

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(2) is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MAKOTO MATSUYAMA

Appeal No. 1999-0081
Application 08/506,645

HEARD: May 9, 2001

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

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 1 through 5 and 8 through 17, which constitute all the claims remaining in the application.

Representative claim 1 is reproduced below:

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1. A position inputting device for use with video signal processing, comprising:

operating means movable in arbitrary directions;

two-dimensional position detection means for detecting the operating positions of said operating means and generating two dimensional first and second coordinate data;

a switch;

control means for switching said operating position between two-dimensional first and second coordinate data and one dimensional coordinate data, responsive to first and second actuating states of said switch, respectively; and

picture processing means for moving a predetermined position of video signals within a picture based on the first and second coordinate data when said switch is in the first state and for altering a range of positions of the video signals within the picture based on the one-dimensional coordinate data when the switch is in the second state.

The following references are relied on by the examiner:

Corballis et al. (Corballis)	5,512,892	Apr. 30, 1996
	(filing date Feb. 25, 1994)	
Engle et al. (Engle)	5,541,622	Jul. 30, 1996
	(filing date Aug. 09, 1993)	

SUPERPAINT, Silicon Beach Software, page 15 (1988).

All claims on appeal, claims 1 through 5 and 8 through 17

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stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon SUPERPAINT alone as to claims 1 through 5 and 8 through 14. The examiner adds Engle as to claims 15 and 17, and adds to this combination, Corballis as to claim 16.

Rather than repeat the positions of the appellant and the examiner, reference is made to the briefs and the answer for the respective details thereof.

OPINION

We reverse all rejections of the claims on appeal.

Both independent claims 1 and 5 on appeal reflect that the switch has first and second actuating states. This feature is more positively recited in independent claim 1 and more implicit in the switching action of the control means in claim 5. In one state the switch enters two-dimensional information and in a second state the switch enters one-dimensional information. The focus of the arguments between appellant and the examiner with respect to claim 1 relates to the second state of the switch causing the picture processing

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means of this claim to operate in such a manner as "for altering a range of positions of the video

signals within the picture based on the one-dimensional coordinate data." Correspondingly, in claim 5 the focus is on the function of the picture processing means which "converts one-dimensional information from the two-dimensional position detection means into range data of the input video signals."

As to both independent claims, the examiner's position to the rejection is best expressed at page 6 of the answer:

[The] SUPERPAINT reference clearly discloses altering the range of position of the video signals when the shift key is pressed. For example, at page 15, [the] SUPERPAINT reference discloses that the shift key restricts the pencil's trails to either vertical or horizontal motion. The direction of the constraint is based on the direction of the pencils's first motion. This feature clearly reads on the limitation of "for altering a range of position of the video signals within the picture based on the one-dimensional coordinate data when the switch is in the second state" as required in [the] claims.

The examiner's statement as to the shift key restricting the pencil's trail to either vertical or horizontal motion is

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an accurate reflection of the function of the shift key in relationship to the operation of the mouse at page 15 of SUPERPAINT. The examiner's views with respect to the claims on appeal is only partially correct in that claim 5 does not contain corresponding language quoted from claim 1 as argued by the

examiner. As noted earlier, claim 5 requires that the picture processing means convert one-dimensional information into range data of the input video signals. This feature distinguishes over the teaching argued by the examiner in the context of the recitation in claim 1 on appeal because it is clear to us that

there is no conversion of anything by the actuation of shift key in the context of the joint action with respect to the mouse as taught at page 15 of SUPERPAINT. The shift key does not convert or cause to be converted, one type of information into another type of information as the claim requires, and the examiner does not directly address this limitation in this claim. As such, we must reverse the rejection of independent

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claim 5 and its respective dependent claims further relying in part upon Engle and Corballis.

On the other hand, the examiner's views expressed at page 6 of the answer are consistent with the language expressed in independent claim 1 as we noted earlier. Appellant's position on the other hand as to this rejection of independent claim 1 (as well as independent claim 5) is best expressed at page 8 of the

brief where appellant argues that the function of the separately claimed switch is such as to enlarge or reduce the "range" of the region of positions of the video signals. Appellant relies on the teachings at page 12 of the specification in support of this view. However, we note that the claim does not specifically state that the claimed "altering" enlarges or reduces the range of a region.

As to this rejection, appellant's positions are more developed at pages 2 through 4 of the reply brief where the appellant again refers to page 12 of the specification as a

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basis for the view that the use of the word "range" is that the respective key actuation of the claimed switch enlarges or reduces the range of a region. Appellant's position at pages 3 and 4 of the reply brief is such that when viewed in light of the specification's disclosure, the word "range" is essentially defined in the specification to mean an enlargement or reduction of the size or range of a region of the video signal.

Our study of the specification as filed as a whole is consistent with this view. Beginning with the discussion of the

prior art at page 1 of the specification as filed, it is noted at the bottom of that page that it was known in the art to utilize an operating lever to enter coordinate or X, Y position information "and to set the input picture size or range using an operating button, such as a so-called volume knob". The setting action "altered" the size or range of the input picture. In this light, the word "range" appears to be

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known in the art to be "settable" or convey the concept of a change in size or range by use of a operating button which does not necessarily have two

claimed states as recited in the claims on appeal.

Appellant's position in the brief and reply brief in substance argues that the word "range" in the art and in the

specification as filed means enlargement or reduction in size of the range of positions of video signals. The remaining

part of the specification verifies the positions taken by

appellant in the brief and reply brief with respect to the discussion at the middle of page 12 of the specification.

Note also the more detailed discussion at the bottom of page

14 through the top of page 16 and the discussion in the

paragraph bridging pages 17 and 18 of the specification as

filed.

Inasmuch as the term "range" has an apparent meaning of size in the art as well as that it may be "set" or "altered" such as to change the size or enlarge or reduce the size of video signals of an image, we reverse the rejection of claim 1

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and by inference, its dependent claim 2 through 4. As indicated at the bottom of page 4 of the reply brief, SUPERPAINT clearly does not show an enlargement or reduction of the range of the displayed region, that is, it clearly does not show a change of size of the displayed region by the operation of the shift key because it only is taught to restrict a pencils's trail to either a vertical or horizontal motion. Therefore, we construe the language of claim 1 of "altering a range of positions of the video signals" as requiring a change or alteration of size of the video signals such as to either enlarge or reduce them. In light of these considerations, we also reverse the rejection of independent claim 5 for similar reasons since it particularly recites the feature of "range data" at the end of this claim.

In view of the foregoing, the decision of the examiner rejecting claims 1 through 5 and 8 through 17 under 35 U.S.C.

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§ 103 is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES

llb/vsh

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BARRY, Administrative Patent Judge, Dissenting:

Although I agree with the majority's decision to reverse the rejection of claims 5 and 8-17 under 35 U.S.C. § 103(a), I disagree with their decision to reverse the examiner's rejection of claims 1-4 under § 103(a) as being obvious over SuperPaint. After considering the record, I am persuaded that the examiner did not err in rejecting claims 1-4 under § 103(a) as being obvious over SuperPaint. Accordingly, I would affirm the rejection of claims 1-4. My opinion addresses the grouping and obviousness of these claims.

I. Grouping of Claims 1-4

In general, 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). When the patentability of dependent claims in particular is not argued separately, the claims stand or fall with the claims from which they depend. 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).

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Here, the appellant asserts, "[c]laims 1 to 5 ... stand or fall together" (Appeal Br. at 7.) Concomitantly, he fails to allege that, let alone explain why, claims 2-4 are separately patentable from claim 1. Therefore, claims 1-4 stand or fall together, with claim 1 representing the group. With this representation in mind, I address the obviousness of the claims.

II. Obviousness of the Claims

I begin by noting the following principles from In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).... "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, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

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In addition, the references 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 that the Board of Patent

Appeals and Interference did not err in concluding that the level of ordinary skill 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, "[e]very patent application and reference relies to some extent upon knowledge of persons skilled in the art to complement that [which is] disclosed'" In re Bode, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977) (quoting In re Wiggins, 488 F.2d 538, 543, 179 USPQ 421, 424 (CCPA 1973)). Those persons "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). With these principles in mind, I agree with the majority that "[t]he focus of the arguments between appellant and the examiner with

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respect to claim 1 relates to the second state of the switch causing the picture processing means of this claim to operate in such a manner as 'for altering a range of positions of the video signals withing the picture based on the one-dimensional coordinate data.'"

"In the patentability context, claims are to be given their broadest reasonable interpretations. 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, representative claim 1 specifies in pertinent part the following limitations: "picture processing means for moving a predetermined position of video signals within a picture based on the first and second coordinate data when said switch is in

¹ Claims are to be given their broadest reasonable interpretation during examination because an "applicant may then amend his claims, the thought being to reduce the possibility that, after the patent is granted, the claims may be interpreted as giving broader coverage than is justified." In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969).

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the first state and for altering a range of positions of the video signals within the picture based on the one-dimensional coordinate data when the switch is in the second state." As the majority notes, the "[a]ppellant relies on the teachings at page 12 of the specification in support of this view." I agree with the majority, however, "that the claim does not specifically state that the claimed 'altering' enlarges or reduces the range of a region." Giving the claim its broadest

reasonable interpretation, therefore, the limitations merely require moving video signals within a picture based on two-dimensional first and second coordinate data when a switch is in a first state and altering a range of positions of the video signals within the picture based on one-dimensional coordinate data when the switch is in a second state.

The prior art would have suggested the limitations. SuperPaint teaches moving video signals that depict a "Pencil tool," p. 15, within a picture as shown in Figure 2.3 of the reference. SuperPaint further teaches a switch, viz., "[t]he Shift key," id., that can be deactivated or activated. When

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the key is deactivated, Figure 2.3 shows that the tool can be moved in two-dimensions, viz., vertically and horizontally. When the key is activated, however, the tool can be moved only in one dimension, viz., either vertically or horizontally. Specifically, "[t]he Shift key restricts the pencil's trail to either vertical or horizontal motion." Id. The majority admits as much by stating, "[t]he examiner's statement as to the shift key restricting the pencil's trail to either vertical or horizontal motion is an accurate reflection"

Because SuperPaint teaches a Shift key that can alter a range of positions of the Pencil tool from two-dimensions to one dimension, I am persuaded that the teachings of the reference in combination with the prior art as a whole would have suggested the claimed limitations of "picture processing means for moving a predetermined position of video signals within a picture based on the first and second coordinate data when said switch is in the first state and for altering a range of positions of the video signals within the picture based on the one-dimensional coordinate data when the switch

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is in the second state." Therefore, I would affirm the rejection of claims 1-4 as being obvious over SuperPaint.

LANCE LEONARD BARRY)
Administrative Patent Judge)

llb/vsh

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