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 THOMAS C. MIELENHAUSEN

Appeal No. 2006-2788
Application No. 09/309,831

ON BRIEF

Before KRASS, BARRY, and HOMERE, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-22.

The invention pertains to the maintenance and customization of words, phrases, and abbreviations that are standard in a profession, industry, trade or occupation, for automatic insertion of abbreviations from the list into the text, for converting selected words and phrases in the text to abbreviations, for converting selected abbreviations in the text to words and phrases, and for automatically converting a number of words and phrases to abbreviations, and abbreviations to words and phrases, throughout the text.

Representative independent claim 1 is reproduced as follows:

1. A data processing method for maintaining and customizing a list of words, phrases, and abbreviations that are standard in a profession, industry, trade or occupation, for insertion of abbreviations from the list into text, for converting selected words and phrases in the text to abbreviations, for converting selected abbreviations in the text to words and phrases, and for automatically converting a number of words and phrases to abbreviations, and abbreviations to words and phrases, throughout the text, comprising the steps of:

(a) storing in a memory a first data structure encoding a plurality of words and corresponding abbreviations;

(b) storing in a memory a second data structure encoding a plurality of abbreviations and corresponding words;

(c) selecting a word in the text to be converted to an abbreviation and converting the selected word to a corresponding abbreviation using the first data structure; and

(d) selecting an abbreviation in the text to be converted to a word and converting the abbreviation to a word using the second data structure.

The examiner relies on the following references:

Goldwasser	5,096,423	Mar. 17, 1992
Ichbiah	5,623,406	Apr. 22, 1997

Claims 1-22 stand rejected under 35 U.S.C. § 103 as unpatentable over Ichbiah in view of Goldwasser.

Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

OPINION

Taking claim 1 as exemplary, the examiner explains, at pages 3-5 of the answer, that Ichbiah discloses step (b) of the claimed process, but that Goldwasser discloses the

remainder of the steps (see page 5 of the answer for the relevant portions of Goldwasser, as indicated by the examiner).

The examiner concludes that it would have been obvious to combine the references

> to obtain converting from a word and phrase to a corresponding abbreviation and converting from an abbreviation to a corresponding word and phrase since Goldwasser provides the first method and Ichbiah provides the second method where both are to help users fast finding a right word or a right abbreviation in writing documents (answer-page 5).

While the examiner could have set forth a little better reasoning and a more grammatically correct rationale, we believe the examiner is clearly indicating that, taken together, the two references would have indicated to the artisan that one may store both a plurality of words and corresponding abbreviations; and a plurality of abbreviations and corresponding words, and that one may select a word/abbreviation in text to be converted to an abbreviation/word. In this sense, it is our view that the examiner has established a prima facie case of obviousness with regard to the subject matter of instant claim 1.

Appellant argues that neither Ichbiah nor Goldwasser discloses the step of c) selecting a word in the text to be converted to an abbreviation and converting the select word to a corresponding abbreviation using the first data structure. In particular, appellant argues that Goldwasser (the reference relied on by the examiner for this limitation) does not teach "selecting" a word in text to be converted to an abbreviation, but, instead, prepares the user to enter abbreviations in the future that will be converted to text, not to convert text to abbreviations. By way of further explanation, appellant asserts, at page 5 of the principal

brief, that the user in Goldwasser is merely making data entry to existing text, not selecting a word in the existing text to be converted; and that the user does not choose from among several existing words or pick out a word from the existing text to be converted to an abbreviation because the only word that can be converted by Goldwasser is the single word that the user is currently entering. Appellant asserts that the user in Goldwasser is "not making an active choice" (principal brief-page 5).

We disagree. While we understand Goldwasser's invention, wherein a user types in a word and, after a certain number of letters of that word, there is a display of an abbreviation of that word (hence, conversion of word to abbreviation), we do not believe that the limitation argued by appellant distinguishes over that taught by Goldwasser.

Appellant may argue that the user in Goldwasser is not making an "active choice," but a choice is being made by the user nonetheless in typing a word, and, in any event, "active choice" is not part of the claim. The claim calls for "selecting" a word in the text to be converted to an abbreviation and converting the selected word to a corresponding abbreviation using the first data structure. The list of abbreviations corresponding to certain words, or portions of words, in Goldwasser, is the "first data structure." Moreover, when the user types in the word, this very act of entering this data is a "selection" of a word in text (albeit a word the user is currently entering into the text) and, at some point in entering the letters that make up the word, a conversion of that word into an abbreviation takes place, with the abbreviation being displayed to the user.

Appellant argues that Goldwasser does not disclose selecting a word in the text to be converted. Again, we disagree. The entry of the word into the text by the user is, broadly interpreted, a "selection" of a word "in the text." That is, any word the user wishes to convert is merely typed into the text and, if there is a corresponding abbreviation, the abbreviation will be displayed to the user.

Appellant further argues (principal brief-page 6) that the abbreviation displayed in Goldwasser is displayed in the text after the typed letters; the abbreviation does not replace the typed letters. First, we note that nothing in claim 1 requires the abbreviation to "replace" a word. The language merely requires a selection of a word in the text to be converted to an abbreviation, and then performing the conversion. This much, Goldwasser's system does. Typing in the word into the text is a "selection" of the word wishing to be converted, and, if an abbreviation for that word exists in the data structure, that abbreviation is displayed, thus concluding the conversion. It matters not that the abbreviation in Goldwasser is displayed in the text after the typed letters. The claim says nothing about where the abbreviation is displayed. In fact, independent claim 1 says nothing at all about displaying the converted word, or abbreviation. Accordingly, appellant's argument in this regard is not persuasive of unobviousness.

Appellant separately argues the limitations of claims 3-6. In particular, appellant argues, at page 6 of the principal brief, that Ichbiah does not select a word in the text to be converted to an abbreviation using a keyboard or a mouse, in that column 3, lines 63-65, of the reference only teaches displaying a list of words that have already been converted from

abbreviations to the user for selection. Appellant asserts that Ichbiah only converts abbreviations to words, not vice-versa, and therefore does not teach converting words to abbreviations.

We disagree.

The rejection is based on 35 U.S.C. § 103, not § 102. Therefore, addressing only Ichbiah, and not Goldwasser, in the rejection is unpersuasive of unobviousness. The examiner relied on Goldwasser, and not Ichbiah, for conversion of words to abbreviations. Moreover, it is clear that a keyboard and a mouse are two known and commonly used input means for making selections. In fact, Goldwasser, for example, uses a keyboard, for entering the selected words which will be converted to abbreviations for the user. The artisan would have recognized the obviousness of alternatively using a mouse to enter such data. We note column 5, lines 22-24, of Ichbiah, wherein it is indicated that characters may be input "in any number of ways as it is well known to those skilled in the art, such as a keyboard and point and select devices."

Appellant separately argues the limitations of claim 7. In particular, appellant argues, at page 6 of the principal brief, that neither Ichbiah nor Goldwasser discloses the step of scanning the text for words to be converted to abbreviations and converting words selected by the data processing method to corresponding abbreviations using the first data structure.

Again, we disagree. As explained *supra*, Goldwasser monitors the letters input by a user and, when those letters indicate a certain word is being entered, an abbreviation for that word is displayed, if there is such an abbreviation. As broadly claimed, it is fair to say that

Goldwasser "scans," or monitors, the text, i.e., the word being entered, for words to be converted to abbreviations.

Appellant separately argues the limitations of claim 13. In particular, appellant argues, at page 7 of the principal brief, that the teaching by Ichbiah, at column 3, lines 50-65, of choosing one of a set of matching words generated from an abbreviation, is not the same as selecting the abbreviation and inserting the abbreviation into the text at a position selected by the user.

Again, we disagree with appellant. While we understand the difference between the instant invention and the systems of Ichbiah and Goldwasser, the instant invention, *as claimed*, does not, in our opinion, distinguish over the references. In Goldwasser, when the user types in a word at a certain position in the text and an abbreviation is displayed therein, this can reasonably be said to be a selection of an abbreviation by the user from the first data structure and an insertion of that abbreviation into the text at a position selected by the user. True, the abbreviation is displayed following the typed word and only in that position, but, as broadly claimed, this point in the text at which the word is entered may be said to be "selected" by the user and the automatic display of the abbreviation after that word, it follows, is "selected" by the user in entering the word. We note that the claim does not say that a user may select any of a plurality of positions, or any position within the text. It says merely that the abbreviation is inserted into the text at a position selected by the user. The user, in typing a given word, is making the position selection at that time by typing the word at a selected position. Therefore, in our view, the broad language of claim 13 is met.

Appellant separately argues the limitations of claim 15. In particular, appellant argues, at page 7 of the principal brief, that the references do not show the step of the user instructing the data processing method to select a position in the text for insertion of an abbreviation.

For the reason *supra* with regard to claim 13, we are unpersuaded by appellant's argument. In Goldwasser, by typing in a word at a particular position, the user has "selected" the location where the abbreviation will be inserted. We disagree with appellant that the user has no control over the position in the text at which the abbreviation is to be inserted because the abbreviation will be inserted following the typed word and the user types the word. Again, if appellant intended that the user be able to insert the abbreviation at any of a plurality of positions, or anywhere, in the text, the claims should have so specified.

Accordingly, since all claims not argued separately will fall with the argued claims, we will sustain the rejection of claims 1-22 under 35 U.S.C. § 103.

The examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (2004).

AFFIRMED

ERROL A. KRASS Administrative Patent Judge	)
LANCE LEONARD BARRY Administrative Patent Judge	) **BOARD OF PATENT APPEALS AND INTERFERENCES**
JEAN R. HOMERE Administrative Patent Judge	)

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