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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BAS ORDING, KENNETH L. KOCIENDA,
BRADFORD ALLEN MOORE, MARCEL VAN OS,
RICHARD WILLIAMSON, STEPHEN O. LEMAY, and
SCOTT FORSTALL

Appeal 2016-007394
Application 12/565,757
Technology Center 2100

Before IRVIN E. BRANCH, JOHN F. HORVATH, and
MICHAEL J. ENGLE, *Administrative Patent Judges*.

BRANCH, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Appellants request rehearing of our Decision on Appeal entered March 22, 2017 (“Decision”), in which we affirmed the Examiner’s rejection of claims 1 and 10–30, all the claims pending in the application.

We have reviewed the Request for Rehearing (“Request” or “Req. Reh’g”) in view of our Decision. For the reasons discussed below, we grant

Appellants' request, reverse the Examiner's rejection, and enter a new ground of rejection.

CONTENTIONS AND ANALYSIS

In the Request, Appellants contend, *inter alia*, we overlooked that “the rejection does not rely on Ording for most claim elements.” Req. Reh’g 2. Upon rehearing, we find this argument persuasive. Specifically, the rejection is unclear with respect to the factual basis upon which several elements are rejected.

The Examiner rejected claims 1 and 10–30 as unpatentable under 35 U.S.C. § 103(a) over Keely ’270 (US 2002/0097270 A1, published July 25, 2002)¹ and Ording (WO 2008/030879, published Mar. 13, 2008). Final Act. 4–8. The factual record does not state explicitly that, for example, “detecting continuous movement of the finger contact on the touch screen display, without breaking finger contact on the touch screen display, from the selected first box of content to a location outside the selected first box of content” stands rejected over *the combination of Keely ’270 and Ording*, rather than Keely ’270 alone. *See id.* So although we agree with the Examiner’s conclusion that claims 1 and 10–30 are unpatentable, the factual basis supporting the Examiner’s conclusion requires clarification. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). We therefore reverse the Examiner’s rejection on this basis and enter a new ground of rejection.

¹ The Examiner and Appellants previously referred to this reference as “Keely.” Because our new ground of rejection adds a second “Keely” reference, we now refer to the published application as Keely ’270.

NEW GROUND OF REJECTION

We reject claims 1 and 10–30 as obvious under 35 U.S.C. § 103(a) over the combination of Keely '270, Keely '551² (US 6,891,551 B2, issued May 10, 2005), and Ording. Our rejection adopts the Examiner's rejection of claims 1 and 10–30, except as supplemented herein, maintaining all references to "Keely" in the Examiner's rejection to Keely '270, as intended by the Examiner. We include Keely '551 because the figures in the issued patent are in final form and better illustrate the subject matter. In particular, Figures 6A and 6B of Keely '551 correct the placement of the selection box 601. Because the teachings of Keely '551 and Keely '270 are otherwise substantially identical, the Examiner's references to "Keely" throughout the record are applicable to both.

Claim 1 reads as follows:

1. A method, comprising:
at a multifunction device with a touch screen display:
displaying at least a portion of a structured electronic document on the touch screen display, wherein the structured electronic document comprises a plurality of boxes of content;
detecting a finger gesture on a first box of content in the plurality of boxes of content;
in response to detecting the finger gesture on the first box of content in the plurality of boxes of content:
selecting the first box of content for copying; and
visually distinguishing the selected first box of content from content on the touch screen display that is not selected for copying;
detecting a finger contact on the selected first box of content;
detecting continuous movement of the finger contact on the touch screen display, without breaking finger contact on the

² Keely '551 is the issued patent from the same application as the published application Keely '270.

touch screen display, from the selected first box of content to a location outside the selected first box of content;

detecting lift off of the finger contact at the location outside the selected first box of content; and

selecting one or more additional boxes of content in the plurality of boxes of content for copying in accordance with the location of the finger contact outside the first box of content.

We adopt the Examiner's rejection of claim 1 (Final Act. 4–8) supplemented by these additional findings:

Ording discloses a multifunction device with a touch screen display that displays a structured electronic document having a plurality of boxes of content. Ording Abstract (“displaying at least a portion of a structured electronic document on the touch screen display, wherein the structured electronic document comprises a plurality of boxes of content”). Ording further discloses selecting one of the boxes of content via a touch, and manipulating the box of content (e.g., by enlarging or centering it) via a gesture. Ording ¶¶ 7–8.

Keely '551 also discloses a multifunction device with a touch screen display that displays a document having boxes of content. Keely '551, col. 4, l. 61–col. 5, l. 21. col. 9, l. 62–col. 10, l. 28, Figs. 7A, 7B, 8A, 8B, and 8C. Keely '551's display of a plurality of “graphical image objects” correspond to the claimed display of “a plurality of boxes of content.”³ *See*

³ Although not relied on in our rejection, we note that both Keely '551 and Keely '270 also disclose triple clicking to select an entire paragraph, then resizing the selection area. *See, e.g.*, Keely '270 ¶ 57. To the extent the process described in paragraph 57 does not specify the selection of additional paragraphs in paragraph increments, the Examiner might consider this disclosure in combination with well-known features of, for example, Microsoft Word®.

Spec. ¶ 369 (indicating a grouping of “content” in a document object model tree can include an “image.”).

Keely ’551 discloses (*see* col. 9, l. 62–col. 10, l. 28, Figs. 7A, 7B, 8A, 8B, and 8C):

detecting a finger gesture on a first box of content in the plurality of boxes of content; [“[t]he user may select an image by tapping it”]

in response to detecting the finger gesture on the first box of content in the plurality of boxes of content:

selecting the first box of content for copying [“an image selection area 701 may appear, surrounding the selected image object”]; and

visually distinguishing the selected first box of content from content on the touch screen display that is not selected for copying; [Fig. 8A, distinguishing selection of left side image from right side image; *see also* col. 5, ll. 22–40 (“The body 301 of the selection area may be of any shape . . . The body 301 may have an appearance that is distinguishable from non-selected portions and/or items in the electronic document to distinguish selected portions from non-selected portions.”)]

detecting a finger contact on the selected first box of content; [“As a user resizes the selection area 701, the computer may determine what objects are surrounded or encountered by the selection area 701 . . .”; *see also* col. 5, ll. 46–48 (“[f]or selecting text, the dragging of a selection handle 302 may increase or decrease portions of the current selection body 301”)]

detecting continuous movement of the finger contact on the touch screen display, without breaking finger contact on the touch screen display, from the selected first box of content to a location outside the selected first box of content; [“The image selection area may include selection handles 702 that operate in a similar fashion as the text selection discussed above”; “As a user resizes the selection area 701, the computer may determine what objects are surrounded or encountered by the selection area 701. . .”; Fig. 8B; *see also* col. 5, ll. 46–48 (“[f]or selecting text,

the dragging of a selection handle 302 may increase or decrease portions of the current selection body 301”)]

detecting lift off of the finger contact at the location outside the selected first box of content [“the user may cease resizing as shown in FIG. 8b, and the computer device may automatically resize the area 801 to encompass the object that was encountered by the user’s resized area, as shown in FIG. 8c”; Fig. 8C]; and

selecting one or more additional boxes of content in the plurality of boxes of content for copying in accordance with the location of the finger contact outside the first box of content [“As a user resizes the selection area 701, the computer may determine what objects are surrounded or encountered by the selection area 701, and may add these objects to the selection area”; “the user may cease resizing as shown in FIG. 8b, and the computer device may automatically resize the area 801 to encompass the object that was encountered by the user’s resized area, as shown in FIG. 8c”; Figs. 8B and 8C].

A person having ordinary skill in the art would have found it obvious to incorporate Keely’s (Keely ’551 or Keely ’270) process for selecting boxes of content in electronic documents displayed on a touch screen device into Ording’s multifunction touch screen device, which operates on structured electronic documents having boxes of content. Keely and Ording both disclose using gestures to select images on a touch screen device. Keely teaches using a continuous gesture to select an image (box of content) in an electronic document, and to expand the selection to include additional images (additional boxes of content) in the electronic document, but doesn’t expressly disclose that the electronic document is a structured electronic document. Ording teaches using a gesture to select and manipulate (e.g., center or resize) an image in a structured electronic document. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Ording based on teachings of Keely to provide a user with greater flexibility and control when manipulating images in a structured

electronic document. For example, doing so would have allowed the user to select a plurality of adjacent images in the document (as taught by Keely), and to center or resize the images (as taught by Ording) as a group rather than individually. This would have achieved Ording's stated goal of providing a more transparent and intuitive user interface, e.g., by providing an interface that allowed a user to "quickly and efficiently make and/or adjust desired selections of portions of electronic documents," as taught by Keely. Ording ¶ 5; Keely '51, col. 2, ll. 30–33.

Moreover, a person having ordinary skill in the art would have known that the selection handles described in Keely are there solely as a visual aid to assist the user in delineating the selected box of content. Keely discloses additional ways of delineating the selected box of content such as by highlighting it with a predefined color. Keely, col. 5, ll. 22–40. A person of ordinary skill in the art would have known that the selected box of content could have been expanded simply by dragging across the selected box of content rather than by dragging selection handles delineating the selected box of content, and would have found it advantageous to do so because it avoids the expense of having to create and display the selection handles. For example, Ording teaches using a dragging/swiping gesture to move an unlock image from a locked position to an unlocked position to unlock a multifunction device. Ording ¶¶ 83–84. It would have been obvious to a person of ordinary skill in the art to use a dragging/swiping gesture directly on a selected box of content (as taught by Ording) in order to select additional boxes of content (as taught by Keely) to provide a more transparent and intuitive user interface that would allow a user to "quickly and efficiently make and/or adjust desired selections of portions of

electronic documents,” as taught by Keely. Ording ¶ 5; Keely ’51, col. 2, ll. 30–33.

Furthermore, because all elements of claim 1 have been shown to preexist Appellants’ invention, they would have been familiar to a person having ordinary skill in the art. Accordingly, because we see no reason combining these familiar elements would have resulted in an unpredictable result, claim 1 is obvious for this additional reason. *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” (quoting *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007))).

Accordingly, claim 1 is unpatentable over the combination of Keely ’551, Keely ’270, and Ording.

For claims 10–30, we adopt the Examiner’s findings and conclusion (Final Act. 6–8) as supplemented herein.

In view of the foregoing, claims 1 and 10–30 are obvious under 35 U.S.C. § 103(a) over the combination of Keely ’270, Keely ’551, and Ording.

DECISION

The request for rehearing is granted.

Claims 1 and 10–30 are unpatentable.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

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Section 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record.

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).

GRANTED
37 C.F.R. § 41.50(b)