

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JEFFREY PHILLIP SNOVER

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Appeal No. 2002-0367  
Application No. 09/108,147

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ON BRIEF

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Before THOMAS, KRASS and SAADAT, Administrative Patent Judges.  
KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-52, all of the pending claims.

The invention is directed to an interactive computer controlled display wherein computing components may be added to a computer operation. The computer components are accessed and added outside of, i.e., non-native to, a current computer

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operation through an organized and user-friendly interactive interface.

Representative independent claim 1 is reproduced as follows:

1. In an interactive computer controlled display, a system for adding computing components to a computer operation comprising:

means for predetermining a plurality of computing components to be selectively added to said operation,

means for displaying a plurality of system elements,

means for predetermining at least one invocative attribute for each of said elements,

means responsive to the occurrence of an invocative attribute for enabling said selective addition of an associated computing component to said operation,

means for displaying a listing of said computing components enabled for said selective addition for each of said displayed elements, and

means for selecting at least one of said listed enabled computing components to thereby add said associated computing component.

The examiner relies on the following references:

Garvey et al. (Garvey)	5,774,667	Jun. 30, 1998 (filed Mar. 27, 1996)
Spofford et al. (Spofford)	5,913,037	Jun. 15, 1999 (filed Jul. 3, 1996)

Claims 1-52 stand rejected under 35 U.S.C. § 103 as

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unpatentable over Garvey in view of Spofford.

Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

OPINION

At the outset, we note that, in accordance with appellant's grouping of the claims, at page 4 of the principal brief, all claims will stand or fall together. Accordingly, we will focus on independent claim 1.

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 much stem from some teachings, suggestions or implications 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,

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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, 1040, 228 USPQ 685, 687 (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, 1051, 189 USPQ 143, 146-147 (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 the initial burden of establishing the prima facie case of obviousness and we find that the examiner has

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not met that burden in the instant case.

Taking claim 1, the important elements of which are present in each and every claim, the examiner says that the "means for predetermining a plurality of computing components to be selectively added to said operation" is taught by Garvey at column 5, lines 1-2 ("window selector 480 allows the user to select other setup windows for setting up remote access server parameters"). The examiner cites column 4, lines 21-22, of Garvey ("Referring... to FIG. 3, the remote access server manager window 300 provides a list 310 of the remote access servers coupled to the network") as a teaching of the claimed "means for displaying a plurality of system elements." For the claimed "means for predetermining at least one invocative attribute for each of said elements," the examiner relies on the teaching, by Garvey, of "To edit the parameters for a particular async interface port, the async interface port is selected and then the edit port button 690 is selected" at column 5, lines 11-13, and "To learn more about a particular remote access server, the user selects a remote access server from the list and then selects the comm. server info button 340."

For the teaching of the claimed "means responsive to the

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occurrence of an invocative attribute for enabling said selective addition of an associated computing component to said operation" and the claimed "means for displaying a listing of said computing components enabled for said selective addition for each of said displayed elements," the examiner again refers to column 4, lines 21-22, of Garvey. Referring, broadly, to Figures 5-13 of Garvey, and specifically to column 4, line 24, ("then selects the add button 320") of Garvey, the examiner says that this section of the patent teaches the claimed "means for selecting at least one of said listed enabled computing components to thereby add said associated computing component."

In fact, the examiner contends that Garvey teaches the claimed subject matter but for explicitly "*enabling and adding new components or elements*" (answer-page 5). The examiner relies on Spofford to supply the alleged omission by Garvey. Specifically, the examiner cites column 6, lines 40 et seq., of Spofford, "the network unit 112 and/or the management module 116 is able to detect connection of a new network device or node through any one of the ports 104" and concludes that it would have been obvious "to incorporate the enabling function as taught in Spofford into the computer network management system in Garvey because Garvey operates with managing computer networks and

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Spofford suggests that added components can be managed once they have been added to a computer network" (answer-page 6).

We disagree.

First, we find it suspect that two or three lines in Garvey, column 4, lines 20-22, "the remote access server manager window 300 provides a list 310 of the remote access servers coupled to the network" is said to teach the claimed, "means for displaying a plurality of system elements," "means responsive to the occurrence of an invocative attribute for enabling said selective addition of an associated computing component to said operation," and "means for displaying a listing of said computing components enabled for said selective addition for each of said displayed elements." Frankly, we do not understand how those few lines in Garvey teach all three of the cited claimed "means."

It appears that the examiner is giving an unreasonably broad interpretation to the terms of the instant claims. For example, claim 1 requires, inter alia, a "means responsive to the occurrence of an **invocative attribute** for each of said elements" [emphasis added]. While the instant specification does not explicitly define this emphasized term, it is clear from the specification, as argued by appellant at page 2 of the reply

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brief, that it refers to some "condition in the operation of a computer controlled user interactive display which if present enables a resulting condition." The specification does give an enlightening example at page 13 of the specification, wherein two invocative attributes, such as an IP address and a home web page, are set forth. As the specification states, "Thus, for each element, the expression to permit invocation or enablement of the computing component for addition would be the existence of an IP address and the existence of a home web page." If either one of these attributes does not exist, then invocation or enablement of the computing component is not enabled.

We find no such "invocative attribute" in Garvey, and certainly nowhere within lines 20-22 of column 4, cited by the examiner as disclosing this claim limitation. We also note that since the examiner has withdrawn a rejection under 35 U.S.C. § 112, based on a problem with the term, "invocative attribute," it is clear that the examiner understands the term as it is used in the instant specification and the instant claims. If the examiner understands the term to be as used in the instant specification to mean a condition, if present, which would enable a resulting condition, the examiner's apparent broad reading of this term to include the mere selection of any menu item,

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resulting in some condition, appears to be unreasonable. This is because the instant claims call for predetermining at least one invocative attribute for each of a plurality of system elements and then, responsive to the occurrence of an invocative attribute, enabling the selective addition of an associated computer component to the operation of the computer.

If the mere selection of a menu item in Garvey is an "invocative attribute," then there is nothing in Garvey responsive to this selection that enables a "selective addition of an associated computing component..." because once the selection of a menu item is made in Garvey, there is no "selective addition" to be made. The menu item in Garvey is merely opened on selecting that item. And if one were to say that the act of opening the menu in Garvey is the "invocative attribute" and the selection of an item from that drop down menu is the "means responsive to the occurrence of an invocative attribute for enabling said selective addition..." then there would still be the problem of the claimed "means for displaying a listing of said computing components enabled for said selective addition for each of said displayed elements" for no such listing would be, or can be said to be, displayed in Garvey.

Since Spofford does not provide for the deficiencies of

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Garvey, we find that no prima facie case of obviousness has been shown by the examiner.

Moreover, even if, arguendo, Garvey and Spofford taught what is alleged by the examiner, it is not clear to us what would have led the artisan to modify Garvey in any way to provide for enabling and adding of new components since Garvey does not appear to be interested in, nor does Garvey require, such new components.

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For at least the reasons supplied supra, we will not sustain  
the rejection of claims 1-52 under 35 U.S.C. § 103.

The examiner's decision is reversed.

REVERSED

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	
ERROL A. KRASS	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
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MAHSHID D. SAADAT	)	
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