

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID H. OWENS,
NICK G. KLEDZIK and
ROBERT G. JOHNSTON JR.

Appeal No. 96-0542
Application 08/025,603¹

ON BRIEF

Before JERRY SMITH, LEE and TORCZON, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed March 3, 1993.

Appeal No. 96-0542
Application 08/025,603

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-11 and 13-20, which constitute all the claims remaining in the application. An amendment after final rejection was filed on August 18, 1994 and was entered by the examiner.

The disclosed invention pertains to a method and apparatus for manipulating data between application programs in a graphical user interface of a computer-controlled display system. More particularly, the invention permits data from a first window to be dragged to a second window, and information is provided which allows a process in the second window to determine if it can accept the data from the first window.

Representative claim 1 is reproduced as follows:

1. A method for manipulating data between application programs in a computer-controlled display system comprising the following steps:

- a. a user selecting a first item in a first window, said first window under control of a first process;
- b. said first process detecting said user selection;
- c. said first process generating first information regarding said first item;
- d. a second process generating second information regarding said first item;

Appeal No. 96-0542
Application 08/025,603

e. said user dragging said selected first item to a second window, said second window under control of a third process; and

f. said third process determining if said second window can accept said first item based upon said first information or the second information.

The examiner relies on the following references:

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| O'Connor et al. (O'Connor) | 4,780,883 | Oct. 25, 1988 |
| Peters et al. (Peters) | 5,157,763 | Oct. 20, 1992 |

Future Enterprises, Inc. (Future) "A Microcomputer Education Course For: QUATTRO PRO 3.0," 1991, page 16.

Claims 1-11 and 13-20 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Peters in view of Future with respect to claims 1-10 and 14-20, and adds O'Connor with respect to claims 11 and 13.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's

Appeal No. 96-0542
Application 08/025,603

arguments set forth in the briefs along with the examiner's rationale in support of the rejections 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 and 13-20. 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 or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley

Appeal No. 96-0542
Application 08/025,603

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
Hospital Systems, Inc. v. Montefiore Hospital, 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).

As indicated by the cases just cited, the examiner has
at least two responsibilities in setting forth a rejection
under 35 U.S.C. § 103. First, the examiner must identify all
the differences between the claimed invention and the
teachings of the prior art. Second, the examiner must explain
why the identified differences would have been the result of
an obvious modification of the prior art. In our view, the
examiner has not properly addressed his first responsibility
so that it is impossible that he has successfully fulfilled
his second responsibility.

Appeal No. 96-0542
Application 08/025,603

We consider first the rejection of independent claims 1 and 17 as unpatentable over the teachings of Peters in view of Future. These claims stand or fall together [brief, page 5]. Peters teaches a graphical user interface in which data items in one window can be selected and dragged to another window. The interface outlines the item as it is being dragged to visually convey to the user that such operation is occurring. Future teaches that Quattro Pro is one application program that can automatically recognize files from other applications and translate such files to Quattro Pro format. The final rejection asserts that the data translation teachings of Future when combined with Peters would have suggested the invention of claim 1.

Appellants provided a reasoned analysis as to why the collective teachings of Peters and Future would not have suggested steps (c), (d) or (f) of claim 1 [brief, pages 5-8]. The examiner rephrased the rejection by attempting to read claim 1 on Peters. The examiner proposed that the first process was Peters' marking process and the first information was the type of data. The examiner further proposed that the "word processor" of Peters' spread sheet program was the

Appeal No. 96-0542
Application 08/025,603

second process and the second information was the transfer border. Finally, the examiner observed that the third process was the determination by the second window in Peters if it could accept the first information [answer, pages 10-12]. Appellants responded to the new reading of claim 1 on Peters by pointing out what they perceived as major errors in the examiner's analysis of Peters [reply brief]. The examiner did not respond to the reply brief.

We do not sustain the examiner's rejection of independent claim 1 for the same reasons basically offered by appellants. The examiner's analysis is based on the obviousness of achieving what appellants have done rather than on the specific recitations of the claims. In other words, the examiner has really only demonstrated that performing translations of data for compatibility between different applications would have been obvious. When the specific limitations of independent claim 1 are considered, however, the examiner's analysis suffers all the deficiencies observed by appellants. We agree with appellants that even if the examiner's analysis is accepted at face value, the applied prior art does not meet the recitations of independent claim

Appeal No. 96-0542
Application 08/025,603

1. The mere desire to have compatibility between the data of different application programs is not sufficient to render obvious the specific invention recited in claim 1. Therefore, we do not sustain the rejection of claim 1 or of independent claim 17 which is grouped therewith.

Independent claims 11 and 13 stand rejected on the collective teachings of Peters, Future and O'Connor. O'Connor was cited by the examiner after he determined that additional recitations of claims 11 and 13 were equivalent to a "handshaking" operation, and O'Connor was said to teach the obviousness of such handshaking operations. Appellants argue that the "handshaking" operation has nothing to do with their claims, and the examiner has not properly addressed the specific recitations of the claims. We agree with appellants. There is no basis for combining the teachings of O'Connor with those of Peters based on calling appellants' invention something that it is not. O'Connor also would not overcome the deficiencies already noted in the rejection based on Peters and Future only. Therefore, we do not sustain the rejection of independent claims 11 and 13.

Appeal No. 96-0542
Application 08/025,603

In summary, since we have not sustained the rejection of any of the independent claims in this application, the examiner's rejection of claims 1-11 and 13-20 is reversed.

REVERSED

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| JERRY SMITH |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| JAMESON LEE |) | |
| Administrative Patent Judge |) | APPEALS AND |
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| RICHARD TORCZON |) | |
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Appeal No. 96-0542
Application 08/025,603

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