

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STUART KENT CARD,
RICHARD CARL GOSSWEILER, III,
ALLISON GYLE WOODRUFF
AND JOCK DOUGLAS MACKINLAY

Appeal No. 2006-2216
Application No. 09/741,038

ON BRIEF

Before HAIRSTON, SAADAT, and HOMERE, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-33, which constitute all of the claims pending in this application.

We affirm-in-part.

BACKGROUND

Appellants' invention is directed generally to a system and method for displaying information and more specifically, to

Appeal No. 2006-2216
Application No. 09/741,038

displaying information in relation with a virtual three-dimensional book image. According to Appellants, the displayed information, such as a table image or other organizational structure of the book, appears on the edge image of the virtual book and allows user interaction with the information (specification, page 4). An understanding of the invention can be derived from a reading of exemplary independent claim 1, which is reproduced as follows:

1. A system for displaying images of a virtual three-dimensional book having a plurality of virtual pages, the system comprising:

a display system capable of executing a display program,

wherein images of the virtual three-dimensional book, including a graphical representation of the book that depicts one or more side edges, are produced on the display system, and

wherein two instances of different categories of information relating to the virtual three-dimensional book represented on the one or more side edges of the virtual three-dimensional book.

The Examiner relies on the following references:

Douglas et al. (Douglas)	5,604,861	Feb. 18, 1997
Gusack	5,921,582	Jul. 13, 1999

Claims 1-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Douglas and Gusack.

Appeal No. 2006-2216
Application No. 09/741,038

Rather than reiterate the opposing arguments, reference is made to the brief (filed October 11, 2005), reply brief (filed February 28, 2006) and the answer (mailed December 29, 2005) for the respective positions of Appellants and the Examiner.

OPINION

In rejecting the claims, the Examiner relies on Gusack for teaching substantially all of the claimed features related to displaying information in the form of a virtual book image and on Douglas for teaching displayed images of information other than the chapter or section (answer, pages 3-4). Based on the teachings of these two prior art references, the Examiner concludes that the skilled artisan would have found it obvious to modify Gusack with the additional forms of information of Douglas to provide users more ability to interact with the displayed object (answer, page 4).

The focus of Appellants' argument is that, contrary to the claimed requirement of "different categories of information," Gusack and Douglas each describe displaying only one category of information, i.e., basic tab or section information (brief, page 8). Appellants further assert that the information other than

Appeal No. 2006-2216
Application No. 09/741,038

the tabs relied on by the Examiner actually relates to the textual data from the forms and journals instead of the claimed information represented on the side edges of the virtual book (reply brief, page 4).

As a general proposition, in rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) and In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993); In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992); Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985). In considering the question of the obviousness of the claimed invention in view of the prior art relied upon, the Examiner is expected to make the factual determination set forth in Graham v. John Deere Co., 383

Appeal No. 2006-2216
Application No. 09/741,038

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. See also In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). Such evidence is required 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); In re Cofer, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

After reviewing the prior art references, we agree with Appellants (reply brief, page 4) that neither Gusack nor Douglas teaches or suggests more than one category of information represented on the side edges of the virtual book. Contrary to the Examiner's reliance on element 614 of Figure 6 of Gusack as the "information different than chapters/sections" to be displayed (answer, page 9), these types of information relate to the text within the actual pages and not those represented on the side edges of the virtual book. Douglas, on the other hand, describes different tabs represented on the side edges of the virtual stack (see Figure 3a-3d). However, these tabs, similar to Gusack represent one category of information related to the virtual book, i.e., section or chapter headings or numbers.

Appeal No. 2006-2216
Application No. 09/741,038

Therefore, what the Examiner characterizes as the claimed different categories of information, is actually absent in the combination of Gusack and Douglas since the tabs represent only the category of section heads. We also observe that although other categories of information, such as the title or the volume information, may be represented on one of the binding edges of the virtual journal of Gusack, the Examiner has not provided any supportive evidence thereof. Thus, even assuming, arguendo, that it would have been obvious to combine Douglas with Gusack, the Examiner has not shown how the claimed arrangement of information may be represented on the one or more side edges of the virtual book. A rejection based on section 103 must rest upon a factual basis rather than conjecture, or speculation. "Where the legal conclusion [of obviousness] is not supported by the facts it cannot stand." In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). See also In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) and In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

Independent claims 16 and 31-33 also include similar limitations that, based on the evidence of record and as discussed above with respect to claim 1, would have not been obvious to one of ordinary skill in the art. Accordingly, as the

Appeal No. 2006-2216
Application No. 09/741,038

Examiner has failed to set forth a prima facie case of obviousness, we cannot sustain the 35 U.S.C. § 103 rejection of claims 1, 16 and 31-33, as well as claims 2-12 and 17-27 dependent thereon, over Gusack and Douglas.

Turning now to the rejection of the remaining claims, we note that unlike, claim 1, claims 13 and 28 do not require any more than one category of information. As set forth by the Examiner, the virtual journal of Gusack includes section tabs represented on one or more side edges of the journal which graphically convey the concept of the section headings of a book. Regarding claim 13, we also note that the images of the section tabs do represent a metaphorical relationship to the content of the virtual book as tabs denote a label for a chapter or section. Thus, we find the position of the Examiner with respect to the rejection of claims 13-15 and 28-30 to be reasonable and will sustain the 35 U.S.C. § 103 rejection over Gusack and Douglas.

CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1-12, 16-27 and 31-33 under 35 U.S.C. § 103 is reversed, but is affirmed with respect to rejecting claims 13-15 and 28-30.

Appeal No. 2006-2216
Application No. 09/741,038

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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Administrative Patent Judge)	
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Appeal No. 2006-2216
Application No. 09/741,038

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