

Ex parte Barker et al.

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

MAILED

FEB 04 1997

PAT & TM OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte BARBARA A. BARKER,  
THOMAS R. EDEL and JEFFREY A. STARK

Appeal No. 95-0212  
Application 07/255,675<sup>1</sup>

ON BRIEF

Before CALVERT, THOMAS and TORCZON, Administrative Patent Judges.

TORCZON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 16 through 21 under 35 U.S.C. §§ 103<sup>2</sup> and 112 ¶ 2. Appellants

<sup>1</sup> Application for patent filed 11 October 1988. Appellants claim no priority under 35 U.S.C. §§ 119 or 120.

<sup>2</sup> After the final rejection was entered, the first paragraph of section 103 was redesignated as subsection 103(a). Pub. L. 104-41, sec. 1, 109 Stat. 351 (Nov. 1, 1995).

Appeal No. 95-0212  
Application 07/255,675

amended claim 16 to overcome the rejection under section 112 and canceled claims 17 and 18. (R20.<sup>3</sup>) The examiner entered this amendment.—(R30.) Thus, claims 16 and 19 through 21 stand rejected under section 103.

We reverse.

#### BACKGROUND

The subject matter of appellants' invention is a method for managing markers in a document defined by a data stream. Markers are managed independently of the content of the data stream. They may include text or non-text data and may be associated physically or logically with the data stream content. Each marker's structure is defined within the data stream. A mapping control determines how the marker will be positioned in the document. (R1 at 4.)

Claim 16, the sole independent claim, defines the invention as follows:

16. A method of managing marker entities within a document described by a data stream, independently of the data content of that data stream, said method comprising the steps of:

establishing an environment group;

---

<sup>3</sup> "R\_\_" indicates a numbered paper in the record.

Appeal No. 95-0212  
Application 07/255,675

specifying within said environment group a physical structure and a plurality of permitted formats for said marker entity;

independently specifying within said data stream at least one position with a presentation area of said document; and

automatically mapping said marker entity at said at least one position within said presentation area of said document utilizing said specified physical structure and a selected one of said plurality of permitted formats wherein said position of said marker entity may be modified independently of said physical structure, format and said data content of said data stream.

The examiner relied on the following reference:

George Washington University, Division of Continuing Education, Information System Specialist Program, Intermediate WordPerfect Workshop: Merging (Revised Feb. 1988) ("WordPerfect").

The WordPerfect reference teaches a set of merge codes for insertion into a document. One code ("^C") permits keyboard entries. Another code ("^D") inserts the date provided by the underlying computer system. Three codes ("^Fn", "^N", and "^P") insert data from other files. The remaining codes control operation of the merge. Merge codes are inserted directly into the document. (p. 2.)

Two additional codes in a data file, "^R" and "^E", are used to indicate the end of a field and the end of a record consisting of fields, respectively. (p. 6-8.) In the document, "Fn" codes,

Appeal No. 95-0212  
Application 07/255,675

in which the "n" is a number, indicate enumerated fields in the data file. (pp. 2 and 4.)

— A panel of this Board included the WordPerfect reference as the basis for a new ground of rejection under 35 U.S.C. § 103, pursuant to 37 CFR § 1.196(b), during a prior appeal. Ex parte Barker, Appeal No. 92-2222 at 2 and 5-6 (Bd. Pat. App. & Int. 1992).<sup>4</sup> Appellants canceled the previously appealed claims and added the present claims (R18), but the examiner has maintained the new ground of rejection.

#### DISCUSSION

We have considered, and our opinion presumes familiarity with, the record and the arguments of the examiner and appellants.

#### A. Scope of the claims

First we must construe the claims in light of the record.

Minnesota Mining and Manufacturing Co. v. Johnson & Johnson

---

<sup>4</sup> The earlier decision predates In re Donaldson Co., 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994) (in banc), and the Patent and Trademark Office's Examination Guidelines for Claims Reciting A "Means or Step Plus Function" Limitation In Accordance With 35 U.S.C. § 112, 6th Paragraph, 1182 Off. Gaz. 175 (1994) ("Guidelines").

Appeal No. 95-0212  
Application 07/255,675

Orthopaedics Inc., 976 F.2d 1559, 1565, 24 USPQ2d 1321, 1327 (Fed. Cir. 1992). All of the claims on appeal are written in step-plus-function format and thus "shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." 35 U.S.C. § 112. The specification places limits on what the broadest reasonable interpretation of the claim may be. Donaldson, 16 F.3d at 1195, 29 USPQ2d at 1850.

In this appeal, appellants have not challenged the applicability of the reference to each of the claimed steps except for the step of specifying a physical structure and a plurality of formats for the markers.<sup>5</sup> The appellants focus on this step and argue that it must be construed in light of the specification. (R24 at 4-5.) Thus, we must identify the acts in the specification corresponding to specifying structure and formats and their equivalents. Unfortunately, neither the examiner nor appellants have discussed what these equivalents might be. Alpex Computer Corp. v. Nintendo Co., - F.3d - , - ,

---

<sup>5</sup> Neither of these limitations were present in the claims during the previous appeal.

Appeal No. 95-0212  
Application 07/255,675

40 USPQ2d 1667, 1672 (Fed. Cir. 1996) (noting the importance of the prosecution history for interpreting means-plus-function claims).

According to the specification, a "define marker structure control" within the data stream specifies "the physical structure and content of the marker entity". (R1 at 4 and 8.) In the embodiments, the "define marker structure control" is the DMO control in figure 2. (R1 at 9.) "The RTD control is then utilized to specify the various formats to be utilized for imaging the content of each marker entity. As may be seen in **Figure 2**, the content of marker entity C is imaged in a different format than the content of marker entities A and B." (R1 at 9.) Alternatively, the DMO control may also format the marker entity. (R1 at 11; Fig. 5.) Appellants provide a step-by-step description of the operation of the DMO control in figure 8 and at pages 13-14.

**B. Patentability of the claims**

The examiner bears the initial burden of showing that the prior-art steps are the same as, or equivalent to, the acts described in the specification corresponding to the claimed step.

Appeal No. 95-0212  
Application 07/255,675

Guidelines at 175. We conclude that the examiner failed to carry this burden with a preponderance of evidence. The examiner argues that the broadest reasonable interpretation of the claims may not contradict the specification (R25 at 5), but section 112 ¶ 6 requires correspondence or equivalence, which is narrower than mere failure to contradict. Guidelines at 175; accord Valmont Indus. v. Reinke Mfg., 983 F.2d 1039, 1042, 25 USPQ2d 1451, 1454 (Fed. Cir. 1993) (explaining the narrowing effect of section 112 ¶ 6).

The examiner and appellants failed to identify a range of equivalents to the DMO control step during prosecution. No equivalents are readily apparent from the record. The DMO control steps disclosed in appellants' specification represent more than an insubstantial change from WordPerfect's merge codes. Guidelines at 176. Moreover, appellants' DMO control does not perform substantially the same function in substantially the same way to produce substantially the same result as WordPerfect's merge codes. Guidelines at 176. Nor is it clear what "well known" prior art step would be interchangeable to approximate the function of the DMO control. Cf. Data Line Corp. v. Micro

Appeal No. 95-0212  
Application 07/255,675

Technologies Inc., 813 F.2d 1196, 1201, 1 USPQ2d 2052, 2055 (Fed. Cir. 1987); Guidelines at 176.

The examiner has not provided a reference to teach or suggest to the DMO control step or an equivalent. WordPerfect's merge function using a data file does not provide such a teaching or suggestion. Moreover, the examiner's argument -- that three merge codes (^Fn, ^C, and ^D) would have suggested specifying a physical structure and several permitted formats (R 25 at 3 and 5) -- is not consistent with the function of the DMO control step disclosed in the specification. These codes specify sources of data, not structures or formats. The code that comes closest, the ^Fn code, may point to data that has a structure or format, but it does not directly specify the structure or format of the data. The examiner's broadest reasonable interpretation is more expansive than WordPerfect's disclosure permits. We also have no teaching to combine with the WordPerfect reference, nor any DMO-like control to interchange with the WordPerfect data file or merge codes, that would have rendered appellants' invention obvious to one of ordinary skill at the time of the invention. The WordPerfect reference also provides no motivation to modify



---

Appeal No. 95-0212  
Application 07/255,675

Andrew J. Dillon  
Felsman, Bradley, Gunter & Dillon  
2600 Continental Plaza  
777 Main Street  
Fort Worth, TX 76102