

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 MARK A. SIBERT

Appeal No. 2004-1413
Application No. 09/475,941

ON BRIEF

Before JERRY SMITH, 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 1-11, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

Appellant's invention relates to a method and system for selecting a target window for automatic fill-in. An understanding of the invention can be derived from a reading of exemplary claims 1 and 7, which are reproduced below.

1. A computer-implemented method of automatically inserting data into at least one window displayed in a graphical user interface (GUI) in a desktop configuration, comprising the steps of:

providing a list of selectable elements, each of said selectable elements in said list associated with a respective window presently opened in said GUI;

designating one of said opened windows for viewing by highlighting one of said selectable elements in said list;

automatically moving said designated open window to the top of the desktop when said one of said selectable elements is highlighted; and

automatically inserting said data into said designated open window when said one of said selectable elements is selected.

7. In a computing environment, a tool for targeting, for automatic insertion of data, one of a plurality of windows displayed in a graphical user interface in a desktop configuration, said tool comprising:

a data storage window for storing data to be inserted into a target window;

a selection window generating a list of selectable elements corresponding to said plurality of windows;

a designator for designating one of said selectable elements, wherein the designation of one of said selectable elements from said list causes the window corresponding to said selectable element to be displayed on top of the desktop as the target window.

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The prior art of record relied upon by the examiner in rejecting the appealed claims is as follows:

Douglas et al. (Douglas)	5,491,784	Feb. 13, 1996
Root	5,606,674	Feb. 25, 1997
Crawford	5,754,176	May 19, 1998
Kausik	6,170,058	Jan. 2, 2001
		(Filed Dec. 23, 1997)

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Root in view of Crawford. Claims 2-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Root and Crawford in view of Kausik. Claims 1-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Douglas in view of Crawford.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 11, mailed Oct. 22, 2003) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 10, filed Apr. 29, 2003) and reply brief (Paper No. 12, filed Dec. 29, 2003) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the

respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Appellant argues that neither Root nor Crawford teaches or suggests a two-step process to move an open window to the top to (pre)view the window prior to the selection of the window for automatic insertion of data. (Brief at pages 6-8 and reply at pages 2 and 3.) The examiner maintains that Root and Douglas clearly teach designating a window for viewing, moving the designated window to the top of the desktop and inserting data into the window when one of the selectable elements is highlighted/selected. (Answer at page 6.) We disagree with the examiner's interpretation of the teachings of Root and Douglas with respect to the claimed invention. From the examiner's position, it appears that the examiner is interpreting the highlighting as the selection, but we find that independent claim 1 requires two separate steps. The first step is highlighting one of the selectable choices of windows which will move the corresponding window to the top of the desktop. This is not the selection step. Next, the user decides if this is the window which is desired to have the data automatically inserted in the window. If not, then the user may highlight a different one of the choices of selectable windows and that next choice is moved to the top of the desktop for determination by the user if this one of the selectable windows is the one which the user desires to have the automatic fill function performed. While it would appear that the highlighting and moving of the window to the top of the desktop could be

a “selection,” we find that this is a choice of windows to preview rather than the selection for the automatic fill function.

Additionally, the examiner remarks that appellant merely is arguing the references individually which is not an adequate showing of nonobviousness. (See answer at pages 6-7.) We disagree with the examiner. From our review of the teachings of Root or Douglas in combination with Crawford, we do not find the two-step process as recited in independent claim 1, and we do not find that the examiner has established a convincing line of reasoning absent a clear teaching why it would have been obvious to one of ordinary skill in the art at the time of the invention to have a two-step process as recited in independent claim 1. Therefore, we find that the examiner has not established a *prima facie* case of obviousness of the invention as recited in independent claim 1, and we cannot sustain the rejection of independent claim 1.

With respect to dependent claims 2-6, the examiner adds the teachings of Kausik as evidence of the use of a digital wallet. (See answer at page 4.) While we agree with the examiner that a digital wallet is not new, we do not find that the teachings of Kausik remedy the deficiency in the base combination noted above. Therefore, we find that the examiner has not established a *prima facie* case of obviousness of the invention recited in dependent claims 2-6, and we cannot sustain the rejection of independent claims 2-6.

With respect to independent claims 7, 9 and 11, the examiner summarily includes these claims as rejected under the same basis as dependent claim 4. We find that independent claims 7, 9 and 11 do not recite the same two-step process of how to manipulate the open windows and bring one to the top to determine if an auto-fill function is desired to be performed and to perform the auto-fill. Here, the two steps and apparatus performing these two steps are for generating a list of selectable elements and designating one of these selectable elements to be moved to the top of the desktop. While the examiner does not specifically address this difference in these claims from independent claim 1, we find that Root alone teaches the invention recited in independent claim 7. Specifically, Figures 6A-D teach that there may be multiple open windows and the pull down menu 640 for the task list which designates the application for insertion of data and the user selecting the focus button 635 which moves the target application window to the top of the desktop. (See Root at columns 6-7.) Therefore, we find that Root teaches and fairly suggests the invention as recited in independent claim 7. Since independent claim 7 does not recite a step or element that realizes an auto-fill function, we find that the preamble merely sets forth an intended field of use limitation which does not limit the claimed apparatus. Similarly, we find that Douglas teaches the invention of independent claim 7 for the reasons set forth by the examiner in the discussion of independent claim 1. While we do not find that Douglas teaches or suggests the invention as recited in independent claim 1, we find

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independent claim 7 to be broader than independent claim 1 as discussed above.
Since appellants have elected to group all the claims together, we will similarly group claims 8-11 as falling with independent claim 7.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-6 under 35 U.S.C. § 103 is reversed, and the decision of the examiner to reject claims 7-11 under 35 U.S.C. § 103 is affirmed.

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

JERRY SMITH)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JOSEPH L. DIXON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
MAHSHID D. SAADAT)	
Administrative Patent Judge)	

JLD:clm

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Mark D. Simpson
Synnestvedt & Lechner
2600 Aramark Tower
1101 Market St.
Philadelphia, PA 19107-2950