

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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PERI HARTMAN and JOHN GEHLEN

Appeal No. 2001-2241
Application No. 08/928,555

HEARD: December 10, 2002

Before FLEMING, DIXON, and BLANKENSHIP, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-38, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

Appellants' invention relates to a method and system for displaying and editing of information. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method for displaying a form at a client system, the method comprising:

providing a document describing the form, the form having a plurality of sections, each section having descriptive information and a plurality of data entry fields;

displaying the descriptive information for each section;

in response to a user selecting descriptive information of a section, expanding that section by displaying the data entry fields associated with that section; and

when the user indicates to collapse the expanded section, collapsing that section by removing the displayed data entry field and redisplaying the descriptive information for that section.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Wright, Jr. (Wright)	5,704,029	Dec. 30, 1997 (Filed May 23, 1994)
Bertram et al. (Bertram)	5,805,159	Sep. 8, 1998 (Filed Aug. 22, 1996)

Microsoft Project for Windows Feature Guide Business Project Planning System, Version 1, Windows Series, Microsoft Corporation, Chapter 2; Managing a Project, pages 54 and 55 (Copyright 1990) (Microsoft).

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Claims 1-5 and 10-14 stand rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Microsoft.

Claims 1-5 and 10-14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Wright¹. We note that Wright does not qualify as prior art under 35 U.S.C. § 102(b) as indicated by the examiner, but does qualify under 35 U.S.C. § 102(a) and (e) as indicated in paper number 8.

Claims 6-9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Microsoft in view of Bertram.

Claims 6-9 and 15-38 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wright in view of Bertram.²

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 18, mailed Jan. 5, 2001) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 17, filed Nov. 8, 2000) and reply brief (Paper No. 19, filed Mar. 2, 2001) for the appellants' arguments thereagainst.

¹ We note that appellants refer to Wright throughout the brief, but list the wrong patent number throughout the brief. Appellants clarified that Wright '029 was the correct patent number. (See supplemental brief filed Dec. 9, 2002.)

² We note that claims 15-38 were not filed at the time of the statement of the rejection in paper number 8 and no statement of the rejection is present therein, but since appellants have not disputed the formal statement of the text of the rejection, we will consider the statement of the rejection as addressing all the claims 15-38.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

As pointed out by the Federal Circuit, we must first establish the scope of the claim. "[T]he name of the game is the claim" **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Moreover, when interpreting a claim, words of the claim are generally given their ordinary and accustomed meaning unless it appears from the specification or the file history that they were used differently by the inventor. **Carroll Touch, Inc. v. Electro Mechanical Sys., Inc.**, 15 F.3d 1573, 1577, 27 USPQ2d 1836, 1840 (Fed. Cir. 1993). Although an inventor is indeed free to define the specific terms used to describe his or her invention, this must be done with reasonable clarity, deliberateness, and precision. **In re Paulsen**, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

At the outset, we note that appellants elect claims 1-5 stand or fall together as a group, claims 6-9 as a second grouping, claims 10-14 as a third grouping, claims 15-19 and 20-26 as a fourth grouping, claims 27-33 as a fifth grouping and claims 34-38 as a sixth grouping. (See brief at pages 4-5.)

35 U.S.C. § 102

Appellants argue that all of the limitations must be taught in order to satisfy the requirements of 35 U.S.C. § 102. (See brief at pages 5-7.) We agree with appellants. With respect to the teachings of Microsoft, appellants argue that there is no teaching of what steps must be carried out in order to display the diagrams. Appellants argue that Microsoft does not teach the steps the user must perform in order to change the display from the MOVE project to display the ANNOUNCE project. We agree with appellants. Appellants argue that the examiner's treatment of the claimed invention does not rise to the level of a *prima facie* case of anticipation. (See brief at page 7.) We agree with appellants. Appellants argue that the language of claim 1 recites "in response to a user selecting descriptive information of a section, expanding that section by displaying the data entry fields associated with that section." Similarly appellants argue that the examiner has not shown how Microsoft teaches "when the user indicates to collapse the expanded section, collapsing that section by removing the displayed data entry field and redisplaying the descriptive information for that section." (See brief at page 7.) We agree with appellants that the brief teachings of Microsoft do not adequately detail the operation to transition from one display to the other display. Specifically, while Microsoft arguably teaches opening and closing a new window, it teaches neither that the descriptive material is selected nor that the display is expanded while keeping the other descriptive material in context on the same display within the fields or sections. The examiner maintains that Microsoft teaches clicking on any button to expand the

window and the resulting button collapses it. (See answer at page 4.) While we agree with the examiner concerning Windows applications generally, the features are not specifically evidenced at page 54 and 55 of Microsoft. It is unclear from the limited teaching whether there are any buttons to expand to a window. Clearly, there is the reduction in size, but we find no evidence of the expanding function as recited in the language of independent claim 1. The examiner maintains that Microsoft is directed to the user and not the professional programmer so that the omission is proof that even the casual user does not require such detail to know that these functions are there. We disagree with the examiner's lack of concern for the requirement of evidence to support the findings in a rejection. The examiner's position that the heavy outline on page 54 is a selection of a subproject is a reasonable interpretation, but it could also be the mere selection of the input cell and perform no expansion thereof. Since it does not inherently follow that there is a selection and expansion, we find that the examiner has not established a *prima facie* case of anticipation, and we cannot sustain the rejection of independent claim 1 and dependent claims 2-5 under 35 U.S.C. § 102 over Microsoft.

With respect to independent claim 10, appellants similarly argue that Microsoft does not teach "receiving a selection of a field" and "displaying an editing window in which the content of the selected field is edited." (See brief at pages 7-8.) Appellants argue that the examiner has not provided any indication in Microsoft of a selection and

an editing window. (See brief at pages 7-8.) We agree with appellants, while Microsoft generally teaches that edited data is updated throughout the subprojects, we do not find it inherent that the editing window is removed and the edited information displayed in the selected field. We find that the examiner has not established a *prima facie* case of anticipation, and we cannot sustain the rejection of independent claim 10 and dependent claims 11-14 under 35 U.S.C. § 102 over Microsoft.

With respect to Wright, Jr. '029, the examiner maintains that when a field is selected, a script associated with the field is invoked to do whatever the script can do. While this may be true for the entry of data into the form, it does not address the express language of independent claims 1 and 10. Appellants argue that Wright does not teach that a displayed section is expanded when its description is selected and Wright does not teach an editing window for editing the contents of a field when the field is selected. (See brief at page 9.) We agree with appellants. The examiner maintains that going from one display in the form to another display necessarily collapses and expands another. (See answer at page 5.) While this may be true of the functioning of windows, it does not address the limitation of the instant claim language. The examiner realizes that the input sequence of Wright is not a series of windows, but maintains that the distinction is trivial. (See answer at page 5.) Since the examiner admits that Wright does not teach a window as required by the language of claim 10,

the examiner has not established a *prima facie* case of anticipation, and we cannot sustain the rejection of independent claim 10 and dependent claims 11-14 under 35 U.S.C. § 102 over Wright. With respect to independent claim 1 the examiner has not addressed the selection of descriptive material and expanding the selected section in context with the other sections. The examiner maintains that the sections of Wright are displayed one at a time. (See answer at page 5.) Therefore, it is unclear how Wright teaches display of a plurality of sections on a form as recited in the language of claim 1. We find that the examiner has not established a *prima facie* case of anticipation, and we cannot sustain the rejection of independent claim 1 and dependent claims 2-5 under 35 U.S.C. § 102 over Wright.

35 U.S.C. § 103

With respect to independent claims 6, 15, 20, 27, 33, and 34,³ the examiner maintains that in light of the great breadth of the claims and the examiner's finding of anticipation of claims 1-5 and 10-15, the use of HTML would have been obvious since it was a convenient and efficient programming technique. (See answer at page 5.) We agree with the examiner that the mere addition of HTML to the above methods is not a great addition technically, but the examiner has not shown how the individual teachings of Microsoft and Wright in combination with Bertram remedy the noted deficiencies in

³ We note that only independent claim 6 recited the use of HTML and the other claims are variations on the basic claims 1 and 10 which the examiner rejected under 35 U.S.C. § 102. Additionally dependent claims 13, 25, 26, 32, and 37 contains limitations to HTML or mark up languages. Therefore, we are not clear as to the use of Bertram for the other claims.

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the individual teachings. The examiner maintains that claims 15-38 introduce no limitations of significance in light of the discussion. (See answer at page 5.) We assume that this is why the examiner has never addressed these claims. We find that the examiner has not established a *prima facie* case of obviousness, and we cannot sustain the rejection of independent claims 6, 15, 20, 27, 33, and 34 and dependent claims under 35 U.S.C. § 103 over Microsoft or Wright in view of Bertram.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-5 and 10-14 under 35 U.S.C. § 102 over Microsoft and Wright is reversed, the decision of the examiner to reject claims 6-9 under 35 U.S.C. § 103 over Microsoft in view of Bertram is reversed,

and the decision of the examiner to reject claims 6-9 and 15-38 under 35 U.S.C. § 103 over Wright in view of Bertram is reversed.

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AFFIRM-IN-PART

MICHAEL R. FLEMING
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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