

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL JOSEPH REDER and CAROLE AMELIA MCCALLUM

Appeal No. 2001-2101
Application No. 09/111,495

ON BRIEF

Before JERRY SMITH, RUGGIERO, and LEVY, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-6 and 8-24, which are all of the claims pending in the present application. Claim 7 has been canceled.¹

The claimed invention relates to a method and system for customizing a graphical user interface (GUI) in which the command structure is dynamically modified in response to direct

¹ Our review of the language of the appealed claims reveals that claims 12 and 13 improperly remain dependent on canceled claim 7.

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manipulation using a graphical pointer controlled by a pointing device such as a mouse. The command structure is modified using a direct manipulation "drag-and-drop" procedure in which command items are moved from a first location to a second location within the command structure, or from a first command structure location to a second location outside the command structure.

Claim 1 is illustrative of the invention and reads as follows:

1. A computer system comprising:

a display device;

a pointing device; and

processor means for generating a graphical user interface on said display device, said graphical user interface including a window having a command structure, and further including a graphical pointer controlled by said pointing device, wherein said processor means dynamically modifies said command structure at runtime in response to direct manipulation of said command structure using said graphical pointer to drag a command item across a portion of the graphical user interface.

The Examiner relies on the following prior art:

Hahn et al. (Hahn)	5,751,287	May 12, 1998
Solimene et al. (Solimene)	5,828,376	Oct. 27, 1998
		(filed Sep. 23, 1996)

Claims 1-6 and 8-24 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Solimene in view of Hahn.

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Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs² and the Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in appealed claims 1-6 and 8-24. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to

² The Appeal Brief was filed October 16, 2000 (Paper No. 7). In response to the Examiner's Answer mailed January 17, 2001 (Paper No. 8), a Reply Brief was filed March 6, 2001 (Paper No. 9), which was acknowledged and entered by the Examiner in the communication dated March 28, 2001 (Paper No. 10).

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support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073-74, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to each of the appealed independent claims 1, 14, and 20, Appellants' response (Brief, pages 5 and 6; Reply

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Brief, page 2) to the obviousness rejection asserts a failure by the Examiner to establish a prima facie case of obviousness since proper motivation for the Examiner's proposed combination of references has not been set forth. After reviewing the arguments of record from both Appellants and the Examiner, we are in general agreement with Appellants' position as stated in the Briefs.

In particular, we agree with Appellants that the applied Solimene and Hahn references are directed to fundamentally different approaches to solving the problems associated with improving the ease of operation of graphical user interfaces. In this regard, our interpretation of the disclosure of Solimene coincides with that of Appellants, i.e., while a command structure is modified to implement the incorporation of a "hyperbutton," any such modification is performed by user prompts through a dialog window (Solimene, Figures 6A and B), not through direct manipulation by dragging and dropping using a graphical pointer as claimed.

Further, while the Hahn reference uses a "drag-and-drop" operation to move documents and folders from one analogized "file drawer" or "file cabinet" to another, there is no suggestion or teaching of the modification of a "command" structure as claimed.

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Given the disparity of problems addressed by the applied prior art references, and the differing solutions proposed by them, it is our view that any attempt to combine them in the manner proposed by the Examiner could only come from Appellants' own disclosure and not from any teaching or suggestion in the references themselves. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992).

Further, while the Examiner, at page 6 in the "**Response to Argument**" portion of the Answer, suggests that the specifically claimed dragging and dropping of "command" items actually refers to the dragging of "data objects" such as in Hahn, we find no support for the Examiner interpreting the claim language in this manner. In our view, the skilled artisan would recognize and appreciate the distinction between "command" items, which are instructions which cause an action to be performed, and "data objects" such as the files and folders described in Hahn.

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In view of the above discussion, since the Examiner has not established a prima facie case of obviousness, the 35 U.S.C. § 103(a) rejection of independent claims 1, 14, and 20, as well as claims 2-6, 8-13, 15-19, and 21-24 dependent thereon, is not sustained.

In summary, we have not sustained the Examiner's 35 U.S.C. § 103(a) rejection of any of the claims on appeal. Accordingly, the decision of the Examiner rejecting claims 1-6 and 8-24 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
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