

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GLENN STEARNS,
BARBARA B. PACKARD,
and
RALPH T. WATSON

Appeal No. 1996-2581
Application No. 08/288,139

ON BRIEF

Before BARRETT, RUGGIERO, and GROSS, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 8-11, 13, 14, 26, and 27. Claims 2-7 and 12 have been allowed, and claims 1 and 15-25 have been canceled.

The claimed invention relates to the recording and monitoring of commands executed by a computer. More particularly, rather than recording user actions at a "syntax"

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level such as keystrokes and mouse movements, user commands are recorded at a "semantic" level which are independent of the location of images on a display. An action processor generates semantic commands by the lexical and syntactical analysis of the selection and movement of images on a viewing screen. These generated semantic commands are then sent to a command processor for execution. Appellants assert at pages 2-5 of the specification that semantic commands are application independent and also permit the accurate playback of recorded commands even though the location of pertinent images on a display screen changes from the time of recording to playback.

Claim 8 is illustrative of the invention and reads as follows:

8. A computing system comprising:

a viewing screen which displays images;

user interface means for enabling a user to select and move images displayed by the viewing screen;

a plurality of application processes, each application process responsive to selection and movement of the images on the viewing screen, and each application process including:

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action processor process for monitoring
selection and movement of the images on the viewing
screen and for generating semantic commands by
lexical and syntactical analysis of the selection
and movement

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of the images on the viewing screen, each of the semantic commands identifying an entity being operated on, where identification of the entity is independent of location of the images on the viewing screen, and

command processor process for receiving the semantic commands from the action processor and for executing the semantic commands; and

recording means for receiving first semantic commands executed by a first command processor from the plurality of application processes, and for recording the first semantic commands in a file, the first semantic commands, after being recorded in the file, giving a history of semantic commands previously executed by the first command processor process.

The Examiner relies on the following prior art:

Barstow et al. (Barstow)	4,827,404	May 02, 1989
		(filed Apr. 14, 1986)

Claims 8-11, 13, 14, 26, and 27 stand finally rejected under 35 U.S.C. § 103 as being unpatentable over Barstow.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (Paper No. 31) and Answer (Paper No. 32) for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, and the

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evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Brief along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

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 obviousness of the invention as recited in claims 8-11, 13, 14, 26, and 27. Accordingly, we reverse.

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

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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 Hosp. Sys., Inc. v.
Montefiore Hosp., 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 In re Oetiker, 977 F.2d 1443, 1445,
24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to the obviousness rejection of independent

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claims 8, 13, 26, and 27 based on Barstow, Appellants assert the Examiner's failure to establish a prima facie case of obviousness since all of the claim limitations are not taught or suggested by the applied Barstow reference. In particular, Appellants contend (Brief, pages 7 and 21) that Barstow has no disclosure of the translation of the selection and movement of graphical images on a viewing screen into semantic commands.

After reviewing the Barstow reference, we are in agreement with Appellants' position as stated in the Brief. We note that the relevant portion of independent claim 8 recites (similar recitations appear in the other appealed independent claims 13, 26, and 27):

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action processor process for monitoring selection and movement of the images on the viewing screen and for generating semantic commands by lexical and syntactical analysis of the selection and movement of the images on the viewing screen, each of the semantic commands identifying an entity being operated on, where identification of the entity is independent of location of the images on the viewing screen,

In attempting to address this claim language, the Examiner (Answer, pages 2, 4, and 7) directs attention to the graphical editor 22 in Barstow and points to Barstow's description at column 2, line 65 to column 3, line 35, column 4, lines 40-44, column 10, lines 7-32, and column 12, line 5 to column 13, line 16 as supporting the position that the claimed semantic command generation is taking place. In our view, however, the cited passages from Barstow merely indicate that graphical images are manipulated in some unspecified manner to enable a computer program to be created. At most, Barstow describes, as illustrated in Figure 5, the linking of graphical images in the form of modular boxes to form a composite image which will be expressed in a program definition language. We find no disclosure in Barstow which supports the Examiner's conclusion that the selection and movement of graphical images is monitored and the movement is

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translated into semantic commands as required by each of Appellants' independent claims on appeal. In order for us to sustain the Examiner's rejection under 35 U.S.C. § 103, we would need to resort to speculation or unfounded assumptions or rationales to supply deficiencies in the factual basis of the rejection before us. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968), reh'g denied, 390 U.S. 1000 (1968).

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In conclusion, since the Examiner has not established a prima facie case of obviousness, the rejection of independent claims 8, 13, 26, and 27, and claims 9-11 and 14 dependent thereon, over Barstow is not sustained. Therefore, the decision of the Examiner rejecting claims 8-11, 13, 14, 26, and 27 is reversed.

REVERSED

LEE E. BARRETT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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ANITA PELLMAN GROSS)	
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JFR:hh

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