

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

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SANFORD H. RUSSELL, JR., DOUGLAS S. DENNIS
and RICHARD J. CAREY

Appeal No. 1998-3385
Application No. 08/601,551

ON BRIEF

Before KRASS, BARRETT, and FLEMING, Administrative Patent Judges.

FLEMING, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 30-37, 40, and 42-43. Claims 1-29, 38-39, and 41 have been canceled.

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The invention relates to a computer-controlled system for annotating a three-dimensionally displayed and manipulable model and for linking multimedia functions to the annotated model by means of three-dimensional pointers.

Independent claims 30 and 40 are as follows:

30. A computer implemented method of annotating a geometric figure by associating multimedia functions with the geometric figure, for use with a computer system including a display and a user input control device, said method comprising the steps of:

(a) displaying the geometric figure on the display, the geometric figure being interactively manipulable in three dimensions in response to the user input control device;

(b) displaying a pointing icon on the display;

(c) interactively positioning the pointing icon at a desired three-dimensional location relative to the geometric figure, wherein the pointing icon moves with the geometric figure when the geometric figure is manipulated in three dimensions;

(d) associating a specified multimedia function with the pointing icon;

(e) interactively activating the pointing icon; and

(f) in response to the activating of the pointing icon, performing the specified multimedia function associated with the pointing icon.

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Claims 30-37, 40, 42-43, and 54 are rejected under 35 U.S.C. § 103 as being unpatentable over Borovoy et al. in view of Woolsey, Lisle, and Vu/Post. Appellants group claims 30-37 and 42-43 together to form Group 1, while claim 40 alone forms Group 2.

Rather than reiterate all arguments of Appellants and Examiner, reference is made to the brief and answer for the respective details thereof.

OPINION

We will not sustain the rejection of claims 30-37, 40, and 42-43 under 35 U.S.C. § 103.

As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim" (Fed. Cir. 1998). Moreover, when interpreting a claim, words of the claim are generally given their ordinary and accustomed meaning unless it appears from the specification or the file history that they were used

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differently by the inventor. ***Carroll Touch, Inc. v. Electro Mechanical Sys., Inc.***, 15 F.3d 1573, 1577, 27 USPQ2d 1836, 1840. Although an inventor is indeed free to define the specific terms used to describe his or her invention, this must be done with reasonable clarity, deliberateness, and precision. ***In re Paulsen***, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

Turning first to the rejection of claims in Group 1, the Board notes that claim 30 is directed to a computer implemented method for annotating a geometric figure. The method includes steps of displaying the figure which may be manipulated interactively via a user control device and displaying an icon in the form of a pointer. The pointer is positioned at a desired three-dimensional location relative to the geometric figure. Whenever the figure is moved, the icon moves in concert with it. Associated with the icon is a specified multimedia function which is initiated by activation of the pointing icon.

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Appellants argue; (1) there would have been no motivation to alter the annotation system of Borovoy to include the note marker of Vu/Post modified to be a three-dimensional pointer of the Woolsey-Lisle combination; and (2) the references taken in combination or alone do not teach or suggest the claimed invention.¹

As noted by our reviewing court, the Examiner must set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings. *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." *Para-Ordnance Mfg., Inc. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1087, 37 USPQ2d 1237,

¹ See pages 7 and 8 of the brief.

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1239 (Fed. Cir. 1995), **cert. denied**, 117 S. Ct. 80 (1996)
citing W. L. Gore & Assocs., Inc., v. Garlock, Inc., 721 F.2d
1540, 1548, 220 USPQ 303, 309 (Fed.Cir. 1983), **cert. denied**,
469 U.S. 851 (1984).

The Examiner points to reasons for combining features from Woolsey and Lisle in the body of the rejection. However, no reasons are provided therein for combining features of Vu/Post into Borovoy or for combining features from Woolsey or Lisle into Borovoy or Vu/Post.² In addition, the Examiner argues that the skilled artisan would have been motivated to combine the teachings of the cited references as "Borovoy provides explicit teachings for annotating a 3-D model, that Vu/Post and Woolsey provides [sic] explicit teachings for logically and visually anchoring annotations with [a] 2-D pointer in a 2-D image and that Lisle merely teaches that 3-D pointers were known in that art."³

² See page 6 of the answer.

³ See page 8 of the answer.

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The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." **In re Fritch**, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n. 14 (Fed. Cir. 1992), **citing In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). It is further established that "[s]uch a suggestion may come from the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem." **Pro-Mold & Tool Co. v. Great Lakes Plastics**, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996) **citing In re Rinehart**, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976) (considering the problem to be solved in a determination of obviousness). The Federal Circuit reasons in **Para-Ordnance Mfg., Inc. v. SGS Importers Int'l Inc.**, 73 F.3d 1085, 1088-89, 37 USPQ2d 1237, 1239-40 (Fed. Cir. 1995), that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop the prior art,

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would have reasonably expected to use the solution that is claimed by Appellants. However, "[o]bviousness may not be established using hindsight or in view of the teachings or suggestions of the invention." **Para-Ordnance**, 73 F.3d at 1087, 37 USPQ2d at 1239, *citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13.

In addition, our reviewing court requires the Patent and Trademark Office to make specific findings on a suggestion to combine prior art references. **In re Dembiczak**, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

In the instant application, the person of ordinary skill in the art would not have reasonably been expected to look to the on-screen note cards of Vu/Post as a means for providing a pointer or visual indicator in a system as disclosed by Borovoy for displaying a computer model. Nor would he have looked to a system for retrieval of information associated with an on-screen figure as found in Woosley and a system of using a three-dimensional pointer as found in Lisle to provide

a replacement of markers used to present the on-screen note cards.

Turning next to disclosures found in the cited prior art, the Board fails to find any teachings or suggestions in Vu/Post of a visual indicator or anchor. Instead, Vu/Post makes use of a *Posted Notes* function to place 'note cards' on a drawing. A small rectangular marker is drawn in the location in which the note is to be placed. Thus, the marker is a "window" with textual information added to a drawing.⁴ Notwithstanding Examiner's arguments to the contrary, the fact that the drawing marker may be moved from one location to another does not, in and of itself, make it an anchor or visual indicator.⁵ The marker is simply additional information associated with the figure. In addition, Vu/Post makes use of a cursor.⁶ If the system were to be modified to substitute a pointer for an element found within, the most

⁴ See page 29 of reference.

⁵ See page 6 of the answer.

⁶ See page 31 of the reference.

logical choice would have been to change the cursor to a pointer as the pointer is normally an element used in display systems to mark user desired locations.

The Examiner relies on Woolsey for disclosure of a pointer used to initiate multimedia functions and directs attention to Figure 4 of the reference.⁷ Woolsey makes use of a menu for user selection of additional materials relating to the main topic under study. One of these selections is a dramatic presentation in the form of a video. Users are allowed to access information relating to each video frame by clicking directly on the video frame.⁸ If this feature were to be combined with the "three dimensional" pointer of Lisle, then the Lisle pointer would be substituted as a visual indicator of user input means in Woolsey and used to click on the video frame of Woolsey. Incorporation of these combined features into the Borovoy-Vu/Post would have logically

⁷ See page 7 of the answer.

⁸ See page 30 of Vu/Post.

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resulted in the note pad of Vu/Post (i.e., additional information associated with items currently on display) being viewed only upon selection by the "three dimensional" pointer when the user clicks on the three-dimensional model of Borovoy.

Thus, even if the concept of a note marker, and a three-dimensional pointer used to select information associated with displayed figures were added to the Borovoy system, the combination would not result in performance of a multimedia function by "activation" of a pointing icon. Instead, the pointing icon or pointer would have been used to activate selection of information associated with the three-dimensional figure.

In sum, the Board finds no reasons to combine Borovoy, Vu/Post, Woolsey, and Lisle and that if combined the references fail to disclose or suggest all features of the invention recited in claims 30 and 42-43.

Attention is turned next to claim 40, the sole claim in

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the second group. This claim is rejected on the same basis as claims

30-37 and 42-43.⁹ As discussed above, the Examiner fails to provide motivation for combining Borovoy, Vu/Post, Woolsey, and Lisle. Therefore, the rejection of claim 40 on this combination must fail.

In view of the foregoing, we have not sustained the rejection of claims 30, 40, and 42-43 nor of claims 31-37 which depend from claim 30. Accordingly, the Examiner's decision is reversed.

REVERSED

ERROL A. KRASS)
Administrative Patent Judge)

⁹ While paragraph 1, page 3 of the answer lists claim 40 as being rejected over Borovoy in view of Woolsey, Lisle, and Vu/Post, the record fails to reflect a discussion of the elements of claim 40. Likewise, the final rejection mailed August 12, 1997, fails to provide a basis for the rejection. The initial office action mailed January 2, 1997 rejects claim 40 on the same basis as that provided for claims 30-37. However, as claim 40 differs significantly in scope from claims 30-37 and 42-43, the basis of the rejection for this claim remains unclear.

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LEE E. BARRETT
Administrative Patent Judge

MICHAEL R. FLEMING
Administrative Patent Judge

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