

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RICHARD E. BERRY, SUSAN F. HENSHAW  
and DAVID J. ROBERTS

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Appeal No. 96-1396  
Application 08/176,335<sup>1</sup>

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ON BRIEF

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Before THOMAS, JERRY SMITH and CARMICHAEL, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-15, which constitute

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<sup>1</sup> Application for patent filed January 3, 1994. According to the appellants, the application is a continuation of Application 07/888,221, filed May 26, 1992.

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all the claims in the application. An amendment after final rejection was filed on April 10, 1995 and was entered by the examiner.

The invention pertains to a method and apparatus for operating a graphical user interface on the display of a computer. More particularly, an icon is placed in the menu bar of a window being displayed. The icon is associated with one or more actionable objects, and a selection message is sent to the associated actionable objects in response to selection of the icon in the menu bar.

Representative claim 1 is reproduced as follows:

1. An apparatus for operating a user interface having one or more icons in a menu bar of a window on a display, comprising:

(a) means for producing a menu bar in a window on the display;

(b) means for placing a menu bar icon in the menu bar;

(c) means for associating one or more actionable objects in said window with said menu bar icon, each of said actionable objects represented by a different icon, said actionable objects having data and procedural information and being operable independent of said menu bar icon; and

(d) means for sending a selection message to the one or more associated actionable objects in response to operator selection of the menu bar icon

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The examiner relies on the following references:

Muller	4,984,152	Jan. 08, 1991
Fleming et al. (Fleming)	5,140,677	Aug. 18, 1992 (Filed May 11, 1990)

Claims 1-15 stand rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the invention. Claims 1-15 also stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Fleming and Muller taken together.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner, the arguments in support of the rejections and the evidence of obviousness relied upon by the examiner as support for the obviousness rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in

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rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that claims 1-15 particularly point out the invention in a manner which complies with 35 U.S.C. § 112. We are also of the view that the rejection as formulated by the examiner does not support the obviousness of the invention in the manner suggested by the examiner. Accordingly, we reverse the examiner's rejections. Nevertheless, we add a new rejection of independent claims 1, 6 and 11 using our authority under 37 CFR § 1.196(b).

We consider first the rejection of claims 1-15 under the second paragraph of 35 U.S.C. § 112. The examiner's rejection states the following:

The recitation of "each of said actionable objects represented by a different icon, having data and procedural information and being operable independent of said menu bar icon; and means for sending a selection message to the one or more associated actionable objects in response to operator selection of the menu bar icon" in claims 1, 6 and 11 is confusing since if actionable objects are operable independent of the menu bar icon, the actionable objects will not have response to the selection of the menu bar icon

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[answer, pages 2-3].

Appellants argue that the criticized terms would be clear to the person skilled in the art when the claims are read in light of the specification [brief, pages 7-9].

The general rule is that a claim must set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure as it would be by the artisan. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed in light of the specification. Seattle Box Co., v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

The examiner appears to misapprehend the meaning of what is recited in the independent claims. The fact that an actionable object is operable independently of the menu bar icon does not preclude it also being operable in response to the menu bar icon. For example, in figure 2 of this application, the actionable object "March Reports" is operable by either selecting icon 250, which is independent of the menu

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bar icon, or by selecting icon 222 which is not independent of the menu bar icon. Thus, the independent claims recite nothing more than that the actionable objects can be operated without using the menu bar icon. We agree with appellants that the artisan having considered the specification of this application would have no difficulty ascertaining the scope of the invention recited in claims 1-15. Therefore, the rejection of claims 1-15 under the second paragraph of 35 U.S.C. § 112 is not sustained.

We now consider the rejection of claims 1-15 under 35 U.S.C. § 103 as unpatentable over the teachings of Fleming and Hoki. Appellants have indicated that the claims on appeal stand or fall together for purposes of this rejection [brief, page 7]. Consistent with this indication appellants have made no separate arguments with respect to any of the claims on appeal. Consequently, all contested claims stand or fall together. See In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Accordingly, we will only consider the rejection against claim 1 as representative of all the claims on appeal.

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In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 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. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note

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In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to representative claim 1, the examiner has basically read the claim on the disclosure of Fleming, and the examiner asserts that Fleming teaches the invention of claim 1 except for the claimed plurality of menu icons [answer, page 3]. The examiner relies on Muller as teaching a plurality of menu icons and suggests that it would have been obvious to replace the menu titles of Fleming with the plural icons of Muller [Id. at pages 3-4].

Appellants argue inter alia that

Fleming *et al* provide no "means for associating one or more actionable objects in said window with said menu bar icon..." Instead they provide only a proxy icon for the window itself - there is no ability to associate another object within the window with a[n] menu bar icon. As a result, there is no "means for sending a selection message to the one or more associated actionable objects" [brief, page 12].

The examiner responds that the menu bar icon and the objects in Fleming are associated by merely being icons displayed on the same window [answer, page 6].

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Although many of appellants' arguments are not commensurate in scope with the invention of claim 1, we are unable to find motivation to combine the teachings of Muller with Fleming so as to arrive at the claimed invention. First, we cannot agree with the examiner that "associating" can be satisfied by the mere presence of two unrelated items on a display window. Claim 1 recites an association that requires functionality between the actionable object and the menu bar icon which is not met by the actionable objects identified by the examiner. Second, we can find no motivation for replacing the action line items of Fleming, such as File, View and Options, with a plurality of menu bar icons based on the teachings of Muller. The plurality of icons in Muller would not fit within the menu bar and would provide no advantage to the Fleming interface. Therefore, we do not sustain the rejection under 35 U.S.C. § 103 as formulated by the examiner.

Notwithstanding our view that the examiner's rejection of the claims cannot be sustained, we are also of the view that the invention as broadly recited in independent claims 1, 6 and 11 is fully met by the teachings of Fleming. Therefore, we exercise our authority under 37 CFR § 1.196(b) to make a

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new rejection of independent claims 1, 6 and 11 under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Fleming.

For purposes of reading the claimed invention on the disclosure of Fleming, we will use claim 1 as the representative claim. We also interpret claim 1 in its broadest form which means that we interpret "one or more icons" as meaning one icon and "one or more actionable objects" as meaning one actionable object. Claim 1 reads on Fleming as follows:

(a) means for producing a menu bar in a window is met by menu bar 37 of Fleming;

(b) means for placing a menu bar icon in the menu bar is met by icon 45 of Fleming;

(c) means for associating one...actionable object in said window with said menu bar icon ... and being operable independent of said menu bar icon is met by actionable object "project X" of Fleming and by menu bar icon 45 of Fleming; [note that actionable object "Project X" is operable independent of menu bar icon 45 by use of icon 21];

(d) means for sending a selection message to the one...associated actionable object in response to operator selection of the menu bar icon is met by icon 45 of Fleming; [note that selection of icon 45 causes a selection message to be sent to actionable object "Project X"].

Since the broadest reasonable interpretation of

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independent claims 1, 6 and 11 is fully met by the disclosure of Fleming as explained above, we make this new ground of rejection of claims 1, 6 and 11. We designate this as a new ground of rejection because our reasoning is substantially different from that used by the examiner in his combination of prior art references. We also only address the three independent claims at this time. We leave it to the examiner to decide the extent to which the dependent claims may be subject to rejection based on Fleming alone or used with other available prior art.

In summary, we have not sustained either of the examiner's rejections of the claims under 35 U.S.C. §§ 112 and 103. Therefore, the decision of the examiner rejecting claims 1-15 is reversed. We have entered a new ground of rejection of independent claims 1, 6 and 11.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1977)). 37 CFR § 1.196(b) provides that "A new ground of rejection shall not be considered final for purposes of

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judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

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

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

REVERSED; 37 CFR § 1.196(b)

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Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
JERRY SMITH	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
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JS/PGG

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