

Board of Patent Appeals and Interferences

Patent and Trademark Office (P.T.O.)

EX PARTE JOSEPH AMMIRATO AND GAVIN PEACOCK

Appeal No. 1999-2076

Application No. 08/597,794

NO DATE REFERENCE AVAILABLE FOR THIS DOCUMENT

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NEW YORK, NY 10022

Before KRASS, BARRETT, and BARRY

Administrative Patent Judges

KRASS

Administrative Patent Judge

ON BRIEF

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-34, all of the pending claims.

The invention is directed to creating multiple scenarios in an electronic spreadsheet. More specifically, the invention requires the electronic spreadsheet system to automatically track different versions or scenarios, as specified by a user, and to automatically identify not only the cells directly changed by the user but also any changing dependent cells which have changed as a result of cell formula dependencies. After automatically identifying these changes to the user's spreadsheet, the system can highlight these changes or automatically generate a report summarizing the changes for one or more scenarios.

Representative independent claim 1 is reproduced as follows:

1. In an electronic spreadsheet system for modeling user-specified information in a data model comprising a plurality of information cells, a method for automatically tracking different versions of the data model and reporting differences between versions to a user, the method comprising:

(a) specifying a base set of information cells for the system to track changes;

(b) creating a new version of the data model by modifying at least one information cell from the specified base set;

(c) automatically determining by the system cells of the data model which have changed by comparing cells in the new version against corresponding ones in the base set; and

(d) reporting said cells of the data model which have changed by creating a report, said system determining and listing in the report for each cell which has changed in step (b):

(i) values for said each cell before and after the cell was changed, and

(ii) values for any other cells storing spreadsheet formulas which express new values as a result of said each cell changing.

The examiner relies on the following references:

Ammirato et al. (Ammirato)

5,303,146

Apr. 12, 1994

(filed Mar. 11, 1993)

Greif et al. (Greif)

5,371,675

Dec. 06, 1994

(filed Jun. 3, 1992)

Bittel, "Encyclopedia of Professional Management", McGraw-Hill Inc., 1978; pp. 373-374. Borland, "Quattro Pro Version 4.0 User's Guide", 1992, pp. 573-577.

*2 Claims 1-34 stand rejected under obviousness-type double patenting over claim 1 of Ammirato in view of old practices of management shown by Bittel.

Claims 1-34 stand further rejected under 35 U.S.C. 103 as unpatentable over Greif in view of Bittel and Borland.

Reference is made to the brief and answer for the respective positions of appellants and the examiner.

OPINION

We turn, first to the obviousness-type double patenting rejection of claims 1-34 and we note that while appellants have presented no arguments regarding the merits of this rejection, appellants have filed a terminal disclaimer (Paper No. 13-October 28, 1998).

We have no input from the examiner as to the acceptability of this terminal disclaimer. In fact, the examiner has repeated the rejection in the answer with apparent disregard for, or ignorance of, the filing of this terminal disclaimer.

Accordingly, we remand this application back to the examiner for a finding of whether the terminal disclaimer overcomes the rejection of claims 1-34 based on obviousness-type double patenting.

Claims 1-34 stand also rejected under 35 U.S.C. 103 as unpatentable over the combination of Greif, Bittel and Borland.

We will not sustain the rejection of claims 1-34 under 35 U.S.C. 103 as the examiner has failed to establish a prima facie case of obviousness.

The examiner contends that Greif discloses, in the abstract, “base information, new version and change determination” [answer-page 3] but does not show reporting changed inputs and outputs. The examiner relies on Bittel for showing reporting changes “in an analogous art” [answer-page 4] for the “purpose of reporting efficiency.” The examiner relies on Borland for the dependency limitation, pointing to the auditing feature of Borland.

We disagree with the combination. We do not find Bittel to be “analogous art” since the instant invention is directed to an electronic spreadsheet, whereas Bittel is not even in the electronic arts, nor does it pertain to any problem sought to be solved by appellants, describing, instead, a management information and control technique for indicating whether a condition or operation is within prescribed standards. We find no reason for the skilled artisan to look to anything within the disclosure of Bittel as a way of improving upon anything disclosed by Greif.

Moreover, the instant claimed invention is concerned with identifying changes between different versions of user-named blocks of cells and we find nothing within the teachings of any of the three applied references remotely suggesting identifying changes between different versions of such cells. Nor do we find the “automatic” nature of the claimed invention suggested by any of the applied references. The instant claims require “automatically determining by the system cells...which have been changed...” The examiner's response is to merely allege that automation of a manual process is “inherently obvious” [answer-page 5]. However, the instant claims do not merely require simply that a process heretofore applied manually be applied automatically. The claims in question require a specific tracking of different versions of a data model “automatically” and that it is “automatically” determined “by the system” that

cells of the data model have changed. If this is obvious over the applied references, the examiner must set forth a coherent rationale in more detail than that it is “inherently obvious” to do so.

*3 We have not sustained the rejection of claims 1-34 under 35 U.S.C. 103 and we have remanded the case back to the examiner for a determination as to whether the terminal disclaimer filed overcomes the rejection of claims 1-34 under obviousness-type double patenting.

This application by virtue of its “special” status requires an immediate action. See MPEP § 708.01(d) (7th ed., February 2000). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REVERSED and REMANDED

BOARD OF PATENT APPEALS AND INTERFERENCES

ERROL A. KRASS

Administrative Patent Judge

LEE E. BARRETT

Administrative Patent Judge

LANCE LEONARD BARRY

Administrative Patent Judge

EK/RWK