

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MINGTE CHEN, ANIL KUMAR ANNADATA, KUANG-YANG
HUANG, ROHIT BEDI and HENRY DANA JAY

Appeal 2008-1920
Application 10/001,140
Technology Center 2100

Decided: January 15, 2009

Before JOSEPH L. DIXON, JEAN R. HOMERE, and STEPHEN C. SIU,
Administrative Patent Judges.

DIXON, *Administrative Patent Judge.*

ORDER REMANDING TO THE EXAMINER

This is an Order remanding the application to the Examiner. From our initial review of the application and prosecution history, we note Appellants contested the eligibility of the Microsoft Word 2000 screen shots. We note that the figure 1 includes both copyright information and an indication of what “Service Pack” was present on the computer at the time of

the screen shots. While difficult to read it appears that SP-3 (Service Pack 3) was in use at the time of the recordation of the screen shot. From our brief Internet search, Service Pack 1a (SR1a) was available on or about May 12, 2000, Service Pack 2 (SP-2) was available on or about November 14, 2000, and Service Pack 3 (SP-3) was available on or about October 21, 2002. Therefore, if the functionality was not added by Service Pack 3, then the date of the reference should make Microsoft Word 2000 prior art, and if Service Pack 3 added the disputed functionality described/shown, then the date is after the critical date in the instant application and is not prior art.

The Examiner should find some corroborating evidence that the add/remove functionality was present in either the original Microsoft Word 2000 release or in Service Pack's 1 or 2, or provide evidence of the availability of Service Pack 3 for Microsoft Word 2000 prior to the filing date.

We cannot evaluate the merits of the Examiner's rejection unless it can be determined what the relevant date to be accorded to the functionality used in the Examiner's rejection with respect to the Microsoft Word 2000 (SP-3) used as evidence of the existence of this functionality. Here, the Examiner is relying upon Microsoft Word 2000 (SP-3) as evidence of the existence of the add/remove buttons. We do note some of the discussions on the Internet to discuss "chevrons" with regard to these features.

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

- (1) determine whether Microsoft Word 2000 (SP-3) is prior art before Appellants' filing date in November 15, 2001, and

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(2) other actions, as deemed appropriate.

REMANDED

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