

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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NANNETTE E. SAVAGE and RAY MALONE

Appeal No. 1999-0013
Application No. 08/649,972

ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-10, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a digital data retrieving, organizing and display system. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A digital data retrieving, organizing and displaying system for retrieving information from a number of disparate sources relating to development of a complex system including firmware, hardware and software and organizing and displaying on cards the information as selected by an operator, the digital data retrieving, organizing and displaying system comprising:

data map display means for facilitating the display of a data map defining types of available information relating to the development of the complex system, the data map including at least one external card link;

a plurality of card display means each for facilitating the display of a card having a selected type of information relating to the development of the complex system; and

control means responsive to the operator input indicia for controlling the data map display means and the card display means to enable the display of a card having a selected type of information as selected by the operator.

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

Jones et al. (Jones)	4,663,704	May 5, 1987
Lubkin et al. (Lubkin)	5,339,435	Aug. 16, 1994

Admitted Prior Art (APA) - page 6 of the specification concerning conventional use of "HyperCard".

Appeal No. 1999-0013
Application No. 08/649,972

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jones in view of APA and Lubkin.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 11, mailed Mar. 30, 1998) for the examiner's reasoning in support of the rejection, and to appellants' brief (Paper No. 10, filed Mar. 5, 1998) for appellants' arguments thereagainst.

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.

Appellants generally argue that the combination of the three teachings does not teach or suggest the retrieval of information related to the development of a complex system including firmware, hardware and software. (See brief at page 4.) We agree with appellants.

From our review of the teachings of Jones, Jones is concerned with industrial process control and further teaches the use of an engineer's console which can be used to develop

a required control program, monitor or control the industrial process. (See Jones at col. 14.) We view the engineer's console as the closest teaching within Jones to the disclosed and claimed invention. With this said, we disagree with the examiner's picking and choosing of random teachings within Jones to arguably meet the various limitations recited in claim 1. (See answer at pages 4-5.) Jones does teach the use of hardware cards for use in processing (see Jones at col. 15), but does not teach the use of a data map display or card display means as recited in the language of claim 1. Nor do we find that Jones teaches at least one external card link as the examiner maintains at page 4 of the answer. The examiner maintains that the use of redundant (hardware) cards somehow teaches the use of a software link. We disagree with the examiner. Further, the examiner maintains that the teaching of a graphics display controller providing a sync signal teaches the plurality of card display means. (See answer at page 4.) We disagree with the examiner. While we agree with the examiner that since HyperCard technology was known, it would have been obvious to a skilled artisan to implement this technology, if there were a convincing line of reasoning or motivation to do so, we find that the examiner has not provided such a convincing line of reasoning in this case.

The examiner has relied upon the teachings of Lubkin merely to teach the use of a software tool in a "complex software system." From our review of Lubkin, Lubkin teaches a software configuration management tool which enables building a software system in a

heterogeneous network. This is generally a Computer Aided Software Engineering (CASE) tool. (See Lubkin at columns 1-3.) The examiner maintains that Lubkin teaches at col. 12, line 60, maintaining a list of information available within the system (see answer at page 6), but we do not see the examiner's point here with respect to the claimed invention.

We agree with the examiner that all aspects of software, hardware, and firmware would have been required to be involved in the successful design of an operational computer system since they are all required. (See answer at page 6.) Here, the examiner has not addressed the invention as recited in the language of claim 1. As pointed out by our reviewing court, we must first determine 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). We find that the examiner has not provided a teaching or convincing line of reasoning why one skilled in the art would have desired to modify the teachings of Jones, APA and Lubkin to achieve a system for retrieving, organizing and displaying data in a complex system.

Since we find that the teachings of neither Jones nor APA concerning HyperCard technology teaches the discrete limitations of the claimed invention, and the examiner has not relied upon the teachings of Lubkin beyond teaching a software tool in a "complex software system," we cannot sustain the rejection of claim 1, since the examiner has not

Appeal No. 1999-0013
Application No. 08/649,972

set forth a **prima facie** case of obviousness. Similarly, we cannot sustain the rejection of dependent claims 2-10.

We note that the examiner has not applied any teachings of a Microsoft Windows-based file manager which lists files and opens windows/cards according to files selected. Nor has the examiner set forth any combination of the teaching of Jones in a Windows-based or browser-based environment which arguably would teach the use of windows, cards, and links to other related information or applications. Since these are not before use, we make no finding with respect to the obviousness of the claimed invention with respect to these types of general teachings.

Appeal No. 1999-0013
Application No. 08/649,972

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Appeal No. 1999-0013
Application No. 08/649,972

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