

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 49

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID T. BERQUIST, PETER M. EISENBERG,
MITCHELL B. GRUNES, MARTIN A. KENNER,
JOHN M. KRUSE, TIMOTHY A. MERTENS and
CINDY L. MUNSON

Appeal No. 1999-2723
Application 08/674,082

HEARD: January 9, 2002

Before JERRY SMITH, BARRETT and FLEMING, 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 1-50, 101, 107-123, 140 and 145-215. Pending claims 51-76, 98-100 and 102-106 stand withdrawn from consideration as being directed to a non-elected invention. Claim 130 has been indicated to contain

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Darnell et al. (Darnell)	5,596,700	Jan. 21, 1997 (filed Feb. 17,
1993)		
Johnston, Jr. et al.	5,598,524	Jan. 28, 1997
(Johnston)		(filed Mar. 03,
1993)		

Claims 1-50, 107-123 and 151-176 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Darnell in view of Johnston. Claims 101, 140-143, 177-179, 187-192, 200-204 and 212-216 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Darnell in view of Gough. Claims 145-150, 180-186, 193-199 and 205-211 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Darnell in view of Gough and Johnston.

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

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants'

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arguments set forth in the briefs along with the examiner's rationale in support of the rejections 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 set forth in the claims on appeal. 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 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

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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). If that burden is met, the burden then shifts to the
applicant to overcome the prima facie case with argument
and/or evidence. Obviousness is then determined on the basis
of the evidence as a whole and the relative persuasiveness of
the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039,
228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d
1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re
Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).
Only those arguments actually made by appellants have been
considered in this decision. Arguments which appellants could
have made but chose not to make in the brief have not been
considered [see 37 CFR

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§ 1.192(a)].

We consider first the rejection of claims 1-50, 107-123 and 151-176 based on the teachings of Darnell and Johnston. This rejection is explained on pages 3-12 of the final rejection mailed on September 29, 1998 and incorporated into the examiner's answer [page 4]. With respect to independent claim 1, appellants argue that in Darnell, the notes are not attached to the contents in a client area of the window or desktop. Appellants also argue that the notes are not moved across boundaries of a window in Darnell. Appellants argue that although contents in Johnston can be dragged across boundaries, the contents in Johnston are assimilated with the contents into which they are dropped and do not remain separate from the contents as claimed. Appellants also argue that it would not have been obvious to combine the teachings of Darnell and Johnston [brief, pages 7-13].

The examiner responds that notes in Darnell are attached at a specific location in the client area of the document. The examiner notes that Johnston teaches the movement of contents across boundaries, and the examiner

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observes that Johnston teaches that users should be able to drag any content from any window to any other window that accepts the content's type. Thus, the examiner finds that it would have been obvious to the artisan to move notes (contents) as taught by Darnell across boundaries as taught by Johnston [answer, pages 4-5]. Appellants respond that Darnell does not teach attaching a note to the content of a client area of a window initially or after releasing the note nor moving the note across boundaries of a window. Appellants also respond that a note is not content and that Johnston does not teach that the content is attached when it is dropped [reply brief, pages 2-3].

We agree with appellants that claim 1 is patentable over the teachings of Darnell and Johnston. First, although the note record in Darnell includes the note position relative to the associated window [column 6, line 35], there is no indication that this position establishes attachment to content within the client area of the window. Thus, the exact position at which the note was attached to the content in Darnell is not clearly taught in Darnell. Notes in Darnell are associated with the title of the window and are opened and

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closed as a function of the associated window being opened or closed. Darnell does not describe in any manner the movement of notes between documents.

The examiner cites Johnston as teaching the desirability of transferring any contents within one document to another document regardless of window boundaries. Appellants' argument that a note is not content is well taken. Content as described by Johnston and notes as described by Darnell and appellants' specification are completely different. A note is a message which is separate from the content of another document, but is attached to the other document at a specific location. Content, as described by Johnston, refers to information in a document which has been assimilated into the document. The concept of moving content from one document in Johnston to another document and assimilating that content into the second document would not have suggested to the artisan that notes as taught by Darnell should be movable across boundaries like other movable content because of the inherent differences between notes and content.

We are also persuaded by appellants' argument that

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even if the artisan sought to move notes across boundaries as suggested by Johnston, the artisan would not apply that teaching to notes as taught by Darnell. Since the notes in Darnell are associated with the title of the window to which they are attached, the notes could not possibly be moved like a paper note because they are available (opened) only as a function of the associated window being opened. Thus, notes moved to a new document would not be visible when the new document in Darnell was opened. As noted above, Darnell contemplates no movement whatsoever of the notes created therein.

Since appellants' arguments have persuaded us that the rejection of claim 1 is in error, we do not sustain the rejection of claim 1 or of any claims which depend from claim 1 and are subject to this same rejection. Since the remaining independent claims 25, 107 and 151 contain limitations similar to those discussed above with respect to claim 1, and since the same arguments are presented with respect to these claims, we do not sustain the rejection of claims 25, 107 and 151 or of any claims which depend from these claims and are subject to this same rejection.

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We now consider the rejection of claims 101, 140-143, 177-179, 187-192, 200-204 and 212-216 based on the teachings of Darnell and Gough. This rejection is explained on pages 12-20 of the final rejection mailed on September 29, 1998 and incorporated into the examiner's answer [page 4]. With respect to independent claims 101, 107, 140, 177, 189, 202 and 214, appellants argue that neither Darnell nor Gough teaches moving a note across a boundary of a window. Appellants argue that push pin mouse cursor 605 of Darnell is not an annotatable note but only an icon so that no note is moved across boundaries in Darnell [brief, pages 20-21]. The examiner responds that Darnell teaches note movement across a window boundary during note creation and attachment while Gough teaches linking a note to an anchor object in the client area of a window [answer, pages 7-8].

In our view, the key question is whether Darnell teaches or suggests moving a note across the boundary of a window. Appellants are correct that the note itself in Darnell is not created until the push pin is moved across the window boundary and attached to the window. Thus, we agree with appellants that push pin mouse cursor 605 of Darnell is

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not a note at the time that it is moved across the boundary of window 602. Therefore, the examiner's finding that Darnell teaches the movement of a note across boundaries is in error. As noted above, Darnell does not teach any movement of the notes created therein. Since the examiner's finding is erroneous and since the examiner has presented no arguments with respect to the obviousness of the actual differences between the teachings of Darnell and the claimed invention, we do not sustain the examiner's rejection of any of these independent claims or of the claims which depend therefrom and are rejected on the same basis.

We now consider the rejection of claims 145-150, 180-186, 193-199 and 205-211 based on the teachings of Darnell, Gough and Johnston. This rejection is explained on pages 20-23 of the final rejection mailed on September 29, 1998 and incorporated into the examiner's answer [page 4]. Since this rejection relies on the examiner's erroneous findings with respect to Darnell, and since Johnston does not overcome the factual deficiencies of this record, we do not sustain the examiner's rejection of claims 145-150, 180-186, 193-199 and 205-211.

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In summary, we have not sustained any of the rejections made by the examiner. Therefore, the decision of the examiner rejecting claims 1-50, 101, 107-123, 140 and 145-215 is reversed. REVERSED

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JERRY SMITH)	
Administrative Patent Judge)	
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LEE E. BARRETT))
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