

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TODD NIX

Appeal No. 1999-2605
Application No. 08/788,669

ON BRIEF

Before FLEMING, RUGGIERO, and BLANKENSHIP, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-11, 17, and 18, which are all of the claims pending in the present application. Claims 12-16 have been canceled.

The disclosed invention relates to a method for controlling a multi-state process in which a series of icons representing phases of a process are displayed. A main action message bar displays a title indicating an action to be performed which corresponds to the title of one of the icons. On actuation of the message bar, the indicated action is performed and the icon title corresponding to the last performed action is highlighted.

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Claim 1 is illustrative of the invention and reads as follows:

1. A method of controlling a multi-state process in a computer system comprising the steps of:

displaying a series of icons representing phases in a build process;

displaying a main action message bar indicating an action to be performed in response to activating the bar;

activating the bar to perform the action indicated; and

automatically pausing between each discrete action.

The Examiner relies on the following prior art:

Bender et al. (Bender) 5,576,946 Nov. 19, 1996

QUE Corporation (QUE), "Adding, Deleting, and Creating Icons,"
1-2-3 Release 4 for Windows Quickstart, pp. 262-63 (1994).

Claims 1-11, 17, and 18 stand finally rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner offers Bender alone with respect to claims 1-5, 7-10, 17, and 18, and adds QUE to Bender with respect to claims 6 and 11.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Brief (Paper No. 8) and Answer (Paper No. 9) for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, and the evidence of

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obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Brief along with the Examiner's rationale in support of the rejection 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 claims 1-11, 17, and 18. 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

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or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley 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).

With respect to the Examiner's obviousness rejection of independent claims 1 and 7, Appellant's arguments in response assert that the Examiner has failed to establish a prima facie case of obviousness. In particular, Appellant contends (Brief, page 4) that there is no teaching or suggestion in the process control system of Bender of the presently claimed feature of ". . . automatically pausing between each discrete action."

After careful review of the Bender reference in light of the arguments of record, we are in agreement with Appellant's position as stated in the Brief. While recognizing that Bender has no explicit disclosure of the claimed automatic pausing

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feature, the Examiner nevertheless suggests (Answer, pages 4, 7, and 8) the obviousness to the skilled artisan of modifying Bender to provide such a feature. In particular, the Examiner points to the discussion of the HOLD function (Bender, column 9, lines 9-58) which permits an operator to interrupt the controlled process to change the parameters of the system. In our view, however, while it is conceivable that a myriad of system parameter changes could be implemented by an operator during a system interruption, the only motivation to provide the specific claimed automatic pausing feature comes not from any disclosure in the Bender reference but rather from Appellant's own disclosure. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992).

Further, while the Examiner suggests (Answer, page 7) that the claimed automatic pausing feature ". . . is still an option of Bender's invention," we find no evidentiary support on the record for such a conclusion. The Examiner must not only make requisite findings, based on the evidence of record, but must also explain the reasoning by which the findings are deemed to

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support the conclusion of obviousness. See In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002). In our opinion, any suggestion to modify the disclosure of Bender to add an automatic pausing feature could only come from an improper attempt to reconstruct Appellant's invention in hindsight.

Lastly, we have reviewed the QUE reference which has been cited by the Examiner to address the "refresh bar" features of dependent claims 6 and 11. We find nothing, however, in the disclosure of the QUE publication which would overcome the innate deficiencies of Bender discussed supra.

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In conclusion, since the Examiner has not established a prima facie case of obviousness, the 35 U.S.C. § 103 rejection of independent claims 1 and 7, as well as claims 2-6, 8-11, 17, and 18 dependent thereon, is not sustained. Therefore, the decision of the Examiner rejecting claims 1-11, 17, and 18 is reversed.

REVERSED

MICHAEL R. FLEMING)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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HOWARD B. BLANKENSHIP)	
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JFR:hh

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