

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JEFF D. WASHINGTON and PAUL F. AUSTIN

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Appeal No. 1999-2641  
Application No. 08/644,119

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ON BRIEF

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Before THOMAS, KRASS, and LALL, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 18-61, all of the pending claims.

The invention pertains to the editing of a control in a computer system. In particular, the instant invention permits a user to see changes applied to a control by selecting the control for an editing transaction and displaying a preview window automatically in response to the user selecting the control for the editing transaction.

Moreover, a copy of the control is displayed in the preview window automatically in response to the user selecting the control for the editing transaction. When the user indicates a change to the control, a copy of the control with the change is displayed in the preview window. Then, the user indicates whether this change is to be applied to the control. If so desired, the change is applied to the control in the main window.

Representative independent claim 18 is reproduced as follows:

18. A computer-implemented method for editing a control in a computer system, wherein the computer system includes a display screen, the method comprising:

displaying said control in a main window on the display screen;

selecting said control for an editing transaction in response to user input;

displaying a preview window on the display screen, wherein said preview window is automatically displayed in response to said user input selecting said control for said editing transaction;

displaying a copy of said control in said preview window, wherein said copy of said control is automatically displayed in said preview window in response to said user input selecting said control for said editing transaction;

receiving first user input indicating a desired change to said control, wherein said first user input indicating a desired change to said control is received after said displaying said copy of said control in said preview window;

displaying said copy of said control with said change in said preview window in response to said receiving said first user input indicating said desired change to said control;

Appeal No. 1999-2641  
Application No. 08/644,119

determining if said change is desired to be applied to said control in response to second user input;

applying said change to said control in said main window if said change is desired to be applied to said control.

The examiner relies on the following references:

Li et al. (Li)	5,555,370	Sep. 10, 1996 (filed Dec. 28, 1993)
Cain et al. (Cain)	5,651,108	Jul. 22, 1997 (filed Jan. 11, 1996)

Claims 18-61 stand rejected under 35 U.S.C. § 103 as unpatentable over Cain in view of Li.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

#### OPINION

Similarly to Appeal No. 99-2615, the examiner here takes the position that Cain discloses the instant claimed subject matter but for displaying a copy of the control in the preview window in response to selecting that control for an editing transaction. The examiner turns to Li for such a teaching, identifying column 4, lines 3-29, and Figures 9 and 11 of Li. Finally, the examiner concludes that it would have been obvious

to provide displaying a copy of control in preview window in response to selecting control for editing transaction as taught by Li to the development system for visual inheritance and improved object reusability of Cain; in order permitting a user to efficiently create an application utilizing a plurality of objects in a graphic user interface graphically presents objects to the user

Appeal No. 1999-2641  
Application No. 08/644,119

in the GUI and providing facility for cutting and pasting object while preserving any attach properties and methods [sic] [answer-page 4].

This is exactly the reasoning employed by the examiner in related Appeal No. 99-2615 and here, as there, we find that the examiner has failed to establish a prima facie case of obviousness with regard to the instant claimed subject matter.

Independent claims 18, 36, 43, and 44 contain many elements, yet the examiner merely alleges that these elements are present in Cain without specifically pointing out where such elements are found. For example, with regard to claim 18, the examiner alleges that all of the elements are in Cain except for the step of displaying a copy of the control in the preview window in response to selecting that control for an editing transaction. However, the only specific reference to Cain is to column 9, lines 5-67, and to Figures 4A-4F. The examiner does not specifically correlate the claimed elements to particular portions of column 9 of Cain.

We have reviewed the portion of Cain cited by the examiner and we find nothing therein about “displaying a preview window on the display screen, wherein said preview window is automatically displayed in response to said user input selecting said control

for said editing transaction.” We recognize that the examiner relies on Li for the display of a copy of a control in a preview window in response to selecting the control for an editing transaction. However, the examiner’s rationale appears to rely on Cain at least

teaching a “preview window” and we find no such teaching therein. If there is no display of a preview window in Cain, then there can be no suggestion of “displaying of a preview window . . . automatically displayed in response to said user input selecting said control for said editing transaction,” as claimed.

Moreover, even assuming, arguendo, that all of the claimed elements but for the displaying a copy of the control in a preview window in response to selecting the control for an editing transaction are shown in Cain, the examiner has provided no convincing rationale establishing a motivation for making the proposed combination wherein anything taught by Li would have led the artisan to provide that teaching to the Cain system. The examiner’s reasoning that the combination would have been made “in order permitting a user to efficiently create an application utilizing a plurality of objects in a graphic user interface graphically presents objects to the user in the GUI and providing facility for cutting and pasting object while preserving any attach properties and methods” [sic] [answer-page 4] is not only so grammatically poor as to defy an accurate understanding of the examiner’s position, but, to the extent that the

examiner is implying that a “cut and paste” operation applied to the Cain system would improve or provide for anything, it is still unclear as to why any “cut and paste” property of Li, applied to Cain, would have resulted in the instant claimed subject matter.

Appellants argue [page 8-principal brief] that Cain

does not even begin to suggest a preview window, much less a preview window in which a copy of the control is displayed in response to an editing transaction for the control. Although Cain in claim 1 does refer to the copying of an object into system memory (the object therefore being undisplayed), the copying takes place in response to user input requesting copying, not user input requesting an editing transaction. See Cain column 20, lines 60-65. In Cain, selecting an object for an editing transaction allows the user only to directly edit the selected object. The selection of an object for an editing transaction in Cain does not cause automatic display of a preview window or automatic display of a copy of the object.

We agree.

In fact, referring to the portion of Cain cited by the examiner, appellants contend that Cain teaches nothing more than the prior art over which the instant claimed subject matter is an improvement and that the cited portion discloses only that objects are placed in forms and the object's properties are then edited through a pop-up menu and a property window. Again, we agree. There is nothing in the cited portion of Cain, or any other portion of Cain, as far as we can tell, that suggests the claimed "preview window in which is displayed the copy of the control in the preview window."

The examiner's response is that the instant claims are broad in nature and that the claim requirement of displaying a copy of the control in a preview window wherein the copy is automatically displayed in the preview window in response to a user input selecting a control for an editing transaction "can be interpreted as simply in the computer-implemented method for editing a control in a computer system in which the

Appeal No. 1999-2641  
Application No. 08/644,119

other property menu items in call up submenus when selected from which various properties, such as type and style, can be customized” [sic] [answer-page 6].

The examiner also appears to take the position that the claimed “applying said change to said control in said main window if said change is desired to be applied to said control” may be met by Cain’s disclosure of an object inheriting “a particular behavior as a result of its containership location” [answer-page 7].

We have carefully reviewed the examiner’s rationale for the rejection and the examiner’s responses to appellants’ arguments but we are unconvinced by any of the arguments or the rationale that either of the applied references suggests, inter alia, the claimed “displaying a preview window on the display screen, wherein said preview window is automatically displayed in response to said user input selecting said control for said editing transaction,” as set forth, in one form or another, in each of the independent claims.

Since each of the independent claims requires this limitation, we will not sustain the rejection of claims 18-61 under 35 U.S.C. § 103.

The examiner’s decision is reversed.

REVERSED

Appeal No. 1999-2641  
Application No. 08/644,119

JAMES D. THOMAS  
Administrative Patent Judge

ERROL A. KRASS  
Administrative Patent Judge

PARSHOTAM S. LALL  
Administrative Patent Judge

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Appeal No. 1999-2641  
Application No. 08/644,119

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