

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ABDOLREZA SALAHSHOUR and
MARVIN L. WILLIAMS

Appeal No. 1997-2110
Application No. 08/143,687

ON BRIEF

Before JERRY SMITH, BARRETT, and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 9 and 11 through 23. Claim 10 has been canceled. An amendment after final rejection was filed November 15, 1995 and was entered by the Examiner.

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The claimed invention relates to a method and system for presenting a temporal based object on a data processing system in which the manner of presentation is determined by the context through which the object is presented. More particularly, Appellants indicate at pages 2 through 4 of the specification that presentation characteristics for a particular context are determined, which characteristics include the selection of a portion of the object content to be presented. The type of presentation is included in the presentation characteristics determination and is associated with the object.

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

1. A computer implemented method of presenting a temporal based object on a data processing system, said object having a content, comprising the steps of:

a) determining a context on said data processing system for presenting said object;

b) providing presentation characteristics of said object for said context, said presentation characteristics comprising a selection of a portion of said content of said object, said portion being less than all of said content, and associating said presentation characteristics with said object;

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Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, the arguments in support of the rejections 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, Appellants' arguments set forth in the Brief 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 set forth in

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claims 1 through 9 and 11 through 23. 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 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).

With respect to independent claims 1 and 15, the Examiner
contends (Answer, page 5) that Vertelney discloses all of the
claim limitations with the exception of the determination of

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whether a user interface element has the capability of operating on the selected data. To address this deficiency, the Examiner asserts the obviousness to the skilled artisan of making such a determination and providing an error indicator if such operation could not be performed.

While Appellants have made several arguments in response, the primary thrust of the arguments centers on the alleged deficiency of Vertelney in disclosing a key feature of independent claims 1 and 15. Appellants assert at page 7 of the Brief:

Vertelney does not teach the combination of selecting a portion of the content of a temporal based object and then distributing all of the content of the object and the presentation characteristics to a context, as is provided by claims 1 and 15.

Upon careful review of the Vertelney reference in light of the arguments of record, we are in agreement with Appellants. In our view, Appellants are correct in their assertion that, while Vertelney teaches the selection of a portion of an object and associates presentation characteristics with such selected portion, the entire content of the object is not distributed as required by the claims.

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It is apparent from our reading of Vertelney that a clear teaching is provided of selecting portions of an object (e.g. text display, Fig. 6a; photo display, Fig. 6b) and distributing that selected portion to a particular context such as "mail" or "print". We can find no disclosure in Vertelney, however, of providing for the distribution of the entire content of an object to a context as required by appealed claims 1 and 15.

We note that in the "Response to Argument" portion of the Answer at pages 14 and 15, the Examiner contends that the claims do not have an explicit recitation of "selecting a portion" of the content of an object as argued by Appellants. In the Examiner's view, the claim language "... presentation characteristics comprising a selection of said content of said object..." does not require a user selection and such selection could already be in place. It is our opinion, however, that, notwithstanding the merits of the Examiner's argument, such does not address the deficiencies of Vertelney's disclosure discussed supra. In other words, regardless of whether Appellants' claims could be interpreted as not precluding a content

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portion selection already in existence, Vertelney remains deficient in disclosing the distribution of the entire content of an object, not just the selected portion, to a context.

As to the 35 U.S.C. § 103 rejection of dependent claims 4 through 7, 9, 18 through 21, and 23 based on the combination of Vertelney and Hoffert, we note that Hoffert was applied solely to meet the "data stream" manipulation limitations of the claims. Hoffert, however, does not overcome the innate deficiencies of Vertelney discussed supra and therefore, we do not sustain the obviousness rejection of dependent claims 4 through 7, 9, 18 through 21, and 23.

Turning to a consideration of the obviousness rejection of independent claim 14 based on the combination of Vertelney and Chang, we do not sustain this rejection as well. While claim 14 is directed to an embodiment in which selected portions of objects are distributed from a first data processing system to a second data processing system, the claim (similar to independent claims 1 and 15 discussed supra) requires the combination of the selection of a portion of the content of an object, the association of presentation characteristics with the object, and the distribution of the

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entire object. For the reasons discussed previously, it is our view that Vertelney is deficient in disclosing the claimed combination of features.

The Chang reference, which is directed to a multimedia conferencing system, was applied by the Examiner as part of the combination to supply a teaching of distributing messages (i.e. objects) from a first data processing system to a second data processing system. Chang, however, does not disclose the selection of a portion of object content along with the distribution of presentation characteristics and the entire object content to a context. As such, Chang does not overcome the deficiencies of Vertelney and we, therefore, do not sustain the 35 U.S.C. § 103 rejection of independent claim 14.

In conclusion, we have not sustained any of the Examiner's 35 U.S.C. § 103 rejections of the claims on appeal. Accordingly, the decision of the Examiner to reject claims 1 through 9 and 11 through 23 is reversed.

REVERSED

JERRY SMITH

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Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS
Administrative Patent Judge)	AND
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JOSEPH F. RUGGIERO)	
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APJ RUGGIERO

APJ BARRETT

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DECISION: REVERSED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s):
Prepared: February 23, 2001

Draft Final

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OB/HD GAU

PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT