

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 CARY L. BATES  
and  
JEFFREY M. RYAN

---

Appeal No. 1999-2217  
Application No. 08/735,776

---

ON BRIEF

---

Before HAIRSTON, LALL, and GROSS, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 4, 6 through 8, 10, 11, 13 through 17 and 19. In an Amendment After Final (paper number 10), claim 1 was amended, and claims 2 through 4, 6 through 8, 10, 11, 13 through 17 and 19 were canceled. Accordingly, claim 1 remains before us on

Appeal No. 1999-2217  
Application No. 08/735,776

appeal.

The disclosed invention relates to a method of displaying within a graphical pointer of a data processing system a graphical representation of a graphical pointing device (e.g., a mouse).

Claim 1 reads as follows:

1. A method within a data processing system of graphically indicating a valid input, wherein said data processing system includes a display device and a graphical pointing device having a plurality of user-activated buttons, said method comprising:

displaying a graphical display within said display device, said graphical display including one or more regions and a graphical pointer that has a location within said graphical display determined by said graphical pointing device;

identifying a particular region among said one or more regions; and

displaying, within said graphical pointer, a graphical representation of said graphical pointing device, said graphical representation of said graphical pointing device including a plurality of areas that each correspond to a respective one of said plurality of user-activated buttons, wherein an aspect of said plurality of areas indicates whether or not pressing two of said user-activated buttons substantially simultaneously will generate a valid input when said graphical pointer is positioned within said particular region.

The reference relied on by the examiner is:

Frid-Nielsen

5,655,093

Aug. 5,

Appeal No. 1999-2217  
Application No. 08/735,776

1997

(effective filing date of Mar. 6,

1992)

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Frid-Nielsen.

Appeal No. 1999-2217  
Application No. 08/735,776

Reference is made to the brief (paper no. 9) and the answer (paper no. 11) for the respective positions of the appellants and the examiner.

OPINION

We have carefully considered the entire record before us, and we will reverse the obviousness rejection of claim 1.

Frid-Nielsen teaches (column 8, lines 29 through 47) that an intelligent screen cursor 275 (Figure 5B) that displays a graphical representation of a mouse conveys more information than a typical graphical pointer/screen cursor 225 (Figure 5A). The examiner recognizes (answer, pages 4 and 5) that Frid-Nielsen does not teach "displaying, within said graphical pointer, a graphical representation of said graphical pointing device," but nevertheless concludes (answer, page 4) that the mouse icon disclosed by Frid-Nielsen "is equivalent to a pointer with the image of a mouse within it." Appellants argue (brief, page 4) that:

As clearly enunciated in MPEP 2144.06, "[i]n order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components are functional or mechanical equivalents." MPEP 2144.06 (citing *In re Ruff*, 256

Appeal No. 1999-2217  
Application No. 08/735,776

F.2d 590, 118 USPQ 340 (CCPA 1958)). In the absence of evidence from the prior art that the mouse icon disclosed by *Frid-Nielsen* suggests the display of a graphical representation of a graphical pointing device within a graphical pointer, Appellant believes [sic, Appellants believe] that the Examiner has failed to establish a *prima facie* case of obviousness . . . .

We agree with appellants' argument that the examiner has failed to establish via evidence that the graphical pointer disclosed by *Frid-Nielsen* is equivalent to the graphical pointer disclosed and claimed by appellants. Thus, appellants have correctly argued that the examiner has failed to establish "a *prima facie* case of obviousness."

Appeal No. 1999-2217  
Application No. 08/735,776

DECISION

The decision of the examiner rejecting claim 1 under  
35 U.S.C. § 103(a) is reversed.

REVERSED

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
PARSHOTAM S. LALL	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
	)	
	)	
	)	
ANITA PELLMAN GROSS	)	
Administrative Patent Judge	)	

KWH:hh

Appeal No. 1999-2217  
Application No. 08/735,776

ANDREW J. DILLON  
FELSMAN, BRADLEY, GUNTER & DILLON, LLP  
Suite 350, Lakewood on the Park  
7600B North Capital of Texas Highway  
Austin, TX 78731