

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 JEFFREY R. BLUM, ELIZABETH A. BASTIAANSE,
and IDO BEN-SHACHAR

Appeal No. 2004-1443
Application No. 09/559,695

ON BRIEF

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

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1, 2 and 4-17, which constitute all the claims in the application.

The disclosed invention pertains to a user interface in a hand-held computing device. More particularly, data within the database of the device can be accessed from an all categories label that represents a full list of all entries in the database

and a recently accessed label that represents a list of recently accessed entries from the database. A particular feature of the invention is that displayed entries from the recently accessed category are capable of being manipulated by the user in the same manner as entries that are displayed when the user selects the all categories label.

Representative claim 1 is reproduced as follows:

1. A method of generating a user interface in a hand-held computing device, the method comprising:

displaying a list of category labels, each label representing a collection of database entries, at least one of the category labels being a recently accessed label that represents a list of recently accessed entries, and at least one other category label being an all categories label that represents a full list of all entries in the database;

receiving an indication that a user has selected the recently accessed label;

displaying the list of recently accessed entries such that the entries are capable of being manipulated by the user in the same manner as entries that are displayed when the user selects the all categories label.

The examiner relies on the following references:

Lincke et al. (Lincke)	6,300,946	Oct. 09, 2001 (filed May 29, 1998)
Hawkins et al. (Hawkins)	6,516,202	Feb. 04, 2003 (filed Aug. 12, 1999)

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Claims 1, 2 and 4-17 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Lincke in view of Hawkins.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1, 2 and 4-17. Accordingly, we reverse.

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

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(Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicants 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 appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived (see 37 CFR § 41.37(c)(1)(vii)(2004)).

The examiner's rejection is set forth on pages 3-6 of the answer. With respect to independent claim 1, the examiner notes that Lincke teaches a user interface for a hand-held device in which a plurality of categories are displayed including an all category label, but the examiner acknowledges that Lincke fails to teach a recently accessed category. The examiner cites Hawkins as teaching a recently accessed category in the form of a call history list. The examiner finds that it would have been obvious to the artisan to combine Hawkins' recently accessed list

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with Lincke's user interface. The examiner states that data in the call history can be manipulated in the same manner as data in the all category.

Appellants argue that the combination of art does not show or suggest the ability to select a recent category so that entries in the recent category are displayed in a manner that allows the user to manipulate the entries in the same manner that entries can be manipulated from the all categories label. Appellants note in particular that a user in Hawkins cannot delete a record in the address book through the call history list because Hawkins does not suggest such a feature and because the user would lose valuable information from the address book when he only wanted to eliminate a phone number (brief, pages 4-7).

The examiner responds that the user in Hawkins may edit entries from the call history list which consists of the same kind of manipulations performed on entries from the address book. The examiner also asserts that the delete argument is not persuasive because claim 1 does not recite the delete manipulation. The examiner notes that the "manner" of claim 1 is met by the manipulations of selected, highlighted, dialed, edited and saved in Hawkins (answer, pages 6-7).

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Appellants respond that the examiner is replacing the claimed limitation "same manner" with the limitation "some manners." Appellants argue that the recitation "same manner" requires that all of the functions that can be performed on an entry must be capable of being performed in both lists of entries. Appellants argue that the inability to perform a delete in Hawkins through the call history list indicates that the user is not able to manipulate the entries in the call history list in the same manner as the entries in the address book (reply brief, pages 1-2).

We will not sustain the examiner's rejection of independent claim 1 or of claims 2 and 4-9 which depend therefrom for essentially the reasons argued by appellants in the briefs. We particularly agree with appellants that the examiner's interpretation of the term "same manner" in claim 1 is incorrect. Thus, we agree with appellants that the correct interpretation of "same manner" in claim 1 requires that a device be capable of performing every manipulation that can be performed in the all category on the entries in the recently accessed category. In other words, if a function which can be performed in the all category, such as delete, cannot be performed in the recently

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accessed category, then the method of claim 1 is not met.

Whether the invention of claim 1 would have been obvious to the artisan when the term "same manner" is interpreted in this manner we cannot say because there are no arguments on this record by the examiner in support of obviousness when the term "same manner" is so interpreted.

With respect to independent claim 10, the examiner's rejection is basically the same as considered above with respect to claim 1. Appellants argue that none of the cited art provides the ability to display recently accessed entries in a manner such that commands applied to the recently accessed entries have the same results on the database record as commands applied to other sets of displayed entries. Appellants note that in Hawkins the delete command from the call history list does not remove an entry from the address book (brief, pages 9-11). The examiner responds with the same position discussed above with respect to claim 1 (answer, page 9). Appellants respond that Hawkins does not provide a delete command for its call history that produces the same change in a record as a delete command in the address book (reply brief, pages 4-5).

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We will not sustain the examiner's rejection of independent claim 10 or of claims 11-17 which depend therefrom for the reasons argued by appellants in the briefs. The examiner's rejection of claim 10 and response to appellants' arguments treat claim 10 as if it is the same as claim 1. As noted by appellants, however, claim 10 is substantially different from claim 1, and the examiner has failed to address the specific limitations of claim 10 or respond to appellants' specific arguments directed to claim 10.

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In summary, we have not sustained the examiner's rejection of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1, 2 and 4-17 is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ERROL A. KRASS)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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JERRY SMITH)	
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JS:hh

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