

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MARTIN JAMES RONAN HEALEY

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Appeal No. 2002-0119  
Application No. 09/015,713<sup>1</sup>

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ON BRIEF

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Before JERRY SMITH, GROSS and SAADAT, Administrative Patent Judges.  
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-9, which are all of the claims pending in this application.

We reverse.

BACKGROUND

Appellant's invention is directed to a method for forming a hyperlinked index of computer-readable pages of information including listings of synonyms and short names for the items

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<sup>1</sup> Application for patent filed January 29, 1998, which claims the foreign filing priority benefit under 35 U.S.C. § 119 of British Application No. 9717068.2, filed August 13, 1997.

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searched by a user. By accessing a table of stored entries, a main portion and an associated portion of an index entry having anchor tags displaying the text in long-name and short-name fields, respectively, are formed (specification, page 5).

Representative independent claim 1 is reproduced below:

1. In a computer system, a method of forming a hyperlinked index of computer-readable pages of information, comprising steps of:

accessing a table of stored table entries, each table entry having a long-name field for storing a long name of a first item, a short-name field for storing a short name of the first item and a related-items field for storing a name identifying a second item related to the first item; and

for each accessed table entry, forming a main portion of an index entry having an anchor tag displaying the text appearing in said long-name field, and forming an associated portion of the index entry having an anchor tag displaying the text appearing in the short-name field of the table entry of the second item referred to in the related-item field.

The Examiner relies on the following references in rejecting the claims:

Hamilton et al. (Hamilton)	5,758,186	May 26, 1998
Schumacher et al. (Schumacher)	5,933,841	Aug. 3, 1999 (filed May 17, 1996)

Claims 1-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schumacher in view of Hamilton.

We make reference to the answer (Paper No. 11, mailed April 9, 2001) for the Examiner's reasoning and to the appeal brief

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(Paper No. 10, filed October 10, 2000) for Appellant's arguments thereagainst.

OPINION

The Examiner relies on Schumacher for teaching stored table entries having a long-name field as the headings of product description and a related-items field as the product aliases except for the claimed accessing table entries that have a short-name field (answer, page 3). The Examiner further relies on Hamilton for teaching the missing elements as the "j" entries in the subset list that includes an IDL short name and takes the position that the product description of Schumacher in combination with the short names of Hamilton would have taught the claimed subject matter (id.).

Appellant argues that the proposed combination of Schumacher and Hamilton lacks proper motivation and would not have resulted in the claimed structure, the Examiner provides no technical principle for such combination and merely relies on Schumacher's disclosing short name features which precludes adding such feature from Hamilton (brief, page 5). Additionally, Appellant asserts that the combination would have still come short of the claimed consulting the short name field and its specific use (brief, page 6). Appellant further asserts that Schumacher, instead of the claimed hyperlinked index and its associated

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anchor tags, teaches an alternative arrangement that avoids hyperlinked anchor tags and uses a structured document that contains no links within the document (brief, page 8).

In response to Appellant's arguments, the Examiner asserts that using well known short names, such as abbreviated versions of names of Hamilton in combination with the product description of Schumacher would have been motivated by Schumacher's disclosed "headings that provide overview information" (answer, page 5). Furthermore, the Examiner refers to the SGML index fields of Schumacher for generating documents with anchors pointing to product descriptions, related items and aliases and acknowledges the absence of a teaching that these aliases are well known short names (answer, page 6). However, the Examiner characterizes the abbreviated versions of names in Hamilton as the claimed short names based on Schumacher's teachings related to headings that provide overview information (id.).

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under § 103, the examiner must produce a factual basis supported by teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Such

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evidence is required in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The Examiner must not only identify the elements in the prior art, but also show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

A review of the applied prior art confirms that Schumacher relates to a computer application for viewing documents having a predefined structure (col. 1, lines 12-14). As pointed out by Appellant (brief, page 8), Schumacher provides an alternative to browsing through a long document wherein using information links within the document makes it difficult to obtain information since the only access to other parts of the document is in whatever part of the document that is being displayed (col. 2, lines 19-25). Although Schumacher teaches that the predefined document structure provides overview information (col. 4, lines 49-56) and also includes sub-headings within each heading for product description, aliases and usage instructions (col. 4, lines 56-60), the document itself includes no entries with anchor tags. Schumacher, in fact, avoids forming information links within the document and merely marks the document to identify

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different sections by signaling the start and the end of each section in which sub-sections using the same convention may be marked such that the sub-sections are kept nested within the sections (col. 5, lines 7-34).

Hamilton, on the other hand, discloses a client/server computer for handling method calls from object request brokers that use various communication protocols (col. 1, lines 8-12). Each method call may be encoded with a different communication protocol which is used by server computer to execute the method corresponding to an index value assigned to each call according to its method descriptor (col. 1, line 56 through col. 2, line 8). Additionally, Hamilton describes operation table 100 in Figure 4 which includes index values that are linked to subset lists which, in turn, include an IDL short name, and IDL long name, a repository identification, an alternate identification, etc. (col. 6, lines 46-57). Thus, although we agree with the Examiner that some kind of short name and long name protocols are recognized by Hamilton, we do not find any specific teaching in the reference that relates to the claimed forming the main and the associated portions having anchor tags for displaying the text appearing in the long-name and short-name fields.

As discussed above, Schumacher marks a structured document for accessing different sections regardless of what part of the

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document is displayed whereas Hamilton only refers to short-name and long-name entries as a part of the protocol-dependent values used by the server computer. In concluding that Schumacher's indication of "to have headings that provide overview information" (answer, page 3) justifies using short-name headings of Hamilton in a structured document, the Examiner attempts to forge a combination of a document browser that is getting away from information links within the document and a scheme of handling method calls encoded with different protocols. Thus, assuming, arguendo, that it would have been obvious to combine Schumacher with Hamilton, as held by the Examiner, the combination would still fall short of teaching or suggesting the claimed forming the main and the associated portions having anchor tags for displaying the text appearing in the long-name and short-name fields, respectively.

In view of our analysis above, we find that the Examiner has failed to set forth a prima facie case of obviousness because the necessary teachings and suggestions related to the claimed forming of a main portion and an associated portion of an index entry having anchor tags, as recited in independent claims 1, 4 and 7, are not shown. Accordingly, we do not sustain the 35 U.S.C. § 103 rejection of independent claims 1, 4 and 7, nor of claims 2, 3, 5, 6, 8 and 9 dependent thereon.

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CONCLUSION

In view of the foregoing, the decision of the Examiner  
rejecting claims 1-9 under 35 U.S.C. § 103 is reversed.

REVERSED

JERRY SMITH	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
ANITA PELLMAN GROSS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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MAHSHID D. SAADAT	)	
Administrative Patent Judge	)	

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