

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL JOHN ALLEN, MICHAEL SLOAN BOMAR,
and WILLIAM FRANCIS PHILLIPS

Appeal No. 2001-1604
Application No. 08/785,912

ON BRIEF

Before KRASS, FLEMING, and RUGGIERO, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-20.

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The invention is directed to surfing the Internet. In particular, in a client web browser, an html is read to identify an entry for a link which is marked for pre-loading. In response to the identification of that link marked for pre-loading, another html, along with any graphical material associated with the another html, is automatically loaded into a local memory device. The automatic loading occurs without the another link being selected by a user but, when the user subsequently does select this another link that was pre-loaded, the html and associated graphics are available at the user's local system without the delay normally required to download the html and associated graphics.

Representative independent claim 1 is reproduced as follows:

1. A client web browser comprising:

means for reading an html to identify an entry for a link which is marked for pre-loading; and

means, responsive to identification of said link marked for pre-loading, for automatically loading another html and associated graphics, if any graphics corresponding to said link into a memory device local to said client web browser, said automatic loading occurring without said link being selected by a user of said client web browser.

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The examiner relies on the following references:

Mogul	5,802,292	Sep. 1, 1998 (filed Apr. 28, 1995)
Nielsen	5,903,727	May 11, 1999 (filed Jun. 18, 1996)

Claims 1-20 stand rejected under 35 U.S.C. §103 as unpatentable over the combination of Nielsen and Mogul.

Reference is made to the briefs and answers for the respective positions of appellants and the examiner.

OPINION

In rejecting claims under 35 U.S.C. §103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teachings,

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suggestions or implications in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make

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in the brief have not been considered and are deemed to be waived [see 37 CFR 1.192 (a)].

With regard to independent claim 1, the examiner asserts that Nielsen taught the web browser with a means for reading a first html to identify an entry for a link which is marked for pre-loading, by reviewing the html to locate a sound attribute, citing column 2, lines 8-9, and column 3, lines 64-65. The examiner further identifies column 2, lines 9-12, and column 4, lines 58-59 and 63-64, of Nielsen as teaching the automatic loading of another html, responsive to identification of a link marked for pre-loading.

Curiously, although the examiner identifies portions of Nielsen as teaching means, responsive to identification of said link marked for pre-loading, for automatically loading into a memory device local to said client web browser, said automatic loading occurring without said link being selected by a user (page 4, first paragraph, of the supplemental answer), in the very next paragraph, the examiner asserts that "Nielson [sic, Nielsen] does not specifically teach pre-loading html." It seems a bit awkward, and somewhat contradictory, to assert that a

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reference teaches a means for doing something responsive to identification of a link marked for pre-loading, and then, to assert that that reference does not teach the pre-loading. In other words, what would be the point of a reference identifying a link marked for pre-loading if the link is not pre-loaded?

In any event, the examiner relies on Mogul for teaching that certain types of files and associated graphics are commonly pre-loaded (citing column 1, lines 62-63) and then, combining this with Nielsen's alleged teaching of marking files for pre-loading, the examiner finds that it would have been obvious to make this combination since "Nielsen expressly taught the problems and disadvantages of the prior art are overcome by adding an extension to html to enable a web page designer to mark files for pre-loading to allow the web page designer more control over presentation" (supplemental answer-page 4).

We will not sustain the rejection of claim 1 under 35 U.S.C. §103 because, in our view, the examiner has not established a prima facie case of obviousness.

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Nielsen does, indeed, disclose a "pre-fetching" operation but Nielsen allows a web designer to specify that an audio file linked to a web page should be pre-fetched before the user does anything with the page. This relates to conventional background sounds on a web page and making sure that the entire web page, along with its associated sound background, is available before user input is accepted.

This is much different from the reading of an html to identify an entry for a link which is marked for pre-loading. But, even assuming that the sound file of Nielsen may be considered to be a "link" which is pre-loaded, or marked for pre-loading, upon the reading of the html associated with the sound, there does not appear to be an "automatic" loading of the sound file in response to identifying the link marked for pre-loading. Even so, and assuming that Nielsen does show all of this, in the sense that the sound background for the website is automatically pre-loaded upon selection of the website, this still lacks any showing by the examiner that the "automatic loading" occurs "without said link being selected by a user of said client web browser." This is so because, in Nielsen, when the link is selected, the sound associated with that link is automatically

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selected and "opened" along with the link, or website. It does not appear that, in Nielsen, a user can select a link without also selecting the sound file associated therewith. Instant claim 1 provides that an html link, along with its associated graphics, is automatically loaded and that, even though it is automatically loaded, a user need not select, i.e., need not view, that loaded html link.

The trouble with Nielsen, as it relates to instant claim 1, is that in Nielsen, when the link is selected, the sound associated with that link is automatically selected and "opened" along with the link, or website, because, as pointed out by appellants at page 5 of the principal brief, the audio files are background audio and, in essence, "**part of the same web page** on which their links are found." It is clear, from the language of the instant claims, that the linked web pages of the invention are such that an entirely new web page replaces the one on which their links are found. Thus, it is clear that Nielsen is deficient in this regard.

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In attempting to remedy this deficiency, the examiner relies on Mogul. But, while Mogul does involve a pre-fetch of an object before a user actually requests it, similar to the linked web pages of the instant invention, Mogul's server selects the objects to be pre-fetched based on "predictive prefetching," i.e., based on observations of the behavior of users of the system.

As pointed out by appellants, at page 6 of the principal brief, this is much different than the instant claimed invention where the definition of the html dictates which link to prefetch. The person who wrote the html determines if any one of the html links defined in the html being displayed should be prefetched. It is true that the instant claims contain no explicit limitation regarding a person writing the html determining if a link should be prefetched. However, the claims do require that a link is "marked for pre-loading." Accordingly, something, or someone, is doing the "marking." While Nielsen may be "marking" a link for pre-loading in the sense that a sound file is "marked" so that it is pre-loaded with a web page, as explained supra, the sound file is part of the same web page with which it is associated and, in this sense, is unlike the instant claimed invention. Clearly, no

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such link is marked for pre-loading in Mogul since Mogul uses a predictive prefetching, based on the server's observation of users' previous behavior.

We agree with appellants that there would have been no reason, within the meaning of 35 U.S.C. §103, to modify Nielsen, with any teaching of Mogul, in order to prefetch web pages specified in an html because Mogul does not suggest that the web page designer should predict a replacement web page for the current web page and Mogul does not include that prediction in the html for a current web page. Rather, this prediction is left to the server based on heuristic observations of the user in Mogul.

Accordingly, it does not appear that the skilled artisan would have sought to combine Nielsen and Mogul in any meaningful manner so as to result in the instant claimed subject matter, within the meaning of 35 U.S.C. §103. Thus, we will not sustain the rejection of claims 1-5, 15 and 20 under 35 U.S.C. §103.

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Since independent claims 6, 9 and 12 contain limitations similar to independent claim 1, we also will not sustain the rejection of claims 6-14 and 16-19 under 35 U.S.C. 103.

The examiner's decision rejecting claims 1-20 under 35 U.S.C. §103 is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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MICHAEL R. FLEMING)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	

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ARTHUR J SAMODOVITZ
IBM CORPORATION
INTELLECTUAL PROPERTY LAW DEPARTMENT
N50/040-4
ENDICOTT, NY 13760