Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT E. WELLS, KENNETH F. KARNOFSKY, ROBERT W. GREEN, ANNE MARIE DOLCE, ERNESTO RAMOS and SASSON HAVUSHA

Appeal No. 1997-3224
Application No. 08/231,531

ON BRIEF

Before KRASS, FLEMING and HECKER, **Administrative Patent Judges.**

FLEMING, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 8, 10 through 19 and 22 through 24, all the

claims pending in the present application. Claims 9, 20 and 21 have been canceled.

The invention relates to a computer interface system. In particular, the computer system includes a computer interface that automatically generates graphical representations of computer operations linked together by graphical representations of functional relationships. On page 24 of the specification, Appellants disclose examples of screen displays of the present invention while referring to Figures 5A to 5F. Appellants disclose that a new data set may be generated from data contained in the Regdata data set 204 illustrated in Figure 5A to create a new data set titled Component Anova. When the new data set is created and the regression analysis is performed, the interface program 11 of the present invention automatically generates corresponding graphical data flow diagram (GDFD) elements as illustrated in Figure 5C with links to show the data set from which the new GDFD elements 222, 224 were generated. Thus, as illustrated in Figure 5C, when the adjusted response graph is generated, a corresponding graph element represented by the adjusted response graph element 220 is added to the GDFD. An arrow

from the Regdata data set element 204 to the adjusted response graph element 220 represents a functional link between the two GDFD elements and indicates that the adjusted response graph was derived from the data contained in the Regdata data set 204.

Independent claim 1 is reproduced as follows:

1. A method of generating a graphical representation of operations performed in a computer system including a processor, an input device, a display device and a memory device containing a data set, the method comprising the steps of:

generating a series of menus including commands;

monitoring the input device to detect a selection of a first command from the menus;

upon detection of the selection of a first command, calling a function corresponding to the first command:

i. to perform a first operation corresponding to the first command and

ii. to generate a graphical representation of the first operation by performing the step of generating a first graphical object representing the first operation; and

monitoring the input device to detect a selection of a second command from the menus;

upon the detection of the selection of a second command, calling a function corresponding to the second command:

i. to perform a second operation corresponding to the second command and

ii. to generate a graphical representation of the second operation by performing the steps of generating a second graphical object representing the second operation and automatically generating a graphical representation of a functional relationship between the second operation represented by the second graphical object and the first operation represented by the first graphical object.

The Examiner relies on the following references:

Kodosky et al. (Kodosky) 4,901,221 Feb. 13, 1990

Macintosh Human Interface Guidelines 70 and 104 (Apple Computer, Inc. 1992)

Macromedia Director Overview Manual 17-20 and 50 (Macromedia, Inc. March 1993)

Claims 10 through 19 stand rejected under 35 U.S.C. § 102 as being anticipated by Kodosky. Claims 1 through 7 and 22 through 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kodosky in view of ***Macromedia Director Overview Manual***. Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Kodosky in view of ***Macromedia Director Overview Manual*** and ***Macintosh Human Interface Guidelines***.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the briefs[1] and answers[2] for the respective details thereof.

OPINION

We will not sustain the rejection of claims 10 through 19 under 35 U.S.C. § 102, nor will we sustain the rejection of claims 1 through 8 and 20 through 24 under 35 U.S.C. § 103.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. ***See In re King***, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and ***Lindemann***

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[1] Appellants filed an appeal brief on April 15, 1996. Appellants filed a reply brief on September 11, 1996. On November 26, 1996, the Examiner responded with a supplemental examiner's answer thereby considering and entering the reply brief. Appellants filed a supplemental reply brief on January 30, 1997. On April 14, 1997, the Examiner mailed a communication stating that the supplemental reply brief filed January 30, 1997 has been entered and considered but no further response by the Examiner is deemed necessary.

[2] The Examiner filed an examiner's answer on July 9, 1996. The Examiner filed a supplemental examiner's answer on November 26, 1996.

Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

On page 13 of the Examiner's answer, the Examiner states that although Appellants argue that Kodosky is different from the claimed invention because Kodosky requires the user to connect block diagrams, claim 10 does not contain any limitations directed to connecting block diagrams. On page 14 of the Examiner's answer, the Examiner argues that claim 10 broadly claims a means to automatically generate graphical representation of any computer operation in response to a pull-down menu selection. The Examiner further argues that Kodosky teaches this limitation.

Appellants argue that the Examiner's interpretation is simply inconsistent with the actual claim language recited in claim 10. The Examiner quotes the relevant portion of claim 10 as follows:

> [A] display module for automatically generating a graphical representation of the record generated by the graphical data flow diagram module, the automatically generated graphical representation including graphical representations of the operations performed in response to the selection of commands from the pull-down command menus and functional relationships between the graphically represented operations.

On page 3 of the supplemental reply brief, Appellants argue that the invention as claimed includes the element of "automatically generated graphical representation including graphical representations of the operations performed . . . **and functional relationships between the graphically represented operations."** Appellants argue that Kodosky does not teach the automatic generation of "graphical representation including graphical representations of the operations performed . . . **and functional relationships between the graphically represented operations."** Appellants argue that Kodosky teaches that the connections between blocks in the block diagram must be entered by the user as opposed to being generated automatically as in the claimed invention. We agree.

We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a ***prima facie*** case. ***In re Piasecki,*** 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed.

Cir. 1984); ***In re Knapp-Monarch Co.***, 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); ***In re Cofer***, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966). Furthermore, our reviewing court states in ***In re Piasecki,*** 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) the following:

> The Supreme Court in ***Graham v. John Deere Co.,*** 383 U.S. 1 . . . (1966), focused on the procedural and evidentiary processes in reaching a conclusion under Section 103. As adapted to *ex parte* procedure, *Graham* is interpreted as continuing to place the "burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103." ***Citing In re Warner,*** 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967) [citations omitted].

Claims 1 through 8 and 22 through 24 stand rejected under 35 U.S.C. § 103. The Examiner has failed to set forth a ***prima facie*** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally

recognizable 'heart' of the invention." ***Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.***, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), ***cert. denied***, 519 U.S. 822 (1996) ***citing W. L. Gore & Assoc., Inc. v. Garlock, Inc.***, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), ***cert. denied,*** 469 U.S. 851 (1984).

Appellants argue on page 13 of the brief that claims 1 through 8 and 22 through 24 should be reversed because the combination of Kodosky and ***Macromedia Director Overview Manual*** would not result in the claimed invention even if the combination could be made. On pages 13 and 14, Appellants quote the pertinent parts of claim 1 and the other independent claim 23. Appellants argue that the Examiner ignores that the claim requires that an operation corresponding to the command be performed upon detection of a selection of a command. Appellants respectfully submit that "Kodosky does not suggest performing an operation corresponding to the command upon detection of the selection of the command but rather at some later time" (page 14 of brief). Appellants further argue that it is clear from the review of ***Macromedia Director Overview Manual*** that the presentation elements are not displayed or

performed until a play command is selected. Appellants further emphasize this point on page 4 of the reply brief stating that the references do not teach automatically generating a graphical representation of a functional relationship between the second operation represented by the second graphical object and the first operation represented by the first graphical object.

On page 20 of the Examiner's answer, the Examiner responds to this argument stating that the operation could be the displaying operation itself. Appellants respond on page 4 of the reply brief that the Examiner's interpretation is misplaced because the preamble of claim 1 refers to graphical representation operations performed in a computer and the body includes graphical representations of the first operation and graphical representations of the second operation.

Upon our review of Kodosky, ***Macromedia Director Overview Manual*** and ***Macintosh Human Interface Guidelines***, we fail to find that these references teach these claimed limitations. Appellants' claim 1 clearly requires automatically generating a graphical representation of a functional relationship between

the second operation represented by the graphical object and the first operation represented by the graphical object. Furthermore, this is generated after the step of performing a second operation corresponding to the second command. Similarly, we find that the other independent claim 23 recites similar language. We find that the Examiner has not made a ***prima facie*** case showing that these references teach these limitations.

In view of the foregoing, we have not sustained the rejection of claims 10 through 19 under 35 U.S.C. § 103, nor have we sustained the rejection of claims 1 through 8 and 22 through 24 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

REVERSED

ERROL A. KRASS Administrative Patent Judge	)	
MICHAEL R. FLEMING Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES

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