Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD JAMES TARANTO, WILLIAM JOSEPH GAUVIN, URSULA SMITH, DAVID J. SULLIVAN, and LOUISE LEMAIRE

Appeal No. 2002-0288
Application No. 08/883,241

ON BRIEF

Before HAIRSTON, KRASS and GROSS, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-26.

The invention is directed to the filtering of downloaded network sites. Conventionally, when a local computer system was turned off, a user had to again re-execute a web browser and traverse the Internet to access a previously accessed web page

because the contents of the volatile cache were erased. The prior art approach was to enable users to save entire remote web sites, and other remote web sites linked to those saved remote web sites, in a non-volatile memory of the local computer system. But the increase in the size of the world wide web and sites on the web makes this kind of download into the non-volatile memory of the local computer system time consuming and causes an extremely large amount of non-volatile memory space in the local computer system to be used.

In order to limit the download time and storage space, the instant invention causes storage in the non-volatile memory of a selected remote web page, all web pages in the same node as the selected web page, and all web pages in a preselected number of nodes below the node of the selected web page. Thus, the non-volatile memory is not loaded with unnecessary web pages from higher level nodes in a remote web site. One embodiment includes filtering parameters to prevent the local computer system from storing certain types of web pages.

Representative independent claim 1 is reproduced as follows:

1. A method of downloading into memory of a local computer system documents from nodes on a remote network site, the nodes being in a hierarchical tree structure with a plurality of

levels, the tree structure having a highest node level, the method comprising:

designating one of the nodes in the tree structure as a root node;

designating a deepest node level of the tree structure, the deepest node level being the same as or below the level of the root node; and

downloading, into the memory of the local computer system, documents in the nodes on levels that are in and between the root node and the node at the deepest node level.

The examiner relies on the following references:

Sanderman	5,794,006	Aug. 11, 1998 (filed Aug. 18, 1995)
Anderson	5,825,363	Oct. 20, 1998 (filed May 24, 1996)
Leshem et al. (Leshem)	5,870,559	Feb. 9, 1999 (filed Apr. 11, 1997)
Hughes et al. (Hughes)	5,892,908	Apr. 6, 1999 (filed Sep. 10, 1996)

Claims 1-26 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner cites Sanderman and Hughes with regard to claim 1, adding Leshem with regard to claims 2-8 and further adding Anderson with regard to claims 9-26.

Reference is made to the brief and answer 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 much stem from some teachings, 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, 1040, 228 USPQ 685, 687 (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, 1051, 189 USPQ 143, 146-147 (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 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 takes the position that Sanderman discloses downloading into memory of a local computer system by teaching the allocation of memory from a node memory area into the computer memory, citing column 8, lines 10-35. The examiner urges that Sanderman's teaching of a hierarchical data structure including three different types of nodes --folder nodes, leaf nodes, and junction point nodes– is a teaching of the claimed hierarchical tree structure. The examiner cites Figures 1 and 2 and column 7, lines 23-65, of Sanderman as a teaching of a variety of levels within a hierarchical tree structure and nodes that contain a deepest level which link a service namespace with another service

namespace. The examiner cites item 204a in Sanderman's Figures 1 and 2 as the designation of one node as the "root" node, and cites items 120, 130, 132, 134 and 138 in Figure 1 as evidence of designating a deepest node level of the tree structure, wherein the deepest node is the same as or below the level of the root node.

The examiner indicates that Sanderman does not explicitly teach downloading, into the memory of the local computer system, documents in the nodes on levels that are in and between the root node and the node at the deepest node level, but turns to Hughes for such a teaching. Citing column 3, lines 8-67 and column 4, lines 1-64, of Hughes, for a downloading of files having the same root address as the original file and downloading the original file and none of the files associated with hyper text links as well as all the files associated with the hyper text links from the same server, which, according to the examiner, means that those files or documents associated with the root as well as the original file would be included in the download.

The examiner concludes that it would have been obvious to combine Hughes' extracting of network information with the Sanderman system for the purpose of retrieving information in a system manner for bundling and distribution in other formats,

citing column 1, lines 35-37, of Hughes.

Appellants argue that while Sanderman may teach viewing a hierarchical nodal structure (for example, in Figure 4, showing a display, the contents of folder 204d are displayed, including leaf nodes "movie Chat Room," etc.) at local computer 102, Sanderman does not teach *designating* a deepest node level of the tree structure. It is argued that by designating a deepest node level in the instant invention, only a selected number of documents are downloaded into the memory of the local computer system, i.e., only the documents in the nodes on levels that are in and between the root node and the node of the deepest level so designated, and so download time and memory space on the local computer system are conserved.

Appellants also argue that Sanderman fails to teach "downloading, into the memory of the local computer system, documents in the nodes on levels that are in and between the root node and the node at the deepest node level." Appellants state that, contrary to the examiner's position, Hughes does not teach this limitation and, even if it did, it would result in *all* of the network information being downloaded to the local computer because Hughes does not designate a deepest node level of the

tree structure and so cannot download documents in nodes on

levels that are in and between the root node and the node of the deepest level designated on the tree structure.

We note that, in accordance with appellants' grouping of the claims at page 4 of the brief, all of the claims will stand or fall together. Accordingly, we will focus our attention on instant claim 1.

We will sustain the examiner's rejection of claims 1-26 under 35 U.S.C. § 103 because, although we understand the difference between the instant disclosed invention and the devices of Sanderman and Hughes (the former having the capability of varying the number of documents that are downloaded by changing the designation of the deepest node level), we are not convinced that claim 1 recites this possibly distinguishing feature.

Appellants admit that Sanderman teaches that a hierarchical nodal structure may be viewed but argues that Sanderman does not teach *designating* a deepest node level of the tree structure. However, while Sanderman may not vary the designation of a deepest node level, it is clear that it discloses a "deepest" node level. Therefore, whatever that "deepest" node level is

becomes the "designated" deepest node level.

With regard to downloading documents in the nodes on levels that are in and between the root node and the node at the deepest node level, appellants do not argue that Hughes may not be combined with Sanderman. Rather, they merely argue that neither Sanderman nor Hughes discloses "downloading, into the memory of the local computer system, documents in the nodes on levels that are in and between the root node and the node at the deepest node level." But then, appellants argue that the combination of references would result in *all* of the network information being downloaded to the local computer because Hughes does not designate a deepest node level of the tree structure and so cannot download documents in nodes on levels that are in and between the root node and the node of the deepest level designated on the tree structure.

The point is, as broadly claimed, a result of *all* the network information being downloaded to the local computer (which appellants admit would result in the combination of Hughes with Sanderman) would meet the instant claim language wherein the designation of the deepest node level is, in fact, the designation of *all* the information.

In fact, we think the admitted prior art, described at pages 1-2 of the instant specification, would meet the language of instant claim 1 because the claim language does not preclude the downloading of an entire remote web site (indicated to be prior art at page 2 of the specification). This is so because an entire remote web site will include a "deepest node level" which is "the same as or below the level of the root node" and the download of the entire remote web site will, in fact, result in documents in the nodes on "levels that are in and between the root node and the node at the deepest node level," as claimed.

Again, we understand that appellants intended the "designation" of a deepest node level to permit a selection which might vary but, as broadly claimed, we view the language as including an entire remote web site. As in the prior art, once an entire remote web site is "designated," the deepest node level of the tree structure of that web site is "designated" and a download of that entire remote web site will clearly result in documents in the nodes on "levels that are in and between the root node and the node at the deepest node level."

While some of the dependent claims may contain limitations distinguishing the claimed invention from that disclosed in the applied references, appellants do not separately argue the merits

of those claims. Arguments not made are waived. In re Kroekel, 803 F.2d 705, 231 USPQ 640 (Fed. Cir. 1986).

Accordingly, the examiner's decision rejecting claims 1-26 under 35 U.S.C. § 103 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	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ANITA PELLMAN GROSS Administrative Patent Judge	)	

EK/RWK

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