

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DIDIER DANIEL CLAUDE BARDON, RICHARD EDMOND BERRY,  
SCOTT HARLAN ISENSEE, SHIRLEY LYNN MARTIN,  
and JOHN MARTIN MULLALY

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Appeal No. 2001-0522  
Application No. 08/887,830

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ON BRIEF

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Before DIXON, GROSS, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-3, 5-9, 11-15, and 17-21, which are all the claims remaining in the application.

We reverse.

BACKGROUND

The invention is directed to an interactive data processor controlled display interface wherein the user may select a plurality of objects (tools) and combine the tools into a combination tool which simultaneously performs the combined interactive functions of the individual tools. Claim 1 is reproduced below.

1. A user interactive data processor controlled display system comprising:

means for displaying a plurality of selectable user interactive objects for respectively performing interactive graphical functions, the results of said functions being displayed,

means for designating a set of said objects for combination into a single object,

means for combining the designated objects into a single combination object having an image representative of the combined graphical functions, and

user interactive means for activating said combination object to perform said combined graphical functions.

The examiner relies on the following reference:

Kojima et al. (Kojima)	5,566,295	Oct. 15, 1996 (filed Sep. 28, 1990)
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Claims 1-3, 5-9, 11-15, and 17-21 stand rejected under 35 U.S.C. § 102 as being anticipated by Kojima.

We refer to the Final Rejection (Paper No. 7) and the Examiner's Answer (Paper No. 11) for a statement of the examiner's position and to the Brief (Paper No. 10) and the Reply Brief (Paper No. 12) for appellants' position with respect to the claims which stand rejected.

OPINION

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

The statement of rejection of claim 1 (Answer at 3) refers to various portions of Kojima deemed to disclose structures corresponding to the instant claimed elements. However, we observe that the rejection points to separate embodiments disclosed by Kojima. For example, column 8, lines 1 through 28 refers to the “Hanoi towers” embodiment; column 17, lines 15 through 47 refers to a second embodiment in which the program personifies a human secretary. Ordinarily, reading a claim on separate embodiments described in a reference would not support a finding of anticipation, but might be subject to an inquiry under obviousness. Whether there is suggestion to combine elements or steps of different embodiments is an inquiry under obviousness, rather than anticipation. “Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.” In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

In any event, appellants submit that neither the “Hanoi towers” embodiment nor the “human secretary” embodiment meets the terms of the instant claims. In particular,

Appeal No. 2001-0522  
Application No. 08/887,830

appellants argue there is no disclosure in Kojima of a combination object which may be user activated to perform combined graphical functions. (Reply Brief at 2.)

We note that both the statement of the rejection and the response to arguments in the Answer (e.g., bottom of page 4) appears to discount or disregard language that has been added to the claims during prosecution pertaining to “interactive graphical functions” and “graphical functions.” However, we consider the relevant recitations to limit the scope of the subject matter and thus be actual limitations. The terms used in the claims bear a “heavy presumption” that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art. Texas Digital Sys., Inc. v. Telegenix, Inc., 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. Oct. 16, 2002). The principal definition of “graphical” is “formed by writing, drawing, or engraving.” Webster’s Ninth New Collegiate Dictionary at 533 (1990 ed.).

The rejection does not attempt to “explain away” the limitations with respect to the graphical functions. We are unsure, as are appellants, how the reference may be deemed to disclose performance of interactive graphical functions and combining of the graphical functions, as required to some extent (i.e., in different scope) by each independent claim on appeal.

The Answer (at 5) asserts that the limitations with respect to performance and combination of graphical functions are clearly anticipated by Kojima, and quotes from (but does not cite) material at column 43 of the reference.

Appeal No. 2001-0522  
Application No. 08/887,830

[I]n the case where an icon corresponding to a program is of a human shape, it is possible to instruct the execution of the program with a feeling that a secretary exists in a computer when see [sic; seen] from a user and a work for the program is requested upon the secretary.

Kojima at col. 43, ll. 32-36.

To the extent that the rejection may be based on the view that Kojima discloses a graphical user interface and that the secretary (e.g., Fig. 47A) may be considered a graphical object, we agree with the assessment. The secretary object may be directed, as shown in Fig. 47A, to pick up a telephone receiver for placing a telephone call. Col. 22, ll. 12-30; col. 29, ll. 42-52. However, we do not find in this disclosure of Kojima's "second embodiment," nor anywhere else in the reference, description of the graphical functions required by the instant claims.

The allocation of burdens requires that the USPTO produce the factual basis for its rejection of an application under 35 U.S.C. § § 102 and 103. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (citing In re Warner, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967)). It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis. Warner, 379 F.2d at 1017, 154 USPQ at 178.

We do not sustain the rejection of claims 1-3, 5-9, 11-15, and 17-21 under 35 U.S.C. § 102 as being anticipated by Kojima.

Appeal No. 2001-0522  
Application No. 08/887,830

CONCLUSION

The rejection of claims 1-3, 5-9, 11-15, and 17-21 under 35 U.S.C. § 102 is reversed.

REVERSED

JOSEPH L. DIXON	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
ANITA PELLMAN GROSS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
HOWARD B. BLANKENSHIP	)	
Administrative Patent Judge	)	

Appeal No. 2001-0522  
Application No. 08/887,830

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