

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JERILYN L. MARLER and MARY J. LALOMIA

Appeal No. 2004-1063
Application No. 09/273,385

ON BRIEF

Before KRASS, JERRY SMITH and BLANKENSHIP, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-20.

The invention is directed to the control of processor-based systems. In particular, a plurality of selectable options is displayed and the selectable options are automatically and consecutively indicated in a timed sequence. When one of the

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options is indicated, an input signal is received, and the option is caused to be selected in response to the input signal.

Representative independent claim 1 is reproduced as follows:

1. A method of controlling a processor-based system comprising:

displaying a plurality of selectable options;

automatically and consecutively indicating said selectable options in a timed sequence;

receiving an input signal when one of said options is indicated; and

in response to said signal, causing said one option to be selected.

The examiner relies on the following references:

White et al. (White)	6,034,689	Mar. 7, 2000 (filed Jun. 3, 1996)
Roach	6,243,085	Jun. 5, 2001 (filed Dec. 27, 1993)

Claims 1-20 stand rejected under 35 U.S.C. § 103 as unpatentable over White in view of Roach.

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

OPINION

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of

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obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under § 103, the examiner must produce a factual basis supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The examiner must identify the elements in the prior art or that knowledge generally available to one of ordinary skill in the art which would lead the individual to combine the relevant teachings of the references. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

With regard to independent claim 1, the examiner contends that White discloses a method of controlling a processor based system in the abstract and column 1, lines 30-60; that White discloses the displaying of a plurality of selectable options in Figures 4A and 4B, the abstract, and column 2, lines 50-68; that White discloses consecutively indicating selection options at column 5, lines 12-30, column 6, lines 32-68, column 7, lines 1-13, and column 8, lines 1-30.

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The examiner indicates that White does not specifically disclose the automatic indication of options in an automatic timed sequence, but the selections and options are made consecutively and sequentially through time. The examiner further alleges that highlighting is performed by White for ease of user navigation and selection of options in a user interface.

The examiner then relies on Roach for a showing of an automatic indication of options in an automatic timed sequence, pointing to the abstract, column 1, lines 60-68, column 2, lines 1-12, column 4, lines 7-17 and 25-55, and column 5, lines 53-68, of Roach. The examiner alleges that this, too, is done for the ease of user navigation and selection of options in a user interface.

The examiner then concludes that it would have been "obvious...to have this automatic feature for the selectable options in White...because it would allow ease of user navigation and selection of options in a user interface" (final rejection-page 3).

For their part, appellants contend that while they are in agreement with the examiner as to White's failure to teach or suggest automatically and consecutively indicating the selectable option in a timed sequence, they dispute the examiner's

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allegation that Roach does teach or suggest automatically and consecutively indicating the selectable options in a timed sequence. Appellants also argue that even if Roach is construed as teaching the disputed limitation, there would have been no motivation for the artisan to make the proposed modification of White in order to reach the instant claimed subject matter.

We agree with appellants.

As pointed out by appellants, Roach deals with interactive film, specifically with a viewer watching a film and interacting therewith by clicking on a character to view the film from that character's perspective. This is described at column 6, lines 14-37, and, again, at locations in columns 7 and 8. While Roach does appear to teach a display of selectable options, i.e., a display of characters on which a user may click a mouse in order to view a film from that character's perspective, Roach does not appear to teach or suggest the indication of such selectable options, viz., the characters, automatically, consecutively and in a timed sequence, as claimed.

The mere display of characters which are clickable by a mouse does not, in our view, amount to a display of a plurality of selectable options which are automatically and consecutively indicating the selectable options in a timed sequence.

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The examiner explains, at page 3 of the answer, that Roach teaches more than just the display of selectable options; that it discloses a story that is formed by a "sequence of timed events," referring to column 4, line 8, of Roach. The examiner further refers to column 4, lines 12-20, and concludes therefrom that instructions for selectively changing perspective are also presented with the sequence of timed events, automatically after each sequential perspective change. The examiner also notes column 4, lines 35-44, of Roach for "the tracking...which are also a timed sequence" (answer-page 3).

The examiner further points to "lines 1-14" of Roach, at the bottom of page 3 of the answer, but there is no reference to a specific column, so it is difficult to specifically determine what portion of Roach is being referenced by the examiner. However, the examiner alleges that this unidentified portion of Roach "will automatically and consecutively indicate selectable options in a timed sequence in the chain of events specifically so as not to interrupt the continuity but exactly so as to mainta[in] the timed sequence of events" (answer-pages 3-4).

Roach coordinates different events in a time sequence, so that the movie goes forward from the perspective of whichever character is clocked by the mouse. One can say, reasonably, that

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the display of the characters in Roach is a display of a plurality of selectable options. But, one cannot, reasonably, say that those characters are "automatically and consecutively" indicated "in a timed sequence," as required by the instant claims. Rather, the characters are indicated in whatever sequence the movie causes them to be indicated.

We also agree with appellants that even if, arguendo, we were to find that Roach disclosed the limitation of "automatically and consecutively indicating said selectable option in a timed sequence," the examiner has not presented a convincing rationale as to why the skilled artisan would have been led to modify anything in White with this alleged automatic and consecutive indication of a selectable option in a timed sequence, of Roach. The examiner's general allegation that it would have been obvious to do so "because it would allow ease of user navigation and selection of options in a user interface" (Paper No. 12-page 3) is an insufficient reason for modifying White in the manner suggested since White already provides for navigation through World Wide Web pages and no advantage is seen in adding an automatic and consecutive indication of a selectable option in a timed sequence to White.

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Since all of the independent claims require the "automatically and consecutively indicating said selectable options in a timed sequence," we will not sustain any of the examiner's rejections of claims 1-20 under 35 U.S.C. § 103.

Accordingly, the examiner's decision is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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JERRY SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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HOWARD B. BLANKENSHIP)	
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