



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. Includes application details for Microsoft Corporation and examiner information for Long, Andrea Natae.

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):

chriochs@microsoft.com
usdoCKET@microsoft.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRIAN SCOTT MOUDY, AARTHI NATARAJAN,
GEEVEN SINGH, and AMY WAI-YEE IP

Appeal 2018-009126
Application 14/187,853
Technology Center 2100

Before JENNIFER S. BISK, LARRY J. HUME, and
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

DIRBA, *Administrative Patent Judge*.

DECISION ON APPEAL¹

Appellants² seek our review under 35 U.S.C. § 134(a) of the Examiner's rejection of claims 1–20, which are all claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

¹ This Decision uses the following abbreviations: “Spec.” for the original specification, filed February 24, 2014, which claims the benefit of U.S. patent application 12/200,356, filed August 28, 2008; “Final Act.” for the Final Office Action, mailed August 10, 2017; “App. Br.” for Appellants’ Appeal Brief, filed May 10, 2018; “Ans.” for Examiner’s Answer, mailed July 27, 2018; and “Reply Br.” for Appellants’ Reply Brief, filed September 26, 2018.

² According to Appellants, the real party in interest is Microsoft Technology Licensing, LLC. App. Br. 2.

BACKGROUND

Appellants' disclosed embodiments and claimed invention relate to a user interface for an instant messaging application that collapses display of a conversation window into a contacts window. Spec. ¶¶ 8–10.

Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method executed at a computing device, the method comprising:
 - displaying a conversation window of an instant messaging application on a display of the computing device, the conversation window comprising a message transmitted between the computing device and a second computing device, wherein the computing device is operated by a user and the second computing device is operated by a contact of the user;
 - receiving a request to remove the conversation window from the display;
 - responsive to receiving the request, removing the conversation window from the display; and
 - responsive to removing the conversation window from the display, displaying a graphical indicator on the display, *the graphical indicator displayed in a contacts window of the instant messaging application*, the graphical indicator indicating that the conversation window comprised the message prior to the conversation window being removed from the display.

App. Br. 16 (Claims App'x) (emphasis added).

THE REJECTIONS

R1. Claims 1, 3–12, and 14–20 stand rejected under pre-AIA 35 U.S.C. § 103(a) as obvious over Fulmer (US 2006/0036703 A1, published February 16, 2006), Forlenza (US 2007/0094360 A1, published April 26,

2007), and Kaminsky (US 2007/0288580 A1, published December 13, 2007). Final Act. 2–13.

R2. Claims 2 and 13 stand rejected under pre-AIA 35 U.S.C. § 103(a) as obvious over Fulmer, Forlenza, Kaminsky, and Fernandez (US 2004/0228531 A1, published November 18, 2004). Final Act. 14–15.

ANALYSIS

We review the appealed rejections for error based upon the issues identified by Appellants and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential). To the extent Appellants have not advanced separate, substantive arguments for particular claims, or other issues, such arguments are waived. 37 C.F.R. § 41.37(c)(1)(iv).

We have considered all of Appellants’ arguments and any evidence presented. We highlight and address specific findings and arguments for emphasis in our analysis below.

Obviousness Rejection R1 of Claims 1, 3–12, and 14–20

Appellants argue claims 1, 3–12, and 14–20 together as a group. *See* App. Br. 8–15. Therefore, consistent with the provisions of 37 C.F.R. § 41.37(c)(1)(iv), we limit our discussion to claim 1. Independent claims 12 and 20 and dependent claims 3–11 and 14–19 stand or fall with claim 1.

Claim 1 recites: “responsive to removing the conversation window from the display, displaying a graphical indicator on the display, *the graphical indicator displayed in a contacts window of the instant messaging application.*” App. Br. 16 (Claims App’x) (emphasis added) (referred to in this Decision as the “indicator limitation”). The Examiner pointed to

Fulmer, Forlenza, and Kaminsky as teaching different aspects of the indicator limitation. Final Act. 3–5, 15–17. Appellants argue the proposed Fulmer-Forlenza-Kaminsky combination does not teach or suggest this limitation (App. Br. 9–12), and Appellants contend the Examiner’s rejection lacks rational underpinning and relies on improper hindsight (*id.* at 12–14). For the reasons explained below, we are not persuaded of Examiner error.

In the Final Office Action, the Examiner found: Fulmer teaches removing a conversation window from a display by either minimizing or closing that window (Final Act. 3 (citing Fulmer ¶¶ 44–46)); Forlenza teaches minimizing a conversation window to an icon that displays the contact’s name (*id.* at 3–4, 15 (citing Forlenza ¶¶ 4–5)); and Kaminsky teaches displaying a status icon in a contacts window (*id.* at 4 (citing Kaminsky, Fig. 3, ¶ 43)).

The Examiner determined that, based on these teachings, it would have been obvious to combine Fulmer, Forlenza, and Kaminsky to display an indicator in a contacts window when a conversation is minimized or closed. *Id.* at 4–5. The Examiner explained that the proposed combination would provide “a visual indication of a minimized conversation window in a location that does not take up additional screen display space while also visually associating the minimized window with [the appropriate] contact.” *Id.*; *see id.* at 17 (finding Forlenza is directed to efficient use of “screen real estate”). The Examiner found the combination “does not change the functionality of selecting the graphical indicator to view the window/message.” *Id.* at 4. The Examiner further explained that, while Kaminsky’s indicator is specifically displayed in response to a new message, “one skilled in the art could reasonably present the graphical indicator in

response to a minimize trigger” as taught by Forlenza. *Id.*; *see id.* at 16 (“What can be pulled from the references by one skilled in the art is the use of graphical indicators/icons to show the status of a message.”).

Appellants argue the proposed Fulmer-Forlenza-Kaminsky combination does not teach or suggest the indicator limitation. App. Br. 9–12. In particular, Appellants contend that “[t]he Examiner concedes” that Fulmer “fails to suggest” the indicator limitation.³ *Id.* at 9. Appellants then note that Forlenza’s icon is “shown in the task bar” rather than “in a contacts window,” as would be required by the claim (*id.* at 10), and Kaminsky’s indicator denotes the presence of a “new message” rather than a minimized window (*id.* at 12). From this, Appellants argue the proposed modification of Fulmer with Forlenza and Kaminsky would include Forlenza’s “minimization feature” and would use Kaminsky’s icon only for new messages. *Id.*

The Examiner responds that a person of ordinary skill in the art would have found it obvious to modify Fulmer’s menu 40, which “show[s] participants in active conversations,” to include an indication of a minimized conversation, as taught by Forlenza and Kaminsky. Ans. 15–16. The Examiner further finds that Forlenza generally teaches displaying an icon in response to removing the conversation window (*id.* at 16–17), and Kaminsky teaches placement of “the graphical indicator . . . in the contacts

³ Appellants do not provide a citation in support of this assertion. *See* App. Br. 9. The Examiner found that “Fulmer does not explicitly teach” the indicator limitation (Final Act. 3), but did not state that this limitation is not suggested by Fulmer.

window,” which is “similar to how Fulmer’s contact window display[s] participants of active conversations” (*id.* at 17).

In the Reply Brief, Appellants contend “there is no suggestion in any of the cited references of record that graphics are set forth in a contacts window in response to a user closing or minimizing a conversation window.” Reply Br. 4; *see* App. Br. 12. Appellants also contend “the Examiner is picking and choosing portions of the cited references for the purpose of mapping the portions of the cited references to the claim features, which is improper.” Reply Br. 5.

Appellants’ arguments do not persuade us of Examiner error. Appellants argue that none of the references teach or suggest displaying a graphical indicator in a contacts window in response to minimizing a conversation window. However, this attacks the references individually, rather than addressing the rejection as articulated, which relied on the combined teachings of the prior art. Consequently, this argument does not persuade us of error. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (“Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.”) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (“[T]he test [for obviousness] is what the combined teachings of the references would have suggested to those of ordinary skill in the art.”)).

The Examiner found Fulmer discloses minimizing a conversation window, Forlenza teaches displaying an icon to indicate a minimized conversation window, and Kaminsky teaches locating such an icon in a contacts window. Final Act. 3–5, 15–17; Ans. 15–17. We see no error in these findings. Fulmer ¶¶ 44–46, Figs. 3–4; Forlenza ¶¶ 4–5; Kaminsky,

Fig. 3, ¶ 43. The Examiner explained that a person skilled in the art would have been motivated to put Forlenza’s icon in Fulmer’s contact window, as taught by Kaminsky, because this arrangement would visually associate the conversation with the appropriate contact while conserving display space. Final Act. 4–5, 16; Ans. 15–17. The Examiner also found the proposed combination is within the skillset of a person of ordinary skill in the art. Final Act. 4, 6. Appellants identify no errors or inaccuracies in this rationale, do not contend the Examiner’s proposals are beyond the level of skill of one of ordinary skill in the art, and do not point to any evidence of record that the proposed combination would yield undesirable, unpredictable, or unexpected results. Accordingly, we are not persuaded of error in the Examiner’s conclusion that the indicator limitation is obvious in light of the references.⁴

We are similarly unpersuaded by Appellants’ arguments that the Examiner’s rejection lacks rational underpinning. *See* App. Br. 12–14. Appellants submit the Examiner proposes a modification of Fulmer that minimizes conversation windows to a task bar (as in Forlenza) and then further modifies the combination to remove the task bar and instead display

⁴ Moreover, we further find that Fulmer suggests the proposed combination. In particular, although Fulmer does not explicitly describe what happens after conversation window 60 is minimized, it does state that minimizing window 60 “shifts focus” to menu 40. Fulmer ¶ 50. In addition, Fulmer’s menu 40 (i.e., the claimed “contacts window”) includes a list of contacts 51 and an area specifically displaying “participants in an active conversation 52,” and Fulmer states that “only the menu 40 is displayed” when “more than one active conversation exists.” *Id.* at ¶¶ 41, 43, Fig. 3. Thus, Fulmer’s contact window identifies the active conversations, and Fulmer suggests that this also identifies active conversations that were minimized.

an indication in a contacts window (as in Kaminsky). *Id.* at 13. However, Appellants’ argument is premised on an assumption—that Forlenza’s teaching is limited to displaying an icon *in a taskbar* in response to minimizing a conversation window—and we disagree that a person of ordinary skill in the art would read Forlenza so narrowly. In particular, Forlenza states that a window may be minimized to the task bar (Forlenza ¶ 5, Fig. 1), but the reference also discloses minimizing a conversation window to a *different window* separate from the task bar (*id.* at ¶ 29, Fig. 6A (*cited by* App. Br. 7–8)). In addition, the Examiner found that Forlenza generally teaches displaying an icon in response to removing a conversation window from a display. *See* Ans. 16. Appellants do not provide argument or evidence to support their contention that a person of ordinary skill in the art would read Forlenza to require this icon to be placed in the taskbar. *See Lear Siegler Inc. v. Aeroquip Corp.*, 733 F.2d 881, 889 (Fed. Cir. 1984) (The ordinary artisan is not “compelled to adopt every single aspect of [a reference’s] teaching without the exercise of independent judgment.”). Accordingly, we are not persuaded that the Examiner’s rationale is in error.

Appellants next contend the Examiner used “hindsight” because the cited references do not discuss the advantages of efficiently using screen real estate. App. Br. 14. However, the Examiner found that “[t]he issue of screen real estate for user interfaces is a well-known problem in the art,” as shown in Forlenza. Ans. 19; *see also* Final. Act. 17. Appellants do not respond to this finding (*see* App. Br. 14; *see generally* Reply Br.), and we perceive no error in it (*e.g.*, Forlenza ¶ 5 (minimized windows use only “a small portion of the display”)). Accordingly, Appellants’ hindsight argument is not persuasive because Appellants do not identify any

knowledge supposedly gleaned from the Specification that was not otherwise within the level of ordinary skill at the time of the invention. *See In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971).

Finally, in the Reply Brief, Appellants present a new argument, contending the references do not teach or suggest *closing* a conversation window, as required by independent claim 20 and dependent claims 5 and 17. Reply Br. 4–5. This argument addresses the rejection as originally provided in the Final Office Action, rather than positions raised in the Answer. Because Appellants have not shown good cause for failing to provide these arguments in the Appeal Brief, Appellants’ argument is untimely and need not be considered. *See* 37 C.F.R. § 41.41(b)(2) (“Any argument raised in the reply brief which was not raised in the appeal brief, or is not responsive to an argument raised in the examiner’s answer . . . will not be considered by the Board for purposes of the present appeal, unless good cause is shown.”).

Further, even if our reviewing court were to consider these arguments to be timely, we would not be persuaded of error. Appellants’ argument is premised on the assumption that *minimizing* a conversation window “is not germane” to *closing* a conversation window (Reply Br. 4); however, Appellants fail to provide any support for this assertion. For example, Appellants fail to explain why minimizing a conversation window, such that it is no longer displayed, does not qualify as “closing the conversation window” under the broadest reasonable interpretation of that phrase,⁵ and

⁵ During prosecution, claims must be given their broadest reasonable interpretation in light of the specification as it would be interpreted by one of

Appellants do not clarify the alleged differences between “removing the conversation window” (as required by claim 1) and “closing the conversation window” (as required by independent claim 20). *See* Spec. ¶ 35 (describing “window minimizer component 202” responsive to indication that “the conversation window [should] be closed or minimized”).

Therefore, based upon the findings above, on this record, we are not persuaded of error in the Examiner’s reliance on the cited prior art combination to teach or suggest the disputed limitation of claim 1, nor do we find error in the Examiner’s resulting legal conclusion of obviousness. Accordingly, we sustain the Examiner’s obviousness rejection of independent claim 1, and grouped claims 3–12 and 14–20, which fall therewith.

Obviousness Rejection R2 of Claims 2 and 13

The Examiner rejects claims 2 and 13 over a combination of Fulmer, Forlenza, Kaminsky, and Fernandez. Final Act. 14–15. For these claims, Appellants rely on the arguments presented for claim 1. App. Br. 15. These arguments however, are not persuasive for the reasons discussed above. Consequently, we find Appellants’ arguments do not show error in the Examiner’s factual findings and the conclusion of obviousness of claims 2 and 13.

ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

Appeal 2018-009126
Application 14/187,853

DECISION

We affirm the Examiner's decision rejecting claims 1–20.

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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED