

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD O. CLAPPER

Appeal No. 2004-0324
Application 09/387,350

ON BRIEF

Before THOMAS, BARRETT, and RUGGIERO, Administrative Patent Judges.
THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 1-20.

Representative claim 1 is reproduced below:

1. A method comprising:
identifying a mouse event;

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determining whether said mouse event is associated with a text entry field;

upon selection of the text entry field and prior to the user inputting text into said text entry field, displaying a plurality of mouse selectable text entry options, each of said options being predefined based on a characteristic of said text entry field; and

upon selection of one of said text entry options, copying code corresponding to a selected option into said text entry field.

The following references are relied on by the examiner:

www.dell.com from 10/7/1997 as accessed through Internet Archive, Way Back Machine, www.archive.org. (referred to as Dell)

Microsoft Internet Explorer 5, as disclosed in Windows-Help.Net: AutoComplete for Passwords & Forms.; www.windows-help.net/windows98/ie50-08.htm, March 29, 1999 (referred to as NET).

Microsoft Internet Explorer 5, as disclosed by Black, Gordon in Getting It Completed - automatically. Microsoft Corp., www.microsoft.com/windows98/usingwindows/work/articles/903Mar/Autocomplete.asp, May 19, 1999 (referred to as Black).

All claims on appeal stand rejected under 35 U.S.C. § 103. As evidence of obviousness as to claims 1-5, 7, 9-13 and 15, the examiner relies upon Black in view of NET, further in view of Dell. As to claims 6, 8, 14 and 16, the examiner relies upon this combination of references, further in view of IE4, a reference not part of the prior art listed in Topic 9 at pages

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2 and 3 of the answer, but otherwise referred to beginning at the bottom of page 6 of the answer. Lastly, claims 17-20 also stand rejected under 35 U.S.C. § 103 based upon the initial stated combination of references, further in view of Light. This reference also has not been listed by the examiner in the list of prior art of record in Topic 9 at pages 2 and 3 of the answer, but otherwise identified at the top of page 8 of the answer.

Rather than repeat the positions of the appellant and the examiner, reference is made to the brief and reply brief for appellant's positions, and to the answer for the examiner's positions.

OPINION

We reverse. Beginning at page 5 of the answer, appellant indicates that all claims may be grouped with respect to our consideration of claim 1 for convenience on appeal. Since the second and third stated rejections are not separately argued by appellant but in turn rely upon the combination of the three references in the first stated rejection, we take claim 1 as representative of the subject matter on appeal. The nature of the subject matter of independent claim 9 corresponds

to the subject matter generally set forth in the body of independent claim 1 on appeal. The argued features there also are present in slightly different terminology in the remaining independent claim 17.

As characterized by appellant, the disputed language in representative claim 1 on appeal is the feature that prior to the user inputting text into the text entry field, a plurality of mouse selectable text entry options are displayed. There appears to be no dispute between the examiner and the appellant regarding the teachings of the two references to Black and NET that both teach the same "AutoComplete" feature of Internet Explorer 5. More specifically, there is no dispute that these references do not teach displaying mouse selectable predefined entries before a user inputs data into a text entry field as required by the claims on appeal. The examiner recognizes this in the statement of the rejection at page 4 of the answer and again at page 11 of the answer in the Responsive Arguments portion thereof. From our perspective and study of both Black and NET, it is clear that the user must enter some limited number of information such as by typing for the so-called AutoComplete feature to be effective and become operable once activated. This requirement is most explicitly indicated at both pages of NET.

On the other hand, the examiner asserts at page 4 that Dell teaches a text entry box that displays a list of predefined entry options upon selection of the field prior to the text being entered as indicated in Figure 1 in the second page of Dell. The selection itself requires only the use and operation of a mouse. As argued by the examiner on page 10 of the answer, this portion of Dell clearly indicates that a box is present into which text is entered by a selection function via a mouse or otherwise from a drop down box. The examiner appears to be referring to the "click here" box to the top right corner of page 1 of Dell as detailed in a drop down fashion to the right center of the second page of the Dell reference.

To simplify our consideration of the arguments and the teachings of Dell, we broadly consider the examiner's noted portion of the Dell reference as teaching a text entry field to the extent broadly recited in representative independent claim 1 on appeal. On the other hand, we do not agree with the examiner's conclusion of unpatentability even if we consider that all three references were properly combinable within 35 U.S.C. § 103. The ability of the user to select a state such as shown in the second page of Dell associated with its labeled Figure 1

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on that page, as an activation of predefined textual information stored in the database to be automatically inserted into a text entry field as recited broadly in independent claim 17 on appeal is misplaced since we do not agree with the examiner's views that the entire subject matter of the claims on appeal is met.

Namely, there appears to be no ability taught in Dell for the user to enter any text information into the fields shown in the drop down menu box relied upon by the examiner in Dell. Thus, without an ability of the user to enter information into the text entry field, since there is no true text entry field that allows the user to enter text, the feature at the end of independent claim 17 cannot be met of the selectability of the given state "prior to entry by the user of text into said text entry field." Corresponding features recited in independent claim 1 on appeal upon the selection of a text entry field, plus selection of the one of the entries of the options shown in the displayed text options, the reference to Dell does not allow any operations to occur "prior to the user inputting text into said text entry field." The identical feature of independent claim 1 is also recited in independent claim 9 on appeal.

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Therefore, taken in the best light to the examiner's position that all references are properly combinable within 35 U.S.C. § 103, all requirements of each of the respective independent claims on appeal cannot be met by the combination. Since we reverse the rejection of independent claims 1, 9 and 17 on appeal, we do so similarly for each of their respective dependent claims. Therefore, the decision of the examiner rejecting all claims on appeal under 35 U.S.C. § 103 is reversed.

REVERSED

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| James D. Thomas |) | |
| Administrative Patent Judge |) | |
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| Lee E. Barrett |) | BOARD OF PATENT |
| Administrative Patent Judge |) | APPEALS AND |
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| Joseph F. Ruggiero |) | |
| Administrative Patent Judge |) | |

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