

1 Ironically, the Appellants consider the rejection of claims 31-33 in view of
2 Reed as a form of admission that the Examiner's previous rejections of the claims
3 have failed to account for the organizational aspect of the present invention that
4 has been detailed above. Nevertheless, wherein the database search system of
5 Reed at least relates to the organization of information in a computer system, the
6 Appellants respectfully submit that Reed fails to render claims 31-33 obvious.

7 Reed discloses a database search system that retrieves "multimedia
8 information." (Reed, the Abstract). The stated novelty of Reed is the provision of
9 multiple "textual entry paths" for searching textual information and "multiple
10 graphical entry paths" for searching graphical information "such that the search
11 system retrieves information through both textual and graphical entry paths."
12 (Reed, col. 3, line 64 to col. 4, line 2). More specifically, a total of eight textual and
13 graphical entry paths are provided (Idea Search 30, Title Finder 40, Picture
14 Explorer 50, Topic Tree 60, Feature Articles 70, World Atlas 80, History Timeline
15 90, and Researcher's Assistant 100), and the eight entry paths are accessible to the
16 user via a Main Menu program 10. (Reed, col. 6, lines 48-65; Figure 1 of the
17 Drawings). Figure 23 of Reed, which is not discussed anywhere in the detailed
18 description of Reed, is described in the Brief Description of the Drawings section
19 as "a plan view of the search system and related hardware," appears to show a
20 display menu generated by the Main Menu program 10 wherein a portion of the
21 "main menu" display is designated to each of the eight entry paths. (Reed, Figure
22 23 of the Drawings). Selecting an entry path from the main menu "activates the
23 designated function or entry path program. (Reed, col. 7, lines 64-68). Figures 3-
24 22 of Reed are flow charts detailing the logic operations of the various programs
25 and functions that may be invoked from the main menu. (Reed, Brief
26 Description of the Drawings).

27 Claim 31 recites the following limitations:

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Examiner: A. Fetting

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APPEAL BRIEF
Art Unit 2301

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31. A method for organizing information in a computer filing system having a display device and a first plurality of documents, said method comprising:

displaying at some time on said display device a graphical representation of a first document;

said computer system creating a collection of documents comprising at least a second document and said first document, wherein said step of creating a collection comprises indicating to said computer system that a collection of documents is to be created using said first document as a sample document for said collection of document and wherein said computer system searches said first plurality of documents based on said first document to find said second document; and

displaying a graphical representation of said collection on said display device.

In his attempt to stretch the teachings of Reed around claim 31, the Examiner was forced both to paraphrase the recited claim limitations and to mischaracterize what Reed actually discloses such that the Examiner could ignore the recited limitations of the claims and the insufficiency of Reed. For example, the Examiner has relied on Figure 23 and the Abstract as disclosing the recited "displaying" steps of claim 23. However, the specification of Reed makes clear that the "main menu" and component sections shown therein by Figure 23 represent functions or programs that the user may invoke by selection (apparently by "pointing and clicking), not documents or collections of documents, as asserted by the Examiner.

Furthermore, the Examiner has asserted that Figures 4, 5, and 8 of Reed show the recited "creating" step with the exception that Reed fails to disclose the use of a sample document. The Appellants note that Figures 4 and 5 of Reed ostensibly show flow charts relating to the logic operations of the Idea Search entry path from the main menu. The Idea Search entry path of Reed allows a user to enter a list of words that the system of Reed uses as search terms to perform a search of the contents of articles in the system to find articles that relate specified search terms. (Reed, col. 6, line 68 to col. 7, line 2). When a

1 search is completed, a list of related articles (if any) is displayed by the system.
2 (Reed, col. 11; Figure 5 of the Drawings). Figure 8 is merely a flow chart that
3 shows the logical operation of the "Tools" function of Reed that enables a user
4 who does not understand word in an article that he is reading to invoke a
5 Glossary function 360 or a Dictionary function 390. The Tools function of Reed
6 also allows the user to invoke a "Find-a-Word" function that finds the next
7 occurrence of a user-specified word within the article that the user is currently
8 reading.

9 The Appellants submit that a list is an example of a textual representation
10 of the found articles, and the list of documents found by the search do not form a
11 "collection of documents" as recited by the claims and defined by the
12 specification of the present application. Instead, the list of documents of Reed
13 merely provides a mechanism for retrieving relevant articles, and there is no
14 indication that forming a list by the Idea Search entry path alters the
15 organizational relationship between the found articles within the filing system of
16 the computer system of Reed. In fact, the list of Reed is more properly termed an
17 "alias" or pointer for allowing access to found articles. (Reed, col. 9, lines 22-26).

18 The Examiner has further asserted that Figure 8 shows "automatically
19 using a word from a predefined document, i.e. contents, for searching other
20 documents." (Final Office Action, page 12). The Appellants note that Figure 8 is
21 merely a flow chart that shows the logical operation of the "Tools" function of
22 Reed that enables a user to invoke a number of functions while viewing an
23 article, wherein all of the functions, including Glossary, Bookmark, and
24 Dictionary, are related to the article the user is viewing. The fact that the
25 Dictionary function allows a user to click on a word in the article that the user is
26 viewing in order to perform a dictionary look-up is irrelevant to the claimed
27 invention, and the Examiner has provided no guidance as to where in Reed that

1 it is shown that the Dictionary function somehow shows the creation of a
2 collection of documents.

3 Therefore, Reed fails to disclose teach or suggest claim 31 of the present
4 application. Claims 32 and 33 depend from claim 31 and incorporate the same
5 limitations that are not to be found anywhere in Reed.

6 Claim 32 recites the further limitation of viewing a document by
7 displaying an indicia of the document in response to selecting the document
8 from the graphical representation of the collection. As Reed discloses a textual
9 list of related articles, Reed fails to disclose a graphical representation, and the
10 step of claim 32 is not taught or suggested by Reed.

11 Claim 33 recites the further limitation of creating a representation of the
12 collection based on an internal representation of the first (sample) document.
13 Reed contains no disclosure relating to internal representations or collective
14 internal representations as defined by the specification of the present application
15 and recited in claim 33. Therefore, claim 33 is not taught or suggested by Reed.

16 The Examiner's application of Reed to claims 31-33 can only be the result
17 of impermissible hindsight wherein the Examiner has used the claims of the
18 present application as a blueprint for his rejection. As stated above with respect
19 to the rejection of the claims in view of Levine and Vale, such hindsight is
20 improper.

21

22 **E. CLAIMS 81-86 ARE SUFFICIENTLY DEFINITE FOR THE PURPOSES OF**
23 **35 U.S.C. § 112, SECOND PARAGRAPH.**

24 The Examiner has asserted that claims 81-86 are indefinite for failing to
25 particularly point out and distinctly claim the subject matter which applicants
26 regard as the invention. More specifically, the Examiner has asserted that the

1 phrase "regardless of said first position on said graphical iconic representation"
2 recited in claim 81 is indefinite. Appellants disagree.

3 Claim 81 recites the following limitations:

4 81. A method for organizing and viewing information in a computer filing system
5 having a display device and a first plurality of documents, said method comprising:

6 displaying a graphical iconic representation of a collection of said first plurality
7 of documents;

8
9 displaying a first indicia of a first document of said collection by selecting a first
10 position from said graphical iconic representation, said first indicia of said
11 first document being selected for display regardless of said first position on
12 said graphical iconic representation.
13

14 Claim 81 states that an indicia is displayed in response to selecting a
15 position on the graphical iconic representation, and that an indicia of a document
16 is displayed regardless of the selected position. In other words, an indicia of a
17 document may be selected for display regardless of the position of the document
18 itself within the graphic of the collection.

1 VII. CONCLUSION

2 For the foregoing reasons, Appellants submit that the applicable
3 objections and rejections have been overcome and that the claims are in condition
4 for allowance.

5 If there are any further charges not accounted for herein, please charge
6 them to our deposit account No. 02-2666.

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Respectfully submitted,

9

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

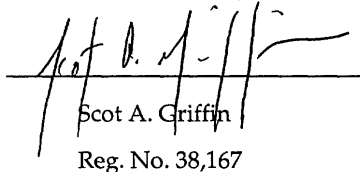
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Date: March 12, 1996

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Scot A. Griffin

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Reg. No. 38,167

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1 **VIII. APPENDIX A**

1 1. A method for organizing information in a computer filing system
2 having a display device and a first plurality of documents, said method
3 comprising :
4 displaying at some time on said display device a graphical representation
5 of a first document and a graphical representation of a second
6 document from said first plurality of documents;
7 creating a collection of documents comprising a second plurality of
8 documents having said first document and said second document;
9 determining for said collection at least one of (a) an internal collective
10 representation or (b) a user defined specification, wherein said internal
11 collective representation is based on internal representations of said
12 first and said second documents;
13 displaying a graphical representation of said collection of documents on
14 said display device; and
15 viewing at least one of the documents in said collection by displaying an
16 indicia of said at least one document by selecting, from said graphical
17 representation of said collection, said at least one document.

1 2. A method as in claim 1 further comprising the step of displaying a
2 base for said collection of documents and wherein said collection of documents is
3 created by one of said user and said computer filing system.

1 3. A method as in claim 2 further comprising a step of selecting said
2 collection of documents for further action by positioning said cursor over said

3 base and by indicating to the computer system that said collection of documents
4 has been selected.

1 4. A method as in claim 1 further comprising the step of:
2 creating a plurality of collections of documents from said collection of
3 documents by comparing said internal representation for each
4 document in said collection of documents with an internal collective
5 representation for each of said collections of documents.

1 5. A method as in claim 1 wherein the step of creating said collection
2 of documents comprises positioning said cursor over said graphical
3 representation of said first document and selecting said first document and
4 moving said first document such that said first document overlaps said second
5 document and then signalling to said computer system that a collection of
6 documents is to be created.

1 6. A method as in claim 1 wherein the step of creating said collection
2 of documents comprises selecting both said first and said second documents and
3 signalling to said computer system that a collection of documents is to be created.

1 8. A method as in claim 1 wherein said computer filing system determines
2 said internal collective representation of said collection of documents and
3 wherein said internal representation of each of the documents in said collection
4 of documents comprises a representation of words within each of the documents.

1 9. A method as in claim 8 wherein said internal representation of each
2 of the documents comprises, for a particular one of the documents, a vector

3 containing a representation of words within said particular one of the documents
4 and a representation of the uniqueness of the words in said particular one of the
5 documents relative to the words in said first plurality of documents.

1 10. A method as in claim 8 wherein said internal collective_representation
2 of said collection of documents comprises a vector containing a representation of
3 words within at least some of the documents in said collection of documents.

1 11. A method as in claim 1 further comprising viewing the contents of
2 said collection of documents by displaying a graphical representation of each
3 document in said collection within a region on said display device.

1 12. A method as in claim 3 further comprising viewing the contents of
2 said collection of documents by selecting said collection and signalling to the
3 computer system to display a graphical representation of each document in said
4 collection within a region on said display device.

1 13. A method as in claim 1 further comprising viewing the contents of
2 said collection of documents by displaying in an overlapping manner the
3 graphical representations of each document.

1 14. A method as in claim 1 wherein said step of creating a collection of
2 documents comprises creating a base for said collection and selecting said first
3 and said second documents and signalling to said computer system that said first
4 and said second documents are in said collection.

1 15. A method as in claim 1 further comprising adding a third
2 document having a graphical representation to said collection by selecting said
3 third document and moving said third document so as to position said graphical
4 representation of said third document over said graphical representation of said
5 collection and signalling to said computer system to add said third document to
6 said collection.

1 16. A method as in claim 15 further comprising removing said first
2 document from said collection by positioning said cursor over said graphical
3 representation of said first document and selecting said first document and
4 moving said graphical representation of said first document away from said
5 graphical representation of said collection.

1 17. A method as in claim 1 wherein said step of viewing comprises
2 pointing a cursor on said display device at a graphical representation of one of
3 said documents in said collection for a predetermined period of time to reveal an
4 indicia of said document in said collection.

1 18. A method as in claim 17 wherein said graphical representation of
2 said collection is displayed on said display device while said indicia is displayed
3 on said display device.

1 19. A method as in claim 18 wherein a means for indicating the
2 location of said document within the graphical representation of said collection is
3 displayed when said indicia is displayed.

1 20. A method as in claim 19 wherein said means for indicating the
2 location comprises a graphical representation having a cone shape which has an
3 apex and a base, said apex being adjacent to the location of said document.

1 21. A method as in claim 17 wherein said collection of documents
2 comprises mail documents which originated from an electronic mail message
3 and wherein said indicia for each of said mail documents comprises a list of
4 words in each of said mail documents.

1 22. A method as in claim 17 wherein said indicia is a miniature of said
2 document.

1 23. A method as in claim 17 wherein said indicia is a reproduction of
2 said document.

1 24. A method as in claim 17 wherein said indicia has multiple pages for
2 a multiple page document and wherein the user views the multiple pages of said
3 indicia by signalling to the computer to move from page to page of said indicia.

1 25. A method as in claim 21 wherein indicia for documents in said
2 collection other than said mail documents include miniatures of said documents
3 other than said mail documents.

1 26. A method as in claim 21 wherein said list of words for each mail
2 document is obtained from said internal representation of each mail document.

1 27. A method as in claim 26 wherein said internal representation of
2 each of the documents in said collection comprises, for a particular one of the
3 documents, a vector containing a representation of words within said particular
4 one of the documents and a representation of the uniqueness of words in said
5 particular one of the documents relative to the words in said first plurality of
6 documents.

1 28. A method as in claim 15 further comprising providing a first zone
2 of a second zone on said graphical representation of said collection and wherein
3 when said graphical representation of said third document is positioned over
4 said first zone, the user of said computer system controls the orientation of the
5 graphical representation of said third document relative to said collection so that
6 the user controls the appearance of said graphical representation of said
7 collection to the extent of the orientation of said graphical representation of said
8 third document relative to said graphical representation of said collection, and
9 wherein when said graphical representation of said third document is positioned
10 over said second zone, the computer systems controls the orientation of the
11 graphical representation of said third document relative to said collection so that
12 the computer system controls the appearance of said graphical representation of
13 said collection.

1 29. A method as in claim 1 wherein said graphical representation of
2 said collection conveys visual information about the contents of said collection.

1 30. A method as in claim 29 wherein said graphical representation of
2 said collection is dynamic such that adding or removing documents to said
3 collection changes the graphical representation of said collection.

1 31. A method for organizing information in a computer filing system
2 having a display device and a first plurality of documents, said method
3 comprising:
4 displaying at some time on said display device a graphical representation
5 of a first document;
6 said computer system creating a collection of documents comprising at
7 least a second document and said first document, wherein said step of
8 creating a collection comprises indicating to said computer system that
9 a collection of documents is to be created using said first document as
10 a sample document for said collection of document and wherein said
11 computer system searches said first plurality of documents based on
12 said first document to find said second document; and
13 displaying a graphical representation of said collection on said display
14 device.

1 32. A method as in claim 31 further comprising viewing at least one of
2 the documents in said collection by displaying an indicia of said at least one
3 document by selecting, from said graphical representation of said collection, said
4 at least one document.

1 33. A method as in claim 31 further comprising creating a
2 representation of said collection of documents based on an internal
3 representation of said first document.

1 34. A method as in claim 8 wherein said graphical representation is in
2 multiple colors such that said computer filing system provides a color for a

3 particular document in said collection based on a measure of the similarity
4 between the representation of said collection and the internal representation of
5 said particular document.

1 35. A method as in claim 34 wherein one of the hue and saturation of a
2 color is varied according to said measure of the similarity.

1 36. A method as in claim 8 wherein the user of said computer filing
2 system provides a third document to said filing system and instructs said
3 computer filing system to file said third document and wherein said computer
4 filing system determines whether to add said third document to said collection
5 based on a measure of similarity between the internal collective representation of
6 said collection and an internal representation of said third document.

1 37. (Twice Amended) A method for organizing information in a
2 computer system having a display device, said method comprising:
3 displaying at some time on said display device a representation of a first
4 document and a representation of a second document;
5 creating a collection of documents comprising said first and said second
6 documents;
7 determining for said collection of documents at least one of (a) an internal
8 collective representation or (b) a first user defined specification,
9 wherein said internal collective representation is based on internal
10 representations of said first and second documents;
11 displaying a graphical representation of said collection of documents; and
12 determining a further internal representation of said collection when a
13 third document is added to said collection based on one of: (a) an

14 internal representation of each of the documents in said collection, or
15 (b) said first or a second user defined specification.

1 38. A method as in claim 37 wherein said computer system has a filing
2 system having a graphical user interface and said method is performed in part by
3 said filing system and wherein said representations of said first document and
4 said second document are graphical representations.

1 39. A method as in claim 38 wherein said first user defined
2 specification is a sample document designated by said user to act as an internal
3 representation of said collection.

1 40. A method as in claim 38 wherein said first user defined
2 specification is a collection of words specified by said user.

1 41. A method as in claim 38 wherein internal representations of
2 documents in said collection are used to determine relevancy comparisons
3 between said collection of documents and a third document added by one of said
4 user and said computer system.

1 42. A method as in claim 38 wherein said first user defined
2 specification comprises a programmable means for causing the execution of a
3 series of instructions and wherein said programmable means is activated by
4 selecting a graphical representation on said display device.

1 43. A method as in claim 38 wherein said step of determining an internal
2 collective representation of said collection occurs each time a document is added
3 to or removed from said collection.

1 44. A method as in claim 43 wherein said step of determining an internal
2 collective representation of said collection occurs each time a modified document
3 is stored to replace a preexisting document in said collection.

1 45. A method as in claim 38 further comprising viewing at least one of
2 the documents in said collection by positioning a cursor provided by said
3 computer system on said display device on a graphical representation of said at
4 least one document in said collection for a predetermined period of time to reveal
5 an indicia of said document in said collection.

1 46. A method as in claim 45 wherein said graphical representation of
2 said collection is displayed on said display device while said indicia is displayed
3 on said display device and wherein said indicia is a graphical representation of
4 said document.

1 47. A method as in claim 46 wherein a means for indicating the
2 location of said document within the graphical representation of said collection is
3 displayed when said indicia is displayed.

1 48. A method as in claim 45 wherein said computer filing system
2 provides a call to the program which created said at least one document and said
3 program responds to said computer filing system by providing said indicia.

1 49. A method as in claim 38 wherein said graphical representation of
2 said collection includes a means for selecting said collection.

1 50. A method as in claim 49 further comprising moving said collection
2 by selecting said collection and indicating to said computer system to move said
3 collection.

1 51. A method as in claim 50 wherein said means for selecting
2 comprises at least one of a base and a top means and a wrapping means for
3 identifying the documents within said collection as a collection and wherein said
4 step of moving comprises pointing a cursor provided by said computer system
5 on said display device at said means for selecting and selecting said collection
6 and moving said cursor while said collection is selected.

1 52. A method as in claim 45 further comprising selecting a selective
2 viewing mode such that only a user specified type of document is selected for
3 viewing wherein only indicia for said user specified type of document is
4 displayed when viewing documents in said collection during said selective
5 viewing mode.

1 53. A method as in claim 52 wherein said user specified type of
2 document is one of (i) documents containing pictures, (ii) electronic mail
3 documents, (iii) documents containing a "To" field, and (iv) documents
4 containing a chart.

1 54. A method as in claim 38 further comprising viewing at least one of
2 the documents in said collection by selecting said at least one document to reveal
3 an indicia of said document in said collection.

1 55. A method as in claim 54 further comprising moving said graphical
2 representation of said document to a location near said collection, said step of
3 moving being performed by said computer system after selecting said document.

1 56. A method as in claim 55 wherein said step of moving is an
2 animation provided by said computer system and wherein said animation
3 includes flipping said graphical representation of said document.

1 57. A method as in claim 55 wherein each time the user selects a
2 document for viewing from said collection, a graphical representation of said
3 document so selected moves to said location.

1 58. A method as in claim 55 wherein said indicia is a full size
2 reproduction of said document, said indicia being displayed behind the
3 graphical representation of said collection and the graphical representation of the
4 document at said location.

1 59. A method as in claim 38 wherein said first user defined
2 specification is modified and wherein said computer system adds new
3 documents to said collection on the basis of said modified first user defined
4 specification.

1 60. A method as in claim 59 wherein said computer system adds to
2 said collection on the basis of a comparison between the internal representation
3 of each of said new documents and said modified first user defined specification.

1 61. A method as in claim 38 wherein said further internal
2 representation of said collection is one of said first and second user defined
3 specifications defining a selected user defined specification and wherein the user
4 indicates to said computer system to add a fourth item to said collection, which
5 fourth item has an internal representation which does not match said selected
6 user defined specification, and wherein, after the user has indicated to add said
7 fourth item to said collection, said computer system prompts the user to
8 determine whether the fourth item is to be added to said collection without
9 modifying said selected user defined specification or the fourth item is to be
10 added and said selected user defined specification is to be modified.

1 62. A method as in claim 61 wherein said computer system prompts
2 the user by displaying a window means for editing the selected user defined
3 specification and wherein said fourth item is one of a document, a pile and a
4 folder.

1 63. A method as in claim 38 further comprising creating a plurality of
2 collections of documents from said collection of documents by comparing an
3 internal representation maintained by said computer system for each document
4 in said collection with an internal representation created by said computer
5 system for each of said collections of document.

1 64. A method as in claim 38 further comprising displaying a window
2 means having user commands for viewing said collection.

1 65. A method as in claim 63 wherein said collection of documents is a
2 subdirectory of documents and wherein said graphical representation of said
3 collection is one of a folder and a container representation means for indicating
4 that said container representation means contains documents.

1 66. (Twice Amended) A computer filing system for organizing
2 information in a computer system having a processor, a bus, and memory for
3 storing information including a plurality of documents, said computer filing
4 system comprising:
5 a display means for producing a display of graphical representations, said
6 display means coupled to said processor;
7 a cursor control means coupled to said processor, said cursor control
8 means for controlling the position of a cursor on said display;
9 a switch means for indicating a selection of an object displayed on said
10 display, said switch means coupled to said processor and having a first
11 and a second position;
12 a graphical representation of a first document and a graphical
13 representation of a second document, said cursor control means and
14 said switch means being used with said graphical representations of
15 said first and said second documents, which are displayed on said
16 display means, to create a collection of documents comprising said first
17 and said second documents;
18 a means for creating a graphical representation of said collection of
19 documents comprising said first and said second document; and

20 a means for determining an internal collective representation of said
21 collection, said means for determining providing a collective
22 representation based on an internal representation of said first and said
23 second documents.

1 67. An apparatus as in claim 66 wherein said collection of documents
2 has user manipulatable graphical user interface features allowing said user to
3 operate on said collection as a group of documents.

1 68. An apparatus as in claim 66 wherein said means for determining
2 determines a further collective representation of said collection each time a
3 document is added to said collection.

1 69. An apparatus as in claim 68 wherein said means for determining
2 includes a table showing the number of times a preselected group of words is
3 used at least once in each of said documents stored in said computer system.

1 70. A method as in claim 1 wherein said graphical representation is in
2 multiple colors such that said computer system provides a color for a particular
3 document based on an attribute of said particular document.

1 71. A method as in claim 70 wherein one of the color parameters in a
2 color space is varied according to said attribute.

1 72. A method as in claim 1 wherein said step of creating a collection of
2 documents comprises creating a means for selecting a collection of documents

3 and wherein said means for selecting includes one of a user provided collective
4 representation of said collection or said user defined specification.

1 73. A method for organizing information in a computer system having
2 a display device, said method comprising:
3 determining an internal representation of each document in a plurality of
4 documents, each said internal representation being based on the
5 content of the corresponding document;
6 creating a collection of documents comprising said plurality of
7 documents;
8 determining at least one of a first internal collective representation or a
9 first user defined specification for said collection, said first internal
10 collective representation being based on said internal representation of
11 each of said plurality of documents; and
12 displaying a visual representation of said collection of documents.

1 74. A method as in claim 73 further comprising:
2 displaying at some time on said display device a visual representation of
3 each document in said plurality of documents.

1 75. A method as in claim 73 further comprising:
2 viewing at least one of the documents in said collection by displaying an
3 indicia of said at least one of the documents, wherein said viewing
4 occurs by selecting from said visual representation of said collection
5 said at least one of the documents.

1 76. A method as in claim 74 further comprising:

2 viewing at least one of the documents in said collection by displaying an
3 indicia of said at least one of the documents, wherein said viewing
4 occurs by selecting from said visual representation of said collection
5 said at least one of the documents.

1 77. A method as in claim 75 wherein said step of viewing comprises
2 pointing a cursor on a display device at said visual representation.

1 78. A method as in claim 75 wherein the user of said computer system
2 instructs said computer system to file a further document and wherein said
3 computer system determines whether to add said further document to said
4 collection of documents based on a measure of similarity between the first
5 internal collective representation and an internal representation of said further
6 document.

1 79. A method as in claim 78 wherein said computer system adds said
2 further document to said collection of documents and further comprising:
3 determining a further internal collective representation of said collection,
4 said further internal collective representation being based on said
5 internal representation of each of said documents in said collection.

1 80. A method as in claim 75 further comprising:
2 creating a plurality of collections of documents from said collection of
3 documents by comparing said internal representation of each of said
4 documents in said collection of documents with an internal collective
5 representation for each of said plurality of collections.

1 81. A method for organizing and viewing information in a computer
2 filing system having a display device and a first plurality of documents, said
3 method comprising:

4 displaying a graphical iconic representation of a collection of said first
5 plurality of documents;

6 displaying a first indicia of a first document of said collection by selecting
7 a first position from said graphical iconic representation, said first
8 indicia of said first document being selected for display regardless of
9 said first position on said graphical iconic representation.

1 82. A method as in claim 81 wherein during said step of displaying a first
2 indicia, said graphical iconic representation is concurrently displayed.

1 83. A method as in claim 82 wherein said indicia is displayed adjacent to
2 said graphical iconic representation of said collection.

1 84. A method as in claim 81 wherein said selecting from said graphical
2 iconic representation comprises positioning a cursor on said graphical iconic
3 representation, and further comprising:

4 displaying in series a second indicia of a second document and a third
5 indicia of a third document by positioning said cursor first on a second
6 position on said graphical iconic representation next on a third
7 position on said graphical iconic representation.



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 24

Serial Number: 08 / 287,108
Filing Date: August 8, 1994
Appellant(s): Mander et al.

Scot A. Griffin
For Appellant

APR 22 1996

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed
March 20, 1996.

(1) *Status of claims.*

The statement of the status of claims contained in the brief
is correct.

(2) *Status of Amendments After Final.*

The appellant's statement of the status of amendments after
final rejection contained in the brief is correct.

(3) *Summary of invention.*

The summary of invention contained in the brief is correct.

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(4) *Issues.*

The appellant's statement of the issues in the brief is correct.

(5) *Grouping of claims.*

Appellant has categorized the 86 claims into 26 groups and has provided arguments for each group.

(6) *Claims appealed.*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(7) *Prior Art of record.*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,060,135	Levine et al.	10/91
5,247,437	Vale et al.	9/93
5,287,448	Nicol et al.	2/94
5,241,671	Reed et al.	8/93

(8) *New prior art.*

No new prior art has been applied in this examiner's answer.

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(9) *Grounds of rejection.*

The following ground(s) of rejection are applicable to the appealed claims.

Claim Rejections - 35 USC § 112

1. Claims 81 to 86 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to independent claim 81, it is unclear whether the phrase "regardless of said first position on said graphical iconic representation" means that the same display is shown regardless (i.e. no matter where positioned, the same display occurs), or that the display is able to follow the position regardless of position (i.e. the display is predicated on position, but any position is accessible and operable).

- Dependent claims 82 to 86 are rejected for fully incorporating the deficiencies of their base claim 81.

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Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1 to 6, 11 to 30, 37 to 68 and 70 to 80 are rejected under 35 U.S.C. § 102(a) and (e) as being anticipated by Levine et al. (U.S. Pat. No. 5060135 10/91) which teaches displaying a plurality of documents in a reduced format (stamps 34) on a display screen using an internal collective representation shown in fig. 5. This is maintained from prior action.

- With respect to independent claim 73, the most broad claim,

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- *graphical display of documents and document collections* is shown figures 2 to 4.
- *creating a collection of documents* is shown fig. 5a.
- *determining an internal representation of each document and of collective documents based on contents* is shown by figures 5 and 6 portraying a process flow based on the structural contents of documents including document type and name.
- *display* is shown fig. 2 to 4.
- With respect to dependent claims 74 to 76,
 - *viewing documents and selecting documents by pointing* is shown by the process flow in fig. 7.
- With respect to dependent claim 77 and 80,
 - *basing collections on measures of similarity* is shown by the process flow of fig. 6 basing collections on application similarity as noted by internal document contents indicating relevant application.
- With respect to dependent claims 78 and 79,
 - *using measure of similarity for document addition* is shown by the process flow in fig. 6 in which similarity of document application is used for addition criteria.

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- Independent claim 66, the next most broad claim, and dependent claims 67 and 68 are for an apparatus performing the methods of claims 73 to 77 and are similarly rejected.
- Independent claim 1 has substantially similar subject matter as claim 73 except as follows and is similarly rejected.
 - *viewing a document among multiple documents in a collection* is shown col. 11 lines 47 to 60.
 - *internal collective representation or user defined specification* is shown fig. 5.
- With respect to dependent claim 2, 3 and 12,
 - *cursor selection of a graphical representation including a base representation* is shown fig. 2 to 4.
- With respect to dependent claim 4,
 - *building collection by document comparison* is shown by the flow chart in fig. 6.
- Dependent claims 5, 6, 11, 13 and 14 are substantially similar in scope to claims 2, 3 and 12 and are similarly rejected.
- With respect to dependent claims 15, 16 and 28
 - *adding and removing third documents using display zones* is shown by the flow charts of figures 6 and 7 using the zones defined by the stamps shown in figures 2 to 4.

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- With respect to dependent claim 17,
 - *pointing for a predetermined time to display an indicia* is shown col. 10 lines 20 to 35.
- With respect to dependent claims 18 to 27, depending from claim 17,
 - *viewing and pointing to collections of mail showing words and uniqueness* is shown by the figures 2 to 4 and col. 13 lines 30 to 50.
- With respect to dependent claim 29, 30 and 70 to 72,
 - *visual representations of contents and attributes by portraying number of documents or color of display* is shown fig. 3 (number of documents) and inherent operation of display devices (color).
- Independent claim 37 has substantially similar subject matter as claim 1 except as follows and is similarly rejected.
 - *adding a third document* is shown inherently by operation of flow charts in figures 6 and 7.
- With respect to dependent claim 38,
 - *filing system* is shown inherently in disk operations for documents in a computer system.
- With respect to dependent claims 39 to 42,

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- *using a sample and collection of words and executing a process using relevancy* is shown in the process flows of fig. 6 and 7. Relevancy is shown by the decision blocks, collections of words is shown by the document types and menus, process execution is shown by the process flow.
- Dependent claims 43 to 53 contains substantially similar subject matter as claims 2 to 6 and 13 to 16 and are similarly rejected.
- With respect to dependent claims 54 to 58,
 - *viewing documents by movement and flipping* is shown col. 11 lines 28 to 60.
- With respect to dependent claim 59 to 65,
 - *adding documents to multiple types of collections which indicate what is contained and querying where addition is questionable* is shown by the portrayal of multiple collections in fig 2 to 4 and the query decision blocks in the process flows of fig. 6 and 7.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

5. Claims 1 to 6, 8 to 30 and 34 to 80 are rejected under 35 U.S.C. § 103 as being unpatentable over Levine et al. as applied above in view of Vale et al. (U.S. Pat. No. 5247437 9/93). This is maintained from prior action.

Alternatively, with respect to claims 1 to 6, 11 to 30, 37 to 68 and 70 to 80, interpreting the claim element "collective internal representation" to mean word tables, Levine shows displaying a plurality of documents in a reduced format (stamps 34) on a display screen using an internal collective representation (fig. 5) as applied above, but does not show using word tables for the collective internal representation. Vale shows using word tables for the collective internal representation in an analogous art for the purpose of aggregating documents based on word content. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply Vale's

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word table to Levine because of the taught advantages of using content as the criteria for document aggregation.

With respect to dependent claims 69, 8 to 10 and 34 to 36, Levine shows displaying a plurality of documents in a reduced format (stamps 34) on a display screen using an internal collective representation (fig. 5) as applied above, but does not show the word table of claims 69 and 8. Vale shows using word tables for the collective internal representation in an analogous art for the purpose of aggregating documents based on word content. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply Vale's word table to Levine because of the taught advantages of using content as the criteria for document aggregation.

- With respect to dependent claims 9, 10 and 34 to 36, depending from claim 8, *vectors and measures of similarity* are shown by Vale's word indexes, and *color indication* is shown inherently as a well known embodiment by operation of a display controller in a color environment.

6. Claims 81 to 86 are rejected under 35 U.S.C. § 103 as being unpatentable over Nicol et al. (U.S. Pat. No. 5287448 2/94) in view of Levine et al. as applied above.

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- With respect to independent claim 81 and dependent claim 82 and 83, Nicol shows
 - *graphical iconic collection representation* is shown fig. 2.
 - *displaying indicia of document by selecting position from representation* is shown fig. 2.
 - *regardless of position on representation* is shown fig. 2 in which help is provided regardless of position.
 - *concurrent adjacent display of representation and indicia* is shown fig. 2.

but does not show document collection. Levine shows a graphical document collection in an analogous art for the purpose of presenting documents. It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Levine's document collection to Nicol's help system because of the generic use of a help system such as Nicol's to any graphic interface such as Levine's.

- Dependent claims 84 to 86 are substantially similar to claims 81 to 83 except for applying to multiple instances inherent in the applied reference and are similarly rejected.

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7. Claims 31 to 33 are rejected under 35 U.S.C. § 103 as being unpatentable over Reed et al. (U.S. Pat. No. 5241671 8/93).

- With respect to independent claim 31 and dependent claims 32 and 33,

- *graphical display of documents and document collections* is shown fig. 23 and abstract.

- *creating a document collection using a first document as a sample for said collection and searching for next document based on first document* is shown fig. 5 in which articles are selected and displayed based on contents. It is noted that fig. 5 originates from fig. 4 which begins with a term entered on a screen. The data entry field for such term may be characterized as a document.

- *viewing and representing documents* is shown fig. 5 ref. 240.

but does not show using a predefined document for the search. However, automatically using a word from a predefined document, i.e. contents, for searching other documents is shown fig. 8 in use of Glossary, Bookmark and Dictionary. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the automated use of a word from a predefined document to the fig. 5 search engine because of the

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teachings for such practice within the same reference as motivated by the same reason for doing so with a dictionary, to immediately search without the need for retyping.

(10) *New ground of rejection.*

This Examiner's Answer does not contain any new ground of rejection.

(11) *Response to argument.*

GROUP 01

Argument - Levine doesn't show determining internal collective representation in claim 66.

RESPONSE

Determining an internal representation of each document and of collective documents based on contents is shown by figures 5 and 6 portraying a process flow based on the structural contents of documents including document type and name. Applicant argues that Levine's icon is not based on the contents represented by the icon. However, the breadth of "based on" is sufficient to encompass the implied meaning of the icon and further, the claim

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does not cite contents of documents but only internal representation, which the icon exemplifies.

Argument - There is no collective representation in Levine.

RESPONSE

The linked list is a collective representation.

GROUP 02

Argument - Levine shows no user defined specification.

RESPONSE

The alternative phrasing in claim 73 renders the claim sufficiently broad to read on Levine even if Levine shows only one of either alternative, in this case, at least the internal collective representation.

GROUP 03

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Argument - Levine doesn't show organizing a collection of documents by having the computer search the second document.

RESPONSE

Creating a document collection using a first document as a sample for said collection and searching for next document based on first document is shown fig. 5 in which articles are selected and displayed based on contents. It is noted that fig. 5 originates from fig. 4 which begins with a term entered on a screen. The data entry field for such term may be characterized as a document. Further, the generation of a linked list of documents in fig. 5 creates a collection wherein the head of the linked list acts as a sample while the computer searches for additional members to add to the list. It would have been obvious to one of ordinary skill in the art at the time the invention was made to search for members of a linked list because the purpose of a linked list is to collect its members.

Basing collections on measures of similarity is shown by the process flow of fig. 6 basing collections on application similarity as noted by internal document contents indicating relevant application. Appellant's argument that figure 6 shows collecting stamps rather than documents is countered by the simple reality that stamps are metaphors for documents and any

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such collection is inherently a collection of documents. Since all data representations are metaphoric by nature, such a metaphor is an inherent anticipation rather than a mere obvious embodiment.

GROUP 04

Argument - Levine doesn't show plural collections.

RESPONSE

Figures 2 and 3 portray plural collections.

GROUP 05

Argument - Claim 63 combines the limitations of groups 4 and 6.

RESPONSE

The response is the combination of responses for groups 4 and 6.

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GROUP 06

Argument - Levine doesn't show adding a third document.

RESPONSE

Adding a third document is shown inherently by operation of flow charts in figures 6 and 7.

GROUP 07

Argument - Levine doesn't show the computer adding the third document.

RESPONSE

Since additions of documents only occur within the computer, such additions are performed by the computer.

GROUP 08

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Argument - Levine doesn't show prompting user where document to be added does not match selected specification.

RESPONSE

Adding documents to multiple types of collections which indicate what is contained and querying where addition is questionable is shown by the portrayal of multiple collections in fig 2 to 4 and the query decision blocks in the process flows of fig. 6 and 7.

Further, under the 35 USC 103 rejection, performing bounds or validity checking on data entry and querying on misfits is a notoriously well known practice in data processing.

GROUP 09

Argument - Levine doesn't show adding documents based on similarity.

RESPONSE

Using measure of similarity for document addition is shown by the process flow in fig. 6 in which similarity of document application is used for addition criteria. Further Levine shows

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using similarity of mail for grouping in proper tray col. 26
lines 55 to 59.

GROUP 10

Argument - Levine doesn't show relevancy comparison.

RESPONSE

Using a sample and collection of words and executing a process using relevancy is shown in the process flows of fig. 6 and 7. Relevancy is shown by the decision blocks, collections of words is shown by the document types and menus, process execution is shown by the process flow.

GROUP 11

Argument - Levine doesn't show adding based on user defined specification.

RESPONSE

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Adding documents to multiple types of collections which indicate what is contained and querying where addition is questionable is shown by the portrayal of multiple collections in fig 2 to 4 and the query decision blocks in the process flows of fig. 6 and 7. Further, the user inherently defines a specification of document type by selection of documents. To the extent documents are added compatible with the user's starting documents, such is an addition on the basis of user defined specification.

GROUP 12

Argument - Levine doesn't show addition based on comparison between internal representation and user defined specification.

RESPONSE

Adding documents to multiple types of collections which indicate what is contained and querying where addition is questionable is shown by the portrayal of multiple collections in fig 2 to 4 and the query decision blocks in the process flows of fig. 6 and 7. Further, the user inherently defines a specification of document type by selection of documents. To the extent documents are added

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compatible with the user's starting documents, such is an addition on the basis of user defined specification.

GROUP 13

Argument - Group 13 claims incorporate group 1 limitations.

RESPONSE

The response to group 1 is repeated here.

Argument - Levine doesn't show displaying indicia in response to selecting document.

RESPONSE

Levine shows displaying top stamp indicia in response to selection. Appellant's argument that an editable image is not an indicia is countered by the simple reflection that an editable image indicates and therefore acts as indicia of the document.

GROUP 14

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Argument - Levine doesn't show viewing by positioning a cursor.

RESPONSE

Figure 7 shows the operation of Bring to Top performed by a pen which is a cursor equivalent.

GROUP 15

Argument - Group 15 combines the elements of groups 13 and 14.

RESPONSE

The response is that of the responses to groups 13 and 14.

GROUP 16

Argument - Levine doesn't show concurrent views of indicia and collections.

RESPONSE

Figures 2 to 4 show examples of concurrent views of indicia and collections. Further, from a 35 USC 103 rejection view, multiple

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coincident views have been notoriously well known since the advent of windowing displays.

GROUP 17

Argument - Group 17 combines groups 13 and 16.

RESPONSE

The response is that of the response to groups 13 and 16.

GROUP 18

Argument - Levine doesn't indicate location.

RESPONSE

The location is indicated at least as being on top for the selected document. Further, the location of an indicia indicates the location of the indicia.

GROUP 19

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Argument - Group 19 combines groups 13 and 18.

RESPONSE

The response is that of the response to groups 13 and 18.

GROUP 20

Argument - Levine doesn't show viewing documents meeting user specified type.

RESPONSE

Levine shows viewing documents in an active tray col. 13 lines 29 to 50. The active tray defines the user specified type. Further, from a 35 USC 103 viewpoint, applying selection criteria to data retrieval is notoriously well known and practiced.

GROUP 21

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Argument - Levine doesn't show plural pages.

RESPONSE

Figures 2 to 4 show plural pages. Further, from a 35 USC 103 viewpoint, plural visual elements is an obvious embodiment of any visual element, particularly where retrieval is claimed.

GROUP 22

Argument - Levine doesn't show displaying a collection or displaying indicia of selected document.

RESPONSE

Levine figures 2 to 4 show displays of collections and indicia of selected documents. Nicol shows

- graphical iconic collection representation is shown fig. 2.
- displaying indicia of document by selecting position from representation is shown fig. 2.
- regardless of position on representation is shown fig. 2 in which help is provided regardless of position.

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- *concurrent adjacent display of representation and indicia is shown fig. 2.*

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Levine's document collection to Nicol's help system because of the generic use of a help system such as Nicol's to any graphic interface such as Levine's.

Argument - Nicol doesn't show documents.

RESPONSE

Nicol shows presentation of help information as evidenced by the title. To this end Nicols presents help messages as evidenced by the abstract. Information in the form of messages comprise documents. Ergo Nicols shows documents.

Argument - The combination of Nicols and Levine doesn't show selecting a document based on which portion of a graphical object is selected.

RESPONSE

The graphical object cited in group 22 is that of a collection. A graphical representation of a collection portrays the components

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of the collection. Selecting a component of the collection is an embodiment of selecting a first position of the graphical object, i.e. collection object. Therefore selecting a component document in Levine or a component help object in Nicols selects the document based on which portion of the graphical object is selected.

GROUPS 23 TO 26

Groups 23 to 26 are argued with repetitions of above arguments and the response is similarly applied.

OTHER ARGUMENTS

Argument - The organization found in Levine comes from the user (Brief p. 11).

RESPONSE

The claims are sufficiently broad to read on organization imposed by a user. Once the organization is imposed, such is maintained by the system and thereafter is indistinguishable from that of any other source of organization.

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Argument - Levine shows no collective representation (Brief p. 12).

RESPONSE

The collections portrayed in figures 2 to 4 are collective representations.

Argument - Vale's indices are not word tables (Brief p. 29).

RESPONSE

Vale teaches the notoriety of word tables in its Background of the Invention col. 1.

Argument - There is no motivation in the cited references to combine their teachings (Brief p. 30).

RESPONSE

This argument appears to be based on a misunderstanding common among patent practitioners: namely, "that an invention cannot be held to have been obvious unless a suggestion to combine prior

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art teachings is found *in* a specific reference" [emphasis in original]¹.

It is a basic tenet of the law regarding obviousness that the suggestion necessary to support a modification to or a combination of prior art references need not be *expressly* stated in a prior art reference². In fact, the prior art need not contain a full blown "suggestion" to combine or modify: an incentive or motivation found in the prior art is sufficient. Put another way, the prior art need not suggest the combination or modification itself: suggesting the desirability of the combination or modification is sufficient³. Moreover, the source

¹ *In re Oetiker*, 24 USPQ2d at 1447 (Nies, J. concurring: "it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found *in* a specific reference" [emphasis in original]).

² *In re Nilssen*, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) ("for the purpose of combining references, those references need not explicitly suggest combining teachings"), *Milliken Research Corp. v. Dan River, Inc.*, 222 USPQ 571, 583 (Fed. Cir. 1984) (As Milliken would have it, the combination would not have been obvious in the absence of an express suggestion in a prior art reference. This clearly is not the law.), and *In re Sernaker*, 217 USPQ 1, 6 (Fed. Cir. 1983) ("it was not necessary that the prior art suggest expressly or in so many words, the changes or possible improvements the inventor made" [internal quotations omitted]).

³ See *Fromson v. Advance Offset Plat, Inc.*, 225 USPQ 26, 31 (Fed. Cir. 1985) ("the critical inquiry is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination" [internal quotations omitted]).

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of that incentive or motivation may be a single reference, multiple references, or knowledge generally available to one of ordinary skill in the art⁴. Finally, "a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references" is enough to support a modification to or a combination of references⁵.

With respect to the combination of Levine and Vale, the title of Vale speaks directly to assembly of documents visible on the front page of Levine. It would have been obvious to one of ordinary skill in the art at the time the invention was made to consult document assembly teachings such as Vale while learning from Levine because the very figures in Levine suggest document assembly. Since one of ordinary skill in data automation would

⁴ *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 227 USPQ 657, 667 (Fed. Cir. 1985) ("To properly combine references A and B to reach the conclusion that the subject matter of a patent would have been obvious, case law requires that there must have been some teaching, suggestion, or inference in either reference A or B, or both, or knowledge generally available to one of ordinary skill in the relevant art, which would have lead one skilled in the art to combine the relevant teachings of references A and B."), and *In re Laskowski*, 10 USPQ2d 1397, 1399 (Fed. Cir. 1989) ("we agree with the Commissioner that the suggestion to modify the Hoffman structure need not be found in Hoffman").

⁵ *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. Appl. & Intr. 1985).

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have sought means to automate what was visible on the face of Levine, an automated mechanism such as that found in Vale would have been consulted.

Argument - Reed's figure 23 represents menus and not documents (Brief p. 36).

RESPONSE

Reed's menus are simply indices for Reed's documents. As such the menus represent document collections and the pop up lists resulting from selection provide indicia from which selection is offered.

Argument - Claims 81 to 86 are sufficiently definite.

RESPONSE

The verb "regardless" modifies is indefinite (i.e. displaying or selecting) and the claim interpretation is significantly different and therefore indefinite in each case.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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08/287108



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FETTIN EXAMINER	
ART UNIT	PAPER NUMBER
2412	25

DATE MAILED: 04/22/96

Please find below a communication from the EXAMINER in charge of this application.

see attached

Commissioner of Patents

Application No. 08/287,108


Art Unit 2412

**NOTICE OF NON-COMPLIANCE OF INFORMATION DISCLOSURE STATEMENT
WITH PROVISIONS OF 37 C.F.R. §1.97**

The information disclosure statement filed in this application on February 28, 1996 fails to include the petition after final rejection required under 37 C.F.R. §1.97(d). See 1135 O.G. 13 dated February 4, 1992, which is effective for all information disclosure statements filed after March 16, 1992.

The petition should also be accompanied by the required fee set forth under 37 C.F.R. §§1.97(d) and 1.17(i)(1) and a proper certification as specified in 37 C.F.R. §§ 1.97(d) and 1.97(e).

The information disclosure statement has been made of record in the application file but will not be considered by the examiner until it complies with 37 C.F.R. §§1.97 - 1.98.


HEATHER R. HERNDON
SUPERVISORY PATENT EXAMINER
GROUP 2400

Sheila - The IDS was not considered
because it doesn't comply with 37 CFR § 1.97
Therefore, it is not signed.

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Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Richard Mander, et al.

Serial No.: 08/287,108

Filed: August 8, 1994

For: METHOD AND APPARATUS FOR
ORGANIZING INFORMATION IN A COMPUTER
SYSTEM

Examiner: A. Fetting

Art Unit: 2301

Appellant's Reply Brief

Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

Pursuant to 37 CFR §1.193. Appellant is filing this reply brief which addresses certain of the Examiner's new points of argument which were raised in the Examiner's Answer.

This reply brief is being submitted in triplicate. Please charge deposit account No. 02-2666 for any fees required in filing this reply brief. Appellant is separately requesting an Oral Hearing for this appeal.

ARGUMENT

Claims 81 to 86 are sufficiently definite

The Examiner's Answer newly argues that the "verb "regardless" modifies is indefinite (i.e. displaying or selecting) and the claim interpretation is significantly different and therefore indefinite ..."

It is respectfully submitted that this rejection is improper in view of the claim language. This is particularly true when such language is read in view of the specification and the drawings. In one embodiment of the present invention, as explained in the specification at page 16, lines 1-18 and at page 20, line 14 to page 28, line 18, the first indicia of the first document may be selected regardless of the position of the first document in the graphic iconic

representation and this selection causes the display of the first indicia. This is radically unlike the system described in Levine where there is no selection for display of an indicia and where there is no ability to display an indicia upon a selection regardless of the position of the "stamp" in the stack of stamps.

The claim language, properly parsed, reveals that the indicia may be displayed by selecting a first position regardless of the first position on the graphic iconic representation, which is usually the pile. The "regardless" clause clearly modifies the step of selecting, which step results in displaying a first indicia. That is, the phrase "selected for display" is modified by the "regardless" clause to indicate that the selection may occur whether the first position is in the middle or near the top or near the bottom of the "pile". This is a natural reading of the claim, and therefore the claim is definite.

Claim 81 (Claim Group 22) and Claims 84-86 (Group 25) Not obvious in view of Levine and Nicol

The Examiner's Answer newly argues that the combination of Levine and Nicol shows the selection of a document based on which portion of a graphical object is selected. See the paragraph which bridges pages 26 and 27.

The Nicol reference teaches a help system which displays a help message when an icon is selected. There is simply no teaching in Nicol that a different help message is displayed when a different position for the same icon is selected. In fact, this would confuse a user and thus is not even conceivable from the teachings of Nicol. Similarly, Levine fails to teach this feature. Thus the combination cannot teach this feature.

Claims 84-86 further amplify the glaring insufficiency of the prior art. These claims require the display of a series of indicia, including a second indicia and a third indicia by positioning the cursor on a second and third position (respectively) on the same icon of the collection. Again, this is taught by neither Levine or Nicol.

At least for the foregoing reasons, the rejection of claim groups 22, 23, 24 and 25 should be reversed.

Levine does not render claim 31 (Group 3) obvious

The Examiner's Answer, at page 15 thereof, newly argues that "the generation of a linked list of documents in Figure 5 creates a collection wherein the head of the linked list acts as a sample while the computer searches for additional members to add to the list." This commentary on the Levine reference completely ignores what Levine discloses. Levine does not show any such searching by using a first document to search for the next. The Examiner's Answer seems to concede this lack of teaching in Levine. Levine's system is user driven, and the Levine computer system does not disclose the computer searching for the "next document" using the first document.

Claim 61 (Claim Group 8) is not obvious in view of Levine

The Examiner's Answer, at page 18 thereof, newly argues that "under the 35 USC 103 rejection performing bounds or validity checking on data entry and querying on misfits is a notoriously well know practice..." Applicant believes this is an admission that the Levine reference does not in fact show the limitations of Claim 61. There is simply no disclosure to be found anywhere in Levine that a user will be prevented from stacking a stamp for any reason or that a user will be prompted to verify the addition of a stamp to a stack of stamps. It is noted that a computer system which prompts a user in the fashion described in claim 61 may be in certain instances undesirable, such as a system where the user dictates the actions of the computer as described in Levine. Thus it is believed that even if the Examiner is correct in that it is "notoriously well known", it does not render the present invention obvious.

Levine does not show adding documents based on similarity

The Examiner's Answer at pages 18 and 19 newly argues that "Levine shows using similarity of mail for grouping in proper tray". The cited portion of the Levine reference does not in fact teach any use of a measure of similarity between a first internal collective representation and an internal representation of the further document. In fact what it suggests, is that certain desk trays may have been selected to be active in order to receive documents. This is unlike the system described in Claim 78 (Claim Group 9).

It is respectfully submitted that the Examiner is ignoring the description of the present invention and is ignoring the claim limitation that the computer system adds new documents. There is no such teaching in Levine, and it respectfully submitted that the user adding documents is very different than the circumstance where the computer adds the new documents to the collection.

Levine fails to disclose the step of displaying a means for indicating the location of a selected document within the graphical representation of the collection


The Examiner's Answer at pages 23 and 24 thereof, newly argues that the "location is indicated at least as being on top for the selected document." First of all, Levine never indicates the idea of having a position indicator for the stack of stamps, and there is no need to relate the image to the position of the stack because the image in Levine is always on top of the stack. Thus there is nothing which indicates the location and no need to do so in the Levine reference.

Conclusion

For the reasons indicated in this reply brief as well as the reasons indicated in Appellant's Appeal Brief which has been previously submitted, all claims are patentable, and the pending rejections should be reversed.

Respectfully Submitted

Date: June 24, 1996



James C. Scheller, Jr.
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04860.P624C

Patent

#26
07-16-96
MJC

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Richard Mander, et al.

Serial No.: 08/287,108

Filed: August 8, 1994

For: METHOD AND APPARATUS FOR
ORGANIZING INFORMATION IN A COMPUTER
SYSTEM

Examiner: A. Fetting

Art Unit: 2301

Request for Oral Hearing and Request that Oral Hearing Occur by
Videoteleconference

Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

Applicant requests, pursuant to 37 CFR 1.194, an oral hearing for the appeal in the above noted application. Applicant includes herewith a check (\$240.00) for the fee required pursuant to §1.17(g). Please charge our deposit account No. 02-2666 for any deficiency in fees required for this request.

Applicant further requests that the hearing be conducted by videoteleconference using the established link between the Sunnyvale Center for Innovation, Invention and Ideas ("Sci 3" -- which was formerly known as the Sunnyvale Patent Library) and the U.S. Patent & Trademark Office. Applicant understands that the Board of Patent Appeals is interested in conducting hearings by videoteleconference.

Respectfully Submitted

Date: June 24, 1996

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Reg. No. 31, 195

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Los Angeles, CA 90025

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FIRST CLASS CERTIFICATE OF
MAILING (37 C.F.R. § 1.8(a))

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on June 24, 1996

Cindy Murphy
Name of Person Mailing Correspondence

Signature

6-24-96
Date



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

JUL 23 1996

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 27

Serial Number: 08 / 287,108
Filing Date: August 8, 1994
Appellant(s): Mander et al.

Scot A. Griffin
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to appellant's reply brief on appeal
filed June 28, 1996.

Response to argument.

Argument - Claims 81 to 86 are sufficiently definite.

RESPONSE

Examiner made this rejection the first time Appellant entered the
respective claims. The claims are clearly indefinite as written
and are easily made definite, however Appellant has not offered
any amendment to render the claims definite.

Serial Number: 08 / 287,108

-2-

Art Unit: 2412

Argument - Nicol fails to show a single icon for application against claims 22 and 84 to 86.

RESPONSE

Although Appellant argues that Nicol fails to show a single icon, this argument is more narrow than the claim presented. The claim cites iconic representation. A single iconic representation may comprise multiple icons, as grouping of icons is a notoriously well used practice in graphic programming arts. In such a group it would have been obvious to attach different help messages to different individual icons because each icon must be discernable in its own right as well as being a member of a group.

Argument - Levine does not show computer searching.

RESPONSE

Levine teaches a computer implemented system and therefore any searching is perforce computer based.

Serial Number: 08 / 287,108

-3-

Art Unit: 2412

Argument - Notoriety of bounds checking does not make bounds checking obvious.

RESPONSE

Boundary checking is taught as part of basic engineering curricula and would have been obvious to one of ordinary skill because of the universality of training and applicability.

Argument - Levine does not show computer adding documents based on similarity.

RESPONSE

Again, Levine shows a computer based system and so all operations including document addition are inherently computer driven. A further specific example of adding documents by type is shown Levine col. 5 lines 1 to 8 where the computer distinguishes types by user and adds to user groups accordingly.

Argument - Levine fails to show indicating document location.

RESPONSE

Levine col. 27 lines 35 to 60 show indicating document location using magnifier and cursor.

Serial Number: 08 / 287,108

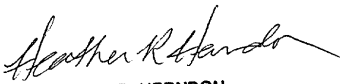
-4-

Art Unit: 2412

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Anton W. Fetting^{AK}
(703) 305-8449
July 16, 1996


HEATHER R. HERNDON
SUPERVISORY PATENT EXAMINER
GROUP 2400

Blakely, Sokoloff, Taylor & Zafman
12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025

MAILED

JUN 13 1997

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD MANDER, DANIEL E. ROSE
GITTA SALOMON, YIN Y. WONG,
TIMOTHY OREN, SUSAN BOOKER
and STEPHANIE HOUDE

Application 08/287,108¹
Appeal No. 97-0129

ORDER REMANDING TO EXAMINER

Effective April 21, 1995, 37 CFR § 1.192(c)² was amended to
provide as follows (underlining added for emphasis):

(c) The brief shall contain the following item
under appropriate heading and in the order indicated
below unless the brief is filed by an applicant who is
not represented by a registered practitioner:

(1) *Related appeals and interferences.* A
statement identifying by number and filing date all
other appeals or interferences known to appellant, the
appellant's legal representative, or assignee which
will directly affect or be directly affected by or have

¹ Application for patent filed August 8, 1994. According
to appellants, the application is a continuation of Application
07/876,921, filed April 30, 1992, now abandoned.

² 60 Fed. Reg. 14518 (Mar. 17, 1995), 1173 Off. Gaz. Pat.
& Trademark Office 62 (Apr. 11, 1995).

Appeal No. 97-0129
Application 08/287,108

a bearing on the Board's decision in the pending appeal. (underlining added for emphasis).

The brief filed March 20, 1996, Paper No. 23, is defective under 37 CFR § 1.192(d) because it fails to comply with the provisions of the rule pertaining to the "related appeals and interferences."

The MPEP § 1206 further states:

. . . If appellant does not identify any other appeals or interferences, the examiner will presume that there are none. While the examiner will assume that there are no related cases when no related case is explicitly set out in the brief, nevertheless, the Board may require the appellant to explicitly identify any related case.

The examiner may presume that there are no related appeals and interferences, if appellant presents the heading but fails to provide the corresponding statement under the heading. Nevertheless, the examiner is encouraged to request from appellant not only the required heading but also explicit statement identifying any related appeals and interferences in order to avoid further delays in the appeal process, since the the Board will otherwise require appellant to explicitly identify any related appeals and interferences.

A further review of the file reveals that an Information Disclosure Statement was submitted on February 26, 1996 (Paper No. 21). It is not apparent from the record that the examiner

Appeal No. 97-0129
Application 08/287,108

considered the Information Disclosure Statement submitted nor notified applicant of why his submission did not meet the criteria set forth in 37 CFR § 1.56 and §§ 1.97 and 1.98.

Accordingly, it is

ORDERED that the application is remanded to the examiner for resolution of the issues set forth above regarding the "related appeals and interferences," and it is

FURTHER ORDERED that the application is remanded to the Examiner for such consideration of the Information Disclosure Statement, appropriate notification to applicant and for such further action as may be appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of the appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: 

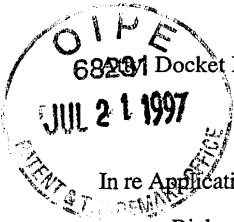
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ALS:ls

Appeal No. 97-0129
Application 08/287,108

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04860412 #29
8-19-97
MJC
1023



Docket No. 04860.P0624C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Richard Mander, et al.)
Application No. 08/287,108)
Filed: August 8, 1994)
For: METHOD AND APPARATUS FOR)
ORGANIZING INFORMATION IN A)
COMPUTER SYSTEM)

Examiner: A Fetting
Art Unit: 2412

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GROUP 2600

Asst. Commissioner for Patents
Washington, D.C. 20231

FURTHER REPLY BRIEF

Sir:

This Further Reply Brief is in response to a request from the Examiner which was made in a teleconference with the undersigned on July 16, 1997. The Examiner requested a "reply brief" which explicitly responded to the Order in Paper No. 28 from the Board of Patent Appeals.

RELATED APPEALS AND INTERFERENCES

There are no known appeals or interferences which are related to the present application.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date: 7/16, 1997

James C. Scheller, Jr.
Reg. No. 31,195

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231

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on July 16, 1997
Date of Deposit
Connie West
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Connie West 7-16-97
Signature Date

#29
3 of 3



Atty. Docket No. 04860.P0624C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Richard Mander, et al.
Application No. 08/287,108
Filed: August 8, 1994
For: METHOD AND APPARATUS FOR ORGANIZING INFORMATION IN A COMPUTER SYSTEM

Examiner: A Fetting
Art Unit: 2412

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GROUP 2600

Asst. Commissioner for Patents
Washington, D.C. 20231

FURTHER REPLY BRIEF

Sir:

This Further Reply Brief is in response to a request from the Examiner which was made in a teleconference with the undersigned on July 16, 1997. The Examiner requested a "reply brief" which explicitly responded to the Order in Paper No. 28 from the Board of Patent Appeals.

RELATED APPEALS AND INTERFERENCES

There are no known appeals or interferences which are related to the present application.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date: 7/16, 1997

James C. Scheller, Jr.
Reg. No. 31,195

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Date of Deposit
Connie West
Name of Person Mailing Correspondence
Connie West 7-16-97
Signature Date

08/287108



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/287,108	08/08/94	MANDER	R 04860.P6240

24M1/0912
 BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN
 12400 WILSHIRE BLVD., SEVENTH FLOOR
 LOS ANGELES CA 90025

EXAMINER	
FETTING, A	
ART UNIT	PAPER NUMBER
2412	30

DATE MAILED: 09/12/97

Please find below a communication from the EXAMINER in charge of this application.

see attached

Commissioner of Patents

Anton W. Fetting

**ANTON W. FETTING
PATENT EXAMINER
GROUP 2403**

Application No. 08/287,108

Art Unit 2412

NOTICE OF NON-COMPLIANCE OF INFORMATION DISCLOSURE STATEMENT WITH
PROVISIONS OF 37 C.F.R. §1.97

The information disclosure statement filed in this application on February 28, 1996 fails to include the petition after FINAL REJECTION required under 37 C.F.R. §1.97(d). See 1135 O.G. 13 dated February 4, 1992, which is effective for all information disclosure statements filed after March 16, 1992.


The petition should also be accompanied by the required fee set forth under 37 C.F.R. §§1.97(d) and 1.17(i)(1) and a proper certification as specified in 37 C.F.R. §§ 1.97(d) and 1.97(e).

The information disclosure statement has been made of record in the application file but will not be considered by the examiner until it complies with 37 C.F.R. §§1.97 - 1.98.

RESPONSE TO SUPPLEMENTAL REPLY BRIEF

It is noted that Appellant has submitted a disclosure of related appeals and interferences as required by the Board.

AWF
9/11/97


Anton W. Fetting
Primary Examiner
Group 2400

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

#31

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

MAILED

UNITED STATES PATENT AND TRADEMARK OFFICE

OCT 29 1999

PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD MANDER, DANIEL E. ROSE
and GITTA SALOMON, YIN Y. WONG, TIMOTHY OREN,
SUSAN BOOKER and STEPHANIE HOUDE

Appeal No. 1997-0129
Application 08/287,108¹

ON BRIEF

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 claims 1 to 6 and 8 to 86, claim 7 having been canceled.

¹ Application for patent filed August 8, 1994. According to appellants, the application is a continuation of Application 07/876,921, filed April 30, 1992, now abandoned.

Appeal No. 1997-0129
Application 08/287,108

The disclosed invention is directed to a method for organizing and displaying information in a computer system that may be used as a substitute for traditional flat file systems and hierarchical file systems. More specifically, the invention provides a method and apparatus for organizing documents of the computer system into one or more collections or "piles" of documents wherein each collection of documents is displayed using a graphical representation such as an icon, and wherein a user may browse individual documents of a collection without removing the documents from the collection. The ability of the filing system to automatically organize documents into collections is enabled through the use of internal representations, such as vectors, associated with each document, or by comparing the documents to a user defined specification such as a script that includes a list of words or other criteria selected by the user. A user may "ruffle" through the documents of a pile and display indicia of the documents as the user "ruffles" by moving the cursor from document to document within the pile. The indicia is a graphical representation of the first page of a document. The invention is further described by the following claim.

Appeal No. 1997-0129
Application 08/287,108

Representative claim 1 is reproduced as follows:

1. A method for organizing information in a computer filing system having a display device and a first plurality of documents, said method comprising:

displaying at some time on said display device a graphical representation of a first document and a graphical representation of a second document from said first plurality of documents;

creating a collection of documents comprising a second plurality of documents having said first document and said second document;

determining for said collection at least one of (a) an internal collective representation or (b) a user defined specification, wherein said internal collective representation is based on internal representations of said first and said second documents;

displaying a graphical representation of said collection of documents on said display device; and

viewing at least one of the documents in said collection by displaying an indicia of said at least one document by selecting, from said graphical representation of said collection, said at least one document.

The Examiner relies on the following references:

U.S. Patents

Levine et al. (Levine)	5,060,135	Oct. 22, 1991
Reed et al. (Reed)	5,241,671	Aug. 31, 1993 (filed Oct. 26, 1989)
Vale et al. (Vale)	5,247,437	Sept. 21, 1993 (filed Oct. 1, 1990)
Nicol et al. (Nicol)	5,287,448	Feb. 15, 1994 (effectively filed May 4, 1989)

Appeal No. 1997-0129
Application 08/287,108

Claims 81 to 86 stand rejected under 35 U.S.C. § 112, second paragraph, as being vague and indefinite. Claims 1 to 6, 11 to 30, 37 to 68 and 70 to 80 stand rejected under 35 U.S.C. § 102 as being anticipated by Levine. Claims 1 to 6, 8 to 30 and 34 to 80 stand rejected under 35 U.S.C. § 103 as being obvious over Levine and Vale. Claims 81 to 86 stand rejected under 35 U.S.C. § 103 as being obvious over Nicol and Levine, while claims 31 to 33 stand rejected over Reed.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the briefs² and the answers³ for 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.

It is our view that claims 81 to 86 are not vague and indefinite under 35 U.S.C. § 112, second paragraph; claims 1 to

² A reply brief was filed as paper no. 25 and was entered in the record. A second reply brief was also filed as paper no. 29 and was entered in the record, however it only went to correct the informalities of the original brief and not the merits of the arguments.

³ A supplemental answer was mailed as paper no. 27.

Appeal No. 1997-0129
Application 08/287,108

6, 11 to 23, 25 to 30, 37 to 60, 62 to 68 and 70 to 80 are anticipated by Levine, while claims 24 and 61 are not anticipated by Levine; claims 1 to 6, 8 to 23, 25 to 30 and 34 to 60 and 62 to 80 are obvious over Levine and Vale, while claims 24 and 61 are unobvious over Levine and Vale; claims 81 to 83 are obvious over Nicol and Levine, while 84 to 86 are unobvious over Nicol and Levine. Claims 31 to 33 are not obvious over Reed. Accordingly, we affirm in part.

We now consider the various rejections in the order discussed in the Examiner's answer and evaluate the corresponding Appellants' arguments in the brief and the reply brief.

In our analysis, we are guided by the precedence of our reviewing court. Before delving into the different grounds of rejections, namely 35 U.S.C. § 112, second paragraph, 35 U.S.C. § 102 and 35 U.S.C. § 103, we first review the applicable precedence relating to these grounds.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976). They are to be construed in

Appeal No. 1997-0129
Application 08/287,108

the light of Appellants' disclosure and not in a vacuum. However, the 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, 230 USPQ 438 (Fed. Cir. 1986). We are also mindful of the requirements of anticipation under 35 U.S.C.

§ 102. Anticipation under 35 U.S.C. § 102 is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. See RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert denied, 469 U.S. 851 (1984). While applying the test of obviousness, we keep in mind the guidelines of our reviewing court. The pertinent general proposition is 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,

Appeal No. 1997-0129
Application 08/287,108

228 USPQ 685, 686 (Fed. Circuit. 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).

Rejection of claims 81 to 86 under 35 U.S.C. § 112

The Examiner contends that the clause "regardless of said first position on said graphical iconic representation" (claim 81, lines 8 to 9) makes claim 81 and its dependent claims 82 to 86 indefinite [answer, page 3 and supplemental answer, page 1]. After reviewing the Appellants' arguments [brief, pages 38 to 39 and reply brief, page 1 to 2], we agree with Appellants' position. The clause in question has to be interpreted in the light of the Appellants' disclosure. We find that the metes and bounds of the claim are definite. Thus, we do not sustain this rejection of the independent claim 81 and its dependent claims 82 to 86 as the Examiner has not pointed out any other 112 problems with the dependent claims.

Rejection of claims 1 to 6, 11 to 30, 37 to 68 and 70 to 80 under 35 U.S.C. § 102

These claims are rejected as being anticipated by Levine. We first take the broad independent claim 73 for consideration. We have reviewed Appellants' arguments [brief, pages 12 to 14] and the Examiner's arguments [answer, pages 4 and 13 to 14] and we agree with the Examiner's position. First, we note the use of

Appeal No. 1997-0129
Application 08/287,108

the word "or" between the phrases "internal collective representation" and "user defined specification" in the limitation "determining ... documents" (claim 73, lines 8 to 11). Contrary to Appellants' position, Levine does show a collection based on an internal representation [column 25, line 50 to column 26, line 28] as well as a collection alternatively based on a user specification [column 5, lines 19 to 34]. See also figures 5a and 5b. The documents are represented by stamps 34 and 70 in figures 3 and 4. Therefore, we sustain the anticipation rejection of claim 73. We further note that Appellants have not raised any individual arguments regarding claims 74 to 77 under this heading. Any arguments not made by Appellants are considered waived. See 37 CFR § 1.192 (c)(6) (in view of) (1996) ("For each rejection under 35 U.S.C. § 103, the argument shall specify limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art."). Cf. In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ 2d 1281, 1285 (Fed. Cir. 1991) ("It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for

Appeal No. 1997-0129
Application 08/287,108

nonobvious 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 this 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."). Therefore, we also sustain the anticipation rejection of claims 74 to 77. After considering Appellants' arguments [brief, page 20] and Examiner's position [answer, pages 5 and 18 to 19] with respect to claim 78, we note that Levine does file a further document to the collection based on a measure of similarity between the internal representation of the further document and the collection, see Levine at column 26, lines 55 to 59 where Levine must compare internal representation of the incoming mail (i.e., further document) to that of the existing mail (i.e., the collection) in order to classify the incoming mail and put it in the proper tray. Thus, we sustain the anticipation rejection of claim 78. Regarding claim 79, no substantive argument is separately made in the brief, therefore we sustain the anticipation rejection of claim 79.

Appeal No. 1997-0129
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Next, we consider independent claim 66. After review of Appellants' arguments [brief, pages 12 to 13] and the Examiner's contentions [answer, pages 6 and 14], we agree with the Examiner's position. As stated in the above discussion relating to claim 73, Levine shows the making of a collection based on the internal representation. Furthermore, contrary to Appellants' view, link list 92 in Levine not only includes an icon but also each item in the desk view 32 [column 25, lines 50 to 57]. The documents are a part of the desk view, see figure 2. Thus, we sustain the anticipation rejection of claim 66 over Levine. Claims 67 and 68 depend on claim 66 and have not have been separately argued by Appellants. Therefore, we sustain the anticipation rejection of claims 67 and 68.

Now, we discuss independent claim 1. Appellants argue that Levine does not disclose the step of "displaying an indicia of said at least one document" (claim 1, lines 15 to 16) [brief, pages 23 to 24]. According to "The American Heritage Dictionary", 2nd College Edition, Houghton Mifflin, 1982, the word "indicia" is defined as "identifying marks". Levine shows that when the pointer is pointed to a stamp in the stack or pile, the top page of the stamp is displayed apart from the pile, see figures 2 and 3. We take that top page as the "indicia" of the

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stamp, see also answer at page 21 relating to "indicia". Also, Levine discloses the internal representation of the collection in figures 5a and 5b as discussed above. Levine further discloses a "user defined specification" (claim 1, lines 10) to arrange the documents, column 5, lines 22 to 26. The other features of claim 1 have been discussed in connection with claims 66 and 73 above. Therefore, we sustain the anticipation rejection of claim 1 over Levine. Appellants have chosen to let claims 2, 3, 5, 6, 8 to 16, 28 to 30, 34-35 [sic, claims 34 and 35 were not a part of this rejection], 70 to 72 and 75 to 77 stand or fall together with claim 1 [brief, page 10] and have not presented any separate arguments for them. Therefore, we also sustain the anticipation rejection of these claims over Levine. With respect to claim 4, we have evaluated Appellants' arguments [brief, page 16] and the Examiner's position [answer, pages 6 and 16], and we have already discussed the manner in which Levine employs the internal representation to organize the incoming document into the existing collection of documents, see figures 5a, 5b and 6 Levine further shows the creation of a plurality of documents, see figures 2 and 3. Therefore, we sustain the anticipation rejection of claim 4 over Levine. The anticipation rejection of

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claim 80 over Levine is also sustained as it is grouped with claim 4. Since claim 7 is grouped with claim 79 whose anticipation rejection over Levine has been sustained above, the anticipation rejection of claim 7 over Levine is also sustained.

Next, we consider claim 17. After reviewing Appellants' arguments [brief, pages 25 and 26] and the Examiner's arguments [answer, pages 7 and 22], we agree with the Examiner that Levine does show a stylus or a pen being used as a cursor to point to any document in the pile and the top page of that document is displayed in the desk view, see figures 1c, 3 and column 10, lines 20 to 35. Therefore, we sustain the anticipation rejection over Levine of claim 17 and its grouped claims 21 to 23 and 25 to 27. With respect to claim 18, we have reviewed Appellants' position [brief, page 26] and the Examiner's position [answer, pages 7 and 23] and we hereby sustain the anticipation rejection of claim 18 over Levine for the reasons given for claim 1 above. Regarding claim 19, and its grouped claim 20, we have evaluated the positions of Appellants [brief, page 27] and the Examiner [answer, pages 7 and 24] and we agree with the Examiner that Levine discloses the manner in which a document is indicated in the stack depth, see figure 3, column 13, lines 30 to 50 and column 28, lines 30 to 37.

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Therefore, we sustain the anticipation rejection of claims 19 and 20.

With respect to claim 24, it calls for the additional limitation of "said indicia has multiple pages ... indicia" (claim 24, lines 1 to 3). After considering the arguments of Appellants [brief, page 28] and the Examiner [answer, page 7 and 25], we conclude that Levine does not show an indicia which comprises multiple pages, rather we have treated indicia in Levine as consisting of just the top page of a document in our discussion above. Therefore, we do not sustain the anticipation rejection of claim 24.

According to Appellants, claims 25 to 27 have been grouped with claim 17 and claims 28 to 30 with claim 1. As we have sustained the anticipation rejection over Levine of claims 17 and 1 above, we also sustain the anticipation rejection of claims 25 to 27 and 28 to 30 over Levine.

With respect to claim 37, Appellants argue that Levine does not show the addition of a third document [brief, pages 17 and 18]. We have also considered the Examiner's corresponding position [answer, pages 7 and 17] and we agree with the Examiner that Levine does show the addition of a third document and its

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organization among the already existing collection of documents is done either by the internal representation of the documents or by a user specification in the same manner as the case of the creation of a collection of two documents discussed above. Appellants argue that Levine discloses the addition of documents to the desk view, not to the addition of a stamp to a stack of stamps. Contrarily, Levine discloses adding more documents to the contents of a tray as the additional documents are being sent to the user over the network [column 5, lines 1 to 6]. Also, Levine discloses further information relating to the addition of documents to an existing collection, see Levine at column 5, lines 23 to 26, column 15, lines 8 to 13. Other features of this claim have been treated with the discussion of claim 1 above. Therefore, we sustain the anticipation rejection over Levine of claim 37 and its grouped claims 38 to 40, 42 to 44, 48 to 51, 53 to 58, 62, 64 to 65, and 68 to 69. With respect to claim 41, Appellants argue that Levine shows neither the use of the internal representation nor a relevancy comparison between the documents [brief, page 21]. We have also evaluated the merits of the Examiner's position [answer, pages 7, 8 and 18 to 19] and we agree with the Examiner's position that Levine discloses the use of internal representation as has been amply discussed above and

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Levine further shows that the incoming documents are being distributed to the proper trays as a result of the relevancy comparison, see column 5, lines 19 to 34 and column 26, lines 50 to 59. Therefore, we sustain the anticipation rejection of claim 41 over Levine. Regarding claims 45 and 17, the former depends on claim 37 and the latter on claim 1. Other than that, each of claims 45 and 17 contains the same limitation, i.e., pointing or positioning a cursor on said display device on a graphical representation of one of said documents in said collection for a period of time to reveal an indicia of said document in said collection. We have evaluated the merits of the specific arguments of Appellants [brief, page 25] and the Examiner [answer, page 8 and 22] relating to claim 45 and also compared those arguments relative to the above discussion in regard to claim 17. Since the anticipation rejection over Levine of claim 17 has been already sustained, this rejection of claim 45 is also sustained for the same reasons. Regarding claim 46, we note that it depends on claim 37 whereas claim 18 depends on claim 1. Otherwise, claim 46, like claim 18, claims that graphical representation of said collection and the indicia of said collection are displayed on the display device.

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After considering the merits of the positions of Appellants [brief, page 26] and the Examiner [answer, pages 6 and 16] and also considering their respective positions in regard to claim 18 above, we sustain the anticipation rejection of claim 46 for the same reasons as claim 18. With respect to claim 47, we observe that it depends on claim 37 whereas claim 19 depends on claim 1. Other than that, they each have a similar limitation, see brief at page 27. We have reviewed the arguments of Appellants [brief, page 27] and the Examiner [answer, page 8 and 23] and for the same reasons as claim 19 above, we sustain the anticipation rejection of claim 47 over Levine. Regarding claim 52, it calls for "selecting ... viewing mode" (claim 52, lines 2 to 5). We have considered the positions of Appellants [brief, page 28] and the Examiner [answer, page 8 and 24] and we conclude that Levine does show that a user can selectively view items from a selected tray [column 13, lines 34 to 43]. The items correspond to the documents and the trays correspond to collections of documents. Thus, we sustain the anticipation rejection of claim 52 over Levine. Regarding claim 59, we have considered the Examiner's position [answer, pages 8 and 19 to 20] and Appellants' position [brief, page 21 and 22] and we agree with the Examiner's view that Levine does show that the user defined specification can be

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modified and the new documents to said collection are added to the collection based on said modified user specification, see column 5, lines 23 to 32, column 8, lines 7 to 18, column 26, lines 55 to 59. Therefore, we sustain the anticipation rejection of claim 59 over Levine. With respect to claim 60, we have evaluated the arguments of Appellants [brief, page 22] and the Examiner [answer, pages 8 and 20 to 21], and Appellants have not presented any counter argument other than a mere conclusory statement. Therefore, we sustain the anticipation rejection of claim 60 over Levine.

Regarding claim 61, after studying the positions of Appellants [brief, pages 19 and 20] and the Examiner [answer, pages 8 and 17 to 18], we are of the view that Levine does not show the limitation "add a fourth item ... be modified" (claim 61, lines 4 to 10). Therefore, we do not sustain the anticipation rejection of claim 61 over Levine. Regarding claim 62, Appellants have elected to group it with group 6 comprising claim 37 etc. even though it depends on claim 61 [brief, page 9]. Since the anticipation rejection of the claims in that group has already been sustained above, the anticipation rejection of claim 62 is also sustained. Regarding claim 63, neither Appellants nor the Examiner have presented any new arguments other than what has

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been discussed above [brief, pages 16 to 17] and [answer, pages 8 and 16] relating to claims 4 and 80. Since we have sustained the rejection of claims 4 and 80, we also sustain the anticipation rejection of claim 63 over Levine for the same reasons.

Rejection of claims 1 to 6, 8 to 30 and 34 to 80 under 35
U.S.C. § 103

These claims are rejected as being obvious over Levine and Vale. Appellants argue that there is no suggestion in either reference to combine their teachings. Appellants' argument is misplaced. Our reviewing court has noted that while there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or prior art specifically suggest making the combination (see B.F. Goodrich Co. v. Aircraft Braking Systems Corp., 72 F.3d 1577, 1583, 37 USPQ2d 1314, 1319 (Fed. Cir. 1996) and In re Nilssen, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988)) as the appellants would apparently have us believe. Rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Moreover, in

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evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). Here, one of ordinary skill in the art looking at the teachings of Levine and Vale would have been motivated to combine the two as one would have been interested in efficiently abstracting the indexing information from the various documents in the computer data bases and rearranging the documents in the various indices to make them conveniently available to the user of those documents. However, we agree with Appellants that Vale is concerned with the indexing of words in the documents in the data base. That is, Vale determines the page numbers of the documents where the keywords may be found and prepares the master indices. Nevertheless, in the process of preparing the indices, the word tables are created before the documents can be searched for the number of occurrences of the keywords in the documents, see Vale at column 1, lines 12 to 23. We note, however, that but for claims 8 to 10, 34 to 36 and 69, all the other claims under this heading have been rejected by the Examiner over Levine under 35 U.S.C. § 102 and that rejection has

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been sustained above except for claims 24 and 61. Since anticipation is the epitome of obviousness, we sustain the obviousness rejection of claims 1 to 6, 11 to 23, 25 to 30, 37 to 60, 62 to 68 and 70 to 80 over Levine and Vale. The obviousness rejection of 24 and 61 over Levine and Vale is not sustained as Vale does not cure the deficiency noted above in Levine in regard to these claims.

Regarding the rest of the claims, i.e., 8 to 10, 34 to 36 and 69, we present an explanation here even though Appellants have not discussed them individually. With respect to claim 8, Levine clearly shows that the documents are organized by using their word content, see for example column 25, line 25 to column 26, line 10 and figures 5a and 5b. Regarding claim 9, Levine would need a vector to determine the position of the words in the individual document relative to vectors representing the words in the collection, see the data structures created and the document organizing scheme in figure 5b. With respect to claim 10, the same explanation applies as for claim 8. Regarding claims 34 and 35, Levine discloses the treating of the multi-color documents for purposes similar to those for which the black and white documents are treated, see for example, column 23, line 26 to column 24, line 48. Regarding claim 36, the addition of a third

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document to the existing collection in Levine based on the internal representations of the third document and the collection has been discussed above, also see for example, column 13, lines 6 to 65, column 15, lines 4 to 20 and column 25, line 58 to column 26, line 28. Regarding claim 69, the claimed limitation is akin to Vale's technique of determining the number of times a keyword, i.e., a word or a group of words is used at least once in each of the documents in the computer data base. Thus, we will also sustain the obviousness rejection of claims 8 to 10, 34 to 36 and 69 over Levine and Vale.

Rejection of claims 81 to 86 under 35 U.S.C. § 103

These claims are rejected as being obvious over Nicol and Levine. We take up independent claim 81 first. We have reviewed the arguments of Appellants [brief, pages 31 to 34 and reply brief, page 2] and the Examiner [answer, pages 10, 11, 25 and 26, and supplemental answer, page 2] and we conclude that Levine shows the displaying of the top page of a document, which we have considered as an icon in our discussion here, alongside of the collection as the pointer is pointed to a document in the collection. We have discussed this at length above. Nicol on the other hand discloses the concept of icons representing various documents and/or software routines in a computer. No individual

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arguments have been presented for claims 82 and 83. Therefore, we sustain the obviousness rejection of claims 81 to 83 over Nicol and Levine. With respect to claim 84, it calls for "displaying in series a second indicia ... and a third indicia ... representation" (claim 84, lines 4 to 7). We have reviewed the Examiner's position [answer, page 11] and find that the Examiner has not established a prima facie case to reject this claim. Claims 85 and 86 depend on claim 84 and the Examiner has not presented any additional evidence for their rejection. Therefore, we do not sustain the obviousness rejection of claims 84 to 86 over Nicol and Levine.

Rejection of claims 31 to 33 under 35 U.S.C. § 103

These claims are rejected over Reed. We do not deal here with any procedural issues raised by Appellants in the utilization of this reference in the final rejection [brief, page 34 and 35]. We only review the merits of the final rejection based on Reed. We take up claim 31 first. We have reviewed the positions of Appellants [brief, pages 35 to 38] and the Examiner [answer, pages 12 to 13] and we conclude that whereas Reed shows the textual search as well as the pictorial search, see columns 17 and 18, it does not meet the limitation "displaying a graphical representation of said collection on said display

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device" (claim 31, lines 13 and 14). Reed makes a list of the documents found as a result of the search, but does not suggest the creation of a graphical collection of the documents. Claims 32 and 33 depend on claim 31 and contain at least the above limitation. Therefore, we do not sustain the obviousness rejection of claims 31 to 33 over Reed.

In summary, we have reversed the rejection of claims 81 to 86 as being vague and indefinite under 35 U.S.C. § 112, second paragraph. We have affirmed the Examiner's rejection under 35 U.S.C. § 102 as being anticipated by Levine with respect to claims 1 to 6, 11 to 23, 25 to 30, 37 to 60, 62 to 68 and 70 to 80, while we have reversed with respect to claims 24 and 61. We have also affirmed the Examiner's rejection under 35 U.S.C. § 103 as being obvious over Levine and Vale with respect to claims 1 to 6, 8 to 23, 25 to 30 and 34 to 60, 62 to 80, and reversed with respect to claims 24 and 61. We have further affirmed the Examiner's rejection as being obvious over Nicol and Levine under 35 U.S.C. § 103 with respect to claims 81 to 83, and reversed with respect to 84 to 86. We have also reversed the Examiner's rejection as being obvious over Reed under 35 U.S.C. § 103 as to claims 31 to 33. Accordingly, we affirm in part.

