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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte WILLIAM H GENGLER and MARK D. ROGALSKI

Appeal 2010-010288
Application 11/556,856
Technology Center 2100

Before CARL W. WHITEHEAD, JR, ERIC S. FRAHM, and
ANDREW J. DILLON, *Administrative Patent Judges*.

DILLON, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 8, 11-14, and 21-31. Claims 1-7, 9, 10, and 15-20 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellants' invention is directed to a method and system for providing contextual help in a computer controlled display interface. *See* Spec. 17, Abstract of the Disclosure.

Claims 8 and 21 are illustrative, with key disputed limitations emphasized:

8. A method for providing contextual help data in a computer controlled user interactive display interface comprising:

displaying a menu of a plurality of selectable items, each representative of a system function;

enabling a user to select a menu item to perform the represented function;

enabling a user to select a menu item for help data for said selected item;

responsive to said user selection of a menu item for help, determining whether the source of contextual help for said selected item is in a running application program or in the operating system of said computer;

linking each of said plurality of menu items to a source of contextual help data in a running application program for each of said menu items related to said application program;

linking each of said plurality of menu items to a source of contextual help data in the operating system of said computer for each of said menu items related to said operating system; and

displaying said contextual help data for a menu item selected for help responsive to a selection of said menu item.

21. A method for providing contextual help data in a computer controlled user interactive display interface comprising:

displaying a menu of a plurality of selectable items, each representative of a system function;

enabling a user to select a menu item to perform the represented function;

enabling a user to select a menu item for help data for said selected item;

determining if said menu item selected for help is disabled;

if said menu item selected for help is disabled, displaying help data disclosing how said disabled item may be enabled; and

if said menu item selected for help is not disabled, displaying contextual help data for said selected menu item.

The Examiner relies on the following as evidence of unpatentability:

Cadiz	US 2003/0164862 A1	Sep. 4, 2003
Vaidyanathan	US 6,467,081 B2	Oct. 15, 2002

THE REJECTION

The Examiner rejected claims 8, 11-14, and 21-31 under 35 U.S.C. §103(a) as unpatentable over Cadiz and Vaidyanathan. Ans. 3-7.¹

¹ Throughout this opinion, we refer to the Appeal Brief filed January 20, 2010; the Examiner's Answer mailed April 29, 2010; and, the Reply Brief filed June 28, 2010.

ISSUE

Based upon our review of the record, the arguments proffered by Appellants and the findings of the Examiner, we find the following issue to be dispositive of the claims on appeal:

Under § 103, has the Examiner erred in rejecting claims 8 and 21 by finding that Cadiz and Vaidyanathan, collectively, show or suggest:

- (a) determining whether a source for help, in response to a request for help, is within an application or a computer operating system and then linking a menu item to that source, as set forth in Claim 8; and
- (b) determining whether a menu item selected for help is disabled and then either displaying the requested help or displaying how to enable the menu item, as set forth in Claim 21?

ANALYSIS

Appellants argue that the Examiner erred by rejecting claim 8 under §103 over Cadiz and Vaidyanathan in view of the failure of the Cadiz reference to disclose access to “help data.” App. Br. 10. Appellants argue that Cadiz cannot, therefore, suggest “responsive to said user selection of a menu item for help, determining whether the source of contextual help for said selected item is in a running application program or in the operating system of said computer” (claim 8) and “linking each of said plurality of menu items to a source of contextual help data in the operating system of said computer for each of said menu items related to said operating system” (*id.*) and therefore it is “accordingly submitted that Cadiz is not an anticipatory reference under 35 USC 102(b) with respect to all of the claims in the present Application.” *Id.* at 11.

Appeal 2010-010288
Application 11/556,856

The Examiner finds that Cadiz depicts a plurality of selectable items, each representative of a system function, and further that Cadiz teaches “an integrated dynamic peripheral interface for providing dynamic communication access across multiple platforms/applications.” Ans. 5-6. The Examiner also points out that the rejection of all of the claims in the present application is under 35 U.S.C. §103(a) and not under §102(b) as argued by Appellants. Ans. 9.

We find that Appellants have failed to address the combination of references relied upon by the Examiner, and Appellants merely urge that the alleged failure of Cadiz to display “help data” is sufficient grounds to reverse the Examiner. Appellants do not traverse the Examiner’s assertions regarding the teachings of Cadiz noted above, with regard to an interface with access across “multiple platforms/applications” which we find to be at least suggestive of accessing help data across applications and operating systems, as claimed by Appellants. Further, the distinction argued by Appellants, namely that Cadiz does not display “help data,” is not persuasive. The “help data” displayed within Appellants’ invention is only visible to a human operator, does not affect the manner in which the claimed system operates and is, consequently, nonfunctional, merely descriptive matter.

"Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious." *Ex parte Curry*, 84 USPQ2d 1272, 1274 (BPAI 2005) (citing *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004)), *aff'd*, Appeal No. 2006-1003 (Fed. Cir. 2006).

With respect to claim 21, Appellants argue that the cited references fail to show or suggest displaying requested help or displaying information on how to enable help if that function is disabled.

Once again, we find the display of “help data” or information on how to enable “help data” to be nonfunctional descriptive material and not entitled to patentable weight. *Supra*, p. 5.

Further, we find that displaying a suggestion to enable a disabled function when that function is requested by an operator is notoriously well known and obvious.

Appellants use the Reply Brief to introduce the following new argument. Appellants allege that the Examiner has not shown “why one ordinarily skilled in the art would combine the teachings of Vaidyanathan relating to the development of help function in application programs with the disclosure of Cadiz in solution of any other problem outside of the specific problem solved by the present invention.” Reply Br. 5.

“Any bases for asserting error, whether factual or legal, that are not raised in the principal brief are waived.” *Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (informative). *See also Optivus Tech., Inc. v. Ion Beam Appl’ns. S.A.*, 469 F.3d 978, 989 (Fed. Cir. 2006) (“[A]n issue not raised by an appellant in its opening brief . . . is waived.”) (citations and quotation marks omitted).

Here, the Examiner’s reliance on the combination of Cadiz and Vaidyanathan in the Examiner’s Answer (p. 3) is identical to that in the Final Rejection (p. 2), from which the instant appeal was taken. Because the reliance is identical, we find nothing that would have prompted the new argument in the Reply Brief. Appellants could have made the argument in the Appeal Brief and did not. The term “Reply Brief” is exactly that, a brief

Appeal 2010-010288
Application 11/556,856

in reply to new rejections or new arguments set forth in an Examiner's Answer. Appellants may not present arguments in a piecemeal fashion, holding back arguments until an examiner answers the original brief. This basis for asserting error is accordingly waived. *See* 37 C.F.R. § 41.41(b)(2).

CONCLUSION

The Examiner did not err in rejecting claims 8, 11-14, and 21-31 under § 103.

ORDER

The Examiner's decision rejecting claims 8, 11-14, and 21-31 is affirmed.

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)(iv).

AFFIRMED

peb