\_") and the Reply Brief (Paper No. 18) (pages referred to as "RBr\_\_") for a statement of Appellants'

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arguments thereagainst. The Examiner notes that the Reply Brief has been entered and considered but that no further response is deemed necessary (Paper No. 19).

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OPINION

Grouping of claims

Claims 1-9 are grouped to stand or fall together (Br5).  
Claims 20 and 21 are argued separately (Br5).

Claims 1-9

"Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention."  
RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Matthies is directed to the Balloon Help system used by the Macintosh System 7 Operating System. When the cursor is positioned within a predefined screen rectangle, called a hot rectangle, a balloon appears containing a message about that area. When the cursor moves out of the area defined by the hot rectangle, the balloon disappears. The balloon appears as a rounded rectangle with a pointer called the tip. Matthies states (p. 1): "The programmer specifies where the tip should be; and the Help Manager is responsible for selecting one of the eight possible balloon positions so the help message is clearly visible on-screen." This is

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described in more detail in the reference Inside Macintosh, Volume VI (Addison-Wesley 1991), pp. 11-3 to 11-10, submitted as Appendix B to Appellants' brief. As discussed in Inside Macintosh, the programmer specifies a variation code, which specifies the preferred position of the help balloon relative to the hot rectangle (p. 11-7), and the tip position (p. 11-10).

The relevant portion of claim 1 recites "an information cursor with a pointing portion . . . and an information portion for displaying information that is displayed in a selected relative position with respect to the pointing portion."

The Examiner states for the first time in the Examiner's Answer that "the term 'relative position' is indefinite [sic, indefinite] therefore regardless where the cursor may be on the object, the information cursor would be displayed in relative position with the cursor" (EA4; see also EA7-8). Appellants respond (RBr3) that the Examiner has not rejected claim 1 as indefinite under 35 U.S.C. § 112, second paragraph, and erred by ignoring the limitation that the "information portion . . . is displayed

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in a selected relative position with respect to the pointing portion." It is argued that the term "relative position" has a known meaning to those of ordinary skill in the art and is defined as follows: "A point defined with reference to another position, either fixed or moving; the coordinates of such a point are usually bearing, true or relative, and distance from an identified reference point." McGraw-Hill Dictionary of Scientific and Technical Terms (3d ed. 1984). The Examiner does not respond to the Reply Brief.

We interpret the term "selected relative position" in the limitation that the "information portion . . . is displayed in a selected relative position with respect to the pointing portion," to require the information portion be at a fixed (selected) position relative to the pointing portion. That is, the information portion location must move in lock step with the pointing portion location to remain in a "selected relative position" with respect thereto. If claim 1 did not include the word "selected," the Examiner may have had a point because a "relative position" alone specifies no particular relationship and can include the relative position of a moving object (the

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cursor) with respect to a stationary object (the balloon). The term "selected relative position" is definite and is not broad enough to read on a stationary information portion and a moving pointing portion. The balloon in Matthies (and Inside Macintosh) stays anchored at its tip position once it appears regardless of the position of the cursor within the hot rectangle. Thus, Matthies does not disclose that the "information portion . . . is displayed in a selected relative position with respect to the pointing portion." Accordingly, the anticipation rejection of claim 1 is reversed. The obviousness rejection of claim 2 does not supply any reasons which would cure the deficiency of Matthies as to claim 1 and, thus, the rejection of claim 2 is reversed. Steele does not cure the deficiency of Matthies as to claim 1, for the reasons discussed infra, and, thus, the rejection of claims 2-9 over Matthies and Steele is reversed.

The Examiner also stated (EA8):

Claim 1 does not require to display the cursor even though the cursor is included as part of the objects. The pointing portion or cursor is not shown on the Figure, however, the cursor must be a part of the information cursor because the balloon would only pop up if the cursor was positioned over the object . . . .

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Appellants argue that claim 1 requires display of the information cursor (RBr8). We read the Examiner's action as referring to the pointing portion of the cursor, not the information portion. Claim 1 clearly requires display of a cursor with a pointing portion and, when the pointing portion is positioned over an object, display of the information portion of the cursor. What the Examiner may have been trying to get at was that the figure in Matthies does not specifically show a pointing cursor (because it only shows how the balloons are created), but that a cursor must be present and does not prevent Matthies from being an anticipation. It is clear that Matthies has a cursor with a pointing portion, although not shown, as evidenced by Inside Macintosh. Appellants do not contest that Matthies has a cursor with a pointing portion which remains visible when the balloon is displayed.

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Claims 20 and 21

Matthies

The Examiner does not repeat, but does not withdraw, the final rejection's anticipation rejection of claims 20 and 21 over Matthies. Any rejection not repeated and discussed in the examiner's answer may be taken by the Board as having been withdrawn. Ex parte Emm, 118 USPQ 180, 181 (Bd. App. 1957). However, the Board has discretion to consider the rejection. See Manual of Patent Examining Procedure § 1208 (under "ANSWER": "Grounds of rejection not argued in the examiner's answer are usually treated as having been dropped, but may be considered by the Board if it desires to do so." ). The reason is that it is technically the examiner's final rejection that is being reviewed under 35 U.S.C. § 134. See In re Webb, 916 F.2d 1553, 1556, 16 USPQ2d 1433, 1435 (Fed. Cir. 1990):

The regulations require that, "[i]n making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable in the case, clearly stating the reasons therefor." 37 C.F.R. § 1.113(b). It follows, then, that an examiner's final rejection, which precipitates the statutory right to appeal to the Board, 35 U.S.C. § 134 (1988), constitutes the "decision" of an examiner for purposes of § 1.196(a).").

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Appellants are not harmed by any treatment of a rejection not repeated in the Examiner's Answer because the brief addresses the final rejection. In this case, we have decided to review the rejection over Matthies for completeness.

Dependent claim 21 recites that "the information displayed in the cursor is moved the same distance and in the same direction as the rest of the cursor." This is interpreted to have the same meaning as the "information portion . . . is displayed in a selected relative position with respect to the pointing portion" in claim 1. Since claim 21 defines that the information is moved the same distance and direction as the rest of the cursor, this limitation is not part of independent claim 20. The question we asked at oral hearing is how the subject matter of claim 20 distinguishes over the Matthies.

Counsel for Appellants argued that a "cursor" is defined as "a movable item used to mark a position," Merriam-Webster's Collegiate Dictionary (Merriam-Webster, Inc. 10th ed. 1997) and that claim 20 recites displaying the information "within the cursor." Thus, claim 20 requires

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the information be movable with the cursor, because it is "within the cursor," although it need not move in lock step as required by claim 21, and defines over Matthies in which the balloon remains at a fixed location.

We agree with counsel's claim interpretation and arguments. Thus, we reverse the anticipation rejection of claims 20 and 21 over Matthies.

Steele

Steele discloses an interactive method of communicating with a language deficient user, such as an aphasic patient. The Examiner's rejection relies on figure 13g as teaching a "visual element" (an icon describing pouring) with the cursor positioned next to it (EA6). The Examiner states (EA6-7): "[w]hen the cursor is moved into a region containing the visual element, the cursor would display information relating to the displayed visual element (see Figure 13g and Abstract, lines 10-13)."

Appellants argue that figure 13g does not depict displaying within the cursor information relating to a pointed-to visual element, but only shows dragging icons corresponding to ideas into the top portion of a phrase window in order to translate them into textual language in a field at the bottom of the phrase window (RBr5).

Appellants argue that lines 10-13 of the abstract refer to figures 4a-6c in which a user selects a tool icon, such as the Phrase Viewing Tool (shown as a pair of eye glasses) in figure 4a, with the cursor, and the image of the cursor changes to the image of the tool icon (RBr5). It is argued

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(RBr5): "Because the appearance of the cursor in this state exactly matches the appearance of the tool icon that was already displayed in the tool icon palette, this feature of the Steele patent does not disclose displaying within the cursor presently undisplayed information relating to the displayed visual element as recited by the amended claim."

The Examiner relies on two unrelated parts of Steele. It is noted that the arrow next to the icon for pouring in figure 13g is not a cursor, as stated by the Examiner, but serves as a visual reminder that this icon can be animated by clicking the arrow cursor on it (col. 12, lines 26-31). The cursor is shown at the far right of the phrase window. Nothing in figure 13g shows that previously undisplayed information would be displayed "within the cursor" upon selecting an icon. The icon changes, not the cursor.

We agree with Appellants that lines 10-13 of the abstract refer to figures 4-6. Selecting a tool causes the cursor to be activated and to take on the appearance of the tool. The cursor tool is then used to perform a function. For example, in figure 4, when the cursor is placed on an icon (col. 5, lines 41-44): "The computer displays a phrase

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in the Phrase Window which is associated with the Cursor Tool acting upon the icon. The cursor then returns to the default display of the arrow (step 3)." Thus, previously undisplayed information is not displayed "within the cursor."

For the reasons discussed above, we conclude that the Examiner erred in finding claim 20 anticipated by Steele. The rejection of claim 20 is reversed. The obviousness rejection of claim 21 does not cure the deficiency with respect to claim 20. Thus, the rejection of claim 21 is reversed.

The Examiner has stated "that the language 'the cursor information' lacks of [sic] antecedent basis" (EA7). Appellants respond that when the claim language is properly parsed, the definite article "the" modifies only the word "cursor," not the words "cursor information," and the claim is not defective (RBr8-9). We agree with Appellants' argument that "the" modifies only the word "cursor" and that there is no antecedent basis problem.

#### CONCLUSION

The rejections of claims 1-9, 20, and 21 are reversed.

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REVERSED

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