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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte YEN-FU CHEN and RAYMOND TANG WANG

Appeal 2010-004952
Application 10/427,378
Technology Center 2100

Before JOSEPH F. RUGGIERO, SCOTT R. BOALICK,
and BRUCE R. WINSOR, *Administrative Patent Judges*.

WINSOR, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1-12. Claims 13-34 are withdrawn from consideration. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse and institute a new ground of rejection within the provisions of 37 C.F.R. § 41.50(b).

STATEMENT OF THE CASE

Appellants' invention relates to the manipulation of data on a graphical user interface, more specifically, making multiple selections, sorting menu items, and recalling selected menu items from a drop down menu in a windows or similar environment. Spec. 1:6-9. Claim 1, which is illustrative of the invention, reads as follows:

1. A method for organizing a plurality of menu items in a drop down menu displayed by a computer comprising:
responsive to a user positioning a pointer over a down button and taking no other action, sorting a plurality of menu items on the drop down menu.

The Examiner relies on the following prior art in rejecting the claims:

Kavanagh	US 5,838,965	Nov. 17, 1998
Smith	US 6,188,407 B1	Feb. 13, 2001
Huynh	US 2002/0198909 A1	Dec. 26, 2002
Toivonen	US 2007/0033275 A1	Feb. 8, 2007

(PCT Filed Mar. 7, 2003)

Claims 1, 2, 7, and 8 stand rejected under 35 U.S.C. § 102(e) as anticipated by Huynh. Ans. 3-4.

Claims 3 and 9 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Huynh and Toivonen. Ans. 4.

Claims 4, 5, 10, and 11 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Huynh and Kavanagh. Ans. 5-6.

Claims 6 and 12 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Huynh and Smith. Ans. 6-7.

Rather than repeat the arguments here, we refer to the Briefs (App. Br. filed Jun. 17, 2009; Reply Br. filed Dec. 3, 2009) and the Examiner's Answer mailed Oct. 05, 2009 (Ans.) for the respective positions of Appellants and the Examiner.

ISSUE

The pivotal issue raised by Appellants' contentions is as follows:

Does Huynh disclose "sorting a plurality of menu items on the drop down menu" as recited in claim 1?

FINDINGS OF FACT (FF)

The following enumerated Findings of Fact (FF) are supported by a preponderance of the evidence.

Huynh

FF 1 Huynh teaches that when a user hovers a cursor over a string 410 associated with a semantic category 400 a drop down menu 405 is displayed. Huynh Fig. 4A; ¶¶ [0133]-[0134].

FF 2 Huynh teaches that when a user hovers a cursor over a media object 610 associated with a semantic category 600 a drop down menu 605 is displayed. Huynh Fig. 6A; ¶¶ [0139]-[0140], [0144].

FF 3 Huynh teaches that the drop down menus 405, 605 display a list of actions associated with the semantic categories 400, 600. Huynh Figs. 4A, 6A; ¶¶ [0134], [0140], [0144].

FF 4 Huynh teaches a media object 610 that has incorporated within it a down arrow icon 615. Huynh Fig. 6A; ¶ [139].

Toivonen

FF 5 Toivonen teaches a recommendations menu listing ranked sites sorted in decreasing frequency count order. Toivonen Fig. 6; ¶ [0084]; *see also* Fig. 7; ¶ [0087].

FF 6 Toivonen teaches that as a response to a specific user initiated command subpage links are displayed according to frequency count and other preferred sorting rules. Toivonen ¶ [0086].

FF 7 Toivonen teaches that the sorted subpage link is established in response to a specific user initiated command by automatically traversing through the accessed page by control logic in order to find the existing subpage links, which are compared to links in storage, and establishing the subpage list based on the retrieved frequency counts. *Id.*

Appellants' Specification

FF 8 Appellants define a “button” as “any graphic element in a display that may be activated and that upon activation causes a specified function to be performed.” Spec. 7:8-9; *see also* Fig. 11A, ref. 24. Appellants further define “graphic element” to “include without limitation graphic characters, graphics characters [sic] and objects.” Spec. 7:10-11.

ANALYSIS

The Examiner finds that Huynh discloses all of the limitations of claim 1, and, in particular, that Huynh discloses “sorting a plurality of menu items on the drop down menu” as recited in claim 1. Ans. 3 (citing Huynh Figs 4A, 6A; ¶¶ [0134], [0140], [0144]). The Examiner explains:

[T]he application program module organizes drop down menu 405 in a particular descending order as a list of actions associated with a semantic category and displays the sorted menu upon user selection of the down button, the sorted menu being responsive only as users position/hover a pointer over a down button and taking no other action). Therefore, Huynh teaches a sorted menu invoked only after [a] user hovers a cursor over the button, i.e., the sorting is not due to user

manually sorting the menu items via, for example, a drag/drop, cut/paste or other user initiated manipulations.

Ans. 8.

Appellants contend, *inter alia*, that “the evidence is devoid of any description of sorting a drop down menu. Merely describing what is in the drop down menu does not disclose sorting the items in the menu.” Reply Br.

5. We agree with Appellants.

We agree with the Examiner that Huynh discloses displaying drop down menu items in response to hovering a cursor over a string or object. FF 1-3. However, the claim recites the act of sorting drop down menu items in response to a user positioning a cursor over a down button. The ordinary meaning of “sort” is “**sort** *vt* . . . **1 a**: to put in a certain place or rank according to kind, class, or nature . . . **b**: to arrange according to characteristics: classify.” MERRIAM-WEBSTER’S NEW COLLEGIATE DICTIONARY 1122 (10th ed. 1999). The passages of Huynh (Huynh Figs. 4A, 6A; ¶¶ [0134], [0140], [0144]) cited by the Examiner demonstrate that Huynh discloses a drop down menu. Although Huynh’s menu items may be in a particular order, the Examiner has not established that Huynh discloses the act of putting the menu items in a certain place or rank according to kind, class, or nature, arranging the menu items according to characteristics, or classifying the menu items, much less that that act is performed in response to the user hovering a cursor over a down button or its equivalent.

Accordingly, we find that the Examiner has failed to establish a prima facie case of anticipation, and we do not sustain the rejection of (1) independent claim 1; (2) independent claim 7, which recites substantially the same limitation discussed *supra* and was rejected on substantially the

same basis as claim 1; and (3) dependent claims 2-6 and 8-12, which depend from claims 1 and 7 respectively.

NEW GROUND OF REJECTION WITHIN 37 C.F.R. § 41.50(b)

Claims 1 and 7¹ are rejected on a new ground of rejection under 35 U.S.C. § 103(a) as unpatentable over Toivonen and Huynh.

Regarding claim 1, Toivonen teaches a method for organizing a plurality of menu items in a menu displayed by a computer. FF 5, 6. Toivonen discloses, responsive to a user action, sorting and displaying the

¹ The Patent Trial and Appeal Board is a review body, rather than a place of initial examination. We have entered new grounds of rejection of claims 1 and 7. However, we have not reviewed claims 2-6 and 8-12 to the extent necessary to determine whether these claims are unpatentable over Toivonen, Huynh, Kavanagh, and Smith, or any other prior art. In the event of further prosecution, we leave it to the instant Examiner to determine the patentability of claims 2-6 and 8-12 in light of our findings and conclusions herein. Our decision not to enter a new ground of rejection for all claims should not be considered as an indication regarding the appropriateness of allowance of the non-rejected claims. Additionally, in the event of further prosecution of claims 7-12, or claims in similar form, we leave to the Examiner to ascertain whether such claims are directed to statutory subject matter under 35 U.S.C. § 101. *See, In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007); MPEP § 2106(I) (8th ed. 2001, rev. 2012); David J. Kappos, *Subject Matter Eligibility of Computer Readable Media*, 1351 OFF. GAZ. PAT. OFFICE 212 (Feb. 23, 2010).

menu items on the menu. FF 6, 7. Toivonen teaches all of the limitations of claim 1, except that Toivonen does not teach a drop down menu and Toivonen's user action is not "positioning a pointer over a down button and taking no other action."

In the same field of endeavor of computer menu displays, Huynh teaches that the menu is a drop down menu. FF 1-3. Huynh further teaches that the user action to initiate drop down menu display comprises positioning a pointer over a button, such as a string or media object (*see* FF 8), and taking no other action. FF 1-3. In addition, Huynh teaches that the media object may have incorporated within it a "down" triangle or arrow. FF 4. We find that whether to initiate an action by positioning a pointer over a button that is a string, a media object, or a "down" triangle or arrow, or any other symbol on a computer display, is a matter of visual appearance. Although the button over which the pointer is positioned has a functional relationship to the computer and computer display (i.e., the substrate), we find that the visual appearance (i.e., "down" triangle or arrow) of the button on the computer display over which the pointer is hovered is merely descriptive and has no functional relationship to the computer or computer display (i.e., the substrate). The appearance of the button is, therefore, non-functional descriptive matter. "Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in

terms of patentability).” *Ex parte Curry*, 84 USPQ2d 1272, 1274 (BPAI 2005) (informative).

We conclude that it would have been obvious to one of ordinary skill in the art to utilize Huynh’s method of displaying a dropdown menu by positioning a pointer over a button on the computer display, FF 1-4, 8, (e.g., a string, media object, or “down” triangle or arrow) to initiate sorting and display of Toivonen’s menu, FF 5-7, as a drop down menu. We conclude that such a combination is merely a combination of familiar elements according to known methods that does no more than yield predictable results, *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007), that is a predictable variation that can be implemented by one of ordinary skill in the art, *id.* at 417.

Claim 7 recites substantially the same limitations as claim 1 and is rejected on the same basis.

ORDER

The decision of the Examiner to reject claims 1-12 is reversed.

We enter a new ground of rejection for claims 1 and 7 under 35 U.S.C. § 103(a).

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides that “[a] new ground of rejection . . . shall not be considered final for judicial review.”

Section 41.50(b) also provides that Appellants, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

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(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record.

37 C.F.R. § 41.50(b).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2010).

REVERSED
37 C.F.R. § 41.50(b)

rwk