

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARY LEE BATES
and
PAUL REUBEN DAY

Appeal No. 2003-1328
Application No. 09/007,493

ON BRIEF

Before FLEMING, SAADAT and MACDONALD, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-37, which are all of the claims pending in this application.

We reverse.

BACKGROUND

Appellants' invention is directed to a method for displaying the hypertext links on a computer display. According to Appellants, the existing applications typically create static

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documents that are rendered in the same manner and with the same relative position of the displayed objects on all computer systems. Therefore, there is a need to modify the relative alignment of hypertext links where the resulting displayed representation of the document can vary from system to system (specification page 3).

Representative independent claim 1 is reproduced below:

1. A method of displaying a document on a computer display, the document of the type including first and second hypertext links, the method comprising:

(a) determining display positions for the first and second hypertext links within a displayed representation of the document;

(b) adjusting the display position of at least one of the first and second hypertext links based upon the determined display positions to modify the relative alignment of the first and second hypertext links; and

(c) after adjusting the display position, displaying the first and second hypertext links on the computer display at the display positions thereof.

The Examiner relies on the following reference in rejecting the claims:

Denise Tyler et al. (Tyler), "Microsoft FrontPage 98," (Laura Lemay's Web Workshop), pp. 44, 157, November 1997.

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Claims 1-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tyler.

We make reference to the answer (Paper No. 11, mailed October 22, 2001) for the Examiner's reasoning, and to the appeal brief (Paper No. 10, filed August 3, 2001) and the reply brief (Paper No. 12, filed February 22, 2002) for Appellants' arguments thereagainst.

OPINION

The Examiner relies on page 157 of Tyler for showing instructions related to moving hotspots while page 44 shows various formatting controls (answer, page 3). The Examiner further argues that Tyler implicitly teaches the claimed "adjusting the display position" since any changes made to the font size of a textual link will necessarily change the alignment between the hypertext links (id.). Acknowledging that Tyler does not disclose the adjustment based on the determined positions, the Examiner concludes that "any change in the text would necessarily require" such adjustment (answer, page 4).

Appellants argue that claim 1 relates to manipulation based upon the determined displayed positions whereas Tyler is merely

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an HTML editor with formatting controls that allow a user to manually edit an HTML web page (brief, page 6). Additionally, Appellants assert that Tyler is silent with regard to the problems associated with various alignment conditions between hypertext links and cannot suggest the modification necessary for adjusting the display position based on the determined positions (brief, page 8 and reply brief, page 2).

In response to Appellants' arguments, the Examiner asserts that Appellants' claims do not specify whether the process is automated or performed manually (answer, page 6). The Examiner concludes that the claims read on the manual editing performed by the user in Tyler (id.).

Initially, we note that in rejecting claims under 35 U.S.C. § 103, it is the Examiner who bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). Furthermore, in considering the question of the obviousness of the claimed invention in view of the prior art relied upon, the Examiner is expected to make the factual determination 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

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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. See also In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000), citing B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996).

Upon our review of Tyler, we agree with Appellants' analysis of the reference and note that the disclosed manual editing of Tyler lacks any guidance as to how the display positions should be adjusted by the user other than the desire of the user. Although the user can change the position of the hotspots, there is no teaching or suggestion that such change is done based upon any "determined display positions." We do not need to address the Examiner's arguments related to whether the adjustment is done automatically or manually since it is the claimed adjusting of the display position based on the determined positions that the examiner has failed to establish by any specific teachings or

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suggestions in Tyler. We also agree with Appellants (reply brief, page 2) that the ability of the user to make modifications to the display position is not sufficient to show a suggestion or motivation to modify the teachings of Tyler.

In view of our analysis above, we find that the Examiner has failed to set forth a prima facie case of obviousness with respect to claim 1 and the other independent claims 23-25 and 35 as the necessary teachings and suggestions related to the claimed adjusting of the display position based on the determined positions are not shown. Accordingly, we do not sustain the 35 U.S.C. § 103 rejection of independent claims 1, 23-25 and 35, nor of claims 2-22, 26-34, 36 and 37, dependent thereon.

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CONCLUSION

In view of the foregoing, the decision of the Examiner
rejecting claims 1-37 under 35 U.S.C. § 103 is reversed.

REVERSED

MICHAEL R. FLEMING)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MAHSHID D. SAADAT)	APPEALS
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)	INTERFERENCES
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ALLEN R. MACDONALD)	
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MDS:psb

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