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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SHUNICHI KASAHARA and TOMOYA NARITA

Appeal 2015-006189
Application 12/938,980
Technology Center 2600

Before JOHN A. JEFFERY, JAMES R. HUGHES, and
MATTHEW J. McNEILL, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's decision to reject claims 1, 3–9, 12, and 13. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Appellants' invention is an information processing apparatus that enables intuitive presentation of the association between the movement directions of an operating member and display information. *See generally* Spec. 2–7. Claim 1 is illustrative:

1. An information processing apparatus comprising:

a detection unit configured to detect an operation input in a predetermined operation direction; and

a display control unit configured to display, on a display unit, first auxiliary information indicating the predetermined operation direction, and second auxiliary information indicating a movement direction of display information with respect to the display unit, and to move the display information while moving the first auxiliary information in the movement direction in accordance with the operation input detected by the detection unit and moving the second auxiliary information in association with the movement of the first auxiliary information,

wherein the display information is movable in a plurality of directions with respect to the display unit,

wherein the display control unit is configured to change the movement direction of the display information and an indication of the second auxiliary information indicating the movement direction of the display information, in accordance with a pressing operation input detected by the detection unit, and

wherein the detection unit and the display control unit are each implemented via at least one processor.

THE REJECTION

The Examiner rejected claims 1, 3–9, 12, and 13 under 35 U.S.C. § 112(b) as indefinite. Ans. 10–14.¹

CONTENTIONS

The Examiner construes the detection and display control units in claim 1 as equivalent to means-plus-function limitations under 35 U.S.C. § 112(f). Ans. 5, 10. Based on this construction, the Examiner concludes

¹ Throughout this opinion, we refer to (1) the Appeal Brief filed February 3, 2015 (“App. Br.”); (2) the Examiner’s Answer mailed April 3, 2015 (“Ans.”); and (3) the Reply Brief filed June 3, 2015 (“Reply Br.”).

that the claim is indefinite because Appellants' Specification fails to disclose the corresponding structure, namely the algorithm, to perform the display control unit's recited function. Ans. 10–11.

Appellants argue that the recited detection and display control units do not invoke § 112(f) because they are implemented via at least one processor. App. Br. 13–15; Reply Br. 4–5.

ISSUE

Has the Examiner erred in rejecting claim 1 as indefinite under § 112(b) for lacking description of the corresponding structure in the Specification for achieving the display control unit's recited function? This issue turns on whether the display control unit's implementation via a processor recites sufficient structure to avoid construing the limitation under § 112(f).

ANALYSIS

As noted above, this dispute turns solely on whether the Examiner erred by construing the recited display control unit² as equivalent to a means-plus-function limitation under § 112(f), for if it is, it must be construed in light of the corresponding structure in the Specification and its equivalents. *See In re Donaldson Co., Inc.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (en banc). For computer-related inventions so construed, the

² Because the Examiner finds that the Specification lacks the corresponding structure *only* for the recited display control unit in the rejection—not the detection unit (*see* Ans. 10–11)—we confine our discussion solely to the display control unit.

application must disclose enough of an *algorithm* to provide the requisite structure—a disclosure that can be expressed in any understandable terms (e.g., a mathematical formula, in prose, or as a flowchart). *See Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1341 (Fed. Cir. 2008); *see also Aristocrat Techs. Australia Pty Ltd. v. Int’l Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008).

Notably, Appellants do not dispute the Examiner’s finding that the Specification fails to adequately disclose the algorithm-based structure corresponding to the recited “display control unit” under the Examiner’s § 112(f) construction of that limitation. Ans. 10–11. Rather, Appellants dispute that *construction*. *See* App. Br. 13–15; Reply Br. 4–5. Therefore, this appeal turns solely on whether the Examiner erred by construing the recited display control unit under § 112(f)—not whether the Specification lacks the corresponding structure under that construction.

Turning to claim 1, the claim recites, in pertinent part, a display control unit configured to (1) display first and second auxiliary information; (2) move display and auxiliary information; and (3) change the display information’s movement direction and associated auxiliary information indication. But apart from reciting that the display control unit is *configured to perform* these functions, the claim recites no particular structure to perform them apart from the unit’s implementation “via at least one processor.”

Although omitting the term “means” in a claim element creates a rebuttable presumption that § 112(f) does not apply, such an omission does not automatically prevent that element from being construed as a means-plus-function element. *Williamson v. Citrix Online, LLC*, 792 F.3d 1339,

1348 (Fed. Cir. 2015) (en banc). In such a case, § 112(f) will apply if the claim term fails to recite sufficiently definite structure, or else recites function without reciting sufficient structure for performing that function. *Id.* at 1349.

That is the case here. First, the term “unit” is merely a generic description for software or hardware that performs a specified function, namely controlling a display in the manner recited. That is, the term “unit” is simply a nonce word or “non-structural generic placeholder” that is tantamount to the term “means” because it fails to connote sufficiently definite structure and, in the context of claim 1, invokes § 112(f). *Cf. id.* at 1350 (discussing similar nonce words). *Accord* MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) § 2181(I)(A) (9th ed. Rev. 07.2015, Nov. 2015) (including the term “unit for” in a list of such non-structural generic placeholders). Although the term “unit” is modified by the words “display control” in claim 1, these modifying words do not add sufficient structure to the recited “unit” to preclude § 112(f) construction, for they merely identify the unit’s recited function, namely controlling a display.

That the recited display control unit is implemented via at least one processor does not change our conclusion because skilled artisans would not recognize the term “processor” as connoting sufficiently definite structure for performing the display control unit’s functions as the Examiner indicates. *See* Ans. 15–16 (citing *Ex parte Lakkala*, No. 2011-001526 (PTAB Mar. 13, 2013) (expanded panel) (informative); *Ex parte Erol*, No. 2011-001143

(PTAB Mar. 13, 2013) (expanded panel) (informative); *Ex parte Smith*, No. 2012-007631 (PTAB Mar. 14, 2013) (expanded panel) (informative)).³

As the expanded panels noted in those decisions, a “processor” is “a general purpose computer, a central processing unit (‘CPU’), or a program that translates another program into a form acceptable by the computer being used.” *See Lakkala* at 10; *see also Erol* at 15; *Smith* at 13. Given this definition, those panels held that the term “processor” in the claims at issue in those cases was a non-structural term that would not be recognized by skilled artisans as reciting sufficiently definite structure for implementing the associated functions. *See Lakkala* at 10–13; *see also Erol* at 15–18; *Smith* at 13–17.

On this record, we see no reason why the recited processor in this case should be treated any differently. That a three-member Board panel later held in a non-precedential decision, *Ex parte Cutlip*,⁴ that a claimed processor and memory referred to structural elements in light of the Specification in connection with a § 101 rejection as Appellants indicate (App. Br. 14–15; Reply Br. 4–5) is of no consequence here. First, the *Cutlip* decision is a routine Board decision that, while binding authority *in that particular case*, is not binding here. *See Publication of Opinions as Precedential, Informative, Representative, and Routine*, PTAB Standard Operating Procedure 2 (Rev. 9) (“SOP 2”) § VI, *available at*

³ These three informative Opinions are available from the Board’s web page entitled “Key Decisions Involving Functional Claiming” at <http://www.uspto.gov/patents-application-process/appealing-patent-decisions/decisions-and-opinions/key-decisions>.

⁴ *Ex parte Cutlip*, No. 2011-011658 (PTAB June 2, 2014) (non-precedential).

<https://www.uspto.gov/sites/default/files/documents/sop2-revision-9-dated-9-22-2014.pdf>.

Second, the panel’s construction in *Cutlip* pertained to whether the claims at issue recited *eligible subject matter under § 101*—not whether the term invoked § 112(f) treatment as is the case here. *Accord* Ans. 15 (noting this point). And lastly, the *Lakkala*, *Erol*, and *Smith* decisions cited by the Examiner are not only directly on point regarding whether the term “processor” lacks sufficient structure to invoke § 112(f), they are *informative* decisions that, while not binding authority, are nonetheless highly persuasive authority that provide instructive guidance and Board norms on this very issue. *See* SOP 2 § IV. That these informative decisions were each decided by *expanded* Board panels, and are specifically highlighted not only on a Board web page dedicated to informative opinions,⁵ but also on *another* dedicated web page regarding functional claiming on the Board’s web site as noted above, only further bolsters the persuasiveness of these prominent and instructive decisions.

Therefore, Appellant’s contention that the Examiner’s reliance on the *Lakkala*, *Erol*, and *Smith* informative decisions is somehow “no longer valid” in view of the later, *non-precedential* *Cutlip* decision (App. Br. 15; Reply Br. 5) is simply wrong. Not only is *Cutlip* not binding authority and involves different patentability issues with respect to the cited opinions’ respective “processor” constructions (§ 112(f) versus § 101), the cited informative decisions are directly on point and, as noted above, are highly persuasive authority on the § 112(f) issue here.

⁵ *See* <https://www.uspto.gov/patents-application-process/appealing-patent-decisions/decisions-and-opinions/informative-opinions-0>.

Therefore, because (1) we find no error in the Examiner's construing the recited display control unit under § 112(f), and (2) Appellants do not dispute the Examiner's finding that the Specification fails to adequately disclose the algorithm-based structure corresponding to the display control unit under the Examiner's construction, we are not persuaded that the Examiner erred in rejecting claim 1 as indefinite, and claims 3–9, 12 and 13 not argued separately with particularity.

CONCLUSION

The Examiner did not err in rejecting claims 1, 3–9, 12, and 13 under § 112(b).

DECISION

The Examiner's decision rejecting claims 1, 3–9, 12, and 13 is affirmed.

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