

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CATHERINE M. ANSBERRY and TODD W. FUGUA

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Appeal No. 1998-2699  
Application 08/387,504

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ON BRIEF

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Before HAIRSTON, BARRETT and LALL, Administrative Patent Judges.

LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claim 1, the only pending claim in the application.

The disclosed invention is directed to an X Windows conferencing enabler to support applications that use non-shareable colorcells while running in a conference in which

the various X server participants differ in their support of

visual classes. An application requests the allocation and initialization of non-shareable colorcells and is displayed in a conference such that the colors for each X server participant are as close to that requested by the application as the hardware supports. The conference enabler distributes all of the non-sharable request to each participant in the conference that supports the request. For those participants that do not support the request, a no-color request is sent in place of the allocation request, and an allocate color or allocate name color order is sent in place of the initialization request. A further understanding of the invention can be obtained by the following claim.

1. A method for an X windows conferencing enabler to support applications that use non-shareable colorcells while running in a conference in which a plurality of X server participants differ in their support of visual classes comprises the steps of:

allocating non-shareable colorcells for a requesting application;

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distributing all of said non-shareable colorcell  
requests to each participant in said  
conference that supports said requests;

for any participants not supporting said requests,  
sending a *No Operations* request instead of said  
allocation requests;

initializing said non-shareable colorcells for said  
requesting application for all participants  
supporting said requests;

automatically sending an *AllocColor* or  
*AllocNamedColor* order in place of an  
initialization request to each participant not  
supporting said requests; and

displaying in a conference said non-shareable  
colorcells in colors for each X server  
participant that supports said requests, and  
displaying colorcells that are as close to  
that requested by said requesting application as  
allowed by a display used by each said X  
server participant that does not support said  
requests.

The Examiner relies on the following reference:

Nye, "Xlib Programming Manual", The Definitive Guides to the X  
Window System, vol. 1, pgs. 199-200, 206-207 O'Reilly & Assoc.  
(1992).

Claim 1 stands rejected under 35 U.S.C. § 103 as being  
obvious over Nye.

Rather than repeat the arguments of Appellants and the  
Examiner, we make reference to the brief and the answer for

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the respective details thereof.

OPINION

We have considered the rejections advanced by the Examiner and the supporting arguments. We have, likewise, reviewed the Appellants' arguments set forth in the brief.

We reverse.

In our analysis, we are guided by the general proposition that in an appeal involving a rejection under 35 U.S.C. § 103, an

Examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness, is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). We are further guided by the precedent of our reviewing court that the

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limitations from the disclosure are not to be imported into the claims. In re Lundberg, 244 F.2d 543, 113 USPQ 530 (CCPA 1957); In re Queener, 796 F.2d 461, 230 USPQ 438 (Fed. Cir. 1986). We also note that the arguments not made separately for any individual claim or claims are considered waived. See 37 CFR § 1.192(a) and (c). In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) ("It is not the function of this court to examine the claims in greater detail than argued by Appellants, looking for nonobviousness distinctions over the prior art."); In re Wiechert, 370 F.2d 927, 936, 152 USPQ 247, 254 (CCPA 1967)("This court has uniformly followed the sound rule that an issue raised below which is not argued in that court, even if it has been properly brought here by reason of appeal is regarded as abandoned and will not be considered. It is our function as a court to decide disputed issues, not to create them.").

The Examiner rejects claim 1 as being unpatentable over Nye and gives a detailed explanation as to how Nye is applied to meet the limitations of the claims on pages 2-4 of the final rejection.

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In meeting the claim limitations, the Examiner asserts, final rejection at pages 2 and 3 that "[s]ending a NO-OP avoids witting [sic, writing] the code to make an exception not to send anything to the participant, and avoids having to process the resulting error caused by sending a non-sharable request. This is a well known programming technique." Appellants argue, brief at page 6, that "the Examiner has engaged in an impermissible exercise of hindsight in choosing to characterize as 'well-known' Applicant's [sic, Applicants'] claimed technique of sending a 'No Operations' request in place of an allocation request for a non-shareable color cell to participants which do not support such requests."

In meeting a further claim limitation the Examiner asserts, final rejection at page 3, that "Ne [sic, Nye] also teaches the use of the XAllocColor() function that allows access to closest sharable color ... It is just common sense to first attempt to allocate a non-sharable color cell, and if upon failure [sic] then to attempt to access a shared color cell of the closest color to that requested." Appellants argue, brief at page 6, that "Nye, at page 200, describes the failure of requests for allocation of color and notes

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'Applications must allocate colors by trial and error'. ... an assumption that Nye automatically could send a No Operation request in place of an allocation request to those participants within a conference which do not support non-shareable color cell requests is an assumption which is not fairly suggested by this reference".

The Examiner further contends, final rejection at page 3, that "[a]s to the last limitation [of claim 1], this an obvious method of achieving and [sic] obviously desirable result. The desirable result is color consistency across all participating platforms. This method to achieve color consistency simply attempts to direct the more flexible participants to accommodate the least flexible. The more flexible participants are naturally MORE LIKELY to accommodate the least flexible, rather than vice versa". Appellants argue, brief at pages 6 and 7, that "Nye is entirely silent on the issue of displaying both read/write colorcells and read-only colorcells for the same element within a single requesting application as set forth within the present claim, and the

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Examiner's presumption that such modification of Nye is well within the ambit of those having ordinary skill in this art is not believed to be well-founded."

On pages 3, 4 and 5 of the Examiner's Answer, the Examiner has diligently responded to the various arguments raised by the Appellants, however, we find that these responses are based largely on mere speculation on the part of the Examiner. For example, the Examiner responds, answer at page 4, that "[t]he approach to color consistency that the applicant has taken is 'strait [sic, straight] forward' as described in the claim rejections. X Window programs can involve millions of lines of code, and often deal with problems much more complicated than the one described here. Such an approach, would be understood by those skilled in the art based upon the capabilities the X Window development library, the complexity of other types of heterogeneous compatibility problems the X programmer successfully deals with, and the desire for color consistency." The Examiner further contends, id., that "[n]aturally, a programmer would not transmit a (non-sharable) color initialization request to a display that was known not to support it. Of course the

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programmer would send the next best alternative. That would be to transmit an XAllocColor request to access colors available for sharing given that no private colors were available. The teachings of Nye expect that each call be used where APPROPRIATE. Other X Window calls, such as ... enable the programmer to probe for the color capabilities and limitations of each X Window display server before choosing the appropriate color establishing calls."

We agree with Appellants' position because Nye is not capable of accomplishing the color matching via a single call but instead clearly relies on a method wherein an application must allocate colors by trial and error, see page 200. The mere allegation by the Examiner that the various steps of the claimed method are obvious or are "simple" amounts to using the Appellants' invention as a road map to achieve obviousness of the claimed invention. We note that mere arguments do not take the place of factual evidence. The Examiner has simply indulged in speculation and conjecture in asserting that the claimed method steps are obvious to an artisan. Therefore, we do not sustain the obviousness rejection of claim 1 over Nye.

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The decision of the Examiner rejecting claim 1 under 35  
U.S.C. § 103 is reversed.

REVERSED

	KENNETH W. HAIRSTON	)	
	Administrative Patent Judge	)	
		)	
		)	
	LEE E. BARRETT	)	BOARD OF
PATENT	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
	PARSHOTAM S. LALL	)	
	Administrative Patent Judge	)	

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