

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHEE H. CHEW and NEIL W. KONZEN

Appeal No. 2001-1308
Application No. 08/354,491

ON BRIEF

Before HAIRSTON, GROSS, and SAADAT, ***Administrative Patent Judges.***
GROSS, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 2. Claims 3 through 8 have been allowed, and in the Answer (page 2) the examiner withdrew the rejection of claims 9 and 10.

Appellants' invention relates to a computer system with a software program utilizing an application program interface to request services from a windowed operating system, wherein the application program interface includes a separate command to request each service. Claim 2 is illustrative of the claimed invention, and it reads as follows:

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2. In a computer-based method of running a software program on a computer, the computer operating under an operating system that provides a windowed display of graphical items, at least some of said items having text associated therewith, the method including issuing instructions from the software program requesting at least ten of the following functions from the operating system, each instruction corresponding to only one of said functions:

arranging the items in an icon view;

creating a drag image list for a specified item;

removing all items from the window;

removing a column of items from the window;

removing an item from the window;

beginning in-place editing of text associated with a specified item;

ensuring that an item is entirely or at least partially visible, scrolling a window control if necessary;

searching for an item with specified characteristics;

retrieving a background color of the window;

retrieving a callback mask for the window;

retrieving attributes of a window column;

retrieving a width of a column in the window;

calculating a number of items that can fit vertically in a visible area of the window;

retrieving a handle of an edit control being used to edit an item's text;

retrieving a handle of an image list used for drawing items;

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retrieving some or all of an item's attributes;
retrieving a number of items in the window;
retrieving a position of an item in the window;
retrieving a bounding rectangle for all or part of an item
in a current view of the window;
retrieving a state of an item;
retrieving text associated with an item;
searching for an item that has specified properties and that
bears a specified relationship to a given item;
retrieving a current view origin for the window;
determining a minimum column width necessary to display all
of a given string;
retrieving a text background color of a window;
retrieving a text color of a window;
retrieving an index to a topmost visible item in the window;
retrieving a bounding rectangle of all items in the window;
determining which item, if any, is at a specified position;
inserting a new column in a window;
inserting a new item in a window;
forcing a window to repaint a range of items;
scrolling contents of a window;
setting a background color of the window;
setting a callback mask for a window;

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setting attributes of a window column;
changing a width of a window column;
assigning an image list to a window;
setting some or all of an item's attributes;
preparing a window for adding items;
moving an item to a specified position in the window;
changing a state of an item in the window;
changing text associated with an item;
setting a background color of text in the window;
setting a text color of a window;
sorting items using an application-defined comparison
function; and
updating an item.

The prior art reference of record relied upon by the
examiner in rejecting the appealed claims is:

Robert Cowart, **Mastering Windows™ 3.1 Special Edition**, SYBEX,
1993, pp. 1-964. (Cowart)

Claims 1 and 2 stand rejected under 35 U.S.C. § 102 as being
anticipated by Cowart.

Reference is made to the Examiner's Answer (Paper No. 14,
mailed February 18, 1998) for the examiner's complete reasoning
in support of the rejection, and to appellants' Brief (Paper No.

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10, filed December 23, 1997) and Reply Brief (Paper No. 16, filed April 20, 1998) for appellants' arguments thereagainst.

OPINION

We have carefully considered the claims, the applied prior art reference, and the respective positions articulated by appellants and the examiner. As a consequence of our review, we will reverse the anticipation rejection of claims 1 and 2.

The examiner (Answer, page 3) states that Cowart discloses "the application program interface **inherently** including a separate command (i.e., corresponding to an invoked function or method) to request each of the following services" followed by the claimed list of services. (Emphasis ours.) As indicated by appellants (Brief, pages 7-8, and Reply Brief, pages 2-3), nowhere does the examiner provide a basis for asserting that a separate command inherently is used to request each service. Also, as pointed out by appellants (Brief, page 8), the examiner (Answer, page 3) refers to the same drag-and-drop function of Windows 3.1 for three different services, thereby suggesting that a separate command is not used for each service.

As explained in **Continental Can Co., U.S.A. v. Monsanto Co.**, 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) and reproduced in **Finnigan Corp. v. U.S. ITC**, 180 F.3d 1354, 1365, 51

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USPQ2d 1001, 1009 (Fed. Cir. 1999), "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." In addition, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the examiner. **See In re Lee**, 277 F.2d 1338, 1342-43, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). As the examiner has failed to supply any evidence of inherency, no **prima facie** case of anticipation has been established, and we cannot sustain the rejection of claims 1 and 2.

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CONCLUSION

The decision of the examiner rejecting claims 1 and 2 under
35 U.S.C. § 102(b) is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
ANITA PELLMAN GROSS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
MAHSHID D. SAADAT)	
Administrative Patent Judge)	

AG/RWK

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KLARQUIST SPARKMAN CAMPBELL
LEIGH & WHINSTON
ONE WORLD TRADE CENTER SUITE 1600
121 S W SALMON STREET
PORTLAND, OR 97204