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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
Row 1: 13/422,737, 03/16/2012, Feng-wei Chen, RSW920100108US2, 1363
Row 2: 75949, 7590, 12/21/2016, EXAMINER ORR, HENRY W
Row 3: ART UNIT 2145, PAPER NUMBER
Row 4: NOTIFICATION DATE 12/21/2016, DELIVERY MODE ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte FENG-WEI CHEN, JOSEPH B. HALL, and
SAMUEL R. JR. MCHAN¹

Appeal 2016-002286
Application 13/422,737
Technology Center 2100

Before DEBRA K. STEPHENS, DAVID J. CUTITTA II, and
PHILLIP A. BENNETT, *Administrative Patent Judges*.

BENNETT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ Appellants' Brief ("App. Br.") identifies the real party in interest as International Business Machines Corporation ("IBM"). App. Br. 2.

CLAIMED SUBJECT MATTER

The claims are directed to an automatically reconfiguring an input interface. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method for automatically reconfiguring an input interface, the method comprising:
 - with a physical computing device, analyzing a string of textual characters input through an input interface of said computing device;
 - with said physical computing device, determining a context based on said input, wherein said context is a category of document selected from among a number of predetermined document categories; and
 - with said physical computing device, reconfiguring said input interface to comprise an additional key added to a set of keys, said additional key having a function related to a domain associated with said context.

App. Br. 23 (Claims App'x).

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Shapiro	US 4,100,602	July 11, 1978
Jobs et al.	US 2008/0174570 A1	July 24, 2008
Spetalnick	US 2010/0131900 A1	May 27, 2010
Wilairat	US 2010/0194690 A1	Aug. 5, 2010
Chou	US 2010/0231523 A1	Sept. 16, 2010

REJECTIONS

Claims 1, 2, 5, 7, 9–12, 14, and 16–20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Jobs. Final Act. 2–7.

Claims 3, 4, 6, and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jobs and Chou. Final Act. 8–10.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Jobs and Spetalnick. Final Act. 10–11.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Jobs and Wilairat. Final Act. 11.

Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Jobs and Shapiro. Final Act. 12.

IDENTIFICATION OF RELATED APPEALS

Initially, we note Appellants have stated “[t]here are no appeals or interferences related to the present application of which the Appellant[s are] aware.” App. Br. 3. However, we determine Appellants have not met the disclosure required by 37 C.F.R. § 41.37 because a parent application, 12/907,311 (hereinafter “parent application”) is pending and furthermore, has a currently pending appeal filed Feb. 4, 2013 (hereinafter, “Parent Appeal”) by the same attorney. 37 C.F.R. § 41.37(c)(1)(ii) states:

A statement identifying by application, patent, appeal, interference, or trial number all other prior and pending appeals, interferences, trials before the Board, or judicial proceedings (collectively, “related cases”) which satisfy all of the following conditions: involve an application or patent owned by the appellant or assignee, are known to appellant, the appellant’s legal representative, or assignee, and may be related to, directly affect or be directly affected by or have a bearing on the Board’s decision in the pending appeal, except that such statement is not required if there are no such related cases.

Here, in both the instant application and the parent application, the real party in interest is listed as IBM. App. Br. 2; Parent Appeal, App. Br. 2. As the

parent application is the parent of this application, includes claims very similar to the claims in this application, and is rejected based on overlapping prior art, we determine the parent application is related to, directly affects or is directly affected by and has a bearing on the Board's decision in the pending appeal. We further find as both appeals list the same real party in interest, list the same inventors, and were filed by the same attorney, the Parent Appeal was known to Appellants, Appellants' legal representative, and Assignee.

We remind Appellants of this requirement which was not met in this Appeal.

ISSUE FOR DECISION

Does Jobs disclose “determining a context based on said input, wherein said context is a category of document selected from among a number of predetermined document categories” as recited in independent claims 1 and 17?

ANALYSIS

In rejecting the independent claims as anticipated by Jobs, the Examiner finds Jobs discloses “analyzing a string of textual characters input through an input interface” at Figures 6B and 6C, and also at paragraph 247. Ans. 3 (emphasis omitted). More specifically, the Examiner finds the word fragment being typed by the user in box 612 describes the string of characters being analyzed, as evidenced by the word suggestion area 622 that provides a list of possible words to complete the fragment inputted into box 612. Ans. 3.

The Examiner also finds the step of “determining a context based on said input, wherein said context is a category of document selected from among a number of predetermined document categories” is disclosed in Jobs. Ans. 3–4, 13–14. Citing Jobs’ paragraph 326, the Examiner finds this limitation is met by Jobs’ disclosure of an “application context.” Ans. 14. More specifically, the Examiner finds Jobs’ application context is determined when a user places the cursor within an inputted string of characters. *Id.* For example, when the user places the cursor within an inputted string of letters, the computing device determines the application context is a letters context, and when the user places the cursor within an inputted string of numbers, the computing device determines a numbers context. *Id.* According to the Examiner, each of these determined contexts is “a category of document selected from among a number of predetermined document categories” because they “may be referring to the textual category of the document being created.” Ans. 15–16.

Appellants argue Jobs does not disclose the recited “determining” step because the “application context” described by Jobs merely uses the designation of field into which data is entered to characterize data. Reply Br. 5. Appellants further contend Jobs does not disclose that context determined from the textual input is a category selected from among any predetermined document categories. App. Br. 11–13; Reply Br. 4.

We agree with Appellants’ assertions. Although we find Jobs describes determining an application context based on the input string of textual characters, the application context described in Jobs is not a “category of document,” nor is it “selected from among a number of predetermined document categories.” The Examiner finds “entering letters

of text or numbers of text or a combination of both (i.e., alphanumeric) are textual categories of a document” Ans. 16. These categories may rightly be considered categories of character sets, but we determine these categories are not categories of documents because they merely reflect the kind of characters present in the vicinity of the cursor.

The Examiner did not make any findings as to the scope and content of the remaining cited references that would cure the deficiency in Jobs discussed *supra*. Accordingly, we do not sustain the rejection of independent claims 1 and 17. Moreover, as we agree with the arguments advanced by Appellants discussed above, we need not reach the merits of Appellants’ other arguments.

Summary

We find the Examiner has erred, and therefore reverse, the rejections of claims 9 and 17 made under 35 U.S.C. § 102(b). Each of the remaining dependent claims rejected as anticipated or obvious over the prior art incorporates the limitation discussed above. Accordingly, we do not sustain the rejections of those claims for the same reasons discussed above.

DECISION

The Examiner’s rejection of claims 1–20 is reversed.²

REVERSED

² Although we reverse the rejections made in the Final Office Action, we recommend the Examiner consider whether a double patenting rejection would be appropriate over co-pending parent application 12/907,311.