

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTONIO ABBONDANZIO, ALAN JOSEPH HAPP, and
GAYLE COLBY STEINBUGLER

Appeal 2008-1428
Application 09/906,351
Technology Center 2100

Decided: September 18, 2008

Before JAMES D. THOMAS, JOSEPH L. DIXON,
and STEPHEN C. SIU, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. 134(a) from the Examiner's final rejection of claims 10 through 15. We have jurisdiction under 35 U.S.C. § 6(b).

As best representative of the disclosed and claimed invention, independent claim 10 is reproduced below:

10. A method of indicating a status of a plurality of features of a data processing system to a user, said method comprising:

displaying a graphical multi-level tree structure including a graphical baseline and a plurality of levels extending from the baseline, wherein each level among said plurality of levels includes a textual identification for a respective one of said plurality of features;

monitoring for status information regarding said plurality of features;

determining if said status information indicates a normal status or a notification status; and

for each of said plurality of features,

displaying a placeholder icon adjacent to said textual identification in response to determining said status information indicates said normal status; and

displaying a notification indicia adjacent to said textual identification in place of a placeholder icon in response to determining said status information indicates said notification status;

wherein said placeholder icon is a graphical connector graphically connecting a textual identification to said baseline of said graphical multi-level tree structure, such that features among said plurality of features having a notification status are readily visually distinguishable from features among said plurality of features having a normal status; and

wherein displaying said placeholder icon comprises displaying a linear graphical connector.

The following references are relied on by the Examiner:

Griesmer	US 5,923,328	Jul. 13, 1999
Hwang	US 5,999,178	Dec. 7, 1999

All claims on appeal, claims 10 through 15, stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner relies upon Hwang in view of Griesmer.

Rather than repeat the positions of the Appellants and the Examiner, reference is made to the Brief and Reply Brief for the Appellants' positions, and to the Answer for the Examiner's positions.

OPINION

For the reasons set forth by the Examiner in the Answer, as expanded upon here, we sustain the rejection of claims 10 through 15 under 35 U.S.C. § 103. According to Appellants' remarks at page 9 of the principal Brief on appeal, claim 10 is representative of the subject matter of that claim as well as of claims 12 and 14. Similarly, page 11 of this Brief considers claim 11 as representative of the subject matter of that claim as well as of claims 13 and 15.

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

The Supreme Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 127 S. Ct. at 1739. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740. The Court noted that “[c]ommon sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *Id.* at 1742.

The Federal Circuit recently concluded that it would have been obvious to combine (1) a device for actuating a phonograph to play back sounds associated with a letter in a word on a puzzle piece with (2) a processor-driven device capable of playing the sound associated with a first letter of a word in a book. *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007). In reaching that conclusion, the Federal Circuit recognized that “[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why

some combinations would have been obvious where others would not.” *Id.* at 1161 (citing *KSR*, 127 S. Ct. 1727, 1739 (2007)). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was “uniquely challenging or difficult for one of ordinary skill in the art” or “represented an unobvious step over the prior art.” *Id.* (citing *KSR*, 127 S. Ct. at 1740-41).

In the absence of separate arguments with respect to claims subject to the same rejection, those claims stand or fall with the claim for which an argument was made. *See In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii)(2004).

Dovetailing with this precedent, we note further that the test for obviousness has been further characterized as not whether the features of a secondary reference may be bodily incorporated into the structure of a primary reference. It is also not that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d 414, 425 (CCPA 1981); *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991).

The Examiner’s reasoning of combinability of Hwang and Griesmer appears to us to be consistent with this precedential case law, such as to directly address the arguments of a lack of proper motivation or suggestion of modification as expressed at pages 10 and 12 of the principal Brief on appeal. Both Hwang and Griesmer relate to the use of graphical user interfaces and tree structures and respectively identifiable/differently labeled icons to indicate the status of the features of the data processing system of

each invention. It is noteworthy that the operating system identified at column 1 of Hwang is consistent with that which was part of the admitted prior art at Specification page 1 from which Appellants' invention appears to be a modification. Correspondingly, the operating system identified at the middle of page 6 of Griesmer is also consistent and similar to the ones identified at Specification page 1.

The issue is best stated by Appellants' observation at the top page 2 of the Reply Brief, which asserts the view that the combination of Hwang and Griesmer "does not render obvious the claimed substitution of a notification indicia in place of a placeholder icon comprising 'a linear graphical connector' (exemplary Claim 10) or 'a partially transparent graphical connector' (exemplary Claim 11) in a multi-level graphical tree structure as claimed." We do not agree with these views.

The so-called "linear graphical connector" of representative independent claim 10 and the "partially transparent graphical connector" of representative independent 11 both relate to non functional descriptive material, which do not exhibit a functional relationship with a substrate and therefore do not affect the manner in which the computer processes are performed. Non functional descriptive material is treated as analogous to printed matter cases where what is printed on a substrate bears no functional relationship to the substrate and is given no patentable weight. *See In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) ("Where the printed matter is not functionally related to the substrate, printed matter will not distinguish the invention from the prior art in terms of patentability. Although the printed matter must be considered, in that situation it may not be entitled to

patentable weight.”). *See also Ex parte Curry*, 84 USPQ2d 1272 (BPAI 2005) (nonprecedential) (Federal Circuit Appeal No. 2006-1003, *aff’d* Rule 36 Jun 12, 2006). The Examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). *See also Ex parte Nehls*,

<http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071823.pdf>

(BPAI Jan. 28, 2008); *Ex parte Mathias*, 84 USPQ2d 1276 (BPAI 205) (nonprecedential)(191 Fed. Appx. 959 (Fed. Cir. 2006)).

Based in part on this precedent, we find that it would have been obvious for the artisan to have chosen any type of indicia or different visual indicia than that, for example, illustrated in Hwang and Griesmer as well as Appellants’ admitted prior art in figure 3A and its corresponding discussion at Specification pages 1 and 2 as filed. The alleged distinctions are based on nonfunctional descriptive material alone where no different functionality of process is imparted by the characterization of an icon being a linear graphical connector or a partially transparent graphical connector as set forth respectively in representative independent claims 10 and 11 on appeal.

Notwithstanding these findings, Hwang specifically illustrates in figures 4A-D in flow chart form as well as the flow chart in figure 5, the concept of replacing or otherwise resetting icons based upon the changing operating status of underlying conditions of the data processing system of this reference. Specifically, column 2, lines 3 through 6, relates to changeable visual displays of an object icon or its otherwise modification to

indicate to the user a different status based upon a different status of the operating conditions of the underlying data processing system. Moreover, column 5, lines 21 through 29, plainly teach that the appearance of the icons may be changed or replaced as the conditions change to include their color or the ability to display them intermittently to produce a blinking effect. Lastly, column 9, lines 28 through 35, contains similar teachings to include the use of different shapes or colors for the respective icons otherwise taught in the reference.

Finally, each independent claim on appeal recites the feature “such that features among said plurality of features having a notification status are readily visually distinguishable from features among said plurality of features having a normal status.” The bottom of page 3 of the Reply Brief notes the Examiner’s view with respect to corresponding arguments as to this feature at the bottom of page 18 of the Answer that there is nothing in the claims regarding limiting a cluttered appearance. We agree with the Examiner’s general observation because the notion of an uncluttered appearance is not an apt characterization of the actual quoted language of the claims on appeal. Moreover, the argument as well as the actual language relate to subjective opinions of a viewer which are not objectively or otherwise recited within the claims themselves. An artisan may just as well consider visually distinguishable the prior art icons of prior art figures 3A of the Specification as filed notwithstanding the additional teachings we outlined earlier in Hwang presenting visually distinguishable icons to the viewer when the underlying status of the data processing system changes.

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In view of the foregoing, the decision of the Examiner rejecting all claims on appeal under 35 U.S.C. § 103 is sustained since Appellants have not presented any persuasive arguments as to any error in the Examiner's positions. Therefore, the decision of the Examiner is affirmed.

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

AFFIRMED

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