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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CRIS RYS

Appeal 2013-002875
Application 12/111,877
Technology Center 2100

Before DAVID M. KOHUT, ERIC B. CHEN, and
ANDREW J. DILLON, *Administrative Patent Judges*.

DILLON, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1–18. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellant's invention is directed to a system which establishes a rename state for a first file in a collection of files and, in the rename state, receives user input specifying a name for the first file. In response to the user input specifying the name, the system renames the first file according to the name and establishes a rename state for a second file in the collection of files. In the rename state, the system can display both the current name of the file and the file extension associated with the file. The system protects

the file extension such that the user cannot change the file extension in the rename state. *See* Abstract.

Claim 1 is illustrative, with key disputed limitations emphasized:

1. A computer-implemented method comprising:

receiving input that defines a specified collection of files from multiple available files and that requests that a name of a single file in the specific collection be changed;

placing the single file in a rename state;

upon detecting that the name is changed, automatically placing a next file in the specified collection in the rename state;

displaying a computer-generated name for the next file, the computer-generated name based on the changed name of the single file; and

wherein the name is changed directly in a file browser display.

The Examiner relies on the following as evidence of unpatentability:

Kaplan	US 2001/0056434 A1	Dec. 27, 2001
Kimura	US 2010/0253815 A1	Oct. 7, 2010

(Effective filing date Aug. 15, 2000)
Sams Teach Yourself Microsoft Windows 2000 Professional, Sams Publishing, November 1999, (hereinafter “Windows 2000”).

THE REJECTIONS

1. The Examiner rejected claims 1–5, 7–11, and 13–17 under 35 U.S.C. §103(a) as unpatentable over Windows 2000 and Kaplan. Final Act. 2–5.¹
2. The Examiner rejected claims 6, 12, and 18 under 35 U.S.C. §103(a) as unpatentable over Windows 2000, Kaplan, and Kimura. *Id.* at 5.

ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellant’s contentions (Br. 5–13) that the Examiner has erred. We have also reviewed the findings and reasons set forth by the Examiner in (1) the action from which this appeal is taken (Final Act. 2–5), and (2) the reasons set forth by the Examiner in the Examiner’s Answer in response to Appellant’s Appeal Brief (Ans. 2–8). We highlight and amplify certain teachings and suggestions of the references as follows.

Appellant argues the Examiner erred in rejecting claims 1–5, 7–11, and 13–17 under 35 U.S.C. § 103(a) as unpatentable over Windows 2000 and Kaplan in view of the failure of the cited references to show or suggest each element recited in independent claim 1 and because the proposed combination would “necessitate a change in the principle of operation of either Windows 2000 or Kaplan.” Br. 5–6.

Specifically, Appellant argues Windows 2000 fails to show or suggest “upon detecting that the name is changed, automatically placing a next file in the specified collection in the rename state [and] displaying a computer-

¹ Throughout this opinion, we refer to the Appeal Brief (“Br.”) filed August 14, 2012; and, the Examiner’s Answer mailed September, 13, 2012.

generated name for the next file, the computer generated name based on the changed name of the single file,” and that the “Rename and Copy window 230” of Kaplan does not show “automatically placing a next file in the specified collection in the rename state ... wherein the name is changed directly in a file browser display,” as recited in claim 1. Further, Appellant argues that Kaplan explicitly requires a “select destination window,” a “rename and copy window,” and/or a “dialog box” to perform this rename. *Id.* at 6–8 (emphasis omitted).

The Examiner finds that Kaplan clearly teaches, at paragraph [063] that upon processing the renaming of the first file the next file in a serialized queue is automatically placed in a rename state, and that if the serialization option or series mode is enabled, the new file name is incremented and inserted into the new file name variable. With respect to changing the file name directly in a file browser display, the Examiner finds that Figure 9.3 of Windows 2000 shows the file name changed directly in a file browser, as claimed. Ans. 5–6.

We agree with the Examiner’s finding. Kaplan indeed demonstrates an automated serial renaming process as claimed by Appellant. With regard to those additional features which Appellant argues are explicitly required, we note Appellant’s claim utilizes the transitional word “comprising.”

“The transitional term ‘comprising’ . . . is inclusive or open-ended and does not exclude additional, unrecited elements or method steps.” *Georgia-Pacific Corp. v. U.S. Gypsum Co.*, 195 F.3d 1322, 1327 (Fed. Cir. 1999) (citing MPEP § 2111.03 (6th ed.1997)). “A drafter uses the term ‘comprising’ to mean ‘I claim at least what follows and potentially more.’” *Vehicular Techs. Corp. v. Titan Wheel Int'l, Inc.*, 212 F.3d 1377, 1383 (Fed.

Cir. 2000). We therefore find that the possible inclusion of certain windows or dialog boxes within the process described by Kaplan does not preclude the Examiner's reliance on Kaplan's description of an automated serialized renaming process.

Appellant also argues that "modifying Kaplan with Windows 2000 would result in a change in the principle of operation required by Kaplan." Appellant urges that the resultant combination would necessarily require Kaplan to operate without the use of the "Rename and Copy window 230," and that Kaplan's incrementing occurs as a result of the serialization and collision options being set, rather than in response to detection of a name change. Br. 8–9.

Further, Appellant argues the Examiner has failed to provide a reason why a person of ordinary skill in the art would have been motivated to the cited references, relying instead on improper hindsight. *Id.* at 9.

Similarly, Appellant argues that "modifying Windows 2000 with Kaplan would result in a change in the principle of operation required by Windows 2000." Appellant urges that incorporating the automated renaming process of Kaplan into Windows 2000 would effectively remove the manual renaming function which Appellant asserts is the "heart of the teachings in Windows 2000." *Id.* at 10.

The Examiner notes that Appellant's own statement in the background of the invention notes the tedious nature of renaming files. Consequently, the Examiner finds that one of ordinary skill in the art, upon review of the automated renaming process of Kaplan, would find suggestion to incorporate that automated renaming process into the system of Windows 2000. Ans. 6.

We agree with the Examiner. With respect Appellant's assertion regarding modification of the existing principles of operation, we find the Appellant has improperly assumed that the two references must be physically combined.

“[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review.” *In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983) (citing *Orthopedic Equip. Co., Inc. v. United States*, 702 F.2d 1005, 1013 (Fed. Cir. 1983); *In re Andersen*, 391 F.2d 953, 958 (CCPA 1968)); see also *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973) (“Combining the *teachings* of references does not involve an ability to combine their specific structures.”). “The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.” *In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (citations omitted).

Here we find that one of ordinary skill in the art, upon review of Windows 2000 and the automated renaming process of Kaplan, would have been motivated to combine that feature into the general process of Windows 2000.

Regarding claims 3, 9, and 15, Appellant argues the cited references fail to show or suggest “wherein the corresponding file extension is displayed in-line with the name of the single file and protecting the corresponding file extension comprises highlighting the name of the single file and not highlighting the corresponding file extension.” Br. 11 (emphasis omitted).

The Examiner finds that Windows 2000 teaches, at Figure 9.3, highlighting a file name while protecting and hiding the file extension from view. Ans. 7. As the file extension is hidden, it is clearly not highlighted.

We find the display or non-display of the file extension is an obvious variation and Windows 2000 clearly teaches protecting the file extension by not displaying that extension while highlighting the file name.

Appellant argues that the Examiner erred in rejecting claims 6, 12, and 18 in view of the failure of the cited references to show or suggest the display of “a list including suffixes.” Appellant urges that the list of formats described in Kimura does not suggest a “list of suffixes” from which a user may select a desired suffix. Br. 12–13.

The Examiner finds that Kimura teaches at Figure 4 the display of a list of suffixes at item 108 and a format selection box at 116. Ans. 7.

Kimura, at paragraph [0092] describes box 116 as permitting a user to select various save formats such as bit map, JPEG, and TIFF. Those having ordinary skill in the art will appreciate that each of the formats has a distinctive suffix which identifies the format. We therefore, find that the Examiner did not err in rejecting claims 6, 12, and 18.

CONCLUSION

The Examiner did not err in rejecting claims 1–18 under 35 U.S.C. § 103(a).

ORDER

The Examiner’s decision rejecting claims 1–18 is affirmed.

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Application 12/111,877

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

cda