

Application No. 08/287,108

Art Unit 2412

- 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

6. 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 such that

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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.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

7. 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 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.

8. 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.

- 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.

9. 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 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.

Response to Amendment

10. Applicant's arguments with respect to claims 1 to 6, 8 to 30 and 34 to 80 have been fully considered but they are not deemed to be persuasive.

Argument - Levine does not show an internal collective representation or a user defined specification for an aligned stack.

Response

Levine's internal collective representation based on internal representations of ... documents is shown fig. 5a and 5b. In particular, the portrayed data structure is internal by virtue of being internal to the system of fig. 1a. The structure is a collective representation by virtue of fig. 5a showing a linked list collecting representations of each document. Each document structure in fig. 4b portrays, i.e. is based on the document's type, i.e. its internal representation.

Although there is one total list shown in fig. 5a for the desktop, the list is doubly linked as shown in fig. 5a. Therefore each internal sequence of documents in the list forms a sublist so there are inherently multiple such sublists or representations. Further, the individual documents are grouped by use of staple or paper clip icons (col. 4 lines 41 to 62), so stapling documents creates a collection. Further, it would have been obvious to one of ordinary skill in the art at the time of the invention to have multiple such lists, one for each type of document since sorting by document type was notoriously well known in the art (operators needed to see all worksheets together, for example).

To the extent the document type field is external to the actual document, it nevertheless serves as an internal representation, internal to the system, and further, it would have been obvious to one of ordinary skill in the art at the time of the invention to base such a field on the actual internal contents of documents since it was notoriously well known at the time that document type was encoded in documents, e.g. worksheet, word processing and database files used the first words in the file to identify the document type and so an alternate well known means of identifying such type was to examine the leading words in such contents.

Argument - Levine does not show a base for documents or comparison of individual with collective representations

Response

Levine shows a base in fig. 2 to 4 where the desktop forms a base. Since the linked list in fig. 5a contains all contents in the desktop, the desktop forms a base for collection. Vale shows building document collections using indexes, which is inherently a comparison of an individual (document) with collective (index) representation. It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Vale's building document collections using indexes to Levine

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Art Unit 2412

because of the advantages taught by Vale of meta indexes for document collections.

Argument - There is no reason to combine Levine and Vale

Response

Both Vale and Levine teach methods of document aggregation using a graphical user interface. One of ordinary skill in the art at the time of the invention, upon referring to Levine would look to related art for similarly aggregating documents to determine what features in such an application would be important. Vale would be among such art found since Vale aggregates documents by means of index entries. In particular, Vale teaches the benefits of a metaindex for tracking multiple documents. This is directly analogous to Levine's linked list for tracking multiple documents. Vale teaches the virtues of incorporating verbal keys in such a tracking mechanism.

11. Applicant's arguments with respect to claim 31 to 33 and 81 to 86 has been considered but are deemed to be moot in view of the new grounds of rejection necessitated by amendment further limiting the nature of the cited sample.

Conclusion

Application No. 08/287,108

Art Unit 2412

12. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anton Fetting whose telephone number is (703) 305-8449. The examiner can normally be reached on Monday through Thursday from 6:45 AM to 5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 305-9701. The fax number for this Group is (703) 305-9564. The fax number for informal communications to this Art Unit is (703) 305-9724.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3800.

AWF *AWF*
6/7/95

-16-

Heather R. Herndon
HEATHER R. HERNDON
SUPERVISORY PATENT EXAMINER
GROUP 2400

TO SEPARATE, FOLD TOP AND BOTTOM EDGES, SNAP-APART AND DISCARD CARBON

FORM PTO-892 (REV. 2-92)		U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE		SERIAL NO. <i>08/287108</i>	GROUP/ART UNIT <i>2412</i>	ATTACHMENT TO PAPER NUMBER <i>18</i>		
NOTICE OF REFERENCES CITED				APPLICANT(S) <i>Mandar et al</i>				
U.S. PATENT DOCUMENTS								
*	DOCUMENT NO.	DATE	NAME	CLASS	SUB-CLASS	FILING DATE IF APPROPRIATE		
A	<i>5297249</i>	<i>3-22-94</i>	<i>Barnstein et al</i>	<i>395</i>	<i>156</i>	<i>10-31-90</i>		
B	<i>5287448</i>	<i>2-15-94</i>	<i>Nicol et al</i>	<i>395</i>	<i>759</i>	<i>5-4-89</i> <i>3-21-93</i>		
C	<i>5241671</i>	<i>8-31-93</i>	<i>Reed et al</i>	<i>395</i>	<i>600</i>	<i>10-26-89</i>		
D	<i>5021976</i>	<i>6-4-91</i>	<i>wexelblat et al</i>	<i>364</i>	<i>188</i>			
E								
F								
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H								
I								
J								
K								
FOREIGN PATENT DOCUMENTS								
*	DOCUMENT NO.	DATE	COUNTRY	NAME	CLASS	SUB-CLASS	PERTINENT SHTS. DWG.	PP. SPEC.
L								
M								
N								
O								
P								
Q								
OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)								
R	<i>Boylan, Quattro Pro User's Guide, 1989, p. 229, 235-236, 251-255, 275-286</i>							
S								
T								
U								
EXAMINER <i>Anton Fetting</i>		DATE <i>6-7-95</i>						
* A copy of this reference is not being furnished with this office action. (See Manual of Patent Examining Procedure, section 707.05 (a).)								



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2301

#19

11-20-95
MJC

007860.P624C

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

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

on October 12, 1995
 Date of Deposit

LESLIE D. ROGAN
 Name of Person Mailing Correspondence

Leslie D. Rogan 10/12/95
 Signature Date

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

PETITION FOR EXTENSION OF TIME
 PURSUANT TO 37 C.F.R. § 1.136 (a)

Sir:

Applicant respectfully requests a one-month extension of time to file a Response to the Final Office Action. The extended period expires on October 12, 1995.

A check in the amount of \$110.00 is enclosed to cover the fee for a one-month extension of time. If any additional fee is required, please charge Deposit Account No. 02-2666. A duplicate of this Petition is enclosed for deposit account charging purposes.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Dated: October 12, 1995

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 Keith G. Askoff
 Reg. No. 33,828

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 Seventh Floor
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110 MG 11/06/95 08287108

1 115 110.00 CK



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#20

11-20-95

Patent

MJC

Attorney's Docket No.: 04860.P624C

In the Application of: Richard Mander et al.

(inventor(s))

Serial No.: 08/287,108

Filed: August 8, 1994

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

(title)

Group Art Unit: 2412 Examiner: Fetting, A.

NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

THE COMMISSIONER OF PATENTS AND TRADEMARKS Washington, D.C. 20231

Sir:

Applicants hereby appeal to the Board of Patent Appeals and Interferences from the decision dated June 12, 1995 of the Examiner rejecting claims 1-6, 8-86.

The item(s) checked below are appropriate:

X The following is the Notice of Appeal fee under 37 C.F.R § 1.17(e):

X a. other than small entity: fee \$ 290.00

b. small entity: fee \$ 140.00

verified statement attached

verified statement was filed

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A petition under 37 C.F.R. § 1.136(a) for an extension of time for reply to the rejection is enclosed along with a check for the fee for the extension of time.

Enclosed is a check in the amount of \$ for the Notice of Appeal fee.

Please charge the Notice of Appeal fee to Deposit Account Number 02-2666. A duplicate of this sheet is enclosed for Deposit Account charging purposes.

X If any additional fee is required, please charge Deposit Account No. 02-2666. A duplicate of this sheet is enclosed for Deposit Account charging purposes.

BLAKELY SOKOLOFF TAYLOR & ZAFMAN

Date: October 12, 1995

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Keith G. Askoff

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on October 12, 1995 Date of Deposit

Leslie D. Rogan

Name of Person Mailing Correspondence

Handwritten signature of Leslie D. Rogan

Signature

10/12/95

Date

110 MG 11/06/95 08287108

1 119 290.00 CK



COPY

Attorney's Docket No.: 04860.P624C Patent

Re the Application of: Richard Mander et al. (inventor(s))

Serial No.: 08/287,108

Filed: August 8, 1994

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

Group Art Unit: 2412 Examiner: Fetting, A.

NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

THE COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Sir:

Applicants hereby appeal to the Board of Patent Appeals and Interferences from the decision dated June 12, 1995 of the Examiner rejecting claims 1-6, 8-86

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN

Date: October 12, 1995

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on October 12, 1995
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Leslie D. Rogan
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Leslie D. Rogan 10/12/95
Signature Date

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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: Fetting, A

Art Unit: 2412

#21
C.D.
3/20/96

INFORMATION DISCLOSURE STATEMENT

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

Sir:

Pursuant to 37 C.F.R. 1.97, Applicant hereby provides a listing on PTO Form 1449 of references and encloses a copy of the references cited on the above referenced form.

While this statement is being submitted as a means to comply with 37 CFR 1.97, it is not to be construed as an admission that the material identified above represents material prior art to Applicant's invention.

Very truly yours,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date: 2/22, 1996

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James C. Scheller, Jr.
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Cindy Murphy 2-22-96
Signature Date



Form PTO-1449 (REV. 8-83)	U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE	ATTY. DOCKET NO. 04860.P624C	SERIAL NO. 08/287,108
INFORMATION DISCLOSURE CITATION <i>(Use several sheets if necessary)</i>			
APPLICANT Richard Mander, et al.			
FILING DATE 08/08/94		GROUP 2412	

U.S. PATENT DOCUMENTS											
EXAMINER INITIAL	DOCUMENT NUMBER					DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE	
	5	4	4	2	7	8	08/15/95	Pedersen, et al.	395	600	11/12/91
	5	4	4	2	7	5	08/15/95	Levine, et al.	395	800	11/19/90

FOREIGN PATENT DOCUMENTS											
	DOCUMENT NUMBER					DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
										YES	NO

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)									

EXAMINER	DATE CONSIDERED
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*EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.



Attorney's Docket No.: 0048609.P624C

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Patent 04-02-96 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

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on March 12, 1996
Date of Deposit

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Leslie D. Rogan 3/12/96
Signature Date

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

PETITION FOR EXTENSION OF TIME
PURSUANT TO 37 C.F.R. § 1.136 (a)

Sir:

Applicant respectfully requests a three-month extension of time to file the Appeal Brief to the Notice of Appeal. The extended period expires on March 12, 1996.

A check in the amount of \$900.00 is enclosed to cover the fee for a three-month extension of time. If any additional fee is required, please charge Deposit Account No. 02-2666. A duplicate of this Petition is enclosed for deposit account charging purposes.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Dated: March 12, 1996

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MJC
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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

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)

Yes
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Examiner: A. Fetting

Art Unit: 2301

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on March 12, 1996
Date of Deposit

LESLIE D. ROGAN
Name of Person Mailing Correspondence

Leslie D. Rogan 3/12/96
Signature Date

APPEAL BRIEF
IN SUPPORT OF APPELLANTS' APPEAL
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Hon. Commissioner of
Patents and Trademarks
Washington, DC 20231

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COMM-FED
COMM-FED

Dear Sir:

The Appellants hereby submit this Brief in triplicate in support of their appeal from a final decision by the Examiner, mailed June 12, 1995, in the above-captioned case. The Appellants respectfully request consideration of this appeal by the Board of Patent Appeals and Interferences for allowance of the above-captioned patent application.

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1 120 290.00 BK

Serial No. 08/287,108
Examiner: A. Fetting

- 1 -

APPEAL BRIEF
Art Unit 2301

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D. REED FAILS TO RENDER CLAIMS 31-33 OBVIOUS.	34
E. CLAIMS 81-86 ARE SUFFICIENTLY DEFINITE FOR THE PURPOSES OF 35 U.S.C. § 112, SECOND PARAGRAPH.	38
VII. CONCLUSION	40
VIII. APPENDIX A	41

1 **I. REAL PARTY IN INTEREST**

2 The real party in interest is APPLE COMPUTER, INC., a corporation of
3 CALIFORNIA having a principle place of business at 1 Infinite Loop, Cupertino,
4 CA 95014.

5

6 **II. STATUS OF THE CLAIMS**

7 Claims 1-6 and 8-86 are currently pending. Claim 7 has been canceled.
8 Claims 1-6 and 8-86 currently stand rejected by the Examiner under the Final
9 Office Action mailed June 12, 1995.

10 Claims 81-86 stand rejected under 35 U.S.C. § 112, second paragraph, as
11 being indefinite for failing to particularly point out and distinctly claim the
12 subject matter which applicants regard as the invention.

13 Claims 1-6, 11-30, 37-68, and 70-80 stand rejected under 35 U.S.C. § 102(a)
14 and (e) as being anticipated by U.S. Patent No. 5,060,135, issued of Levine et al.
15 ("Levine").

16 Claims 1-6, 8-30, and 34-80 stand rejected under 35 U.S.C. § 103 as being
17 unpatentable in view of the combination of Levine and U.S. Patent No. 5,247,437,
18 issued of Vale et al. ("Vale").

19 Claims 81-86 stand rejected under 35 U.S.C. § 103 as being unpatentable in
20 view of the combination of Levine and U.S. Patent No. 5,287,448, issued of Nicol
21 et al. ("Nicol").

22 Claims 31-33 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S.
23 Patent No. 5,241,671, issued of Reed et al. ("Reed").

1 **III. SUMMARY OF INVENTION**

2 The claimed invention provides a method for organizing and displaying
3 information in a computer system that may be used as a substitute for traditional
4 flat file systems and hierarchical file systems. (Specification at pages 2-5). More
5 specifically, the claimed invention provides a method and apparatus for
6 organizing documents of the computer system into one or more collections or
7 "piles" of documents wherein each collection of documents is displayed using a
8 graphical representation such as an icon, and wherein a user may browse
9 individual documents of a collection of documents without removing the
10 documents from the collection. The claimed invention also provides an
11 apparatus that implements the novel method.

12 The act of organizing documents into a collection may be performed by a
13 user individually selecting documents for inclusion. (Specification at page 18,
14 line 16 to page 20, line 12; Figure 3 of the Drawings). Alternatively, the filing
15 system of the computer system can automatically create collections in view of the
16 similarity of documents based upon inherent characteristics of the documents or
17 user-defined criteria. (Specification at page 57, line 1 to page 60, line 15; Figures
18 17, 18a, and 18b of the Drawings).

19 The ability of the filing system to automatically organize documents into
20 collections is enabled, for one embodiment, through the use of internal
21 representations, such as vectors, associated with each document. (Specification,
22 page 49, line 22 to page 55, line 23; Figure 15 of the Drawings). An internal
23 representation is based on the contents of its associated document, and the filing
24 system may compute an internal representation by determining the frequency of
25 selected words within the document. (Specification at page 50, lines 15-23).
26 When a collection of documents is created, a collective internal representation
27 based on the internal representations of the documents of the collection is

1 created. (Specification, page 53, line 22 to page 54, line 7; Figure 15 of the
2 Drawings). The filing system can automatically create a collection of documents
3 by comparing the internal representation of a user-provided sample document to
4 other documents and collecting together those documents having a reasonable
5 degree of similarity. (Specification at page 58, line 26 to page 59, line 8; Figure 17
6 of the Drawings). Similarly, the filing system can determine whether a selected
7 document should be added to an existing collection by comparing the internal
8 representation of the selected document to the internal collective representation
9 of the collection. (Specification at page 57, line 1 to page 58, line 24; Figure 17 of
10 the Drawings).

11 According to an alternative embodiment, a collection of documents may
12 be created by comparing documents to a user defined specification such as a
13 script that includes a list of words or other criteria selected by the user.
14 (Specification, page 45, line 9 to page 49, line 20; Figure 14 of the Drawings).
15 Similarly, the filing system can determine whether a selected document should
16 be added to an existing collection by comparing the selected document to the
17 script. (Specification at page 59, lines 10-14; Figure 17 of the Drawings).

18 Another feature of the present invention is the manner in which a user is
19 allowed to browse through the documents in a pile. (Specification at page 20,
20 line 19 to page 28, line 18; Figures 4a-4m of the Drawings). For example, a user
21 may view an indicia of a document within a collection of documents--regardless
22 of the position of the document within the collection-- by pointing to a position
23 of the graphical representation for the collection that corresponds to the desired
24 document. For one embodiment, the graphical representation of a collection of
25 document comprises a "pile" of documents that is dynamically altered as
26 documents are added to or removed from the pile, and the icon for each
27 document in the pile may be selected by positioning the cursor over the icon in

1 the pile. (Specification at page 15, line 1 to page 16, line 9; Figures 4a-4e of the
2 Drawings). For an alternative embodiment, the graphical representation of the
3 pile does not change as documents are added to and removed from the
4 collection, and a document in the pile may be selected based on a mapping of the
5 height position of the cursor relative to the total height of the graphical
6 representation. (Specification at page 16, lines 10-18). A user may "ruffle"
7 through the documents of the pile and display indicia of the documents as the
8 user "ruffles" by moving the cursor from document to document within the pile.
9 (Specification at page 23, lines 7-16; Figure 4b of the Drawings).

10 For one embodiment, once a document of a pile is selected, an indicia of
11 the document is displayed while the graphical representation of the pile remains
12 displayed. (Specification at page 20, line 22 to page 21, line 7; Figures 4a-4b of
13 the Drawings). According to one embodiment, an indicia comprises a graphical
14 representation of the first page of a document that is related to the document's
15 position within the pile by a means for indicating position such as a view cone
16 having its apex pointing to the selected document. (Specification at page 21, lines
17 5-26; Figures 4b, 4c, and 4e of the Drawings). The indicia might alternatively
18 comprise information regarding the document that is relevant to the filing
19 system such as file size, date of creation, and application program used to create
20 the document. (Specification at page 22, lines 17-21; Figure 4e of the Drawings).

21 Several additional features are disclosed and claimed. These additional
22 features will be discussed in view of the prior art in the Argument section, below.

1 **IV. ISSUES**

2 The following issues are presented in this appeal:

- 3 A. Whether Levine anticipates claims 1-6, 11-30, 37-68, and 70-80;
- 4 B. Whether the combination of Levine and Vale renders claims 1-6, 8-
5 30, and 34-80 obvious;
- 6 C. Whether the combination of Levine and Nicol renders claims 81-86
7 obvious;
- 8 D. Whether Reed renders claims 31-33 obvious; and
- 9 E. Whether claims 81-86 are indefinite under 35 U.S.C. § 112, second
10 paragraph.
- 11

12 **V. GROUPING OF CLAIMS**

13 For the purposes of this appeal:

- 14 • Claims 66-67 stand or fall together as Claim Group 1;
- 15 • Claims 73-74 stand or fall together as Claim Group 2;
- 16 • Claims 31 and 33 stand or fall as Claim Group 3;
- 17 • Claims 80 and 4 stand or fall as Claim Group 4;
- 18 • Claim 63 stands or falls as Claim Group 5
- 19 • Claims 37-40, 42-44, 48-51, 53-58, 62, 64-65, and 68-69 stand or fall
20 together as Claim Group 6;
- 21 • Claim 79 stands or falls as Claim Group 7;
- 22 • Claim 61 stands or falls as Claim Group 8;
- 23 • Claims 78 and 36 stand or fall together as Claim Group 9;
- 24 • Claim 41 stands or falls as Claim Group 10;
- 25 • Claim 59 stands or falls as Claim Group 11;
- 26 • Claim 60 stands or falls as Claim Group 12;

- 1 • Claims 1-3, 5-6, 8-16, 28-30, 34-35, 70-72, and 75-77 stand or fall
- 2 together as Claim Group 13;
- 3 • Claim 45 stands or falls as Claim Group 14;
- 4 • Claim 17, 21-23, and 25-27 stand or fall as Claim Group 15;
- 5 • Claim 46 stands or falls as Claim Group 16;
- 6 • Claim 18 stands or falls as Claim Group 17;
- 7 • Claim 47 stands or falls as Claim Group 18;
- 8 • Claims 19-20 stand or fall together as Claim Group 19;
- 9 • Claim 52 stands or falls as Claim Group 20;
- 10 • Claim 24 stands or falls as Claim Group 21.
- 11 • Claim 81 stands or falls as Claim Group 22;
- 12 • Claim 82 stands or falls as Claim Group 23;
- 13 • Claim 83 stands or falls as Claim Group 24; and
- 14 • Claims 84-86 stand or fall together as Claim Group 25.
- 15 • Claims 32 stands or falls as Claim Group 26.
- 16
- 17

18 **VI. ARGUMENT**

19 As a preliminary matter, the Appellants submit that the examination of
20 the present utility patent application has been more akin to the examination of a
21 design patent application wherein the Examiner has compared the figures of the
22 cited references to the figures of the present application without regard to the
23 actual teachings of the references or the recited limitations of the claims.

24 To assist the Board in this appeal, the Appellants' arguments responding
25 to each of the prior art rejections are generally categorized as relating to either
26 the organizational or displaying aspect of the claimed invention.

27

1 **A. LEVINE FAILS TO ANTICIPATE THE CLAIMS.**

2 The Appellants submit that the Examiner's application of Levine to the
3 claims has completely ignored recited limitations that relate to the organizational
4 aspect of the invention. The Examiner has similarly ignored recited limitations
5 relating to the display and browsing of documents within a collection that are
6 not disclosed by Levine .

7
8 **1. ORGANIZATION**

9 As the Appellants have previously stated, Levine discloses nothing more
10 than a "dumb" stack of stamps which may be treated as a group. Levine
11 discloses that an aligned stack of stamps 70 may be formed by using a "touch and
12 move" operation to bring a first stamp within a predefined distance of a second
13 stamp. (Levine, col. 12, lines 25-44; Figure 3 of the Drawings). Larger stacks are
14 formed by a user performing multiple "touch and move" operations. (Levine,
15 col. 12, lines 25-28). Thus, any "organization" or relationship that the stamps of
16 an aligned stack may be said to have with one another is provided by the user
17 who creates the stack and this organization in Levine is limited to the manner in
18 which the icons are displayed.

19 The system disclosed by Levine does use a doubly linked list 92 for storing
20 the attributes of each data structure displayed in the desk view 32. (Levine, col.
21 25, lines 50-52; Figure 5a of the Drawings). Each object to be displayed in the
22 desk view thus has a corresponding entry 94 in the doubly linked list 92 of the
23 desk database. The desk application routine, in the process of displaying an
24 object, determines the attributes of the object to be manipulated in the desk view
25 by looking up the corresponding entry of linked list 92, and the desk application
26 routine manipulates the object as indicated by the requested process and the
27 attributes of the object's data structure. (Levine, cols. 25-29, Figures 5-7 of the

1 drawings.) While the data structure attributes stored in each entry 94 of the
2 linked list 92 may be said to "represent" the data structure indicated by the entry
3 94, each data structure is that of an object, such as an icon, to be displayed in the
4 desk view 32, and the data structure attributes in entry 94 is not described as
5 being based on the contents of the data structure indicated by the entry 94.
6 (Levine, cols. 25-26; Figures 5a, 5b, and 6 of the Drawings). Thus, any
7 "organization" to be found in the disclosure of linked list 92 of Levine relates only
8 to the manner in which icons are displayed.

9 Moreover Levine does not disclose any internal collective representation
10 for a collection of documents which is based on the internal representation of
11 documents in the collection. There is simply no collective representation for a
12 collection. Each representation in entry 94 is specific for a particular object and
13 not representative of a collection.

14

15 **a. LEVINE FAILS TO DISCLOSE THE FUNCTION OR STEP OF**
16 **DETERMINING AN INTERNAL COLLECTIVE**
17 **REPRESENTATION BASED ON AN INTERNAL**
18 **REPRESENTATION OF THE DOCUMENTS OF A COLLECTION**
19 **AS RECITED IN CLAIM 66.**

20 Claim 66 (Claim Group 1) recites the following limitations:

21 66. A computer filing system for organizing information in a computer system
22 having a processor, a bus, and memory for storing information including a plurality of
23 documents, said computer filing system comprising:

24 a display means for producing a display of graphical representations, said
25 display means coupled to said processor;

26 a cursor control means coupled to said processor, said cursor control means for
27 controlling the position of a cursor on said display;

28 a switch means for indicating a selection of an object displayed on said display,
29 said switch means coupled to said processor and having a first and a second
30 position;

1 a graphical representation of a first document and a graphical representation of a
2 second document, said cursor control means and said switch means being
3 used with said graphical representations of said first and said second
4 documents, which are displayed on said display means, to create a collection
5 of documents comprising said first and said second documents;

6 a means for creating a graphical representation of said collection of documents
7 comprising said first and said second document; and

8 a means for determining an internal collective representation of said collection,
9 said means for determining providing a collective representation based on an
10 internal representation of said first and said second documents.

11 The Examiner has asserted that Figures 5 and 6 of Levine disclose a
12 "means for determining . . . an internal collective representation based on the
13 internal representation" of the documents in a collection. The disclosure of
14 Levine reveals that the linked list 92 (shown in Figure 5) is manipulated by a
15 function (detailed in Figure 6) that stores entries regarding icons that are
16 displayed in the desk view 32. There is no disclosure in Levine that an entry 94
17 for an icon in the linked list 92 is based on the contents of the document
18 represented by the icon.

19 Moreover Levine does not disclose any internal collective representation
20 for a collection of documents which is based on the internal representation of
21 documents in the collection. There is simply no collective representation for a
22 collection. Each representation in entry 94 is specific for a particular object and
23 not representative of a collection.

24 Therefore, the linked list 92 and its component entries 94 do not disclose
25 the means for determining an internal collective representation, and Levine fails
26 to anticipate claim 66. Claim 67 depends from and incorporates the limitations of
27 claim 66.

1 **b. LEVINE FAILS TO DISCLOSE THE STEP OF DETERMINING AT**
2 **LEAST ONE OF AN INTERNAL COLLECTIVE**
3 **REPRESENTATION OR A USER DEFINED SPECIFICATION AS**
4 **RECITED IN CLAIM 73.**

5 Claim 73 (Claim Group 2) recites the following limitations:

6 73. A method for organizing information in a computer system having a display
7 device, said method comprising:

8 determining an internal representation of each document in a plurality of
9 documents, each said internal representation being based on the content of
10 the corresponding document;

11 creating a collection of documents comprising said plurality of documents;

12 determining at least one of a first internal collective representation or a first user
13 defined specification for said collection, said first internal collective
14 representation being based on said internal representation of each of said
15 plurality of documents; and

16 displaying a visual representation of said collection of documents.

17 The Appellants note that claim 73 recites a step of "determining an internal
18 representation for each document in a plurality of documents" and a step of
19 "determining at least one of a first internal collective representation or a first user
20 defined specification." Therefore, the above remarks made with respect to claim
21 66 also apply to claim 73 and are hereby incorporated by reference.

22 The Appellants also submit that Levine fails to disclose the option of
23 determining a "first user defined specification," and the Examiner has not
24 attempted to apply Levine to this additional limitation. The Appellants therefore
25 submit that claim 73 is not anticipated by Levine. Claim 74 depends from and
26 incorporates the limitations of claim 73

1 c. LEVINE FAILS TO DISCLOSE THE STEP OF THE COMPUTER
2 SYSTEM CREATING A COLLECTION OF DOCUMENTS AS
3 VARIOUSLY RECITED IN CLAIMS 31, 33, 80, 4, AND 63.

4 Claim 31 (Claim Group 3) recites the following limitations:
5

6 31. A method for organizing information in a computer filing system having
7 a display device and a first plurality of documents, said method comprising:
8

9 displaying at some time on said display device a graphical representation of a
10 first document;
11

12 said computer system creating a collection of documents comprising at least a
13 second document and said first document, wherein said step of creating a
14 collection comprises indicating to said computer system that a collection of
15 documents is to be created using said first document as a sample document
16 for said collection of document and wherein said computer system searches
17 said first plurality of documents based on said first document to find said
18 second document; and
19

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

21 Figure 6 of Levine, which the Examiner has asserted as disclosing claim
22 31, merely shows the process undertaken by a supervisor task 15 that is
23 responsible for maintaining the display of desk view 32. (Levine, col. 26, lines 28-
24 31). The "ADD DOCUMENT" box of Figure 6 of Levine appears to relate to
25 displaying a new icon and generating a corresponding entry for desk list 92
26 when a new document is added to the system desk. (Levine, col. 26, lines 32-59)

27 The ADD DOCUMENT function would appear to be performed only
28 when a new document is added to the desk view, not when a stamp representing
29 a document is added to a stack of stamps. This conclusion results from the
30 observation that a stamp must first exist for the stamp to be added to a stack of
31 stamps because stacks are created by positioning one stamp over another stamp.
32 (Levine, col. 12, lines 25-44). Therefore, contrary to the Examiner's implied
33 assertion, the ADD DOCUMENT function of supervisor task 15 is not disclosed
34 as organizing a plurality of documents into a collection of documents, and the
35 only method for forming a collection or stack of stamps disclosed by Levine is for

1 the user to perform multiple "touch and move" operations. Also, claim 31
2 requires that the computer system create the collection by using the first
3 document (which exists) to search for the second document (which exists) to
4 create the collection. This feature is totally absent from Levine. Thus, Levine
5 fails to anticipate claim 31 or claim 33.

6 Claim 80 (Claim Group 4), which ultimately depends from claim 73,
7 recites the following similar limitation:

8 80. A method as in claim 75 further comprising:
9 creating a plurality of collections of documents from said collection of documents
10 by comparing said internal representation of each of said documents in said
11 collection of documents with an internal collective representation for each of
12 said plurality of collections.

13 Claim 80 does not require the system to use a sample document and is
14 therefore separately patentable from the claims in Claim Group 3. Claim 4 of
15 Claim Group 4, which depends from claim 1, recites a similar limitation as claim
16 80 and is similarly not anticipated by Levine. Levine fails to disclose a
17 comparison of the internal representation of each of the documents in the
18 collection of documents with an internal collective representation of each
19 collection. Furthermore, Levine fails to disclose creating a plurality of collections
20 of documents from a collection of documents in the manner claimed.

21 Claim 63 (Claim Group 5), which ultimately depends from claim 37,
22 recites the following similar limitation:

23 63. A method as in claim 38 further comprising creating a plurality of collections of
24 documents from said collection of documents by comparing an internal representation
25 maintained by said computer system for each document in said collection with an
26 internal representation created by said computer system for each of said collections of
27 documents.

28 Claim 63 is patentable at least for the same reasons given for claim 80 (in
29 Claim Group 4) above. Claim 63 also incorporates the limitations of claim 37 and
30 is patentable also for the reasons given for claim 37. For the reasons discussed in

1 the immediately following section, claim 37 recites an additional limitation that is
2 not recited or incorporated by claims 4 and 80. Therefore, claim 63 recites a
3 distinct combination of elements from Claim Groups 3 and 4 and is separately
4 patentable for this reason.

5

6 **d. LEVINE FAILS TO DISCLOSE THE STEP OF DETERMINING A**
7 **FURTHER INTERNAL COLLECTIVE REPRESENTATION WHEN**
8 **A NEW DOCUMENT IS ADDED TO AN EXISTING COLLECTION**
9 **OF DOCUMENTS AS RECITED IN CLAIMS 37 AND 79.**

10 Claim 37 (Claim Group 6) recites the following limitations:

11 37. A method for organizing information in a computer system having a display
12 device, said method comprising:

13 displaying at some time on said display device a representation of a first
14 document and a representation of a second document;

15 creating a collection of documents comprising said first and said second
16 documents;

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

21 displaying a graphical representation of said collection of documents; and

22 determining a further internal representation of said collection when a third
23 document is added to said collection based on one of: (a) an internal
24 representation of each of the documents in said collection, or (b) said first or
25 a second user defined specification.

26 Claim 37 recites limitations that are similar to those of claim 73, and the
27 arguments relating to claim 73 are hereby incorporated by reference. Claim 37
28 recites the further limitation of "determining a further internal representation" of
29 a collection of documents when a new document is added. The Examiner has not
30 specifically addressed claim 37 except to say that "adding a third document is

1 shown inherently by operation of flow charts in Figures 6 and 7" of Levine.
2 (Final Office Action, page 6).

3 The Appellants note that the flow charts of Figures 6 and 7 of Levine relate
4 to a program that manages the display of a desktop metaphor and a program
5 that manages a user's manipulation of displayed objects, respectively. As stated
6 previously, the addition of documents shown in Figure 6 relates to the addition
7 of documents to the desk view, not to the addition of a stamp to a stack of
8 stamps. However, whether or not Levine shows that a third document may be
9 added to a stack of stamps is irrelevant. What is relevant is that Levine does not
10 show the use of a collective internal representation for a collection of documents
11 based on the internal representations of the documents, which means that Levine
12 cannot show the determination of a further internal representation for the
13 collection when a new document is added to a stack of stamps.

14 Claim 79 (Claim Group 7), which ultimately depends from claim 73,
15 includes the following similar limitation:

16 79. A method as in claim 78 wherein said computer system adds said further
17 document to said collection of documents and further comprising:

18 determining a further internal collective representation of said collection, said
19 further internal collective representation being based on said internal
20 representation of each of said documents in said collection.

21 Claim 79 ultimately depends from claim 73 but also incorporates the
22 limitations of claims 75 and 78. Claim 78 recites an additional limitation (where
23 the computer system adds the further document) over claim 37 which the
24 Appellants believe further distinguishes over Levine, and claim 79 therefore
25 recites a different combination of elements than claim 37.

1 e. LEVINE FAILS TO DISCLOSE THE STEP OF THE COMPUTER
2 SYSTEM INDICATING TO THE USER THAT A DOCUMENT
3 SELECTED FOR ADDITION TO A COLLECTION OF
4 DOCUMENTS HAS AN INTERNAL REPRESENTATION THAT
5 DOES NOT MATCH THE INTERNAL COLLECTIVE
6 REPRESENTATION OF THE COLLECTION AS RECITED IN
7 CLAIMS 61, 36, AND 78.

8 Claim 61 (Claim Group 8), which ultimately depends from claim 37,
9 recites the following limitations:

10 61. A method as in claim 38 wherein said further internal representation of said
11 collection is one of said first and second user defined specifications defining a selected
12 user defined specification and wherein the user indicates to said computer system to add
13 a fourth item to said collection, which fourth item has an internal representation which
14 does not match said selected user defined specification, and wherein, after the user has
15 indicated to add said fourth item to said collection, said computer system prompts the
16 user to determine whether the fourth item is to be added to said collection without
17 modifying said selected user defined specification or the fourth item is to be added and
18 said selected user defined specification is to be modified.

19 The Examiner has stated that the step of claim 61 "is shown by the
20 portrayal of multiple collections in fig 2 and 4 and the query decision blocks in
21 the process flows of fig. 6 and 7." (Final Office Action, page 7). Appellants
22 strongly disagree with the Examiner's application of Levine to claim 61. First,
23 there is no disclosure to be found anywhere in Levine that a user will be
24 prevented from stacking a stamp for any reason, or that a user will be prompted
25 to verify the addition of a stamp to a stack of stamps. Second, the Examiner's
26 assertion regarding the query decision blocks of Figures 6 and 7 of Levine
27 completely ignores the text shown within the query decision blocks and the
28 corresponding sections of the detailed description. In summary, 1) Levine
29 simply does not disclose the use of a "user defined specification" as claimed, 2)
30 none of the query decision blocks of Levine specify comparing the internal

1 representation of a document to the user defined specification, and 3) there is no
2 process block of Levine that shows the actions specified by claim 61.

3 Claim 78 (Claim Group 9), which ultimately depends from claim 73,
4 recites the following similar limitation as claim 61:

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

10 The Examiner has stated that the step of claim 78 is shown by Figure 6 of
11 Levine, which allegedly shows that "similarity of document application is used
12 for addition criteria." (Final Office Action, page 4). Appellants disagree. Figure
13 6 of Levine does show a decisional block that determines whether a queue entry
14 is a document or an application, but the outcome of the determination is how to
15 proceed, i.e. whether to add a document or to install an application, not whether
16 adding the document or installing application is an acceptable task.
17 Furthermore, as previously stated, Levine does not show the use of internal
18 representations or internal collective representations. Therefore, Levine does not
19 anticipate claim 78.

20 Claim 78, which depends from claim 75, does not recite or incorporate the
21 limitation of determining further collective internal representations that is
22 incorporated into claim 61. Thus, claim 78 is patentable separately from claim 61
23 of Claim Group 8. Claim 36 recites and incorporates a similar combination of
24 elements as claim 78.

1 **f. LEVINE FAILS TO DISCLOSE THAT THE INTERNAL**
2 **REPRESENTATIONS OF DOCUMENTS ARE USED TO**
3 **DETERMINE RELEVANCY COMPARISONS BETWEEN A**
4 **DOCUMENT AND A COLLECTION OF DOCUMENTS AS**
5 **RECITED IN CLAIM 41.**

6 Claim 41 (Claim Group 10), which ultimately depends from claim 37,
7 recites the following limitation:

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

11 Again, Levine does not disclose the use of internal representations, and
12 the flow charts of Figures 6 and 7 of Levine do not disclose relevancy
13 comparisons as asserted by the Examiner. Therefore, Levine fails to disclose the
14 limitation recited by claim 41 wherein the internal representation of the
15 document are used for relevancy comparisons.

16
17 **g. LEVINE FAILS TO DISCLOSE THE STEP OF THE COMPUTER**
18 **SYSTEM ADDING NEW DOCUMENTS TO A COLLECTION**
19 **BASED ON A USER DEFINED SPECIFICATION AS RECITED IN**
20 **CLAIM 59.**

21 Claim 59 (Claim Group 11), which ultimately depends from claim 37,
22 recites the following limitation:

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

26 Levine discloses that only the user can add or remove stamps from a stack
27 of stamps, and Levine fails to disclose the use of user defined specifications.
28 Therefore, Levine fails to disclose the limitation of claim 59 wherein the

1 computer system adds new documents to a collection on the basis of a user
2 defined specification.

3

4 **h. LEVINE FAILS TO DISCLOSE THE STEP OF THE COMPUTER**
5 **SYSTEM ADDING NEW DOCUMENTS TO A COLLECTION**
6 **BASED ON A COMPARISON BETWEEN THE INTERNAL**
7 **REPRESENTATION OF A DOCUMENT AND A USER DEFINED**
8 **SPECIFICATION AS RECITED IN CLAIM 60.**

9 Claim 60 (Claim group 12), which ultimately depends from claim 37,
10 recites the following limitation:

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

14 Levine discloses that only the user can add or remove stamps from a stack
15 of stamps. Therefore, Levine fails to disclose the limitation of claim 60 wherein
16 the computer system adds new documents to a collection on the basis of a
17 comparison between of a comparison between the internal representation of each
18 new document and user defined specification.

19

20 **2. DISPLAY**

21 Levine discloses the display of stamps (icons) that are reduced images of
22 the documents that they represent. (Levine, col. 8, lines 23-26). As previously
23 described, the stamps may be stacked, and Levine discloses that selecting an
24 individual stamp or the top stamp of a stack causes the document represented by
25 the stamp to be displayed so that the user may annotate the document. (Levine,
26 cols. 11 and 12). Thus, Levine discloses that a stamp may be used to invoke the
27 document that the stamp represents. Furthermore, Levine discloses that the top

1 stamp of a stack may be a miniaturized image of a page of the document
2 represented by the stamp. (Levine, col. 11, lines 28-60).

3

4 a. LEVINE FAILS TO DISCLOSE THE STEP OF VIEWING AN
5 INDICIA OF A DOCUMENT IN RESPONSE TO SELECTING A
6 DOCUMENT FROM THE GRAPHICAL REPRESENTATION OF
7 THE COLLECTION OF DOCUMENTS AS RECITED IN CLAIM 1.

8 Claim 1 (Claim Group 13) recites the following limitations.

9

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

12

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

16

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

19

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

24

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

27

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

31 The Appellants note that claim 1, like claim 73, explicitly recites the
32 organizational limitation of determining one of an internal collective
33 representation or a user defined specification. Therefore, the arguments made
34 with respect to claim 73 apply equally to claim 1.

35 Claim 1 recites the further limitation that an indicia of a document is
36 viewed by selecting the document from the graphical representation of the
37 collection of documents. Examiner Fetting has paraphrased the recited limitation
38 as being "viewing a document among multiple documents in a collection." (Final

1 Office Action, at page 5). The Appellants submit that the Examiner has
2 improperly ignored the fact that claim 1 requires that the indicia is displayed in
3 response to selecting a document from a collection of documents.

4 Levine discloses that only the top stamp of a stack is displayed as a
5 miniaturized image of its corresponding document. Furthermore, the display of
6 the top stamp as a miniaturized image is automatic, not selected. Levine does
7 disclose that the top stamp--and only the top stamp-- of a stack may be displayed
8 and annotated (Levine, col. 11, lines 50-60 and col. 12, lines 30-40), but Appellants
9 submit that the display of the top stamp results in the actual document being
10 displayed by invoking the application which created the document, not in the
11 display of an indicia of the document by the filing system. That is, Levine
12 generates a full screen view of the document by launching the application which
13 created the document. That is why Levine can allow annotation of the
14 document. This is radically different than the display of an indicia as claimed.
15 An indicia merely "indicates" the document and is not itself the "live" document
16 in the application which created it. Therefore, Levine fails to disclose the display
17 of an indicia (without invoking the application which created the document) in
18 response to selecting a document from a collection of documents.

19 Claim 32 of Claim Group 26 is patentable at least for the reasons given for
20 Claim Group 3 above because claim 32 depends on claim 31. Moreover, claim 32
21 is also patentable as it includes a limitation relating to displaying an indicia of a
22 document in the collection by selecting the document. Thus, for the reasons
23 provided for Claim Group 13, claim 32 is patentable because Levine fails to
24 disclose displaying an indicia by selecting the document in the collection.

1 **b. LEVINE FAILS TO DISCLOSE THE STEP OF VIEWING A**
2 **DOCUMENT BY POSITIONING A CURSOR ON THE**
3 **GRAPHICAL REPRESENTATION OF A COLLECTION OF**
4 **DOCUMENTS TO REVEAL AN INDICIA OF THE DOCUMENT**
5 **AS RECITED IN CLAIMS 45 AND 17.**

6 Claim 45 (Claim Group 14), which ultimately depends from claim 37,
7 recites the following limitation:

8
9 45. A method as in claim 38 further comprising viewing at least one of the
10 documents in said collection by positioning a cursor provided by said computer system
11 on said display device on a graphical representation of said at least one document in said
12 collection for a predetermined period of time to reveal an indicia of said document in
13 said collection.
14

15 Levine discloses that a miniaturized image of the top stamp of a stack of
16 stamps is automatically displayed, and the miniaturized image is therefore not
17 selected for display. Levine also discloses that the full screen view of the
18 document represented by the top stamp is selected by a "touch and move"
19 operation, not by placing a cursor on the graphical representation of the
20 document for a predetermined period of time. Therefore, claim 45 is not
21 anticipated by Levine. Claim 45 is also patentable for those reasons provided for
22 claims in Claim Group 6.

23 Claim 17 (Claim Group 15), which depends from claim 1, recites the
24 following similar limitation as claim 45:

25
26 17. A method as in claim 1 wherein said step of viewing comprises pointing a cursor
27 on said display device at a graphical representation of one of said documents in said
28 collection for a predetermined period of time to reveal an indicia of said document in
29 said collection.
30

31 Claim 17 incorporates the limitations of claim 1 and therefore recites a
32 different combination of elements than claim 45. Both claim 45 and claim 17
33 incorporate the organizational limitations of their base claims, and the above

1 arguments regarding the organizational limitations apply equally to claims 17
2 and 45.

3

4 **c. LEVINE FAILS TO DISCLOSE THE STEP OF CONCURRENTLY**
5 **DISPLAYING AN INDICIA OF A DOCUMENT WITHIN A**
6 **COLLECTION AND A GRAPHICAL ICONIC REPRESENTATION**
7 **OF THE COLLECTION OF DOCUMENTS AS RECITED IN**
8 **CLAIMS 46 AND 18.**

9 Claim 46 (Claim Group 16) recites the following limitation:

10

11 46. A method as in claim 45 wherein said graphical representation of said collection
12 is displayed on said display device while said indicia is displayed on said display device
13 and wherein said indicia is a graphical representation of said document.

14

15 Claim 46 incorporates the organizational limitations of claim 37, which are
16 detailed above. Therefore, the arguments made with respect to claim 37 apply
17 equally to claim 46.

18 Appellants submit that Levine cannot disclose claim 46, which recites that
19 the indicia of the selected document and the graphical representation of the
20 collection are concurrently displayed. The so-called "full screen" view of Levine
21 clearly prevents the stack of stamps from being concurrently displayed.

22 Claim 18 (Claim Group 17), which ultimately depends from claim 1,
23 recites the following similar limitation as claim 18:

24

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

27

28 Claim 18 incorporates the organizational limitations of claim 1, which are
29 detailed above. Therefore, claim 18 recites a distinct combination from that of
30 claim 46. Claim 18 is patentable for the reasons provided for claim 1 and also for
31 the reasons provided for claim 46 above.

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d. 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 WHEN THE INDICIA OF THE DOCUMENT IS DISPLAYED AS RECITED IN CLAIMS 47 AND 19.

Claim 47 (Claim Group 18), which ultimately depends from claim 37, recites the following limitation:

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

Levine discloses that only the top stamp of a stack of stamps has a miniaturized image, and there is no need to relate the image to the position of the stack because it is always on top. Furthermore, when the document represented by the top stamp of a stack of stamps is displayed on the full-screen for annotation (after launching the application which created the document), there is no stack icon being displayed. Therefore, Levine fails to disclose claim 47. Claim 47 is also patentable for the reasons given relative to Claim Group 6.

Claim 19 (Claim Group 19), which depends from claim 1, recites the following similar limitation as claim 47:

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

Claim 19 incorporates the limitations of claim 1 and therefore recites a different combination of elements than claim 47. However, the arguments concerning Claim Group 18 also apply to Claim Group 19. Both claim 47 and claim 19 incorporate the organizational limitations of their base claims, and the

1 above arguments regarding the organizational limitations apply equally to
2 claims 47 and 19.

3

4 **e. LEVINE FAILS TO DISCLOSE THE STEP OF SELECTING A**
5 **SELECTIVE VIEWING MODE AS RECITED IN CLAIM 52.**

6 Claim 52 (Claim Group 20), which ultimately depends from claim 37,
7 recites the following limitation:

8

9 52. A method as in claim 45 further comprising selecting a selective viewing mode
10 such that only a user specified type of document is selected for viewing wherein only
11 indicia for said user specified type of document is displayed when viewing documents in
12 said collection during said selective viewing mode.
13

14 As stated previously, Levine fails to disclose a user specified type of
15 document or selecting such a document. Furthermore, Levine discloses that the
16 miniaturized image of the top stamp is automatically displayed and that only the
17 top stamp of a stack of stamps may be selected for viewing. Levine does not
18 disclose any limitations on the ability to view only selected documents.
19 Therefore, Levine fails to anticipate claim 52.

20

21 **f. LEVINE FAILS TO DISCLOSE THAT THE INDICIA OF THE**
22 **DOCUMENT SELECTED FOR DISPLAY HAS MULTIPLE PAGES**
23 **THAT THE USER MAY VIEW AS RECITED IN CLAIM 24.**

24 Claim 24 (Claim Group 21), which ultimately depends from claim 1,
25 recites the following limitation:

26

27 24. A method as in claim 17 wherein said indicia has multiple pages for a multiple
28 page document and wherein the user views the multiple pages of said indicia by
29 signaling to the computer to move from page to page of said indicia.
30

31 Levine discloses that the miniaturized image is only of a single page of the
32 represented document. (Levine, col. 3, lines 49-51). Furthermore, Appellants

1 submit that the full-screen view of the document is the live, annotatable
2 document itself as it exists with the application which created it having been
3 launched and running; this is not an indicia. Therefore, claim 24 is not
4 anticipated by Levine.

5 **B THE COMBINATION OF VALE AND LEVINE FAILS TO RENDER THE**
6 **PENDING CLAIMS THE OBVIOUS.**

7 Claims 1-6 and 8-80 are rejected as obvious in view of the combination of
8 Levine and Vale. Applicants submit that the claims are not obvious in view of
9 the Examiner's combination of the cited references.

10 In making the combination of Vale and Levine, the Examiner first
11 interpreted the claim element "internal collective representation" to mean "word
12 tables." The Examiner then asserted that Vale discloses the use of "word tables"
13 as an internal collective representation "for the purpose of aggregating
14 documents based on word content." (Final Office Action, page 9). The
15 Appellants disagree.

16 Vale discloses a method for managing index entries during the creation,
17 revision, and assembly of a document. (Vale, the Abstract). The type of "index"
18 referred to by Vale includes keywords and the page numbers of the document
19 wherein each keyword may be found. (Vale, col. 1). Vale discloses "master"
20 indices, each of which may contain index entries from multiple documents.
21 (Vale, col. 4; Figure 7 of the Drawings). Figure 7 of Vale clearly shows that each
22 index is itself a separate document.

23 Because the indices taught by Vale-- including the master indices-- are
24 themselves documents that merely indicate to a user where entries and sub-
25 entries may be found in a document or documents, Vale fails to disclose the use
26 of "word tables for the collective internal representation in an analogous art for

1 aggregating documents based on word content," as asserted by the Examiner. As
2 stated above, Levine also fails to disclose the use of internal representations, and
3 the Examiner has not asserted Vale as teaching any of the display-related
4 limitations. Therefore, because the combination of Vale and Levine fails to
5 disclose, teach, or suggest each of the recited limitation of claims 1-6 and 8-80,
6 claims 1-6 and 8-80 are not obvious in view of the combination of Vale and
7 Levine.

8 Appellants further submit that the Examiner's combination of Levine and
9 Vale is a result of impermissible hindsight wherein the Examiner has ignored
10 both the teachings of the prior art and relevant limitations recited by the claims.
11 It is well settled in patent law that there must be something in the prior art as a
12 whole to provide the motivation for, or suggest the desirability of, making the
13 combination arrived at by the Examiner. See, for example, Fromson v. Advanced
14 Offset Plate, Inc., 225 U.S.P.Q. 26, 31 (Fed.Cir. 1985). Of course, it has been held
15 that a judgment on obviousness may necessarily be a reconstruction based on
16 hindsight reasoning. In re McLaughlin, 170 U.S.P.Q. 209 (C.C.P.A. 1971).

17 However it is also well settled that:

18
19 It is impermissible within the framework of §103 to pick and choose from
20 any one reference only so much of it as will support a given position, to
21 the exclusion of other parts necessary to the full appreciation of what such
22 a reference fairly suggests to one of ordinary skill in the art.

23 In re Wasselau, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965).

24 As previously discussed, any "organization" of the stamps taught by
25 Levine is provided by the user based on a series of "touch and move" steps.
26 Furthermore, Vale teaches an index having contents that merely reflect the
27 location of selected key words in one or more documents, and any documents
28 that form the basis of the index are not themselves formed into a collection of
29 documents by the index. As neither reference discloses methods for

1 automatically creating collections of documents, neither reference suggests the
2 use of internal representations or user defined specifications to reflect and/or to
3 organize a collection of documents. Furthermore, Vale fails to provide any
4 additional disclosure relating to the display of indicia, and Appellants submit
5 that Levine alone fails to teach or suggest the display-related limitations.
6

7 **C. THE COMBINATION OF NICOL AND LEVINE FAILS TO RENDER THE**
8 **CLAIMS 81-86 OBVIOUS.**

9 Nicol relates to a method and apparatus for providing help information to
10 users of computers. More specifically, Nicol discloses a "balloon" help function
11 that enables a user to cause a bubble containing help information regarding an
12 icon to be displayed by using a cursor to point to the icon. (Nicol, the Abstract;
13 Figure 2 of the Drawings).

14 Contrary to the Examiner's assertions,
15

- 16 • Figure 2 of Nicol is not a graphical representation of a collection of
17 documents, but a representative display of an application program
18 that includes a number of icons;
19
- 20 • the icons do not represent documents, but functions or commands
21 that may be performed by the application program; and
22
- 23 • the "bubble" displayed is not an indicia of a document, but help
24 information regarding the function that may be selected by
25 selecting the icon.
26

1 The Examiner does admit that Nicol fails to disclose a collection of
2 documents. Therefore, the Appellants question how the Examiner can possibly
3 maintain that Nicol shows a graphical iconic representation of a collection of
4 documents? Without the teaching or suggestion of a collection of documents,
5 Nicol as applied to claims 81-86 can only be said to fairly suggest the general
6 concept of a graphical user interface wherein information regarding an icon may
7 be retrieved by pointing a cursor at the icon. The Examiner has explained that
8 Levine provides the missing link, that Levine teaches a graphical iconic
9 representation of a collection of documents such that the combination of Levine
10 and Nicol therefore claim 81 obvious. The Appellants strongly disagree.

11 Claim 81 (Claim Group 22) recites the following limitations:
12

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

16 displaying a graphical iconic representation of a collection of said first plurality
17 of documents;
18

19 displaying a first indicia of a first document of said collection by selecting a first
20 position from said graphical iconic representation, said first indicia of said
21 first document being selected for display regardless of said first position on
22 said graphical iconic representation.
23
24

25 Levine discloses that only the top stamp of a stack is displayed as a
26 miniaturized image of its corresponding document. Furthermore, the display of
27 the top stamp as a miniaturized image is automatic, not selected. Levine does
28 disclose that the top stamp--and only the top stamp-- of a stack may be displayed
29 and annotated (Levine, col. 11, lines 50-60 and col. 12, lines 30-40), but Appellants
30 submit that the display of the top stamp results in the actual "live" document
31 being displayed by invoking (launching and running) the application which
32 created the document, not in the display of an indicia of the document.
33 Appellants refer also to the discussion above concerning Claim Group 13, which

1 also explains the difference between an indicia and the actual "live" document
2 (supported in the running application). Moreover, Levine completely fails to
3 disclose the claim limitation that an indicia may be selected by "selecting a first
4 position from" the icon of the collection, where the indicia is selected for display
5 regardless of the first position on the icon. That is, the first position does not
6 have to be on the top of the stack of stamps and an indicia of a document may be
7 selected regardless of the first position on the icon. Therefore, Levine fails to
8 disclose the display of an indicia in response to selecting a document from a
9 collection of documents, regardless of the position of the first position (e.g. the
10 cursor's position) on the graphical iconic representation of the collection of
11 documents.

12 Nicol discloses that help information may be displayed for an on-screen
13 graphic item such as an icon. (Nicol, Fig. 4). The icons represent functions, not
14 documents, and the help information explains the function performed when the
15 icon is selected. (Nicol. col. 2, lines 15-31). Thus, Appellants submit that the help
16 information is not equivalent to the recited "indicia" as the icons are not
17 documents. As the combination of Nicol and Levine fails to disclose, teach, or
18 suggest all of the limitations of claim 81, claim 81 is not obvious.

19 Assuming for the sake of argument that the help information of Nicol is
20 equivalent to the recited "indicia," the combination of Levine and Nicol still does
21 not render claim 81 obvious. Levine discloses that the stack of stamps 70 is
22 displayed and manipulated as a single graphical object. (Levine, col. 12, lines 45-
23 48). Nicol discloses the provision of help information when a graphical object is
24 selected, but Nicol does not disclose that a different help message will be
25 displayed depending upon which portion of the graphical object is selected.
26 Therefore, the combination of Levine and Nicol results in the display of help
27 information regarding a stack of stamps when the stack of stamps is selected, and

1 the provision of separate help messages for each stamp within the stack is not
2 taught or suggested.

3 Claim 82 in Claim Group 23 is separately patentable from claim 81 for the
4 reasons provided for Claim Group 16. Thus, the arguments presented above for
5 Claim Group 16 also apply to claim 82. Claim 82 is also patentable for the
6 reasons specified for claim 81.

7 Claim 83 is separately patentable from claim 81 because claim 83 requires
8 that the indicia be displayed adjacent to the icon of the collection. This limitation
9 cannot exist in Levine because Levine teaches a full screen view.

10 Claims 84-86 in Claim Group 25 clearly point out the insufficiency of the
11 art. These claims require the display of a series of indicia, including a second
12 indicia and a third indicia by positioning the cursor on a second and third
13 position respectively. Levine fails to disclose this feature as well as the
14 concurrent feature of claim 85.

15

16 **D. REED FAILS TO RENDER CLAIMS 31-33 OBVIOUS.**

17 With respect to rejection of claim 31-33 in view of Reed, Appellants note
18 that the Examiner first made the rejection in view of Reed in the Final Office
19 Action. The Appellants further note that the Examiner's explanation of the new
20 rejection does not rely upon or specifically respond to any amendments found in
21 the Amendment of April 14, 1995, and the Appellants question the Examiner's
22 assertion that the Appellants' amendments necessitated the new grounds of
23 rejection. In fact, the Appellants submit that the rejection of claims 31-33 in view
24 of Reed is a classic example of piecemeal examination, which is strongly
25 discouraged by the MPEP § 707.07(g).