

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAKOB NIELSEN

Appeal No. 2001-1528
Application No. 08/998,661

ON BRIEF

Before HAIRSTON, KRASS, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 9-11, 19-21, and 29-34.

We affirm.

BACKGROUND

The invention relates to a method and system for retrieving and acting on information elements in a computer network. Claim 1 is reproduced below.

1. A method executed in a computer network to facilitate acting on information elements, the computer network including at least a client computer and server computer, the method comprising the steps of:

 sorting a list of information element references so that the list is ranked from a first information element reference with a highest priority to a last information element reference with a lowest priority;

 retrieving from the server computer to the client computer, the information elements in ranked order, and

 acting on retrieved information elements in the order received.

The examiner relies on the following references:

Byrd, Jr. et al. (Byrd)	5,826,260	Oct. 20, 1998 (filed Dec. 11, 1995)
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Claims 1, 9-11, 19-21, and 29-34 stand rejected under 35 U.S.C. § 102 as being anticipated by Byrd.

Claims 2, 12, and 22 have been allowed.

Claims 3-8, 13-18, and 23-28 have been canceled.

We refer to the Final Rejection (Paper No. 8) and the Examiner's Answer (Paper No. 16) for a statement of the examiner's position and to the Brief (Paper No. 15) for appellant's position with respect to the claims which stand rejected.

OPINION

Byrd describes an information retrieval system which may be implemented in a client/server architecture (Fig. 1). The databases contain document collections having one or more documents 141, which may be text only, text mixed with images, or any other multi-media object. Col. 4, ll. 17-35. In the embodiment pictured in Figures 3A through 3C, Figure 3A shows the display 200 after the user has submitted a query 125. The user may select new criteria (Fig. 3B) to reorder the results. Figure 3C shows the display 200 after the user reordering. Col. 5, ll. 29-37.

The reference details the preferred embodiment at column 5, line 38 et seq. In Figures 3A through 3C, the document identifier is the document title. After an initial query, or after user reordering, the user has one of several options as shown in the flowchart of Figure 5. At step 595, the user may leave the query mode, either by quitting the system or by retrieving one or more of the documents retrieved by the query. Col. 7, ll. 23-28.

Appellant argues (Brief at 4) that, in the Byrd system, the user must take an action, such as double clicking on a document reference in order to retrieve the document itself. Appellant quotes extensively from the instant specification (id. at 4-5), and then submits that “Byrd does not teach that the documents are automatically retrieved from a server or automatically acted upon at the browser in that order.”

We acknowledge that differences exist between Byrd’s system and appellant’s invention as disclosed. However, claims are to be given their broadest reasonable

Appeal No. 2001-1528
Application No. 08/998,661

interpretation during prosecution, and the scope of a claim cannot be narrowed by reading disclosed limitations into the claim. See In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969).

Instant claim 1 recites “retrieving from the server computer to the client computer, the information elements in ranked order, and acting on retrieved elements in the order received.” Consistent with appellant’s disclosure, “acting on” retrieved elements may be as simple as displaying text, or displaying an image file. (See specification at 2, ll. 1-8.) Contrary to the implications of appellant’s position set forth in the Brief, however, there is nothing in the claim that excludes user input to cause the “retrieving from the server computer to the client computer, the information elements in ranked order.”

Consider the case where a user’s query in the Byrd system retrieves two “hits,” which are presented to the user as two document titles ordered with respect to relevance. The “retrieving” set forth in claim 1 may be in response to a user clicking on the first title in the hit list to retrieve the first document, then clicking on the second title in the hit list to retrieve the second document.

The Byrd reference is not express in describing the above-noted example of operation, but the artisan would have immediately recognized that Byrd’s system operates in the manner we describe. “A reference anticipates a claim if it discloses the

claimed invention ‘such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention.’” In re Graves, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995) (quoting In re LeGrice, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962)).

We do not find language in any of the independent claims that sets forth the “automatic” operation that is argued by appellant. Instant claim 11 requires that “code” retrieves the information elements in ranked order. In the Byrd system, the “code” (i.e., software instructions) comprises a portion of the hardware and software that do the actual retrieving, after user input to initiate the action. Instant claim 21 recites “a mechanism configured to retrieve” the information elements in ranked order. In the Byrd system, computer hardware and software perform the actual retrieval. Instant claims 31 and 34 recite retrieving “information elements” or “information” in yet broader terms than the other independent claims.

With respect to the dependent claims, appellant argues (Brief at 6-7) that Byrd does not anticipate the claims because of alleged failure to show “an audio file,” an “applet,” or “playing an audio file.” However, the corresponding dependent claims do not require the features appellant allege as missing from Byrd. Claim 9, for example, requires “one of” a list of features, which includes “displaying text.” Claim 10, as further example, requires that the information element is “one of” a list of features, which includes “text.” Byrd at the least discloses text documents that are retrieved and

Appeal No. 2001-1528
Application No. 08/998,661

displayed at the user's terminal. We find that Byrd meets the terms of the relevant dependent claims (i.e., 9, 10, 19, 20, 29, and 30).

Dependent claim 33 requires that the objects to be displayed or executed include "one or more of applets and an image file." As we have previously noted, Byrd also discloses (e.g., col. 4, ll. 33-35) that the documents may be image files, thus meeting the terms of claim 33.

Appellant argues (Brief at 7) that Byrd does not show "network addresses," and thus does not anticipate claim 32. While Byrd does not disclose displaying network addresses -- where the documents are found on the network -- to the user, the claim does not require display to the user. The information element references in Byrd include the title of the document that is displayed to the user. However, consistent with instant claim 32, the information element references also include the network addresses of the documents; else, the documents could not be retrieved upon selection by the user.

We thus are not persuaded of error in the examiner's finding of anticipation with respect to any of the claims on appeal. We thus sustain the rejection of claims 1, 9-11, 19-21, and 29-34 under 35 U.S.C. § 102 as being anticipated by Byrd.

Appeal No. 2001-1528
Application No. 08/998,661

CONCLUSION

The rejection of claims 1, 9-11, 19-21, and 29-34 under 35 U.S.C. § 102 as being anticipated by Byrd is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

KENNETH W. HAIRSTON
Administrative Patent Judge

ERROL A. KRASS
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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Appeal No. 2001-1528
Application No. 08/998,661

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