

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

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALLISON A. CARLETON, PAUL A. PETERSON, and
WILLIAM C. SCHWARTZ

Appeal No. 1998-2983
Application No. 08/481,230

ON BRIEF

Before HAIRSTON, KRASS, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-12 and 14-18, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellants' invention relates to a method and apparatus for display of video images in a video conferencing system. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. In a computer having a screen, and being able to communicate with a remotely located computer, a method of displaying a video image comprising the steps of:

a) creating a first type of window on said screen, said first type of window having an image region and a control region, said control region being used for (1) establishing a communication link with said remotely located computer during a first time period, and (2) controlling a communication link with said remotely located computer during a second time period which is different from said first time period;

b) creating a second type of window on said screen;

c) displaying the video image within said image region in said first type of window during said second time period; and

d) displaying a graphics image in said second type of window, wherein said video image displaying step is performed concurrently with said graphics image displaying step.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Maruo et al.(Maruo) EP-0410 378 Jan. 30, 1991

Myers, "Windows Interfaces- A Taxonomy of Window Manager User Interfaces," IEEE Computer Graphics and Applications, Vol. 8, No 5, pp 65-84 (Sept. 1988).

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IBM, "Person to Person, Personal conferencing - communications that work", Ultimedia, October 1991.

Claims 1-6, 9, 15, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Maruo. Claims 10-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Maruo in view of IBM. Claims 7-8, 14, 16, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Maruo in view of Myers.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 27, mailed May 11, 1998) for the examiner's reasoning in support of the rejections, and to appellants' amended brief (Paper No. 26 1/2, filed Oct. 14, 1997) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Appellants have grouped the claims in four separate groupings and provided separate arguments thereto. (See brief at page 9.)

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The basic dispute between appellants and the examiner is based upon the definition of the term "window" in the claims. (See brief at page 12.) Appellants rely upon the express definition in the specification and the examiner relies upon the ordinary usage in the relevant field.

Before addressing the examiner's rejections based upon prior art, it is an essential prerequisite that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art under 35 U.S.C. §§ 102 and 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. **See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.**, 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988). Accordingly, we will initially direct our attention to appellants' claim to derive an understanding of the scope and content thereof.

Before turning to the proper construction of the claims, it is important to review some basic principles of claim construction. First, and most important, the language of the claim defines the scope of the protected invention. **Yale Lock Mfg. Co. v. Greenleaf**, 117 U.S. 554, 559 (1886) ("The scope of letters patent must be limited to

the invention covered by the claim, and while the claim may be illustrated it cannot be enlarged by language used in other parts of the specification."); **Autogiro Co. of America**

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v. United States, 384 F.2d 391, 396, 155 USPQ 697, 701 (Ct. Cl. 1967) ("Courts can neither broaden nor narrow the claims to give the patentee something different than what he has set forth [in the claim]."). **See also Continental Paper Bag Co. v. Eastern Paper Bag Co.**, 210 U.S. 405, 419 (1908); **Cimiotti Unhairing Co. v. American Fur Ref. Co.**, 198 U.S. 399, 410 (1905). Accordingly, "resort must be had in the first instance to the words of the claim" and words "will be given their ordinary and accustomed meaning, unless it appears that the inventor used them differently." **Envirotech Corp. v. Al George, Inc.**, 730 F.2d 753, 759, 221 USPQ 473, 477 (Fed. Cir. 1984). Second, it is equally "fundamental that claims are to be construed in the light of the specification and both are to be read with a view to ascertaining the invention." **United States v. Adams**, 383 U.S. 39, 49, 148 USPQ 479, 482 (1966).

Furthermore, the general claim construction principle that limitations found only in the specification of a patent or patent application should not be imported or read into a claim must be followed. **See In re Priest**, 582 F.2d 33, 37, 199 USPQ 11, 15 (CCPA 1978). One must be careful not to confuse impermissible imputing of limitations from the specification into a claim with the proper reference to the specification to determine the meaning of a particular word or phrase recited in a claim. **See E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co.**, 849 F.2d 1430, 1433, 7 USPQ2d 1129, 1131 (Fed.

Cir. 1988), **cert. denied**, 488 U.S. 986 (1988). What we are dealing with in this case is the construction of the limitations recited in the appealed claims.

The specification expressly states that

[t]he term "window" as used herein means a region (usually rectangular) of a computer display screen which the operating system of the computer grants use of to an application. The window has associated controls which direct the actions of the application. The size and location of the window on the display screen can also be changed by the user of the computer.

A computer having the ability to display multiple windows provides visual access to the application running in each of the windows. Typically, the user of the computer can scale, move and otherwise arrange the windows on the screen. (Specification at page 5.)

While we agree with appellants that the term "window" is specifically defined in the specification. The generally accepted definition in the relevant area of the prior art does not require that a "window has associated controls which direct the actions of the application." The term "window" is defined in **The American Heritage® Dictionary of the English Language** as "a small area on a screen in which a file or a part of a file can be displayed."¹ Furthermore, the **Microsoft Press Computer Dictionary**, Third Edition (1997) defines window as "[i]n applications and graphical interfaces, a portion of the screen that can contain its own document or message. In window-based programs,

¹ *The American Heritage® Dictionary of the English Language, Third Edition* copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSO Corporation; further reproduction and distribution restricted in accordance with the Copyright Law of the United States. All rights reserved. A copy attached to decision.

the screen can be divided into several windows, each of which has its own boundaries and can contain a different document (or another view into the same document).”² These two definitions appear to agree with the examiner’s interpretation of “window” without any associated control. We agree with the examiner that a “window” need not be required to have any associated controls which direct the actions of the application.

With this said, we further find that any window from a MICROSOFT Windows operating system which is opened on a computer screen necessarily would have some controls associated with opening, closing or adjusting the window (whether or not the controls are present within the window is a separate issue which we need not address here). With respect to the location of the control of an application within a window, we disagree with appellants’ implied argument that the claim language requires that there be control associated with the window and the control must be within the window. Specifically, dependent claim 6 recites activation of a control element in the first type of window. Furthermore, to distinguish between each window having associated control, independent claims 1, 5, 7, 9, 10, and 18 each recites a control region which specifically requires the control functionality in one of the windows, but is silent with respect to the other window(s). Therefore, we find that the language of the claims, given their ordinary and

²A copy attached to decision.

accustomed meaning, would not require a “window” to have any specific associated controls or control area without explicit recitation thereof.

In our view, to require the association of control functions with each window would be paramount to reading that limitation from the specification into the claim in view of the ordinary and accustomed meaning of the term “window.” Appellants further argue that both the first and second windows must have associated controls and have the ability to be resized by the user. (See brief at page 13.) We disagree with appellants, as discussed above.

With respect to the teachings and suggestions in Maruo, appellants again rely solely upon the definition of “window” in the specification to distinguish the claimed invention as recited in claim 1. (See brief at page 14.) We disagree with appellants.

Appellants further argue that the window is required to have the functionality that “the size and location of the window on the display screen can also be changed by the user of the computer.” (See brief at page 13.) We find no support for this limitation in the express language of claim 1. Therefore, this argument is not persuasive.

With respect to claim 1, we note that Figure 6 shows the display menus according to an embodiment of the invention. We note that the display of Maruo has areas:

111- common display, 112- other party dynamic picture area, 113- own dynamic picture area, and 114- meeting progress menu display area. (See Maruo at col. 10, lines 23-29.)

Area 114 contains controls associated with the window which directs the action of the application.

With respect to the associated controls in the second window, the language of claim 1 does not require that any associated control be present nor that the control be within the window. We note that any independent window would have some control associated therewith to allow the window to be closed and/or resized, if available.

Here, from the teaching of Maruo, the window areas are set in size, due to the structured configuration of the display area. But, if the windows were to include independent configurability, then there would have been a required function to control the size along with the ability to close each window. Here, we disagree with appellants that the language of claim 1 requires associated control with each of the two windows and further that the language of claim 1 does not require that the “size and location of the [second] window . . . be changed.” (See brief at page 13.)

Here, we note that appellants are relying on material within the specification for patentability. We disagree with appellants’ use of a definition to incorporate additional substantive limitations as to the functionality of the claimed invention as to the requirement of associated controls and the ability to resize the window. Furthermore, this is especially problematic when one window within the claim explicitly recites the presence of a control region within the window and one window is silent as to a control region or any control

functionality associated therewith. Here, we agree with the examiner that the ordinary definition of a window is appropriate (see answer at page 13), and we find that appellants' definition attempts to import substantial limitations from the specification into the claim rather than to include an express limitation in the language of the claim itself. Therefore, this argument is not persuasive.

The examiner relies upon the transition from Figures 1(A) to 1(B) where image of both parties are simultaneously displayed in windows 112 and 113 where image 112 is automatically (see Maruo at col 22, lines 21-27 and col. 23, lines 46-49) switched from window 111/117 to window 112. Thereafter, window 111 is used for graphical display of meeting materials. (See answer at pages 3-5.) ; (See Maruo figures 1(A), 1(B) and 6.)

With respect to claims 2-4, appellants have not set forth separate arguments for patentability of these claims, therefore, claims 2-4 fall with claim 1.

With respect to claim 5, Maruo teaches the automatic transfer of the video image from the common image display area 111 to the other party dynamic picture image area upon display of the principal picture 120 in figure 1(B). Again, appellants argue that the associated controls are required by the definition of a window. Again, we disagree with appellants. Therefore, this argument is not persuasive.

With respect to claim 6, appellants argue that Maruo does not disclose or suggest the “activating a control element in said first type of window to recreate said second type of window.” We agree with appellants. While the examiner does not address the language of claim 6, in the actual text of the rejection, the examiner discusses claim 6 at page 14 of the answer. The examiner maintains that the language of claim 6 is so broad as to read on starting a meeting a second time after the first meeting. (See answer at page 14.) We disagree with the examiner since, in our view, this would not be a recreating, but an initial creating of the window. Therefore, this argument by the examiner is not persuasive, and we cannot sustain the rejection of claim 6.

With respect to claims 9, 15, and 18, appellants rely upon the argument with respect to claim 1. Therefore, this argument is not persuasive and the claims fall with claim 1.

With respect to claims 10-12, appellants rely upon the argument with respect to claim 1. Therefore, this argument is not persuasive and the claims fall with claim 1.

Appellants do not argue or discuss the combination of Maruo and IBM.

With respect to claim 7, appellants again argue the definition of a window in the specification. We disagree with appellants. Clearly, the explanation mode selection menu 505 of Maruo would have controls which allow the user to change the actual drawing within the shared space/window. Therefore, we find this argument unpersuasive.

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With respect to claim 8, appellants rely upon the argument presented with respect to claim 6 and the activation of a control to transfer the video picture back to a third type of window. As with claim 6, the examiner has not addressed the language of claim 8 in the rejection or in the response to the arguments section. Similarly, we cannot sustain the rejection of claim 8 for the same reasons with respect to claim 6.

With respect to claims 14, 16 and 17, appellants rely upon the argued allowability of claim 18 for patentability. We disagree with appellants as discussed above with respect to claim 1, which is grouped with claim 18. Therefore, we sustain the rejection of these claims for the same reasons with respect to claim 18.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-5, 7 and 9-12, and 14-18 under 35 U.S.C. § 103 is affirmed, and the decision of the examiner to reject claims 6 and 8 under 35 U.S.C. § 103 is reversed.

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

AFFIRMED-IN-PART

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KENNETH W. HAIRSTON
Administrative Patent Judge

ERROL A. KRASS
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

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INTELLECTUAL PROPERTY SECTION
LAW DEPARTMENT ECD2 NCR CORPORATION
101 W. SCHANTZ AVENUE
DAYTON, OH 45479-0001