The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 41

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARRY APPELMAN

Appeal No. 2002-0366
Application No. 08/803,692

HEARD: October 7, 2003

Before RUGGIERO, GROSS, and LEVY, Administrative Patent Judges.

LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 3-7 and 10-46[1],[2], which are all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to user definable on-line co-user lists. An understanding of the invention can be derived from a reading of exemplary claim 5, which is reproduced follows:

5. The method of claim 15, further comprising, based on block selections received from the user, selectively blocking co-users from adding the user to their associated user-definable co-user lists.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Tang et al. (Tang'365)	5,793,365	Aug. 11, 1998 (filed Jan. 2, 1996)
Tang et al. (Tang'173)	5,960,173	Sep. 28, 1999

[1] Two amendments (Paper No. 22, filed June 2, 2000, and Paper No. 32, filed January 28, 2003) were filed by appellant subsequent to the final rejection. The former was entered by the examiner (Paper No. 23, mailed June 14, 2000). The latter was denied entry by the examiner (Paper No. 38, mailed June 4, 2003). It is unclear from the record as to why the examiner denied entry of the latter amendment, as the amendment merely canceled claims and rewrote other claims in independent form, which would have reduced the issues before us on appeal.

[2] At the Oral Hearing, counsel for appellant indicated that the appeal should be dismissed as to claims 3, 4, 7, 10, 11, 14-20, 25, 26, 28-34, 39, 40 and 42-46, as appellants intend to cancel these claims subsequent to the appeal, and that the appeal should proceed only as to claims 5, 6, 12, 13, 21-24, 27, 35-38, and 41. Accordingly, the appeal as to claims 3, 4, 7, 10, 11, 14-20, 25, 26, 28-34, 39, 40 and 42-46 is dismissed. By dismissing the appeal as to these claims, we consider the dismissal to be an acknowledgment that these claims are met by the prior art relied upon by the examiner. Upon return of the application to the examiner, the status of the dismissed claims is that they stand finally rejected.

(filed Dec. 22, 1995)

Claims 5, 6, 12, 13, 21-24, 27, 35-38, and 41 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Tang'365 in view of Tang'173. Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 28, mailed January 17, 2001) for the examiner's complete reasoning in support of the rejections, and to appellant's brief (Paper No. 27, filed November 1, 2000) for appellant's arguments thereagainst. 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. See 37 CFR 1.192(a).

OPINION

In reaching our decision in this appeal, 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, appellant's arguments set forth in the brief along with the

examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we affirm-in-part. We begin with the rejection of claims **5, 6, 12, 13, 21-24, 27, 35-38, and 41** under 35 U.S.C. § 103(a) as being unpatentable over Tang'365 in view of Tang'173.

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 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. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); 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. 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, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

We consider first the rejection of claims 5 and 12 based on the teachings of Tang'365 in view of Tang'173. The examiner's position (answer, page 5) is that Tang'365 does not discuss the ability of the user to selectively prevent others from being informed when they are on-line. To overcome this deficiency in Tang'365, the examiner turns to Tang'173 for a teaching of being able to selectively prevent others from being able to identify or contact an individual based on some criteria.

Appellant asserts (brief, page 10) that claim 5 recites selectively blocking co-users from adding a user to their associated user definable co-user lists, based on block

selections received from the user. Appellant (breif, page 11) acknowledges that Tang'173 describes a system in which a worker in a work group can select a closed mode to prevent the worker's representation from being provided to other task proximate workers. However, appellant argues that the closed mode applies to all other co-workers, and cannot be selectively enabled so as to select co-workers.

From our review of Tang'365, we agree with the examiner that Tang'365 does not disclose the ability of the user to selectively prevent others from being informed when they are on-line. From our review of Tang'173, we find that Tang'173 discloses a closed mode (col. 10, lines 28 and 29) in which no representation is made to other task proximate workers. From our review of Tang'173, we agree with appellant that the closed mode feature of Tang'173 applies to all other co-workers. Thus, we find no disclosure in Tang'365 or Tang'173 of providing a worker with the ability to select which other workers can add the worker to their associated user-definable co-user lists. In sum, we find that the combined teachings of Tang'365 and Tang'173 do not teach or suggest selectively blocking co-users from adding the user to their associated user-definable co-user lists, as required by claims 5 and 12. Because the examiner has failed to establish a

prima facie case of obviousness of claims 5 and 12, the rejection of claims 5 and 12 under 35 U.S.C. § 103(a) is reversed. As claims 6 and 13 depend from claims 5 and 12, respectively, the rejection of claims 6 and 13 under 35 U.S.C. § 103(a) is reversed.

We turn next to claims 21-24. We begin with claim 21. We find that Tang'365 discloses (col. 2, lines 56-58) monitoring the presence or level of activity of each worker. Tang'365 discloses (col. 5, lines 19-21) the use of a gallery window 10 which provides visual representations of a set of selected workers, relating to the worker's level of activity (col. 5, lines 15 and 16, and 44 and 45). Activity levels include: "attentive" which means the worker is actively working at his computer; "idle" which means the worker is not actively working at his computer; "engaged" which means that the worker is engaged in a computer mediated interaction with other workers; "do not disturb" which means that the worker has established that the worker does not wish to be disturbed at this time, and "absent" which means that the user is not in his office (col. 5 line 56 through col. 6, line 55). Thus, the worker's activity level is a function of their use of their computer or their presence in the workspace (col. 6, lines 64-66). If the keyboard is idle for a

predetermined period of time, such as three minutes, the gallery display is updated to indicate that the worker is in the idle level of activity. If the keyboard is idle for a predetermined period, such as two hours, the activity level is updated to "absent." In an alternative embodiment, an absent determination may be based on whether the worker has logged out of his computer (col. 7, lines 7-18). Thus, the activity level is updated automatically, preferably any time there is a change in the worker's state (col. 7, lines 20-22). Each user determines which other workers' icons to have in his gallery window 10 (col. 13, lines 15 and 16). Tang'365 further discloses that when the user logs on and starts up, the activity manager 91 is also started up on the user's computer. The activity manager monitors the windows and keyboard and determines whether the computer 101 is active (col. 14, line 64 through col. 15, line 1).

From the disclosure that the activity manager is started up and monitors the activity of the computer when the user logs on, and the teaching of Tang'365 that the user is determined to be absent when the user logs off from his computer, we find that the system of Tang'365 monitors log-on and log-off of the computer, in addition to monitoring user activity. If Tang'365 can sense the logging off of a user, Tang'365 must inherently be able to

know that the user was logged in before logging out. In addition, the monitoring of the keyboard, mouse, etc. are indicative of whether or not the user is logged onto the computer. Thus, we find that in addition to determining log-on and log-off of the computer, Tang'365 discloses additional monitoring of the activity of the user. Accordingly, we find that Tang'365 discloses displaying in the gallery window information indicative of the currently logged-on co-subscribers among those in the predefined personal directory, and indicates a change in log-on status of at least one of the co-subscribers in the predefined personal directory, as recited in claim 21. However, Tang'365 does not disclose playing a sound to indicate the change in log-on status, such as logging off from the user's or worker's computer. However, Tang'173 discloses that in addition to a visual indication, an aural indication be provided (col. 4, lines 31-35, and 61 and 62). From the disclosure of Tang'173 of providing an aural indication and the disclsoure of Tang'365 of incorporating the disclosure of Tang'173 by reference (col. 1, lines 7-12), we find that an artisan would have been motivated to provide aural indications in the system of Tang'365. Accordingly, we find that the teachings of Tang'365 and Tang'173 would have suggested the limitations of claim 21. The rejection

of claim 21 under 35 U.S.C. § 103(a) is therefore affirmed.

Turning to claims 22-24, Tang'173 discloses (col. 7, lines 29-36) that "[i]n addition to the visual representation of workers in the encounter window, an aural indication may be used to indicate each time a worker becomes task proximate, or loses task proximity. Different aural indications may be used for each of these events, for example, with a long beep tone when a worker becomes task proximate, and a short beep tone when a worker loses proximity. Other sound effects may also be used," and (col. 10, lines 3-6) "[i]n addition, the minimal mode optionally includes aural indications commensurate with the visual ones, with distinct tones for when a worker enters the task space and for when a worker leaves the task space." From these disclosures of Tang'173, we find that Tang'173 would have suggested to an artisan allowing a user to select a sound, and that different sounds be provided to indicate when a person has logged on or logged off. From all of the above, the rejection of claims 22-24 under 35 U.S.C. § 103(a) is affirmed.

We turn next to the rejection of claim 27.

We find that in Tang'365, each worker decides which other worker's visual representations are displayed in the gallery window (col. 5, lines 19-21). If the worker has established that

they do not want to be disturbed, this is indicated by the icon (figure 2). To contact another worker, the current worker selects one or more of his icons 14, 17 and presses the contact button (col. 8, lines 3-5). Turning to Tang'173, we find that Tang'173 discloses various modes of awareness about other workers. The mode of awareness is specified by each worker independently, and controls both ends of the encounter, i.e., how the encounter mechanism appears to the current worker, and how the current worker appears to the encounter window 20 of the other workers. The open mode is used by workers who are receptive to interacting with other workers who are task proximate (col. 6, line 66 through col. 7, line 17). From the disclosure of Tang'173 we find that by selecting the open mode, the worker grants permission to have himself added to the encounter window of other subscribers. If he chooses the closed mode, no representation of him is provided to the other workers. Thus, by choosing the open mode, the worker grants permission to have other logged-on workers add him to the other workers' encounter window. In addition, we find from Tang'365 that a co-worker is selected by selecting his icon and pressing the contact button. Thus, we find that the combined teachings of Tang'365 and Tang'173 teach the steps set forth in the method of claim 27,

but not in the order recited in the claim, because the co-worker grants permission to be in the encounter window of other workers before he is selected. Although Tang'173 further discloses (col. 10, lines 34-36) that alternatively, the worker can specify for each mode the type or degree of information to be provided back to the other workers, we find that this disclosure does not suggest, without speculation, the granting of permission after a request to add the co-worker has been made. In sum, we find that the steps of claim 27 are met by the teachings of Tang'365 and Tang'173, but they are not met in the order recited. However, we find nothing in the claim, specification, or prosecution history, that would require that the steps be carried out in the order claimed. As set forth by the court in Interactive Gift Express Inc. v. CompuServe Inc., 59 USPQ2d 1401, 1416 (Fed. Cir. 2001) "Unless the steps of a method actually recite an order, the steps are not ordinarily construed to require one." See Loral Fairchild Corp. v. Sony Corp., 181 F.3d 1313, 1322, 50 USPQ2d 1865, 1870 (Fed. Cir. 1999) (stating that "not every process claim is limited to the performance of its steps in the order written"). However, such a result can ensue when the method steps implicitly require that they be performed in the order written. See Loral, 181 F.3d at 1322, 50 USPQ2d at 1870 (stating

that "the language of the claim, the specification and the prosecution history support a limiting construction[, in which the steps must be performed in the order written,] in this case"). From all of the above, we affirm the rejection of claim 27 under 35 U.S.C. § 103(a).

We turn next to claims 35-38. We affirm the rejection of claims 35-38 under 35 U.S.C. § 103(a) for the same reasons relied upon, supra, with respect to claims 21-24.

We turn next to claim 41. We affirm the rejection of claim 41 under 35 U.S.C. § 103(a) for the same reasons we relied upon, supra, with respect to claim 27.

CONCLUSION

To summarize, the decision of the examiner to reject claims 5, 6, 12, and 13, under 35 U.S.C. § 103(a) is reversed.

The decision of the examiner to reject claims 21-24, 27, 35-38, and 41 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136 (a).

AFFIRMED-IN-PART

JOSEPH F. RUGGIERO Administrative Patent Judge	)	
ANITA PELLMAN GROSS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
STUART S. LEVY Administrative Patent Judge	)	

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