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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TORU MORITA, TOMONORI SHIMOMURA,
TAKASHI HATAKEDA, and MUNETAKA TSUDA

Appeal 2015-000908
Application 13/810,780
Technology Center 3700

Before JENNIFER D. BAHR, WILLIAM A. CAPP, and
GEORGE R. HOSKINS, *Administrative Patent Judges*.

HOSKINS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Toru Morita et al. (“Appellants”)¹ appeal under 35 U.S.C. § 134 from the Examiner’s decision rejecting claims 1 and 3–10² in this application.

The Board has jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

¹ The Appeal Brief identifies Sony Computer Entertainment Inc. as the real party in interest. Appeal Br. 2.

² Appellants’ Claims Appendix lists only claims 1 and 8–10. Appeal Br. 14–16. However, the Appeal Brief indicates the appeal concerns claims 1 and 3–10. *Id.* at 3, 13.

CLAIMED SUBJECT MATTER

The independent claims are claims 1, 9, and 10. Claim 1 illustrates the subject matter on appeal, and it recites:

1. An information processing apparatus, comprising:
display element information acquisition means for acquiring display element information output by an application program during an execution of the application program, and storing the display element information in a storage unit; and
program-related image display control means for generating an image including a display element represented by the display element information stored in the storage unit as a program-related image for presenting information relating to the application program, and controlling a display unit to display the generated image during a period in which the application program is not executed,
wherein the display element information acquisition means acquires, along with the display element information, information indicating a display time of the display element information output by the application program; and
wherein the program-related image display control means controls a display timing of the display element represented by the display element information by using the information indicating the display time.

Appeal Br. 14 (Claims App.).

REJECTIONS ON APPEAL³

Claims 1, 3–6, 9, and 10 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Yoshida (JP 11-161405 A, pub. June 18, 1999) and Edlund (US 7,003,735 B2, iss. Feb. 21, 2006).

³ The rejection of claim 8 under 35 U.S.C. § 112, second paragraph, as being indefinite, has been withdrawn. *See* Final Act. 7; Ans. 7.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Yoshida, Edlund, and Sinclair (US 2004/0061714 A1, pub. Apr. 1, 2004).

Claim 8 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Yoshida, Edlund, and Bergman (US 5,601,432, iss. Feb. 11, 1997).

ANALYSIS

A. Obviousness based on Yoshida and Edlund— Claims 1, 3–6, 9, and 10

Independent Claims 1, 9, and 10

Appellants argue for the patentability of independent claims 1, 9, and 10 together as a group. *See* Appeal Br. 10–11. Accordingly, we select claim 1 to decide the appeal of the rejection of these claims, with claims 9 and 10 standing or falling with claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

In rejecting claim 1, the Examiner finds Yoshida discloses the claimed “display element information acquisition information means” and “program-related image display control means” where Yoshida teaches, as shown in Figure 3, that when a user clicks minimize button 43 of window W_2 (Fig. 3(a)), window W_2 is reduced in size by a predetermined ratio as it is closed to become $ICON_2$ (Fig. 3(b)). Final Act. 2–3; *see* Yoshida, Fig. 3, ¶¶ 37–43, 46.⁴ The Examiner finds, when that happens, the program represented by window W_2 “is not executed” as recited in claim 1, but later a user may click on $ICON_2$ to re-execute the program and resume operation in a new window W_2 . Final Act. 3; Yoshida, Fig. 4, ¶¶ 44–46. The Examiner determines Yoshida “lacks specificity as to displaying time information on

⁴ Citations herein to the written description of Yoshida refer to the machine translation provided by the Examiner with the Non-Final Office Action mailed on April 11, 2013.

the minimized icon associated with the respective program or starting or stopping the respective program at predetermined times as claimed.” Final Act. 2.

The Examiner finds Edlund discloses the limitations of claim 1 which Yoshida lacks—that is, the final two “wherein” limitations of the claim.

Final Act. 3 (citing Edlund, 6:45–55).⁵ According to the Examiner:

[Edlund’s] program acquires timing information pertaining to the executable program (the start and stop times at which the program corresponding to the task is to be executed according to the schedule), and expands the program icon into an application window when the program is to start and collapses the application window into a program icon when the program is scheduled to end.

Id. The Examiner further finds Edlund’s “program icons are highlighted and the corresponding program is executed beginning at the time the task is intended to start and ending at the time the task is to end.” *Id.* at 3–4.

The Examiner determines it would have been obvious “to have applied the time-based icons of Edlund” to Yoshida. *Id.* at 4. The Examiner reasons:

Minimized program icons showing times at which programs will be used and maximizing and minimizing programs used at predetermined times will have the advantage of making use of the software maximize more intuitive for the software users, since less input will be required on their part to carry out routine tasks which are best left as automated as possible.

⁵ The final two “wherein” limitations of claim 1 originally appeared in claim 2, which depended from claim 1. *See* Application (filed Jan. 17, 2013), at 46:3–24. After the initial Office Action, Appellants amended claim 1 to include the limitations of claim 2, and canceled claim 2. *See* Amendment (filed July 9, 2013), at 2.

Id.

Appellants argue “in Edlund it is the user that sets the items on the schedule, not the application program” as recited in claim 1. Appeal Br. 10. That is, according to Appellants, claim 1 requires “the display time is output by the application program.” *Id.*

We disagree with Appellants’ construction of claim 1. Appellants apparently rely on the following limitation in claim 1: “wherein the display element information acquisition means acquires . . . *information indicating a display time of the display element information output by the application program.*” Appeal Br. 14 (Claims App.) (emphasis added). Under a broadest reasonable interpretation, the “output” term in that limitation ties the application program *only* to the immediately preceding “display element information,” and not to the “display time.” That interpretation is consistent with the previous recitation in claim 1 of “display element information acquisition means for acquiring *display element information output by an application program.*” *Id.* (emphasis added). That is, the phrase “output by the application program” in the first “wherein” clause of claim 1 merely specifies that the display element information recited therein is the same display element information previously recited in the claim. Thus, Appellants’ attempt to distinguish claim 1 from Edlund on the basis of Edlund failing to disclose an application program that outputs information indicating a display time is unavailing, because it relies on a limitation not found in the claim.

Appellants next agree with the Examiner’s finding that Edlund “expands the program icon into an application window when the program is to start and collapses the application window into a program icon when the

program is scheduled to end.” Appeal Br. 11 (quoting Final Act. 3). Nonetheless, Appellants argue claim 1 requires the display element “will *only* be displayed . . . when the application program is not running” and “is *only* displayed when specified by the display timing and when the application program is not running,” and “Edlund clearly does not teach these two criteria.” *Id.* (italicized emphases added).

We, again, disagree with Appellants’ construction of claim 1. The second “wherein” limitation merely requires “using” the information indicating the display time to control a display timing of the display element, without specifying what form such control must take. Appeal Br. 14 (Claims App.). The “program-related image display control means” limitation more specifically requires display of the generated image “*during* a period in which the application program is *not executed.*” *Id.* (emphasis added). We can find no requirement in claim 1 for the display element image to be displayed “only” when the application program is not executed, as Appellants assert. In other words, there is no limitation on whether the display element image is displayed (or not displayed) during periods when the application program is being executed.

Our construction of claim 1 is consistent with claim 4, which depends from claim 1 to add “*a display start time* for the display element” such that the “image display control means *restricts* the display of the program-related image including the display element *when the display timing of the program-related image is before the display start time.*” Response (filed Dec. 10, 2013), at 3 (emphases added). That is, Appellants have demonstrated the ability to claim that display of the display element image is restricted at

certain times, but no such requirement is recited in claim 1 as to times when the application program is being executed.

Appellants concede Edlund discloses “collaps[ing] the application window into a program icon when the program is scheduled to end.” Appeal Br. 11. Edlund, thus, discloses the only specific timing requirement recited in claim 1, which is the display of an image during a period in which the application program is not executed. Further, Appellants do not dispute the Examiner’s additional reliance on Yoshida as disclosing the display of an image during a period in which the application program is not executed. *See* Final Act. 2–3; Appeal Br. 10–11. For these reasons, we are not persuaded of Examiner error in relation to the claimed timing for display of the display element image in claim 1.

Appellants further argue “in Edlund, the application window (i.e., not an image) is displayed at the display timing whereas claim 1 clearly recites that the display element (i.e., an image) is displayed at the display timing.” Appeal Br. 11. Appellants also assert Edlund discloses that “application windows are displayed at the display timing (i.e., applications are executed) whereas claim 1 clearly recites that the display element is not displayed when the application program is running.” *Id.*

These arguments in part rely on the premise that claim 1 requires the display element not to be displayed when the application program is running, which we determine is erroneous for the reasons provided above. Further, Appellants concede Edlund discloses “collaps[ing] the application window into a *program icon* when the program is scheduled to end.” Appeal Br. 11 (emphasis added). Appellants have not persuasively established that Edlund’s program icon, which is displayed during a period

in which the application program is not executed, is not an “image” as recited in claim 1. Further, Appellants do not dispute the Examiner’s additional reliance on Yoshida as disclosing the display of an image (i.e., ICON₂) during a period in which the application program is not executed. *See* Final Act. 2–3; Appeal Br. 10–11. For these reasons, we are not persuaded of Examiner error in relation to the claimed display of an “image” during a period in which the application program is not executed.

For the foregoing reasons, we sustain the rejection of claims 1, 9, and 10 as unpatentable over Yoshida and Edlund.

Dependent Claims 3–6

Appellants do not present arguments for the patentability of claims 3–6, each of which depends from claim 1, separately from claim 1. Appeal Br. 10–11. Therefore, we sustain the rejection of claims 3–6 as unpatentable over Yoshida and Edlund.

*B. Obviousness based on Yoshida, Edlund, and Sinclair—
Claim 7*

Appellants do not present arguments for the patentability of claim 7, which depends from claim 1, separately from claim 1. Appeal Br. 8, 10–12. Therefore, we sustain the rejection of claim 7 as unpatentable over Yoshida, Edlund, and Sinclair.

*C. Obviousness based on Yoshida, Edlund, and Bergman—
Claim 8*

Claim 8 depends from claim 1 to add, *inter alia*, menu image display control means to display menu item images associated with different (first and second) types of applications. Appeal Br. 14–15 (Claims App.). Claim 8 then recites that, when a user selects the menu item image

associated with the first application type, the means “generates a program-related image,” and displays “the image output by the application program . . . *after the user carries out a predetermined activation instruction operation while the program-related image is displayed.*” *Id.* at 15 (emphasis added). Claim 8 further recites that, when a user selects the menu item image associated with the second application type, the means displays “an image output by the application program.” *Id.*

In rejecting claim 8, the Examiner initially finds Yoshida and Edlund “lack[] specificity as to switching from a first window pertaining to a first program to a second window pertaining to a second [program] as claimed,” and cites Bergman as containing such a disclosure. Final Act. 5–6 (citing Bergman, 6:45–72). According to the Examiner, it would have been obvious to apply Bergman’s switching of windows or program images to the combination of Yoshida and Edlund, to “prevent ergonomic confusion on the part of the user by displaying only the window pertaining to the program being used at the present time, and minimize the video memory and processing power used to support the visual display.” *Id.* at 6–7.

Appellants object that the Examiner’s rejection overlooks “what claim 8 states.” Appeal Br. 12. Appellants particularly contend “the portion of Bergman cited by the Examiner relates to switching windows and not to displaying a menu item [image] and detailing what occurs when different menu item images are selected.” *Id.*

The Examiner answers by additionally citing Bergman’s Figure 3 as “show[ing] a menu image with icons for the respective programs.” Ans. 12 (further citing Bergman, 8:38–55). According to the Examiner, “Bergman accepts input from the user carrying out tasks in the first program; the

program continues to display after these tasks are completed until the window is closed and the second type of program is started,” which “necessarily occurs after the user engages in the activation operation instruction (selecting the program on the menu) to start the program, as claimed.” *Id.* at 12–13.

We are persuaded of Examiner error in rejecting claim 8. We appreciate that Bergman discloses displaying a plurality of menu item images 24, 26, etc., each associated with application programs of different types, and the user may select a menu item image to launch its associated application program. Bergman, Fig. 3, 8:38–55. Nonetheless, it is not clear from the rejection what disclosure in Bergman is found to correspond to “generat[ing] a program-related image,” and then displaying “the image output by the application program of the first type . . . *after the user carries out a predetermined activation instruction operation while the program-related image is displayed*” (emphasis added). Thus, we do not sustain the rejection of claim 8 as unpatentable over Yoshida, Edlund, and Bergman.

DECISION

The Examiner’s decision to reject claims 1 and 3–10 is affirmed as to claims 1, 3–7, 9, and 10, and is reversed as to claim 8.

No time period for taking any subsequent action in connection with this appeal may be extended, under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART