

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte CARY LEE BATES and PAUL REUBEN DAY

---

Appeal No. 2002-2011  
Application No. 09/163,643

---

ON BRIEF

---

Before HAIRSTON, KRASS 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, 3-10, 12-21 and 23-28.

The invention relates to bookmarks for marking favorite websites when using the Internet. In particular, the invention concerns the organization of the bookmarks in order to simplify and accelerate the user's ability to find bookmarks and find

Appeal No. 2002-2011  
Application No. 09/163,643

relevant information. The organization is automated by determination of a "mutual affinity" between bookmarks based upon shared characteristics that are obtained from the bookmarks and/or the documents referenced thereby. These characteristics are quantified so that an association between two bookmarks can be automatically established whenever an affinity between the two bookmarks, as determined based upon a particular "affinity criteria," exceeds a predetermined threshold.

Representative independent claim 1 is reproduced as follows:

1. A computer-implemented method of associating a first bookmark for a storage location to a second bookmark, the method comprising:

(a) determining an affinity between the first and second bookmarks based upon a predetermined affinity criteria; and

(b) associating the first bookmark with the second bookmark by creating an affinity link responsive to the affinity exceeding a predetermined threshold.

The examiner relies on the following references:

Dolan et al. (Dolan)	5,801,702	Sep. 1, 1998
Burke	6,032,162	Feb. 29, 2000
Mantha et al. (Mantha)	6,163,779	Dec. 19, 2000

Maarek et al., "Automatically Organizing Bookmarks per Contents", Fifth International World Wide Web Conference, (May 6-10, 1996), pp. 1-13.

Appeal No. 2002-2011  
Application No. 09/163,643

Claims 1, 3-10, 12-21 and 23-28 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner offers Burke, Maarek and Mantha with regard to claims 1, 5, 6, 9, 12-14, 17-21, 23, 24 and 26, adding Dolan to this combination with regard to claims 3, 4, 8, 10, 15, 16 and 25. The examiner applies Burke and Maarek against claims 7, 27 and 28.

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,

Appeal No. 2002-2011  
Application No. 09/163,643

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 cites Burke as teaching the determination of an affinity between a first

Appeal No. 2002-2011  
Application No. 09/163,643

bookmark merged with a second bookmark using a predetermined affinity criteria (citing column 5, lines 8-15). Citing column 5, lines 42-50, of Burke, the examiner contends that the reference teaches associating related bookmarks.

The examiner recognizes that Burke does not specifically teach bookmark association in response to an affinity exceeding a threshold, but points to Maarek for a teaching of association using predetermined thresholds of similarity including lexical affinity and data slicing, at page 6, paragraphs 1-3 and page 7, paragraphs 2-3. The examiner concludes that it would have been obvious to apply Maarek to Burke "because Maarek's taught advantage of a lexical affinity indexing scheme to provide increased precision to the bookmarking association method of Burke" (answer-page 5).

The examiner further recognized a deficiency in Burke in not teaching the claimed affinity association via a link, i.e., a linked list. The examiner turned to Mantha for a teaching of categorization of related web pages utilizing a linked list pointing to the pages, in an embodiment utilizing bookmarks. Specifically, the examiner points to column 2, lines 34-44, and column 9, lines 26-33, and Figures 7A-7C, of Mantha. The examiner then concludes that it would have been obvious "to apply

Appeal No. 2002-2011  
Application No. 09/163,643

Mantha to Burke, because of Mantha's taught advantage of links (linked lists), providing a more flexible data structure to hold bookmarking references" (answer-page 5).

For their part, appellants argue that Burke may be considered to teach two bookmarks related by affinity, but the bookmarks are "only indirectly related through the common category, rather than directly linked by affinity to another bookmark via an affinity link" (brief-page 7). This argument is not persuasive since it does not appear to be based on any limitation in the claims. Claim 1 does not require any "direct" or "indirect" relations between bookmarks.

Appellants also argue that Burke requires that a user traverse through a hierarchy to display and navigate between bookmarks and that this does not provide the same level of intuitiveness as is provided by direct affinity links. Again, this argument does not appear to be based on any specific limitation of the claims. Accordingly, it is not persuasive.

Similarly, appellants' argument that Maarek suffers from the same drawbacks as Burke is not persuasive because no specific claim limitation is cited as distinguishing over Burke and Maarek.

Appeal No. 2002-2011  
Application No. 09/163,643

Appellants further argue that Mantha merely discloses the use of linked lists to represent all of the outbound links in a document and that while linked lists do arguably link together embedded links in a document, these links are not bookmarks. Further, appellants note that there is no determined "affinity," within the context of the instant invention, between Mantha's embedded links.

Accordingly, appellants conclude that not one of the applied references discloses "associating the first bookmark with the second bookmark by creating an affinity link responsive to the affinity exceeding a predetermined threshold."

While we do not necessarily agree with all of appellants' arguments, we do agree with their conclusion that none of the cited references disclose "associating the first bookmark with the second bookmark by creating an affinity link responsive to the affinity exceeding a predetermined threshold."

It is clear to us, as the examiner points out, that Burke does disclose a determination of an affinity between bookmarks based upon a predetermined affinity criteria (e.g., "by theme and topic" -column 5, lines 12-13). It may also be argued that Mantha might suggest something about an affinity "link" since a user activates a link to a pointer from a menu associated with a

Appeal No. 2002-2011  
Application No. 09/163,643

category relative to a hypertext reference (column 2, lines 38-40).

However, we find nothing disclosed or suggested by any of the references relative to the claimed feature of associating the bookmarks by creating an affinity link "responsive to the affinity exceeding a predetermined threshold." The examiner relies on pages 6-7 of Maarek for this suggestion. However, we have read and re-read the Maarek reference, concentrating on the cited portions thereof, and we are at a loss to find any clear suggestion of this claim limitation. The examiner appears to rely on the disclosure, at page 7, of expressing a minimum degree of intra-cluster similarity as a "percentage" as a finding that the reference discloses an affinity "threshold."

While we cannot glean such a conclusion from pages 6-7 of Maarek, even if we were to find that some kind of threshold is suggested by Maarek, it still begs the question as to why the skilled artisan would have applied any such teaching to the teachings of Burke and Mantha in order to modify these references so that there is an association between bookmarks by the creation of an affinity link "responsive to the affinity exceeding a predetermined threshold." The examiner does not satisfactorily

answer this question.

As such, we will not sustain the rejection of claims 1, 3-6, 8-10, 12-21 and 23-26 under 35 U.S.C. § 103, noting that the addition of Dolan, with regard to the rejection of claims 3, 4, 8, 10, 15, 16 and 25, does not provide for the deficiencies of the combination of Burke, Maarek and Mantha.

Turning to the rejection of independent claim 7, the examiner again points out that Burke teaches the associating of related bookmarks (column 5, lines 42-50) and that Burke teaches determining an affinity between two bookmarks (column 5, lines 8-15).

However, the examiner notes that Burke does not specifically teach the display of a second bookmark in response to a first bookmark. The examiner turns to Maarek for a bookmark display whereby the selection of a bookmark set results in a plurality of related displayed bookmarks (page 11, Figure 5). The examiner concludes that it would have been obvious to apply Maarek to Burke "because Maarek's taught advantage of a lexical affinity indexing scheme to provide increased precision to the bookmarking association method of Burke," (answer-page 13), citing Maarek, page 6, paragraph 2.

Claim 7 does appear rather broad in nature and we can agree

that Burke does disclose the determination of an affinity between first and second bookmarks and associating the first bookmark with the second bookmark. However, as the examiner recognized, Burke does not teach that the second bookmark is displayed "in response to" a user selecting the first bookmark, as claimed. In order to provide for this teaching, the examiner cites Figure 5 of Maarek. But, even the examiner admits that, in Maarek, the selection of a bookmark "set," of a folder entitled "Netscape: Bookmarks," results in a plurality of related displayed bookmarks, themselves incorporating a plurality of additional related bookmarks (answer-page 13).

A bookmark "set" or a folder is not the same as a bookmark. While claim 7 does not specifically recite an "individual" or "single" bookmark, it is clear that this is what is intended by the phrases, "a first bookmark" (emphasis added) and "a second bookmark" (emphasis added). That being the case, it is apparent to us that the disclosure of a bookmark "set," or folder, by Maarek, wherein the selection of a bookmark set results in a plurality of related displayed bookmarks, would not have suggested to the skilled artisan the display of an individual bookmark in response to a user selecting another individual bookmark.

Appeal No. 2002-2011  
Application No. 09/163,643

Moreover, even if we assume, arguendo, that Maarek might be considered to suggest the display of a second bookmark in response to a user selecting a first bookmark, we find no reason apparent in the applied references, or in the knowledge of skilled artisans, for employing such a teaching in order to modify Burke in any manner. The examiner's allegation of a motivation in the "advantage of a lexical affinity indexing scheme to provide increased precision..." is not persuasive since there is no reason to believe that the "lexical affinity indexing scheme" of Maarek would be applicable to Burke's system or that it would "provide increased precision," as alleged by the examiner.

Accordingly, we will not sustain the rejection of claims 7, 27 and 28 under 35 U.S.C. § 103.

Appeal No. 2002-2011  
Application No. 09/163,643

Since we have not sustained any of the rejections of claims  
1, 3-10, 12-21 and 23-28, the examiner's decision is reversed.

REVERSED

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	
	)	
ERROL A. KRASS	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
	)	
JOSEPH F. RUGGIERO	)	
Administrative Patent Judge	)	

EK/RWK

SCOTT A. STINEBRUNER  
WOOD HERRON & EVANS

Appeal No. 2002-2011  
Application No. 09/163,643

2700 CAREW TOWER  
441 VINE STREET  
CINCINNATI, OH 45202-2917