

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS G. CANNON and DANIEL L. DE HART

Appeal No. 1997-1012
Application No. 08/115,937¹

ON BRIEF

Before HAIRSTON, BARRETT, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3, 4, 8, 10, 11, 13, 14, 18, 20-22, 24, 28 and 30, which are all of the claims pending in this application.

We REVERSE.

¹ Application for patent filed September 1, 1993.

BACKGROUND

The appellants' invention relates to a system for indexing and retrieving graphic and sound data for social expression cards using a thesaurus to expand a list of search descriptors input by a user. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

Claim 1. A system for indexing and retrieving information for social expression cards comprising:

means for linking said information for each social expression card to a set of descriptors;

means for allowing a user to enter one or more search descriptors;

thesaurus means for expanding the list of search descriptors by including equivalent words for the search descriptors; and

means for retrieving said information for social expression cards linked to said search descriptors or equivalent words for said search descriptors in said expanded list.

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Cannon	5,056,029	Oct. 08, 1991
Kawai	5,107,343	Apr. 21, 1992
Katz et al. (Katz)	5,309,359	May, 03, 1994 (Filed Aug. 16, 1990)

Strong et al., "A Thesaurus for End-User Indexing and Retrieval," Information Processing and Management, Vol. 22, No. 6, pp. 487-492 (1986). (Strong)

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Claims 1, 3, 4, 8, 11, 13, 14, 18, 21-22, 24 and 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kawai in view of Strong and Cannon. Claims 10, 20 and 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kawai, Strong and Cannon in view of Katz.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the appellants regarding the above-noted rejections, we make reference to the Examiner's answer (Paper No. 16, mailed April 25, 1996) for the Examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 14, filed February 29, 1996) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the Examiner. As a consequence of our review, we make the determinations which follow.

Assuming *arguendo* that the combination is proper, we do find that the Examiner has not set forth a ***prima facie*** case of obviousness. The Examiner has set forth that the prior art applied against the claims teaches the claim limitation with respect to the "thesaurus means for expanding the list of search descriptors by including equivalent words for the search descriptors." The Examiner argues that Strong teaches this claim

limitation and directs our attention to pages 487 and 488 of Strong for a teaching of this limitation. (See answer at page 15.) Appellants argue that “Strong et al. do not disclose a thesaurus as claimed here. Strong et al. employ a concept-based hierarchical structure (i.e., facets and sub-facets). With regard to independent claim 1, Strong et al. do not expand the list of search descriptors, but rather only allow the user to navigate down the hierarchical tree from broad to narrow facets.” (See brief at page 5.) We agree with appellants. The three brief quotations of the text of the Strong reference cited by the Examiner do not expressly teach that the thesaurus is used in a manner to function as a means to “expand” the list of search descriptors. Furthermore, the Examiner has not provided a convincing line of reasoning why the skilled artisan would have been motivated to “expand” the list of search descriptors using a thesaurus means in view of the lack of an express teaching in any of the references applied against the claims. Appellants further argue that Kawai, Strong and Cannon “all base their search strategies on either menus or hierarchies of limited, predetermined terms.” (See brief at page 6.) We agree with appellants.² Therefore, we will not sustain the rejection of claims 1, 3, 4, 8, 11, 13, 14, 18, 21-22, 24 and 28 under 35 U.S.C. § 103.

² While we do not find that Strong teaches the use of a thesaurus to expand the list of search descriptors, we note that Reed et al. U.S. Patent 5,241,671 at col. 3-4 and IBM Technical Disclosure Bulletin, Vol. 30, No. 12, pp. 117-118, May 1988 teach and suggest the use of a thesaurus in the generation or modification of data base search queries. We make no finding beyond directing attention thereto.

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With regard to the Katz patent, the Examiner has not identified any portion of this reference to teach or suggest the thesaurus means for expanding the list of descriptors. Therefore, Katz does not remedy the deficiency in the *prima facie* case of obviousness presented by the Examiner in the combination of Kawai, Strong and Cannon. Therefore, we will not sustain the rejection of claims 10, 20 and 30 under 35 U.S.C. 103.

CONCLUSION

To summarize, the decision of the Examiner to reject claim 1, 3, 4, 8, 10, 11, 13, 14, 18, 20-22, 24, 28 and 30 under 35 U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON)
Administrative Patent Judge)
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) BOARD OF PATENT
LEE E. BARRETT) APPEALS
Administrative Patent Judge) AND
) INTERFERENCES
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JOSEPH L. DIXON)
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