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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/298,363	10/20/2016	Kayoko SEO	70404.3257/ka	4374

54072 7590 10/15/2020

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EXAMINER	
ZHANG, FAN	

ART UNIT	PAPER NUMBER
2674	

NOTIFICATION DATE	DELIVERY MODE
10/15/2020	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KAYOKO SEO

Appeal 2019-002864
Application 15/298,363
Technology Center 2600

Before ST. JOHN COURTENAY, III, BETH Z. SHAW, and JAMES W. DEJMEK, *Administrative Patent Judges*.

DEJMEK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant[1] appeals under 35 U.S.C. § 134(a) from a Non-Final Rejection of claims 1–9. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b). *See Ex parte Lemoine*, 46 USPQ2d 1420, 1423 (BPAI 1994) (precedential).

We reverse.

[1] Throughout this Decision, we use the word "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42 (2017). Appellant identifies Sharp Kabushiki Kaisha as the real party in interest. Appeal Br. 2.

STATEMENT OF THE CASE

Introduction

Appellant's disclosed and claimed invention generally relates to organizing a number of functional items among a plurality of tabs displayed on an information processing device. *See* Spec. 1:10–14, 3:6–13, 11:23–12:2. As described in the Specification, an information processing device may include scanner functions, printer functions, copier functions, and facsimile functions. Spec. 8:13–17. Functions associated with these modes of operations may be organized within tabs on a display portion of the information processing device. *See* Spec. 11:23–12:6. In a disclosed embodiment, a user may create a customized (i.e., shortcut) tab comprising, for example, recently used functions. *See* Spec. 14:18–15:23, Figs 5–7.

Claim 1 is illustrative of the subject matter on appeal and is reproduced below with the disputed limitation emphasized in *italics*:

> 1. An information processing device connected to a terminal including a display and an operator through a network and capable of executing a plurality of functions relating to information processing, the information processing device comprising:
>
> a controller configured or programmed to:
>
> function as a screen creator that creates an individual tab including a plurality of functional items previously arranged for each screen and having screen information of a list page in which a functional item among the plurality of functional items for each screen is able to be arbitrarily registered and a functional item among registered functional items is able to be arbitrarily deleted; and
>
> function as a setting processor that receives a command to register and delete a functional item that is arbitrarily selected by the operator to the individual tab

having the screen information of the list page displayed on the display of the terminal, from the terminal through the network, causes a storage to store an arbitrarily selected functional item related to the registration and deletion, and also reads the screen information of the list page of a result of the registration and deletion from the storage and guides the screen to the display of the terminal, wherein

the screen creator, when receiving a command to delete the arbitrarily selected functional item from the terminal through the network, determines whether a remaining functional item after the deletion is present from storage content of the storage,

the screen creator creates a screen in which the individual tab having the screen information of the list page is not displayed upon deletion of a last functional item such that no remaining functional item is present, and guides the screen to the display of the terminal through the network, and

the screen creator creates a screen displaying a shortcut symbol button that shows display and non-display corresponding to display and non-display of the individual tab, and guides the screen to the display of the terminal through the network.

The Examiner's Rejections

1. Claim 1–6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Watanabe et al. (US 2016/0077687 A1; Mar. 17, 2016) ("Watanabe"); Steiner et al. (US 2010/0157359 A1; June 24, 2010) ("Steiner"); Patten et al. (US 2015/0121194 A1; Apr. 30, 2015) ("Patten"); and Chaudhri (US 2011/0252346 A1; Oct. 13, 2011). Non-Final Act. 3–8.

2. Claims 7–9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Watanabe, Steiner, Patten, Chaudhri, and Ono (US 2016/0094738 A1; Mar. 31, 2016). Non-Final Act. 9–10.

ANALYSIS[2]

In rejecting claim 1, the Examiner finds, Watanabe teaches, *inter alia*, "a shortcut symbol button is changed between 'on' and 'off' to show whether a custom tab [is] containing items or not containing items." Non-Final Act. 6–7 (citing Watanabe ¶ 7). More particularly, the Examiner explains that the claimed shortcut symbol button only functions as an indication as to whether all of the items within a custom tab have been deleted. Ans. 4. As such, the Examiner finds that

> display or non-display of a custom tab is equivalent to non-completely deleting or completely deleting of items associated with the tab, the "on"/"off" setting for indication of non-completely deleting or completely deleting of items would have served the same purpose for indication of display or non-display of the custom tab.

Ans. 5.

Appellant asserts that Watanabe, as relied on by the Examiner, merely identifies Japanese Patent Laid-Open No. 2006-98803, which describes a custom menu being displayed when there are items contained within the custom menu and not displayed if the plurality of items are deleted from the custom menu. Appeal Br. 5–6 (citing Watanabe ¶ 7). Appellant argues that rather than teaching the claimed shortcut symbol button, the custom menu

[2] Throughout this Decision, we have considered the Appeal Brief, filed July 30, 2018 ("Appeal Br."); the Examiner's Answer, mailed November 16, 2018 ("Ans."); and the Non-Final Office Action, mailed March 19, 2018 ("Non-Final Act."), from which this Appeal is taken. Appellant did not file a Reply Brief. To the extent Appellant has not advanced separate, substantive arguments for particular claims or issues, such arguments are considered waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

discussed in Watanabe corresponds to the claimed individual tab. Appeal Br. 5–6.

As recited in claim 1, a screen creator creates an individual tab that may include a plurality of functional items, each of which may be individually registered or deleted from the individual tab. Additionally, the screen creator creates a screen displaying a shortcut symbol button that provides a display/non-display indication "corresponding to display and non-display of the individual tab." *See* Claim 1. Thus, the Examiner is required to find the prior art teaches a screen creator that creates *both* an individual tab and a shortcut symbol button. *See Applied Med. Res. Corp. v. U.S. Surgical Corp.*, 448 F.3d 1324, 1333 n.3 (Fed. Cir. 2006) ("[T]he use of two terms in a claim requires that they connote different meanings . . . ."); *see also* 37 C.F.R. § 1.104(c)(2) ("When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable."). Here, rather than finding the prior art teaches a shortcut symbol button as recited in claim 1, the Examiner finds the custom menu of Watanabe (i.e., which corresponds to the claimed individual tab), is capable of providing a similar display/non-display indication as the recited shortcut symbol button. As such, the Examiner has not shown by a preponderance of evidence that the prior art teaches or reasonably suggests the claimed shortcut symbol button.

Because we find it dispositive that the Examiner has not shown by a preponderance of evidence that the cited prior art teaches or reasonably suggests the claimed shortcut symbol button as recited in claim 1, we do not address other issues raised by Appellant's arguments related to these claims. *See Beloit Corp. v. Valmet Oy*, 742 F.2d 1421, 1423 (Fed. Cir. 1984)

(finding an administrative agency is at liberty to reach a decision based on "a single dispositive issue").

For the reasons discussed *supra*, and constrained by the record before us, we do not sustain the Examiner's rejection of independent claim 1. For similar reasons, we do not sustain the Examiner's rejection of claims 2–6, which depend therefrom.

Claims 7–9 also depend from claim 1. In addition to Watanabe, Steiner, Patten, and Chaudhri (as relied on by the Examiner in rejecting claim 1), the Examiner also relies on the teachings of Ono in rejecting claims 7–9. *See* Non-Final Act. 9–10. Although Ono *does* teach a shortcut button displayed on an information processing device (*see, e.g.*, Ono, Fig. 2A), the Examiner does not rely on Ono to remedy the deficiencies of Watanabe, discussed above, with respect to claim 1.[3]

Accordingly, we do not sustain the Examiner's rejection of claims 7–9.

CONCLUSION

We reverse the Examiner's decision rejecting claims 1–9 under 35 U.S.C. § 103.

[3] Although the Board is authorized to reject claims under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so. *See* Manual of Patent Examining Procedure (MPEP) § 1213.02 (9th ed. Rev. 08.2017, Jan. 2018).

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–6	103	Watanabe, Steiner, Patten, Chaudhri		1–6
7–9	103	Watanabe, Steiner, Patten, Chaudhri, Ono		7–9
Overall Outcome				1–9

REVERSED