

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WILHELMUS J.H.J. BRONNENBERG

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Appeal No. 2004-0257  
Application No. 09/296,724

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ON BRIEF

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Before KRASS, BARRETT and BARRY, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-6.

The invention is directed to a software controlled imaging system and is best described by reference to representative claim 1, reproduced as follows:

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1. A software controlled imaging system comprising an application module interconnected to a user interface control module, and furthermore user interaction means and an imaging subsystem,

characterized in that said user interface controller module is arranged for generating a pull request to said application module, the application module arranged for, in a demand driven organization, outputting to the user interface controller module one or more user interface elements indicated in the request, so that the user interface controller module is operative for deciding which GUI elements will be rendered and when and how those GUI elements will be structured.

The examiner relies on the following references:

Fults et al. (Fults)	5,327,529	July 5, 1994
Wilson et al. (Wilson)	5,499,341	March 12, 1996

Claims 1-6 are rejected under 35 U.S.C. 103(a). As evidence of obviousness, the examiner offers Fults and Wilson with regard to all claims.

Reference is made to the briefs<sup>1</sup> and the answer<sup>2</sup> for the respective positions of the Appellant and the examiner.

#### **OPINION**

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

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<sup>1</sup> Substitute Appeal Brief of 2-19-03 (Paper No. 15) and Reply Brief of 7-29-03 (Paper No. 19)

<sup>2</sup> Examiner's Answer of 5-9-03 (Paper No. 16)

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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 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, 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

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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, 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)].

With regard to independent claim 1, the examiner relies on Fults to teach an application module interconnected to a user interface controller module that is arranged for generating a pull request to said application module. The application module is arranged for a demand driven organization outputting user interface elements to the user interface controller module as indicated by a request. The user interface controller module is arranged for deciding which GUI elements will be rendered and then how and when they will be structured. For support of these

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conclusions, the examiner points to figures 18, 21, and 22; column 5, lines 65-68; column 22, lines 51-63; column 24, lines 38-49; and column 6, lines 30-39, lines 48-50, and 62-67 of Fults.<sup>3</sup>

The examiner then states that Fults lacks a user interaction means and an imaging subsystem. The examiner then points to a teaching in Wilson at column 3, lines 17-67, for such a user interaction means and imaging subsystem. As motivation to modify Fults with the teaching of Wilson, the examiner states that "providing a modular working storage unit improves upon the existing working storage unit design."<sup>4</sup>

The Appellant argues that claim 1 of the application requires that the user interface controller module controls which GUI elements will be rendered, when and how those GUI elements will be structured, and *then* generates a pull request to an application module for selected GUI elements. The Appellant goes on to further argue that the 'pull request,' as defined by the specification is a request that is spontaneous, without first receiving information from the application module. In

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<sup>3</sup> Examiner's Answer, page 4 lines 1-12.

<sup>4</sup> Examiner's Answer, page 4, lines 12-20.

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conclusion, the Appellant states that neither Fults nor Wilson, either alone or in combination, discloses, teaches, or suggests the invention as claimed; and therefore, the examiner has failed to meet the burden of establishing a prima facie case of obviousness.

We agree with appellant.

First, we must consider the scope of the term 'pull request.' The Appellant states that a 'pull request' is "a request that is issued spontaneously from the user interface controller module to the application module."<sup>5</sup> We find, in view of the specification, as well as the drawings, that this is the proper definition of the term as intended and disclosed by the Appellant at the time of filing.

Although we agree with the examiner that the broadest interpretation of the term 'generating a pull request' only requires the generation of a request, the remainder of the claim and the definition within the specification modifies the broad meaning of the term. Claim 1 of the application requires that the "interface controller module [is] arranged for generating a

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Substitute Appeal Brief, page 7, lines 7-8

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pull request to said application module... so that the user interface controller module is operative for deciding which GUI elements will be rendered and when and how those GUI elements will be structured." It is clear from the language that the claim requires the pull request to interact with the application module and, as discussed supra, that the pull request be made spontaneously.

We now look to the references to determine if the claimed limitations are met. The examiner, when answering the arguments with regard to the 'pull request,' states that all that is required by the claims is that a request is produced, not the performance of a pull request. The examiner goes on further to state that figure 2 and column 6, lines 29-45 of Fults disclose the claimed limitations. As to figure 2, we cannot find a disclosure of an interface controller module spontaneously generating a pull request. Moreover, the cited text is taken out of context. In view of the text as a whole, we find that the interface control module (GUI design of Fults) only outputs information as opposed to requesting input. We find no teaching in Fults of information flowing from the application module

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(Specific UI Interface of Fults) to the interface control module (GUI Design); thus, we find no teaching of a request in Fults.

We find that neither Fults, Wilson, nor the combination, provides a spontaneously generated pull request emanating from the interface controller module and sent to the application module, nor do they teach an interface control module that determines which GUI elements will be rendered and how those elements will be structured as required by the claim. Since the limitations of claim 1 are neither disclosed nor suggested by the applied references or any combination thereof, we will not sustain the rejection of claim 1, or of claims 2-6 which depend therefrom, under 35 U.S.C. 103(a).

We also note that the examiner did not repeat the rejection of the claims under 35 U.S.C. 112 in the Answer. Accordingly, such rejection is not before us on appeal.

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The examiner's decision rejecting claims 1 through 6 under  
35 U.S.C. 103(a) over Fults in view of Wilson is reversed.

REVERSED

ERROL A. KRASS	)
Administrative Patent Judge	)
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	)
LEE E. BARRETT	) BOARD OF PATENT
Administrative Patent Judge	) APPEALS AND
	) INTERFERENCES
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	)
LANCE LEONARD BARRY	)
Administrative Patent Judge	)

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PHILIPS INTELLECTUAL  
PROPERTY & STANDARDS  
P.O. BOX 3001  
BRIARCLIFF MANOR, NY 10510