

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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN WILLIAM ROTH

Appeal No. 2001-1764
Application No. 08/784,670

ON BRIEF

Before THOMAS, RUGGIERO, and BARRY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claims 1, 5, 7, 9, 10-14, 16, 17, 23, 25, 29, 31-33, 36, 39, and 43. The appellant appeals therefrom under 35 U.S.C. § 134(a). We affirm-in-part.

BACKGROUND

The appellant's invention manages menus of a graphical user interface ("GUI") for a computer. Using a GUI, a user interacts with a computer by pointing to pictorial representations of programs ("icons"), lists of items ("menus"), and to individual representations of other items such as files and commands. Menus may be "fixed content" or "variable content" (Spec. at 1.) While the items of a fixed content menu

remain the same over time; the items of a variable content menu change over time. (*Id.*)

According to the appellant, existing menu managing mechanisms arrange menu items rigidly. (*Id.* at 2.) Fixed content menus are never rearranged, no matter how often a user selects or ignores certain items. (*Id.*) Variable content menus change only in strict sequence with the order of past selections such that only recent selections appear on the menu. (*Id.*)

Accordingly, the appellant's invention provides three features for managing menus. First, "automatic ranking control" uses "heuristics" to control the order in which menu item are arranged on a given menu. (*Id.* at 4.) Heuristics describe past use, e.g., frequency of selection, recency of selection, and time-of-day of selection. (*Id.*) Second, "manual menu item control" allows a user to rank items in a given menu and to specify a time-of-day during which individual items are to appear near the top of the menu. (*Id.*) Third, "menu initialization" uses historical arrangements of menu item to initialize or reset a user's menus upon request. (*Id.* at 5.)

A further understanding of the invention can be achieved by reading the following claim:

43. A computer-implemented method for presenting a first menu comprising:

receiving a request to present said first menu; and

presenting said menu, said menu having at least some menu items arranged based on two or more heuristic factors, wherein at least one of said two or more heuristic factors is selected from the group consisting of recency of menu item selection, frequency of menu item selection, and time of day of menu item selection, and wherein said menu is selected from the group consisting of a fixed content menu, a variable content menu, and a mixed menu.

Claims 1, 5, 7, 9-14, 16-17, 23, 25, 29, 31-33, 36, 39, and 43 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,862,498 (“Reed”) in view of U.S. Patent No 5,119,475 (“Smith”).

OPINION

At the outset, we recall that claims that are not argued separately stand or fall together. *In re Kaslow*, 707 F.2d 1366, 1376, 217 USPQ 1089, 1096 (Fed. Cir. 1983) (citing *In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979)). Here, the appellant groups “claims 1, 5, 7, 9, 16, 17, 25, 29, 31-33, and 43 . . . together,” (Appeal Br. at 4); “[c]laims 10-12 and 36 . . . together,” (*id.* at 3-4); and “[c]laims 13, 14, 23, and 39 . . . together. . . .” (*Id.* at 4.) Therefore, claims 1, 5, 7, 9, 16, 17, 25, 29, and 31-33 stand or fall with representative claim 43; claims 10-12 stand or fall with representative claim 36;

and claims 13, 14, and 23 stand or fall with representative claim 39. With this representation in mind, we address the groups in the following order:

- claims 1, 5, 7, 9, 16, 17, 25, 29, 31-33, and 43
- claims 10-12 and 36
- claims 13, 14, 23, and 39.

I. Claims 1, 5, 7, 9, 16, 17, 25, 29, 31-33, and 43

Rather than reiterate the positions of the examiner or appellant *in toto*, we address the main point of contention therebetween. The examiner asserts, "Reed teaches system can be implemented [sic] either separately or together using three heuristics factors as frequency, recency, and previous fails commands (see abstract, and col.4, line 50-61), '*This frequency heuristic could also be made dependent on the time of day...*', (col.5, line 28-30)." (Final Rejection at 2.)¹ The appellant argues, "[s]imply stated, Reed does not disclose menu items *arranged based on two or more heuristic factors* within a *single* menu." (Appeal Br. at 9.)

¹We advise the examiner to copy his rejections into his examiner's answers rather than merely referring to a "rejection . . . set forth in the Final Office Action." (Examiner's Answer at 3.)

“Analysis begins with a key legal question -- *what* is the invention *claimed*?” *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, “the Board must give claims their broadest reasonable construction. . . .” *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000). “Moreover, limitations are not to be read into the claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Here, representative claim 43 specifies in pertinent part the following limitations: “presenting said menu, said menu having at least some menu items arranged based on two or more heuristic factors, wherein at least one of said two or more heuristic factors is selected from the group consisting of recency of menu item selection, frequency of menu item selection, and time of day of menu item selection. . . .” Giving the claim its broadest, reasonable construction, the limitations do not require arranging menu items based on “a recency heuristic combined with a frequency heuristic; . . . a recency heuristic combined with a time of day heuristic; or . . . a recency heuristic combined with both a frequency heuristic and a time of day heuristic,” (Appeal Br. at 10), as argued by the appellant. Instead, claim 43 merely requires arranging menu items based on at least two heuristics, one of which is frequency, recency, or time-of-day.

Having determined what subject matter is being claimed, the next inquiry is whether the subject matter is obvious. The question of obviousness is “based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently. . . .” *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ 1614, 1616 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995)). “A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.” *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, we find that Reed arranges menu items, viz., “command items most likely to be utilized by a user,” abs., ll. 2-4, based on heuristics including “frequency of command use, recency of command use,” *id.* at ll. 7-10, and “the time of day. . . .” Col. 5, l. 29. The primary reference explains that its “heuristics may be implemented either separately **or together** in the system.” Abs., ll. 10-12 (emphasis added). As one example of implementing heuristics together, Reed discloses that the “frequency heuristic could also be made dependent on the time of day [heuristic]” Col. 5, ll. 28-29. Although the appellant belittles “the Reed authors’ commentary [a]s no more

than sideline speculation," (Appeal Br. at 10), we are persuaded that disclosure teaches, or at least would have suggested, arranging menu items based on at least two heuristics, one of which is frequency, recency, or time-of-day. Therefore, we affirm the rejection of claim 43 and of claims 1, 5, 7, 9, 16, 17, 25, 29, and 31-33, which fall therewith.

II. Claims 10-12 and 36

The examiner asserts, "Reed teaches system can be implemented either separately or together using three heuristics factors as frequency, recency, and previous fails commands (see abstract, and col.4, line 50-61), '*This frequency heuristic could also be made dependent on the time of day...*', (col.5, line 28-30)." (Final Rejection at 2.) The appellant argues, "none of the elements within the Markush group have been disclosed, taught, or otherwise suggested by Reed." (Appeal Br. at 5.)

Representative claim 36 specifies in pertinent part the following limitations: "said menu having menu items arranged based on user control, wherein said user control is selected from the set consisting of automatic recency control, automatic frequency control, automatic time of day control, manual ranking control, and manual time of day control. . . ." Giving the claim its broadest, reasonable construction, the limitations merely require arranging menu items based on frequency or recency.

As mentioned regarding the first group of claims, we found that Reed arranges its menu items based on heuristics including frequency and recency. "Thus, the command items in a specific menu might be displayed, for example, . . . in order of cumulative frequency, most frequent first, for a 'Frequent' command item menu (401); or in order of recency, most recent first, for a 'Recent' . . . menu (402)." Col. 4, ll. 54-59. Therefore, we affirm the rejection of claim 36 and of claims 10-12, which fall therewith.

III. Claims 13, 14, 23, and 39

Admitting that "Reed did not explicitly teaches [sic] the profile information gathered base on a specific user type," (Final Rejection at 4), the examiner asserts, "Smith discloses in one of stream determines [sic] whether the command item matches a previous entry in a list or directory of the command items, or is new before create new entry [sic] and the command item is update [sic]. It would have been obvious to have a profile information base on specific type in order to creates [sic] an entry for stored list or table of command items and update to current for subsequent usage [sic] (col.3, line 60-7)." (*Id.* at 4.) The appellant argues, "Smith may be meaningful to the Examiner, it is not meaningful to the Appellant. . . ." (Appeal Br. at 8.)

"In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)(citing *In re Oetiker*, 977 F.2d 1443,

1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). Here, we do not understand the examiner's assertion. The passage of Smith on which the examiner relies, for example, merely describes Figures 12-14 as follows:

FIG. 12 is a graph showing the taxonomy of a sloteditorassubcommandmenu object 1200.

FIG. 13 illustrates the class object definition of a sloteditorcommandmenu object 1205.

FIG. 14 is a reproduction of a window display associated with a fastobjecteditor in which commands "pop up" in response to selection of captions such as partially obscured caption 1400 in FIG. 14.

Col. 3, l. 60 *et seq.* Absent an intelligible explanation, the examiner fails to present a *prima facie* case of obviousness. Therefore, we reverse the rejection of claims 13, 14, 23, and 39.

CONCLUSION

In summary, the rejection of claims 1, 5, 7, 9-12, 16, 17, 25, 29, 31-33, 36, and 43 is affirmed, while the rejection of claims 13, 14, 23, and 39 is reversed. Our affirmance is based only on the arguments made in the brief. Arguments not made therein are neither before us nor at issue but are considered waived. No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

JAMES D. THOMAS
Administrative Patent Judge

JOSEPH F. RUGGIERO
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)
)

PRYOR A GARNETT
IBM CORPORATION DEPT 917
3605 HIGHWAY 52 NORTH
ROCHESTER, MN 559017829