

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HOLLY MICHELLE LUCKE

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Appeal No. 2004-1460  
Application No. 09/495,217

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ON BRIEF

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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 1-16, which constitute all the claims in the application.

The disclosed invention pertains to an improved graphical user interface for interactively selecting objects and tasks to perform operations in a computer system.

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Representative claim 12 is reproduced as follows:

12. A computer program product for providing a user interface to select objects and tasks on at least one computer system, said computer program product comprising:

a plurality of processor executable instructions recorded on signal-bearing media, wherein said instructions, when executed by at least one processor, cause the at least one computer system to present an interactive selection window to a user on a display, said window comprising:

an first pane for listing a plurality of objects and receiving a user selection of an object listed therein;

a second pane for listing a plurality of tasks and receiving a user selection of a task listed therein, said user selection of a task causing said task to be performed, wherein at least some of said plurality of tasks listed in said second pane are responsive to the object selected from said first pane.

The examiner relies on the following reference:

Lindhorst et al. (Lindhorst)      6,268,852      Jul. 31, 2001  
(filed Jun. 02, 1997)

Claims 1, 2, 5-8, 11-13 and 16 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Lindhorst. Claims 3, 4, 9, 10, 14 and 15 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Lindhorst taken alone.

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

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejections 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 does not support either of the examiner's rejections. Accordingly, we reverse.

We consider first the rejection of claims 1, 2, 5-8, 11-13 and 16 under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Lindhorst. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of

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performing the recited functional limitations. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Appellant has indicated that these claims stand or fall together as a single group (brief, page 4), and we will consider claim 12 as the representative claim for this group. The examiner has indicated how he reads the invention of claim 12 on the disclosure of Lindhorst (answer, pages 3 and 4). Appellant argues that Lindhorst fails to disclose a window having both object and task panes for launching tasks, in which a task is performed responsive to selection from the task pane, and in which the list of tasks displayed in the task pane is dependent on the object selected in the object pane. Specifically, appellant argues that the items in Lindhorst cited by the examiner to meet the claimed object and task panes fail to satisfy the claimed invention. Appellant asserts that the actions displayed in Lindhorst are not tasks which are performed responsive to a selection. Appellant also asserts that actions

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displayed in Lindhorst are independent of the event selected by the developer from the event pane. Appellant notes that in response to selecting an action in Lindhorst, the action is inserted into the script code, but the action itself is not performed. Appellant notes that neither Lindhorst's action pane nor the code pane meets all the limitations of the claimed pane for displaying tasks. Finally, appellant argues that Lindhorst discloses an editing application, which is significantly different from process navigation (brief, pages 6-12).

The examiner responds that Lindhorst fully meets the claimed invention. The examiner asserts that Lindhorst discloses that an event is triggered when a particular user action occurs, and that once the user performs an action that triggers an event, the corresponding event handling software is initiated and run on the computer system. The examiner essentially finds that the linkage of events and actions in Lindhorst meets the claimed invention (answer, pages 5-8).

We will not sustain the examiner's rejection of the claims as being anticipated by the disclosure of Lindhorst. We essentially agree with all of appellant's arguments set forth in the brief. Most importantly, we agree with appellant that

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neither the action pane nor the code pane of Lindhorst meets the recitations of the second pane in representative claim 12. Claim 12 requires that the user selection of the task be made from the second pane and that the selection results in the task being performed. The action pane does not meet the claimed second pane because selection of a task in the action pane of Lindhorst does not cause the task to be performed. It only establishes a computer program which will implement the task at some later time if the action should occur. No task is performed simply in response to the selection made in the action pane. The code pane does not meet the claimed second pane because the tasks listed in the code pane are not responsive to the object selected from the event pane in Lindhorst. Therefore, the examiner's findings of anticipation are not supported by the disclosure of Lindhorst.

We now consider the rejection of claims 3, 4, 9, 10, 14 and 15 under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Lindhorst taken alone. 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, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the

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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 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant 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,

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783 F.2d 1038, 1039-40, 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 appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellant (see 37 CFR § 41.37(c)(1)(vii)(2004)).

Since the examiner's findings with respect to Lindhorst are incorrect for reasons discussed above, the examiner has failed to establish a prima facie case of obviousness. Therefore, we cannot sustain the examiner's rejection of the claims based on Lindhorst taken alone.

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In summary, we have not sustained either of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-16 is reversed.

REVERSED

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

JS/hh

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