

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN JOHN CRAGUN

Appeal No. 2001-2381
Application 09/025,155

ON BRIEF

Before THOMAS, HAIRSTON, and JERRY SMITH, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 28-48, which constitute all the claims remaining in the application.

The disclosed invention pertains to a method and apparatus for automatically swapping application tasks running

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Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

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, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection 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 claims 28-48. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual

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determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 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). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472,

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223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 1.192(a)].

The examiner has indicated how he finds the claimed invention to be obvious over the teachings of Slotznick [answer, pages 3-6]. Specifically, after essentially reading the invention of claim 1 on the disclosure of Slotznick, the examiner asserts that "[I]t would be obvious that the multitasking application operates separate from the communications application since code for displaying secondary information does not have to be the same code ... and both the communications application and multitasking application have separate windows."

With respect to independent claims 28, 35 and 42, which stand or fall together as a single group [brief, page 5], appellant argues that Slotznick does not teach or suggest automatically switching focus from a communications application to another active application in response to the initiation of a link to a remote network site. More particularly, appellant argues that Slotznick relates to a single application that

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displays multiple windows. Appellant argues that it was improper for the examiner to equate the windows of Slotznick with applications running on a computer. The essence of appellant's position is that Slotznick switches between processes of a single application rather than from a communications application to an active multitasking application as claimed. Appellant also argues that the portion of Slotznick related to filtering teaches away from the claimed invention [brief, pages 6-9].

The examiner responds that Slotznick teaches that windows are equated with applications and that the windows are programs capable of displaying information. The examiner asserts that since Slotznick equates a window to a program, and since an application is a program, then a window is considered to be an application. Therefore, the examiner finds that the two display windows of Slotznick teach the claimed invention [answer, pages 6-12].

Appellant responds that the examiner's attempt to equate a window to an application distorts the clear meaning of the claimed invention [reply brief].

We will not sustain the examiner's rejection of independent claims 28, 35 and 42 or of any of the claims which depend therefrom for essentially the reasons argued by appellant.

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We agree with appellant that the windows of Slotznick do not equate to multitasking applications as claimed. The examiner's finding that Slotznick teaches that windows equate to applications is not supported by the referenced portion of Slotznick. Specifically, the reference merely notes that when information from the Internet is downloaded to a window, that window automatically becomes the active window and is displayed on top of all other windows [column 3, lines 28-34]. This portion of the reference clearly does not establish that a window is an application. The invention of Slotznick simply permits different information received from the Internet to be displayed during interstitial space. The different information displayed in Slotznick is retrieved by the same communications application and this information does not interact with other applications running on the computer in any manner. Thus, we find the examiner's attempt to interpret the two display windows of Slotznick as the claimed multitasking applications to be an unreasonable interpretation of the claimed invention and unsupported by the cited prior art.

Although appellant has separately argued the patentability of some of the dependent claims, there is no need to separately consider these claims since the discussion above

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applies to these claims as well by virtue of their dependency from one of the independent claims considered above.

In summary, we have not sustained the examiner's rejection of the claims on appeal. Therefore, the decision of the examiner rejecting claims 28-48 is reversed.

REVERSED

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| JAMES D. THOMAS |) | |
| Administrative Patent Judge |) | |
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| KENNETH W. HAIRSTON |) | BOARD OF PATENT |
| Administrative Patent Judge |) | APPEALS AND |
| |) | INTERFERENCES |
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| JERRY SMITH |) | |
| Administrative Patent Judge |) | |

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BRACEWELL & PATTERSON, L.L.P.
P.O. BOX 969
AUSTIN TX 78767-0969