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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOHN LOUCH

Appeal 2017-002119
Application 11/693,604
Technology Center 2100

Before ST. JOHN COURTENAY III, JAMES R. HUGHES, and
JOYCE CRAIG, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of claims 1–4, 8, 11, 13, 14, 18–20, 22, 28–30, 34, 37, 38, 43–47, 50–52, 55, 56, and 60–63, which are all the claims pending in this application. Claims 5, 6, 7, 9, 10, 12, 15–17, 21, 23–27, 31–33, 35–36, 39–42, 48, 49, 53, 54, 57–59, and 64–68 are cancelled. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We reverse.

STATEMENT OF THE CASE

Introduction

Appellant’s invention “relates generally to presenting information within a cursor, and more particularly to techniques for presenting information, within a cursor, about a target represented by an on-screen element.” (Spec. ¶ 2).

Illustrative Claim

1. A method comprising:

moving a cursor on a display of a computing device in response to a first user input to the computing device; and

while the cursor is positioned at a first location to point to a user-activatable element referencing a link that corresponds to content:

presenting, alongside the cursor, a user interface element including a preview of the content at a first size;

while displaying the user interface element alongside the cursor, detecting a press input with an input mechanism; and

responsive to receiving the press input, displaying additional information in the preview of the content, [L] *the additional information being displayed only as long as the press input is held down.*

(Emphasis added regarding contested limitation L).

Rejection

Claims 1–4, 8, 11, 13, 14, 18–20, 22, 28–30, 34, 37, 38, 43–47, 50–52, 55, 56, and 60–63 are rejected under pre-AIA 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of Kelly et al. (US 2006/0101341 A1) (hereinafter “Kelly”), in view of Branson et al. (US

2005/0114778 A1) (hereinafter Branson), and further in view of Thames et al. (US 2003/0145281 A1) (hereinafter Thames).

Issue on Appeal

Did the Examiner err in rejecting claims 1–4, 8, 11, 13, 14, 18–20, 22, 28–30, 34, 37, 38, 43–47, 50–52, 55, 56, and 60–63 as being obvious over the cited combination of references under pre-AIA 35 U.S.C. § 103(a)?

ANALYSIS

We have considered all of Appellant’s arguments and any evidence presented.

Claim 1 rejected under § 103(a)

Issue: Under pre-AIA 35 U.S.C. § 103(a), did the Examiner err by finding Kelly, Branson, and Thames collectively teach or suggest contested limitation L:

responsive to receiving the press input, displaying additional information in the preview of the content, [L] *the additional information being displayed only as long as the press input is held down* [,]

within the meaning of representative claim 1?¹ (Emphasis added regarding contested limitation L).

¹ We give the contested claim limitations the broadest reasonable interpretation (BRI) consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

Appellant notes possible dictionary interpretations of limitation L of claim 1, inter alia:

Each of the independent claims recites “*the additional information being displayed only as long as the press input is held down.*” In ordinary English, the phrase “as long as” has multiple meanings. One of those meanings is “provided that.” Another meaning is “for the duration” or “during the time that.” Interpreting which of these meanings is used in the claim is not a matter of reading in limitations from the specification, but of correctly interpreting the claims in light of the specification.

App. Br. 10 (emphasis added).

Appellant cites to various dictionaries in support of various plain meanings. (*Id.*, fn. 15–17). Appellant then focuses on claim construction in light of the Specification, citing to Spec. ¶ 57, contending:

it is clear that the embodiment in which “**information only remains in cursor 303 as long as**” **the press input is received** is distinct from the embodiment in which the press input merely acts as a “toggle.” In the “**as long as**” embodiment, the **information is presented while the key is pressed down, and ceases to be presented when the key is released.** In the “toggle” embodiment, the information is presented when the key is pressed, continues to be shown when the key is released, and is hidden when the key is pressed a second time.

App. Br. 11 (emphasis added).

The Examiner disagrees, and construes the contested claim language broadly under BRI: “First of all, it should be noted that paragraph [0057] of the specification states, in part, ‘the additional information **only remains in cursor 303 as long as** the modifier key or other key **is held down.**’” (Emphasis added). From this support, the Examiner concludes the claim language “as long as the press input is held down” can be construed under

BRI such that “the additional information is displayed *as provided that a key is pressed or a command is executed.*” (Ans. 3) (emphasis added).

In the Final Action (4), the Examiner relies on Thames, Figure 68, and paragraph 974, in combination with Kelly and Branson, for teaching or suggesting the contested claim limitation: “the additional information being displayed **only as long** as the press input is held down [(fig. 68; 0974)].” (Emphasis added).

Turning to the evidence, paragraph 974 of Thames describes Figure 68, in pertinent part:

When the manager goes to the display for patch smatrix and does a mouseover of answer symbol **6775 (FIG. 68)**, tooltip **6710** appears with the original query. However, the question mark at the end of the query is now a link. Hence, if the manager holds control key **6890** down, positions cursor **1601** on the link, and clicks a mouse key, a popup answer window **6810** is presented that contains the answer to the query.

The Examiner provides a rationale to modify the combination of Kelly and Branson with Thames, as follows:

it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system, disclosed in Kelly and Branson, to include: *the additional information being displayed only as long as the press input is held down*, for the purpose of providing for user to view information intuitively, as taught in Thames.

(Final Act. 4).

We find the dispositive point of disagreement in this appeal turns upon the Examiner’s broader claim construction: “It should be noted that in the interpretation of [A]ppellant regarding [the] ‘as long as’ embodiment, the

operation of which ‘the information ceases to be presented when the key is released’ **has been assumed** and is *not consistent with the supporting description of the specification.*” (Ans. 4) (emphasis added in bold and italics, underline omitted).

We disagree. As recently emphasized by our reviewing court in *Smith*:

Even when giving claim terms their broadest reasonable interpretation, the Board cannot construe the claims “so broadly that its constructions are *unreasonable* under general claim construction principles.” *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015). “[T]he protocol of giving claims their broadest reasonable interpretation . . . does not include giving claims a legally incorrect interpretation” “divorced from the specification and the record evidence.” *Id.* (citations and internal quotation marks omitted); *see PPC Broadband, Inc. v. Corning Optical Commc'ns RF, LLC*, 815 F.3d 747, 751–53 (Fed. Cir. 2016).

...

The correct inquiry in giving a claim term its broadest reasonable interpretation in light of the specification is not whether the specification proscribes or precludes some broad reading of the claim term adopted by the examiner. And it is not simply an interpretation that is not inconsistent with the specification. It is an interpretation that corresponds with what and how the inventor describes his invention in the specification, i.e., an interpretation that is “consistent with the specification.” *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997) (citation and internal quotation marks omitted); *see also In re Suitco Surface*, 603 F.3d 1255, 1259–60 (Fed. Cir. 2010).

In re Smith Int’l, Inc., 871 F.3d 1375, 1382–83 (Fed. Cir. 2017).

Applying our reviewing court’s guidance here, we broadly but reasonably interpret the disputed claim language in a manner consistent with

Appellant's Specification. (*Id.*). As pointed out by Appellant (App. Br. 10) we find the contested claim limitation L (“*the additional information being displayed only as long as the press input is held down*” finds clear support in at least the third sentence of paragraph 57 of the Specification: “Thus, the user can indicate **when** he or she would like to see the additional information in cursor 303. In one embodiment, the additional information **only remains in cursor 303 as long** as the modifier key or other key is **held down.**” (Emphasis added).

Given the aforementioned *context* and support in the Specification (§ 57), we conclude the broadest reasonable interpretation of “*the additional information being displayed only as long as the press input is held down*” (claim 1), that is “consistent with the specification” *Morris*, 127 F.3d at 1054, means that **when** the press input is **not held down**, the additional information is **no longer displayed**. Therefore, we conclude the Examiner's broader construction is overly broad, unreasonable, and inconsistent with the Specification. (Ans. 4).

On this record, we find a preponderance of the evidence supports Appellant's arguments for essentially the same reasons articulated in the Briefs. We note remaining independent claims 22, 28, 30, and 43 recite contested limitation L of claim 1 in similar form having commensurate scope.

Accordingly, we are constrained on this record to reverse the Examiner's § 103(a) rejection of all independent claims on appeal. Because we have reversed the rejection of all independent claims, for the same reasons we reverse the Examiner's § 103(a) rejection of all dependent claims on appeal.

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DECISION

We reverse the Examiner's decision rejecting claims 1–4, 8, 11, 13, 14, 18–20, 22, 28–30, 34, 37, 38, 43–47, 50–52, 55, 56, and 60–63 under pre-AIA 35 U.S.C. § 103(a).

REVERSED