

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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL J. BERANEK

Appeal No. 2002-1517
Application No. 08/927,660

ON BRIEF

Before JERRY SMITH, DIXON, and BARRY, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-31, which are all of the claims pending in this application.

We REVERSE.

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Appellant's invention relates to an HTTP caching proxy to filter and control display of data in a web browser. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method of controlling presentation on a client of a Web document formatted according to a markup language and supported on a server, the client including a browser and connectable to the server via a computer network, the method comprising the steps of:

as the Web document is received on the client, parsing the Web document to identify formatting information;

altering the formatting information to modify at least one display characteristic of the Web document; and

passing the Web document to the browser for display.

The prior art of record relied upon by the examiner in rejecting the appealed claims is as follows:

Mighdoll et al. (Mighdoll) 5,918,013 Jun. 29, 1999

Brown, M.R. et al., Special Edition Using Netscape™ 2, Chapter 26, HTML Primer 647-701 (2d ed., Que Corporation 1995) (Brown)

Claims 1-12, 14, 18-19, 21-23, and 25-29 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mighdoll. Claims 13, 15-17, 20, 24, and 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mighdoll in view of Brown.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's rejection (Paper No. 13, mailed Sep. 25, 2000), examiner's final rejection (Paper No. 17,

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mailed Apr. 2, 2001) and the examiner's answer (Paper No. 24, mailed Jan. 2, 2002) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 23, filed Oct. 16, 2001) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations which follow.

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). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**,

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837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Products Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the examiner can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.'" **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999-1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to

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establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations set forth in independent claim 1. Appellant argues that independent claim 1 is directed to methodology for implementing a caching proxy at the client that can control the "look and feel" of the data that is received from a Web server and subsequently presented to a browser at a client. (See brief at page 11.) We agree with appellant that the claims specifically require that the parsing/analysis and the altering be performed at the client. The examiner maintains that "the client is a combination of WebTV client 1 and WebTV service 5 that is connected to the network 3." (See answer at page 4.) We find the examiner's correlation of client to be unreasonable in view of its ordinary meaning and the clear usage in the text of Mighdoll. Mighdoll uses the same term wherein the end user is the client and WebTV service 5 (server) is an intermediary/proxy at a location remote from the client unit 1. We generally agree with appellant's arguments in the brief, but do not find appellant's argument with respect to the economic impact on the WebTV service for moving the parsing and/or transcoding to the client to be persuasive regarding the technological obviousness. Additionally,

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we do note that Mighdoll specifically states in column 8, lines 43-46, and column 9, lines 7-9, that “[i]t should be noted that transcoding can be deferred until after the document has been downloaded, as described above; hence the sequence of FIG. 6 is illustrative only” and “that transcoding can be deferred until after the document has been downloaded in some cases.” Here, we find that Mighdoll specifically teaches that the client may perform the transcoding or altering of the data, but we leave it to the examiner to evaluate this specific teaching and determine whether it would have been obvious to one of ordinary skill in the art to further perform the analysis or parsing of data to determine the appropriate transcoding at the client rather than at the intermediary. Since we find that the examiner has not established a *prima facie* case of obviousness of independent claim 1, we cannot sustain the rejection of independent claim 1 and its dependent claims.

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With respect to independent claims 12, 19, and 23, we find similar limitations concerning the parsing and altering being performed at the client as with independent claim 1. Since we find that the examiner has not established a *prima facie* case of obviousness of independent claims 12, 19, and 23, we cannot sustain the rejection of independent claims 12, 19, and 23 and their dependent claims. Furthermore, we agree with appellant that the teachings of Brown do not remedy the deficiency in Mighdoll.

With respect to independent claims 25, 28, and 31, we agree with appellant that the examiner has not established a *prima facie* case of obviousness of the claimed invention with respect to the functionality being performed at the client with a browser rather than at an intermediary as discussed above. Since we find that the examiner has not established a *prima facie* case of obviousness of independent claims 25, 28, and 31, we cannot sustain the rejection of independent claims 25, 28, and 31 and their dependent claims.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 1-31 under 35 U.S.C. § 103 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
JOSEPH L. DIXON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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)	
LANCE LEONARD BARRY)	
Administrative Patent Judge)	

JLD:clm

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