

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MARGARET GARDNER MACPHAIL

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Appeal No. 2004-1557  
Application 09/451,942

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ON BRIEF

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Before HAIRSTON, FLEMING, and GROSS, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 28.

The disclosed invention relates to a method and system for configuring multiple selectable points along a line in a

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graphical user interface. The selectable points do not comprise alphanumeric characters.

Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A method of forming a graphical user interface, comprising:

configuring a line on a display screen which is in communication with a display controller; and

configuring multiple selectable points along the line, wherein each selectable point corresponds to a piece of information accessible using the display controller, wherein said each selectable point does not comprise alphanumeric characters, and wherein the graphical user interface is adapted to display the corresponding piece of information in response to selection of a selectable point.

The references relied on by the examiner are:

Isensee et al. (Isensee)	5,550,559	Aug. 27, 1996
Manson et al. (Manson)	5,731,997	Mar. 24, 1998
Kirk et al. (Kirk)	5,768,578	June 16, 1998
Bates et al. (Bates)	5,777,616	July 7, 1998
Mukherjee	6,314,415	Nov. 6, 2001

(filed Nov. 4, 1998)

Claims 1 through 28 stand rejected under the first paragraph of 35 U.S.C. § 112 for lack of written description of the phrase "each selectable point does not comprise alphanumeric characters."

Claims 1 through 5, 19 through 22 and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kirk.

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Claims 7, 23 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kirk in view of Bates.

Claims 8, 24 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kirk in view of Isensee.

Claims 6, 9 through 18 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kirk in view of Mukherjee and Manson.

Reference is made to the briefs (paper numbers 14 and 16) and the answer (paper number 15) for the respective positions of the appellant and the examiner.

#### OPINION

Turning first to the lack of written description rejection, the examiner states (answer, pages 4 and 5) that:

Specifically, support for the exclusionary statement "wherein said each selectable point does not comprises [sic, comprise] alphanumeric characters" which was added into the claims by amendment is not found in the original disclosure of the instant application. Any negative limitation or exclusionary proviso must have basis in the original disclosure. See MPEP 2173.05(i). As such, the limitation(s), *supra*, must be deleted from the claims in response to this action.

Appellant argues (brief, page 6; reply brief, page 3) that Figure 2A of the disclosure shows selectable points 44 as small dots, and that the visible indicator 48 presents a display when pointer 46 is moved over one of the selectable points 44.

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According to the appellant, such a showing in the drawing is adequate support for the limitation of "each selectable point does not comprise alphanumeric characters."

The examiner's rejection is tantamount to a per se prohibition of any negative limitation that does not have expressly stated support in the originally filed specification. Ex parte Grasselli, 231 USPQ 393 (Bd. App. 1983) aff'd mem., 738 F.2d 453 (Fed. Cir. 1984), appears to provide support for the examiner's position because the Board found that the negative limitation added to the claims introduced new concepts in violation of the description requirement of the first paragraph of 35 U.S.C. § 112. In the subsequent case of Ex parte Parks, 30 USPQ2d 1234, 1236 (Bd. App. 1994), the Board did not adhere to Grasselli's per se prohibition of negative limitations that lack express written description support in the originally filed disclosure, and, instead, resorted to a more reasonable test of what the originally filed disclosure would have conveyed to one having ordinary skill in the art.

Based upon the test set forth in Parks, we find that the skilled artisan after viewing the noted figure of the drawing in context with the remainder of the disclosure would clearly see that the points 44 are mere dots that are devoid of any

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information, especially "alphanumeric characters." Thus, the lack of written description rejection of claims 1 through 28 is reversed.

Turning to the anticipation rejection of claims 1 through 5, 19 through 22 and 25, the examiner states (answer, page 5) that the nodes in Kirk "do not comprise alphanumeric characters (Fig. 7; line 59, col. 31 to line 12 of col. 32)." We disagree. The node designated by the numeral 704 in Kirk (Figure 7) clearly contains alphanumeric characters. The blackened and unnumbered nodes in Kirk (Figure 7) do not contain alphanumeric characters, but they are not described as either "selectable" or as "points" as required by the claims on appeal. Accordingly, the anticipation rejection of claims 1 through 5, 19 through 22 and 25 is reversed.

Turning lastly to the obviousness rejections, we find that the teachings of Bates, Isensee, Mukherjee and Manson do not cure the noted shortcoming in the teachings of Kirk. In summary, the obviousness rejections of claims 6 through 18, 23, 24 and 26 through 28 are reversed.

#### DECISION

The decision of the examiner rejecting claims 1 through 28 under the first paragraph of 35 U.S.C. § 112 is reversed. The

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decision of the examiner rejecting claims 1 through 5, 19 through 22 and 25 under 35 U.S.C. § 102(b) is reversed. The decision of the examiner rejecting claims 6 through 18, 23, 24 and 26 through 28 under 35 U.S.C. § 103(a) is reversed.

REVERSED

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
MICHAEL R. FLEMING	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
	)	
	)	
ANITA PELLMAN GROSS	)	
Administrative Patent Judge	)	

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