



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
14/278,213 05/15/2014 Chris Han 319790-US-CNT 9233

69316 7590 03/13/2018
MICROSOFT CORPORATION
ONE MICROSOFT WAY
REDMOND, WA 98052

EXAMINER

RIEGLER, PATRICK F

ART UNIT PAPER NUMBER

2142

NOTIFICATION DATE DELIVERY MODE

03/13/2018

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usdoCKET@microsoft.com
chriochs@microsoft.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* CHRIS HAN and NATHAN DUNLAP

---

Appeal 2017-007950  
Application 14/278,213  
Technology Center 2100

---

Before JOSEPH L. DIXON, JOHNNY A. KUMAR, and  
MATTHEW J. McNEILL, *Administrative Patent Judges*.

KUMAR, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants seek review under 35 U.S.C. § 134(a) of a final rejection of claims 21–40. We have jurisdiction over the appeal of these claims pursuant to 35 U.S.C. § 6(b).

We AFFIRM.

## STATEMENT OF CASE<sup>1</sup>

An understanding of the invention can be derived from a reading of exemplary claim 21, which is reproduced below:

21. A method for providing a table of contents, comprising:

displaying information that contains a plurality of portions of content;

upon receiving a selection from a user to access a table of contents for the information, displaying a table of contents containing a plurality of thumbnail representations, each thumbnail representation corresponding to a respective portion of the plurality of portions of the content, in a manner that is overlaid on at least some of the information; and

allowing the user to view at least part of the information between a first thumbnail representation of the plurality of thumbnail representations and a second thumbnail representation of the plurality of thumbnail representations while the plurality of thumbnail representations is overlaid on the at least some of the information.

## REJECTIONS

Claims 37–40 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 21–24, 26–32, and 34–40 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Tally (*Customize the Adobe Acrobat 8 Interface* (March 16, 2007), <http://layersmagazine.com/customize-the-adobe-acrobat-8-interface.html>), and further in view in Sullivan et al. (US 2007/0192791 A1, published August 16, 2007) (hereinafter “Sullivan”).

---

<sup>1</sup> Our Decision makes reference to Appellants’ Appeal Brief (“App. Br.,” filed January 4, 2017), and the Examiner’s Answer (“Ans.,” mailed March 27, 2017), and the Reply Brief (“Reply Br.,” filed May 1, 2017).

Claims 25 and 33 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Tally and Sullivan, and further in view of Sadikali et al. (US 2008/0126982 A1, published May 29, 2008) (hereinafter “Sadikali”).

## ANALYSIS

### *Rejection under 35 U.S.C. § 101*

#### *Claims 37–40*

**Issue 1:** Did the Examiner err in finding that the claims are directed to non-statutory subject matter?

Appellants contend “the ordinary meaning of the phrase ‘computer readable device’ does not include signals.” App. Br. 7.

The Examiner found that Appellants have not limited the claimed computer readable device to statutory subject matter. Ans. 2–4. We agree with the Examiner.

We sustain the Examiner’s § 101 rejection of independent claim 37 reciting, in pertinent part, a *computer-readable device having computer-executable instructions*. We note the *claim* does not limit the computer-readable device to non-transitory forms.

The device recitation, however, is insufficient to limit the claim to non-transitory forms. *See Ex parte Mewherter*, 107 USPQ2d 1857 (PTAB 2013) (expanded panel) (precedential) (holding recited machine-readable storage medium ineligible under § 101 since, absent a contrary disclosure in the Specification, a machine-readable storage medium encompasses transitory media).

We are not persuaded that the Examiner erred in rejecting representative claim 37, and claims 38–40 for similar reasons.

*Rejections under 35 U.S.C. § 103*

We have reviewed the Examiner’s rejections in light of Appellants’ contentions that the Examiner has erred. Further, we have reviewed the Examiner’s response to Appellants’ arguments regarding claims 21–40. App. Br. 10–40; Reply Br. 4–5.

We disagree with Appellants’ conclusions. We adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in the Examiner’s Answer in response to Appellants’ Appeal Brief. Ans. 4–11. We concur with the conclusions reached by the Examiner. We highlight and address specific findings and arguments for emphasis as follows.

**Issue 2:** Did the Examiner err in finding that the combined teachings of Tally and Sullivan teach and/or suggest “a table of contents,” as set forth in claim 21, and similarly recited in independent claims 29 and 37?

Appellants contend,

displaying thumbnails of all of the pages in a document in a separate panel, as described by Taz-Tally, does not satisfy the definition of the term “table of contents” as set forth in the Wiktionary® technical dictionary. For example, displaying thumbnails of all of the pages in a document in a separate panel, as described by Taz-Tally, does not constitute a list of titles of the parts of a book or document, organized in the order in which the parts appear.

Clearly, displaying thumbnails of all of the pages in a document in a separate panel, as described by Taz-Tally, does not satisfy the ordinary and customary meaning of the term

“table of contents.” Moreover, Sullivan is not asserted to and does not remedy this deficiency of Taz-Tally.

Reply Br. 5.

Regarding Appellants’ above argument that in Tally “thumbnails of all of the pages in the document are displayed,” (Reply Br. 4–5 (emphasis omitted)), Appellants’ argument is not commensurate with the scope of claim 21, because claim 21 does not preclude such a reading of the displaying step.

The Examiner also finds

within Tally, the “pages panel” described on pages 3, 4, 8 and 9 suggests a floating table of contents that comprises page thumbnails for selection. Specifically, the figures on page 4 clearly show a page panel that fills a navigation panel and a larger document view, where a user can select pages within the page panel to view the document at the selected page in the larger document view. This clearly suggests that *a page panel is a table of contents* as claimed. Page 2 describes at least a “page” icon within a navigation panel that is used to show the page panel (equivalent to a selection receivable by a user to access a table of contents). The bottom of page 8 is where it is suggested that the (page) panel can float above the document via a manipulation.

Ans. 5 (emphasis added).

We agree with and adopt the Examiner’s findings as our own. Particularly, we concur with the Examiner’s conclusion that Tally in combination with Sullivan teaches or suggests Appellants’ claimed invention.

Thus, in light of the broad terms recited in claim 21 and the arguments presented, Appellants have failed to clearly distinguish the claimed

invention over the prior art combination relied on by the Examiner. Therefore, in the absence of sufficient evidence or argument, we are not persuaded the Examiner's reading of the claims on the cited references is erroneous and sustain the rejection of independent claims 21, 29, and 37, which include substantially the same limitations.

Regarding dependent claim 24, while Appellants raised additional arguments for patentability (App. Br. 18–20), we find that in the Answer the Examiner has rebutted with sufficient evidence each and every one of those arguments. Ans. 7–8. Therefore, we adopt the Examiner's findings and underlying reasoning, which are incorporated herein by reference.

With respect to dependent claims 22, 23, and 25–40, Appellants argue these claims are patentable due to their dependency on their respective independent or dependent claims. Thus, as we sustained the rejection of claims 1, 29, and 37, we also sustain the rejection of claims 22, 23, and 25–40, dependent therefrom.

Consequently, we conclude there is no reversible error in the Examiner's rejections of claims 21–40.

#### DECISION

The Examiner's decision rejecting claims 37–40 under 35 U.S.C. § 101 as being directed to non-statutory subject matter is affirmed.

The Examiner's decision rejecting claims 21–40 under 35 U.S.C. § 103(a) is affirmed.

Appeal 2017-007950  
Application 14/278,213

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