

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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** DAN S. BLOOMBERG and THOMAS P. MORAN

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Appeal No. 2004-0644  
Application No. 09/222,209

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ON BRIEF

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Before KRASS, DIXON, and SAADAT, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1-15, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

## BACKGROUND

Appellants' invention relates to a method and system for transcribing and editing using a structured freeform editor. An understanding of the invention can be derived from a reading of exemplary claims 1 and 2, which are reproduced below.

1. A method for use with a device that stores freeform data, the method comprising:

importing the data from the device;

segmenting the data into freeform graphic elements;

interpreting a structure of the freeform graphic elements;

selectively editing the structure; and,

selectively transcribing the freeform graphic elements into an editable text format.

2. The method as set forth in claim 1 further comprising generating a surrogate element based on the structure.

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

Capps et al. (Capps)	5,778,404	Jul. 07, 1998
Zellweger et al. (Zellweger)	6,230,170	May 08, 2001 (filed Jun. 17, 1998)

Moran, T. P., et al., "Implicit structures for Pen-Based Systems Within a Freeform Interaction Paradigm," **Proceedings of CHI'95**, pp. 1-8, Final Version Dec. 16, 1994. (Moran1)

Appeal No. 2004-0644  
Application No. 09/222,209

Claims 1-4, 6-7, and 9-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Moran1 in view of Capps. Claims 5, 8, and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Moran1 and Capps in view of Zellweger.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 16, mailed Oct. 2, 2003) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 15, filed Jul. 21, 2003) for appellants' arguments thereagainst.

### **OPINION**

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

At the outset, we note that appellants have elected to group the claims into two groupings with claims 1 and 2 as the representative claims. (See brief at page 3.) Therefore, we will address the respective arguments to those claims.

### **CLAIM 1**

From our review of the examiner's rejection, we find that the examiner has established a *prima facie* case of obviousness of the invention as recited in

independent claim 1. Therefore, we look to the appellants' arguments to rebut this *prima facie* case of obviousness. Appellants argue that there is no motivation to combine the teachings of Moran1 and Capps since Moran1 is a freeform graphics system and Capps is a text-based system for insertion into a string of text information. (See brief at page 4.) The examiner maintains that both Moran1 and Capps teach the implementation of user interfaces with text and graphic entries and that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine these teachings. We agree with the examiner that the two references teach and suggest the user interface for data input and manipulation and that skilled artisans would have looked to each of the teachings for data input and manipulation.

Appellants argue that Capps does not teach the steps of interpreting a structure of the freeform graphic elements or editing that structure. (See brief at page 4.) Appellants argue that the specification refers to the interpretation of the structure as "the detection of spatial relationships between the FGE's (Freeform Graphic Elements) to organize them into at least one structured element such as a list, table, outline, etc. (Page 10, lines 23-28.) Capps does not disclose the organization or even the existence of such structured elements." From our review of the cited portion of the specification, we do not find that the term "structure" with respect to FGE's has been specifically

defined by appellants. We do find that the first line of page 11 additionally states “the structure, e.g. lists, lists with sublists, two-dimensional tables or arrays, etc. can be altered in the text domain using the keyboard, etc.” yet no specific definition of the term “structure” has been identified by appellants. (Emphasis added.) The examiner maintains that Capps’ implementation refers to capturing, interpreting, and manipulating “text, graphics and data objects.” (See answer at page 11.) We agree with the examiner that Capps discloses the basics of capturing, interpreting, and manipulating text, graphics and data objects which we find would include importing the data from the device; segmenting the data; interpreting a structure of the text, graphics and data objects; selectively editing the structure; and selectively transcribing the text, graphics and data objects into an editable text format wherein the structure would be the overall combination of the objects. (See Capps at columns 8-9 and Fig. 3.) Appellants argue that Capps does not disclose the organization or even the existence of such structured elements. (See brief at page 4.) We disagree with appellants.

While Capps does not specifically address FGE’s, he does disclose manipulation of text and objects. Therefore, we agree with the examiner that it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the methodology of Capps into the system of Moran1. Moreover, we find that Moran1 also teaches the analysis of the “implicit structures” and manipulation of FGE’s then a

conversion back to FGE's without a final conversion to an editable text format. We note that Moran1 teaches that it is their choice to keep the document in a freeform graphical format rather than allowing it to remain in the structured format. Moran1 recognizes the tradeoffs and has chosen not to take advantage of the structure. (Moran1 at page 2.)

Appellants argue that the examiner has relied upon improper hindsight reconstruction to meet the claimed limitations. (See brief at page 5.) We disagree with appellants. As discussed above, we find that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Moran1 and Capps and do not find that Capps is a text only system as appellants maintain. Appellants further argue that the examiner is reading the references much too broadly. (See brief at page 5.) Rather, we find that appellants are interpreting the term "structure" much too narrowly. Therefore, this argument is not persuasive.

Appellants argue that Moran1 does not deal with the editing of the text making up the structures. (See brief at page 5.) We disagree with appellants and find that the manipulation of the organization and rearrangement of the graphical objects making up the structure of Moran1 would have been an editing of the structure as claimed. Therefore, this argument is not persuasive.

Appellants argue that the examiner's motivation for the combination is faulty for two reasons which are based upon a "need" in the art. (See brief at page 6.) However, the examiner has restated his rationale for the combination and has removed "need" as a basis for the combination. Therefore, this argument is not persuasive.

Appellants argue that manipulation of text and graphic structures are in fact two separate technologies. (See brief at page 7.) We disagree with appellants as discussed above.

Appellants argue that Capps provides absolutely no motivation for the editing, interpretation and manipulation of the structure of freeform graphic elements. (See brief at page 7.) We disagree with appellants as discussed above and find that appellants are interpreting the term "structure" much too narrowly and that the combination of Moran1 and Capps would have suggested the invention as recited in independent claim 1. Therefore we will sustain the rejection of independent claim 1 and claims 4-8, 11, 14 and 15 which appellants elected to group therewith. (See brief at page 3.)

While appellants have elected to group claims 5, 8, and 15 with independent claim 1, appellants have included arguments to the combination of Moran1, Capps and Zellweger. (See brief at page 3 and 8-10.) Therefore, we will address these arguments for completeness. Appellants argue that there is no motivation to combine the teachings of Zellweger with Moran1 and Capps and that the teachings of Zellweger are

not pertinent to the base combination. (See brief at page 9.) The examiner maintains that Zellweger teaches the use of annotations to data and that it would have been obvious to one of ordinary skill in the art at the time of the invention to look to annotations in a pen-based system. (See answer at pages 14-15.) We agree with the examiner and find that the use of annotations in Zellweger would be similar to the notepad of Capps. Therefore, we disagree with appellants' contention that Zellweger is not pertinent and is non-analogous. Therefore, this argument is not persuasive. Appellants' further reliance on the arguments above are also not persuasive. Therefore, we find that appellants have not adequately rebutted the examiner's *prima facie* case of obviousness, and we will sustain the rejection of claims 5, 8 and 15.

## **CLAIM 2**

Appellants argue that neither Moran1 nor Capps discloses the use of a surrogate element. (See brief at page 7.) The examiner maintains that Capps teaches a surrogate structure which is implied to replace the handwritten stroke in the recognized text. (See answer at pages 13-14.) While we agree with the examiner that the recognized text is a surrogate for the handwritten input, we do not find that the surrogate is "based on the structure" as recited in dependent claim 2. Appellants argue that the examiner confuses what appellants mean by the term "structure." (See brief at pages 7-8.) As discussed above, appellants have not specifically defined, and we do

Appeal No. 2004-0644  
Application No. 09/222,209

not find a specific definition of the term “structure“ in the specification. Although we do not find a specific definition to the term “structure,” we find that Capps teaches the use of surrogate data/elements which are based on the input data and not on any structure. Therefore, we find that the examiner has not established a *prima facie* case of obviousness for a surrogate structure, and we will not sustain the rejection of claims 2, 3, 9, 10, 12 and 13 which contain the limitation regarding a surrogate structure.

#### **CONCLUSION**

To summarize, the decision of the examiner to reject claims 1, 4-8, 11, 14, and 15 under 35 U.S.C. § 103 is affirmed, and the decision of the examiner to reject claims 2, 3, 9, 10, 12 and 13 under 35 U.S.C. § 103 is reversed.

Appeal No. 2004-0644  
Application No. 09/222,209

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**

ERROL A. KRASS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JOSEPH L. DIXON	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
MAHSHID D. SAADAT	)	
Administrative Patent Judge	)	

JLD/vsh

Appeal No. 2004-0644  
Application No. 09/222,209

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