

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 ERIK J. SNAPPER, JULIAN P. JIGGINS, BHARAT SHYAM,
HADI PARTOVI, ERIC R. BERMAN, STEVEN J. FREEDMAN,
JAMES E. ALLARD, FRANK Z. CHANG, STEPHEN P. PROTEAU,
and CLINT C. JORGENSON

Appeal No. 2006-2585
Application No. 09/388,351

HEARD: October 19, 2006

Before KRASS, MACDONALD and HOMERE, Administrative Patent Judges.

MACDONALD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 3-28 and 31-55. Claims 1, 2, 29, and 30 have been canceled.

Invention

Appellants' invention relates to a method and apparatus for learning data values from a user over time as the user enters values into fields on a form such as a web page form. In one embodiment, an Internet web browser includes code that suggests previously used data values for any form text field that is the same as or similar to a previously used form text field. This feature can take advantage of the fact that web page authors frequently use the same or similar names for fields when prompting for the same information (e.g., "phone" when requesting a telephone number). Any browser-based application program (or any form retrieved from a web site using the browser) can gain limited access to previously used field values without compromising security or privacy. The invention can be implemented without modifying any of the application programs or web sites that contain forms.

In one embodiment, software in a web browser associates field names across different Universal Resource Locators (URLs), so that when a user enters a value into a field (e.g., username) at a first web site, that same value can be automatically suggested when the user displays a different form on a different

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web site that uses the same field name. The more web sites that are visited by the user, the more the software learns field values and is able to suggest likely choices for field values. For security reasons, field values are preferably not stored in the application program or on the target web site, but are instead stored locally on the client computer or at a trusted web site known to the browser.

Appellants' specification at page 4, lines 12-30.

Claim 3 is representative of the claimed invention and is reproduced as follows:

3. A computer-implemented method of entering information, comprising the steps of:

(1) displaying on a computer screen a form comprising a plurality of fields, each field having a field identifier and a data entry region into which a data value can be written;

(2) determining that a user has selected one of the plurality of fields;

(3) comparing the field identifier of the selected field to previously stored field identifiers and, upon finding a match, displaying a list of suggested data values previously stored in response to one or more different forms previously filled in by the user;

(4) in response to the user selecting one of the suggested data values, copying the selected one data value into the data entry region of the selected field; and

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(5) in response to the user entering a non-suggested data value, storing the non-suggested data value into a data storage area for future use,

further comprising the step of, prior to step (4), detecting a user-initiated action and inhibiting the copying of the suggested data value into the data entry region until after receipt of the user-initiated action.

References

The references relied on by the Examiner are as follows:

Capps	5,666,502	September 9, 1997
Kikinis	5,794,259	August 11, 1998
Light et al. (Light)	6,192,380	February 20, 2001 (Filed March 31, 1998)
Gupta et al. (Gupta)	6,199,079	March 6, 2001 (Filed March 20, 1998)

Rejections At Issue

Claims 3, 4, 6, 7, 9-15, 21, 22, 24, 26-28, 31, 33, 34, 36-44, 46, 47, and 50-54 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Kikinis and Light.

Claims 5, 23, and 32 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Kikinis, Light, and Gupta.

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Claims 8, 25, and 35 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Kikinis, Light, and applicants' specification.

Claims 16, 17, 19, 20, 48, 49, and 55 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Light and Capps.

Claim 18 stands rejected under 35 U.S.C. § 103 as being obvious over the combination of Light, Capps, and applicants' specification.

Claim 45 stands rejected under 35 U.S.C. § 103 as being obvious over the combination of Kikinis, Light, and Capps.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.¹

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated infra, we affirm the Examiner's rejection of claims 3-13, 15-17, 19-28, 31-40, and 42-55 under 35 U.S.C. § 103; and we reverse the Examiner's rejection of claims 14, 18, and 41 under 35 U.S.C. § 103.

¹ Appellants filed an appeal brief on April 30, 2004. Appellants filed a reply brief on September 24, 2004. The Examiner mailed an Examiner's Answer on July 26, 2004.

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Appellants have indicated that for purposes of this appeal the claims stand or fall together in twenty (20) groupings:

Claims 4, 9, 10, 12, 15, 21, 26, 27, 28, 36, 37, 39, 42, and 44 as Group 1;

Claims 3, 22, and 31 as Group 2;

Claims 13 and 40 as Group 3;

Claims 14 and 41 as Group 4;

Claim 43 as Group 5;

Claim 54 as Group 6;

Claims 46, 50, and 52 as Group 7;

Claims 47, 51, and 53 as Group 8;

Claims 6, 7, 24, 33, and 34 as Group 9;

Claims 11 and 38 as Group 10;

Claims 5, 23, and 32 as Group 11;

Claims 8, 25, and 35 as Group 12;

Claims 16 and 19 as Group 13;

Claim 17 as Group 14;

Claim 20 as Group 15;

Claim 48 as Group 15;

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Claim 49 as Group 17;

Claim 55 as Group 18;

Claim 18 as Group 19; and

Claim 45 as Group 20.

See pages 6-7 of the appeal brief. Furthermore, with respect to Groups 1-7, 9-13, 19, and 20, Appellants argue each group of claims separately and explain why the claims of each group are believed to be separately patentable.

However, with respect to Groups 8 and 14-18, Appellants do not argue each group of claims separately and explain why the claims of each group are believed to be separately patentable. Rather, with respect to Groups 8 and 14-18, Appellants merely point out differences in what the claims cover.

See pages 7-25 of the brief and pages 2-13 of the reply brief. With respect to Groups 1-7, 9-13, 19, and 20, Appellants have fully met the requirements of 37 C.F.R. § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellants' filing of the brief. 37 C.F.R. § 1.192 (c)(7) states:

Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the

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group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider Appellants' claims as standing or falling together in the fourteen (14) groups noted below, and we will treat:

Claim 21 as a representative claim of Group 1;

Claim 3 as a representative claim of Group 2;

Claim 13 as a representative claim of Group 3;

Claim 14 as a representative claim of Group 4;

Claim 46 as a representative claim of Groups 7 and 8

(claims 46-47 and 50-53);

Claim 6 as a representative claim of Group 9;

Claim 11 as a representative claim of Group 10;

Claim 5 as a representative claim of Group 11;

Claim 25 as a representative claim of Group 12; and

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Claim 16 as a representative claim of Group 13 through Group 18
(claims 16-17, 19-20, 48-49, and 55).

If the brief fails to meet either requirement, the Board is free to select a single claim from each group and to decide the appeal of that rejection based solely on the selected representative claim. In re McDaniel, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). See also In re Watts, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004).

I. Whether the Rejection of Claims 4, 9, 10, 12, 15, 21, 26, 27, 28, 36, 37, 39, 42, and 44 Under 35 U.S.C. § 103 is proper?

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 have suggested to one of ordinary skill in the art the invention as set forth in claims 4, 9, 10, 12, 15, 21, 26, 27, 28, 36, 37, 39, 42, and 44. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). See also In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The

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Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. Oetiker, 977 F.2d at 1445, 24 USPQ2d at 1444. See also Piasecki, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. “In reviewing the [E]xaminer’s decision on appeal, the Board must necessarily weigh all of the evidence and argument.” Oetiker, 977 F.2d at 1445, 24 USPQ2d at 1444. “[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion.” In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to all claims rejected based on Kikinis and Light in combination, Appellants argue at pages 7-8 of the appeal brief and 2-3 of the reply that with respect to the combination the Examiner has not identified a

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motivation or suggestion to combine the references and thus, the Examiner has engaged in improper hindsight. Further, Appellants argue the mere fact that Kikinis and Light both “pertain to filling in forms on web pages does not lead to the conclusion that the references are in the same field of endeavor.” (Reply at page 2).

We address Appellants’ second argument first. To support of their position that Kikinis and Light are from different fields of endeavor, Appellants cite Wang Labs., Inc. v. Toshiba Corp., 993 F.2d 858 (Fed. Cir. 1993) for the proposition that “two references both regarding single in-line memory modules (SIMMs) were nevertheless determined to be in different fields of endeavor.” In Wang, the prior art reference involved memory circuits in which modules of varying sizes may be added or replaced; in contrast, the claimed subject matter related to compact modular memories. We agree with Appellants up to a point, but we are not persuaded as to Appellants’ ultimate point that the Kikinis and Light references are from a different field of endeavor than Appellants’ claimed invention.

We agree that Wang holds that a reference is not in the same field of endeavor as the claimed subject matter merely because the reference relates to

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the same broad area (memories or SIMMs). However, we see no support in Wang for holding that a reference is from a different field of endeavor than the claimed invention when both are directed to the same narrow area. In the appeal before us, the references are directed to the same field of endeavor as the claimed invention. That is, the field of endeavor of Kikinis (“filling fields in Internet forms”, Abstract) and the field of endeavor of Light (“automatic web form fill-in”, Abstract) is the same narrow area as Appellants’ field of endeavor (“automatically populating data fields in forms [on the web]” (spec. at page 1, line 7)).

As to Appellants’ first point that the Examiner has not identified a motivation or suggestion to combine the references, we are also not persuaded. Appellants argue the Examiner’s statement in the rejection that combining the references “would have increased the efficiency of filing out the form ...” is a result not a motivation. We disagree. The Light reference explicitly teaches problems at column 1, lines 32-35, that are being solved by their invention. Improved timeliness and error rate (i.e., increased efficiency) is more than sufficient motivation to combine the prior art references.

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With respect to independent claim 21, Appellants argue at page 8 of the appeal brief that claim 21 is patentable because “the ‘highlighted item in the list’ disclosed by Kikinis is a name tag and not its associated data value, as recited in claim 21.” Appellants go on to argue at pages 9-10 of the appeal brief that displaying the name tag rather than its name tag prevents certain types of erroneous data entry. We agree with this second point. However, we do not agree that claim 21 is thus patentable. The level of skill in the relevant art is sufficiently high enough to recognize that the data values themselves could be displayed in place of the data value name tags. We look to Capps at figure 5B as exemplary of this level of skill.

Appellants’ reply merely reiterates the above argument.

Therefore, we will sustain the Examiner’s rejection under 35 U.S.C. § 103.

II. Whether the Rejection of Claims 3, 22, and 31 Under 35 U.S.C. § 103 is proper?

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 have

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suggested to one of ordinary skill in the art the invention as set forth in claims 3, 22, and 31. Accordingly, we affirm.

With respect to independent claim 3, Appellants argue at pages 10-11 of the appeal brief and page 4 of the reply, that Kikinis does not teach or suggest actively “inhibiting the copying of the suggested data value into the data entry region until after receipt of the user-initiated action.” We disagree.

As Appellants recognize at page 4 of the reply “Kikinis, at col.3, lines 63-66, implies waiting for a user-initiated action prior to filling in the form.” We find nothing more than this required by the language of the claim. Even if we accept Appellants arguments that copying in Kikinis can be triggered by something other than user initiated input (i.e., mimicked user input), it does not show Examiner error. That Kikinis may be triggered by other than actual user initiated input is not relevant so long as Kikinis teaches that actual user initiated input will trigger copying.

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We will not speculate on the result we would have reached had we found that claim 21 is by its current language limited to wherein copying “only” occurs after user initiated input.²

Therefore, we will sustain the Examiner’s rejection under 35 U.S.C. § 103.

III. Whether the Rejection of Claims 13 and 40 Under 35 U.S.C. § 103 is proper?

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 have suggested to one of ordinary skill in the art the invention as set forth in claims 13 and 40. Accordingly, we affirm.

With respect to independent claim 13, Appellants argue at pages 11-12 of the appeal brief and page 5 of the reply that claim 13 is patentable over the prior art because HTML 4.0 merely teaches “masking of sensitive data” and not selecting whether to store a data value for a password field. We disagree.

We agree that HTML 4.0 teaches at most detecting and then special handling of a password field by masking. However, this argument alone is not

² As argued by Appellants at the Hearing on October 19, 2006.

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sufficient to show Examiner error because Light teaches at column 7, lines 11-12, that the user is forced to select whether a data value will be stored. We agree with the Examiner that the combination of Kikinis, Light, and HTML 4.0 renders the claimed invention obvious.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

IV. Whether the Rejection of Claims 14 and 41 Under 35 U.S.C. § 103 is proper?

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 invention as set forth in claims 14 and 41. Accordingly, we reverse.

With respect to independent claim 14, Appellants argue at page 12 of the appeal brief, HTML 4.0 does not teach “performing numerical processing” or “suppressing suggestions for a credit card” as required by claim 14. We agree as to the first function, but we find “suppressing suggestions” taught by Light at Fig. 6 and column 4, line 57, through column 9, where data may be restricted.

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Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

V. Whether the Rejection of Claim 43 Under 35 U.S.C. § 103 is proper?

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 have suggested to one of ordinary skill in the art the invention as set forth in claim 43. Accordingly, we affirm.

With respect to independent claim 43, Appellants argue at page 13 of the appeal brief and page 7 of the reply, that claim 43 is allowable because the Office Action . . . does not indicate that Light teaches or suggests the limitation of detecting a password and inhibiting the display of any suggested values unless the URL matches. We disagree.

We have already discussed that special handling of a password field is known as shown by HTML 4.0. As to inhibiting unless the URL matches, this is taught by Light at Fig. 6 and column 4, line 57, through column 9, where data may be restricted.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

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VI. Whether the Rejection of Claim 54 Under 35 U.S.C. § 103 is proper?

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 have suggested to one of ordinary skill in the art the invention as set forth in claim 54. Accordingly, we affirm.

With respect to independent claim 54, Appellants argue at pages 13-14 of the appeal brief and page 7 of the reply, that claim 54 is patentable because it additionally requires that if there is no previous indication to save a password then it prompts the user to indicate whether to save the data value. We disagree.

As we have already noted, this is how Light operates with respect to any new data value (i.e. it has not been previously stored) as shown at column 7, lines 11-12.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

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VII. Whether the Rejection of Claims 46-47 and 50-53 Under 35 U.S.C. § 103 is proper?

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 have suggested to one of ordinary skill in the art the invention as set forth in claims 46, 47, and 50-53. Accordingly, we affirm.

With respect to independent claim 46, Appellants argue at pages 14-15 of the appeal brief and page 8 of the reply that Kikinis and Light do not teach or suggest the feature of detecting a first data value in a first field and automatically copying a second data value onto a second field. We agree. However, this feature is explicitly described in Capps at column 13, lines 20-27.

Therefore, we find claim 46 obvious over the teachings of Kikinis, Light, and Capps, and we will sustain the Examiner's rejection under 35 U.S.C. § 103.

VIII. Whether the Rejection of Claims 6, 7, 24, 33, and 34 Under 35 U.S.C. § 103 is proper?

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 have suggested to one of ordinary skill in the art the invention as set forth in claims 6, 7, 24, 33, and 34. Accordingly, we affirm.

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With respect to independent claim 6, Appellants argue at pages 15-16 of the appeal brief and page 8 of the reply that (1) “Contrary to the Examiner, Kikinis does not compare a field identifier to a dynamically updated field identifier,” and (2) “Light merely discloses a database.” We are not persuaded of Examiner error based on these arguments.

As to the first, we find nothing in the Examiner’s rejection that corresponds to this argument. The Examiner does not rely on Kikinis for this teaching. As to the second, on its face Light teaches more than a database. Further, the Examiner at pages 5-6 of the Answer has set forth where and why Light teaches or suggests the claim limitations. Appellants have not shown any Examiner error with respect to the rejection of claim 6.

Therefore, we will sustain the Examiner’s rejection under 35 U.S.C. § 103.

IX. Whether the Rejection of Claims 11 and 38 Under 35 U.S.C. § 103 is proper?

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 have

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suggested to one of ordinary skill in the art the invention as set forth in claims 11 and 38. Accordingly, we affirm.

With respect to independent claim 11, at page 16 of the appeal brief and page 9 of the reply, Appellants point to three features: (1) storing on a case-by-case basis as taught by Light; (2) disabling storage on a case-by-case basis; and (3) globally disabling storage altogether. Appellants first conclude without explanation that (1) is not the same as (2). Appellants then conclude without explanation that (1) is different from (3) and thus claim 11 is allowable.

As to the first conclusion, without some explanation as to why the Appellants deem these to be different, we are not persuaded of Examiner error. As to the second conclusion, even if accepted as fact it does not render claim 11 allowable. The Examiner's rejection is premised on the fact that the teaching of Light is different than the claim, but the claimed limitation is obvious over Kikinis and Light. Thus, merely stating that (1) and (3) are not the same does not demonstrate the Examiner has erred.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

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X. Whether the Rejection of Claims 5, 23, and 32 Under 35 U.S.C. § 103 is proper?

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 have suggested to one of ordinary skill in the art the invention as set forth in claims 5, 23, and 32. Accordingly, we affirm.

With respect to independent claim 5, Appellants argue at page 17 of the appeal brief and page 9 of the reply that “the examiner has not provided a proper motivation to combine Gupta with Kikinis, stating only that ‘a person would have recognized that field identifiers having the same URL were likely to represent the same fields on the same form’” and that “the examiner has provided no evidence of the level of knowledge of one of ordinary skill in the art.” We disagree on both points.

First, the Examiner has provided the Kikinis, Light, and Gupta references which are evidence of the level of skill in the art. Second, as pointed out by the Examiner, Gupta teaches that the form filling fields can be associated with a particular URL at column 8, lines 26-27. We go further than the Examiner as we find that Gupta teaches that field identifiers having the same URL represent

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the same fields on different forms and that there is a benefit to associating fields with a specific URL. Appellants have not demonstrated any Examiner error.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C.

§ 103.

XI. Whether the Rejection of Claims 8, 25, and 35 Under 35 U.S.C. § 103 is proper?

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 have suggested to one of ordinary skill in the art the invention as set forth in claims 8, 25, and 35. Accordingly, we affirm.

With respect to dependent claim 25, Appellants admit that the vCard schema was known at the time of invention (appeal brief at page 18). Appellants go on to argue at pages 18-19 of the appeal brief and page 9 of the reply that claim 25 is allowable because “[the] only possible motivation to combine Kikinis with vCard that the examiner points to is Appellants’ disclosure itself.” We disagree.

Appellants’ specification at page 5 states “[t]he invention can also be made compatible with the existing vCard schema standard, such that standard

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fields in that schema (e.g., vCard.email) are correlated with fields on different forms.” Appellants admit that the vCard schema (and its fields) is known and Kinikis teaches the benefits of a system that “allows a user to link specific pre-stored data . . . with fields in forms encountered on the Internet” (col. 1, lines 45-50). We find this to be more than sufficient motivation to combine the prior art teachings.

Therefore, we will sustain the Examiner’s rejection under 35 U.S.C.

§ 103.

XII. Whether the Rejection of Claims 16-17, 19-20, 48-49, and 55 Under 35 U.S.C. § 103 is proper?

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 have suggested to one of ordinary skill in the art the invention as set forth in claims 16-17, 19-20, 48-49, and 55. Accordingly, we affirm.

With respect to independent claim 16, Appellants argue at pages 19-21 of the appeal brief and page 10 of the reply that there is no motivation to combine the Light and Capps references. We disagree. Capps explicitly states that his

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user interface (and thus its disclosed features) is useful for any computer system (col. 3, lines 1-2, and col. 4, lines 37-38). We find this to be more than sufficient motivation to combine the prior art teachings.

Appellants also argue that “Light et al. does not first detect a correlation between field identifiers and then retrieve a previously stored data value from the local storage area in response thereto.” We disagree.

Appellants’ argument appears to overlook two things. First, the server and client computers in Light are the same computer in one embodiment (col. 2, lines 12-13). Thus storage is local. Second, although Light has a learning mode, this is not the only mode as shown at col. 3, lines 48-52. Contrary to Appellants’ argument, Light describes “[t]he tags recognition unit 350 then scans the form, and determines what the form is asking for.” Again, Appellants have not convinced us of Examiner error.

Therefore, we will sustain the Examiner’s rejection under 35 U.S.C. § 103.

XIII. Whether the Rejection of Claim 18 Under 35 U.S.C. § 103 is proper?

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

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suggested to one of ordinary skill in the art the invention as set forth in claim

18. Accordingly, we reverse.

With respect to dependent claim 18, Appellants argue at page 23 of the appeal brief that the references do not teach Bayesian inference techniques and there is no motivation to use Bayesian techniques except Appellants' specification. We agree.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103.

XIV. Whether the Rejection of Claim 45 Under 35 U.S.C. § 103 is proper?

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 have suggested to one of ordinary skill in the art the invention as set forth in claim 45. Accordingly, we affirm.

With respect to independent claim 16, Appellants argue at page 24 of the appeal brief and page 13 of the reply that there is no motivation to combine the Light and Capps references. We disagree. As we have already noted, Capps explicitly states that his user interface (and thus its features) is useful for any

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computer system (col. 3, lines 1-2, and col. 4, lines 37-38). We find this to be more than sufficient motivation to combine the prior art teachings.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

Conclusion

In view of the foregoing discussion, we have sustained the rejection under 35 U.S.C. § 103 of claims 3-13, 15-17, 19-28, 31-40, and 42-55; and we have not sustained the rejection under 35 U.S.C. § 103 of claims 14, 18, and 41.

Options for further proceedings

We designate that part of our affirmation (claims 46-47 and 50-53) which includes newly applied prior art as a new ground of rejection under 37 CFR § 41.50(b) (2005).

37 CFR § 41.50(b) provides that, “[a] new grounds of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 CFR § 41.50(b) also provides that the Appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of

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the following two options with respect to the new grounds of rejection to avoid termination of proceedings as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner ...

(2) Request that the proceeding be reheard under 37 CFR § 41.52 by the Board upon the same record ...

Should the Appellants elect to prosecute claims 46-47 and 50-53 further before the Primary Examiner pursuant to 37 CFR § 41.50 (b) (1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection of claims 3-13, 15-17, 19-28, 31-40, 42-45, 48-49, and 54-55, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection of claims 3-13, 15-17, 19-28, 31-40, 42-45, 48-49, and 54-55 is overcome.

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If the Appellants elect further prosecution before the Examiner and further prosecution does not result in allowance of the application, abandonment or a second appeal, this application should be returned to the Board of Patent Appeals and Interferences for entry of a final decision with respect to the affirmed rejection of claims 3-13, 15-17, 19-28, 31-40, 42-45, 48-49, and 54-55, including any action on any timely request for reconsideration thereof.

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

AFFIRMED-IN-PART
37 CFR § 41.50(b)

ERROL A. KRASS)
Administrative Patent Judge)

Appeal No. 2006-2585
Application No. 09/388,351

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