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The opinion in support of the decision entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL M. TSO

Appeal No. 2002-2013
Application 09/036,699¹

ON BRIEF

Before LEE, LANE and MOORE, Administrative Patent Judges.

LEE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's rejection of appellant's claims 9, 11-17, 22-26 and 29. No claim has been allowed.

References relied on by the Examiner

Barrett et al. ("Barrett")	5,727,129	March 10, 1998
Hirai et al. ("Hirai")	5,974,371	October 26, 1999

¹

Application for patent filed March 6, 1998. The real party in interest is Intel Corporation.

The Rejections on Appeal

Claims 9, 16, 17, 22, 23, and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable for obviousness over Barrett.

Claims 11-15 and 29 stand rejected under 35 U.S.C. § 103 as being unpatentable for obviousness over Barrett and Hirai.

Claims 24 and 26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Barrett.

The independent claims are claims 9, 22 and 24. Claims 11-17 and 29 each depend, either directly or indirectly, from independent claim 9. Each of claims 23 and 25 depends from claim 22, and claim 26 depends from claim 24.

The Invention

In a network environment having at least two platforms, the invention is directed to producing or parsing a list of Uniform Resource Locators (URLs) and prefetching one or more of the URLs to a remote proxy server or platform. Independent claims 9, 22 and 24 are reproduced below:

9. A method of using a network connection between a client platform and a server platform comprising:

producing on one of the platforms a list of Uniform Resource Locators (URLs) from a requested network page, said list comprising links in said requested network page; and

pre-fetching via said connection at least one of said URLs to a remote proxy server.

22. A network comprising:

a first platform and a second platform;

said platforms being adapted to parse a list of URLs from a requested network data object and to pre-fetch via said network connection said URLs to a remote proxy server.

24. An article comprising:

a machine readable storage medium having stored thereon instructions capable of being executed by a data processing platform, said instructions being adapted to parse a list of URLs from a received network data object and to pre-fetch via a network connection said URLs to a remote platform in accordance with a pre-determined pre-fetching policy.

Discussion

A. The Anticipation Rejection

To establish anticipation under 35 U.S.C. § 102, each and every element and limitation in a claim, arranged as is recited in the claim, must be found in a single prior art reference. Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); see also Glaxo, Inc. v. Novopharm, Ltd., 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir. 1995). The examiner has rejected claims 24 and 26 under 35 U.S.C. § 102(e) as being anticipated by Barrett. Claim 26 depends from claim 24 and thus includes all the limitations of claim 24. Claim 24 specifically requires stored instructions executable on a data processing platform, which are adapted (1) to parse a list of URLs from a received network data object and (2) to pre-fetch via a network connection the URLs to a remote platform in accordance with a

pre-determined pre-fetching policy. The key here is the pre-fetching of URLs to a remote platform, one other than that on which the stored instructions are executed.

Citing Barrett's abstract and column 9, lines 1-45, the examiner finds that Barrett discloses stored instructions which pre-fetch via a network connection URLs to a remote platform in accordance with a predetermined pre-fetching policy. (Answer at 9) The examiner further states (Answer at 9-10): "The instructions are included in any one of browser, a network driver, protocol stack and a proxy (see figures 1-3, column 6, lines 9-60, browser, a network driver, protocol stack and a proxy are inherently included in the internet 12)."

We have reviewed both the abstract of Barrett as well as column 9, lines 1-45 of Barrett, and like the appellant, we do not find anything in the cited material about pre-fetching a URL or URLs to a remote platform. While it is true that URL's are pre-fetched to minimize the wait-time in case they are selected by a user, the examiner simply presumes that the URL's are pre-fetched to "a remote platform," one other than that on which the stored instructions are executed. The material in Barrett refers to downloading. It is without basis to assume that the downloading is done to send material expected to be desired by the user to a remote platform.

While it is true that the internet includes multiple proxy servers, the examiner presented no evidence that URLs are necessarily pre-fetched to a proxy server. Moreover, on page 9 of the answer, the examiner states that in Barrett the instructions are inherently included in the internet 12 and node 16. Stating that instructions are inherently included in the internet 12 is too vague to have any useful meaning in the context of locating specific platforms on which the

instructions are executed, especially when the examiner also states that the instructions are inherently included in node 16. Assuming that the instructions are located in node 16, which is a local node with respect to the user (column 6, lines 50-65), then in the context of claim 24, a remote platform is remote from the user. The examiner has pointed to no disclosure in Barrett about downloading or pre-fetching to a remote platform relative to the user's own platform. Even if the platform on which the stored instructions are executed is not that of the user, the examiner has not shown that the platform to which the URLs are downloaded is remote from the platform on which the instructions are executed.

For the foregoing reasons, the rejection of claims 24 and 26 cannot be sustained.

B. The Obviousness Rejection Over Barrett

The examiner has rejected claims 9 and 16-17 under 35 U.S.C. § 103 as being obvious over Barrett. Claims 16 and 17 each depends from claim 9 and thus includes all the limitations of claim 9. Under Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966), one of the underlying facts the examiner must determine is the differences between the claimed invention and the prior art. In that regard, the examiner found (Answer at 4):

Barrett does not explicitly show that the URLs are prefetched to a remote proxy server because URLs are prefetched to a remote client

To account for that difference, the examiner states (Answer at 4):

[H]owever, Barrett teaches the use of internet and suggests that the internet 12 includes numerous servers, storage, repositories, communication links, etc. Barrett further teaches that general architecture of the internet is well known in the art. Therefore, it would have been obvious for one with ordinary skill in the art at the time the invention was made to modify Barrett by sending URLs to a

proxy server or any one of servers, storage, repositories, communication links in the internet environment because the use of proxy servers are old and well known in the art. In addition, sending URLs to a different destination is not a patentable distinction, and it is only a design choice.

The above-quoted rationale is unpersuasive. Most of the examiner's assertions are merely conclusory and without supporting evidence, e.g., the statement that sending URLs to a different (meaning remote in this context) destination is not a patentable distinction and is only a design choice. The examiner has not cited to any prior art which makes use of a remote server or remote platform as the destination for a pre-fetch operation for URLs. Even assuming that remote servers or remote platforms exist on the internet, that alone does not mean all uses or applications involving remote servers and platforms are without patentable distinction. It is incumbent upon the examiner to produce evidence to support an obviousness conclusion and not simply declare the claimed invention obvious.

The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. Id. We also do not find that the examiner either has taken official notice or can take such official notice that it is common knowledge to pre-fetch URLs to a remote platform or a remote server. The matter is clearly in dispute. Ultimately, and in any event, it is still up to the examiner to produce evidence sufficient to make out a prima facie case of obviousness. The

examiner must provide a factual basis to support an obviousness conclusion. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967). A determination of obviousness must be based on facts and not on unsupported generalities. In re Freed, 425 F.2d 785, 787, 165 USPQ 570, 571 (CCPA 1970). Here, the examiner has failed to set forth sufficient evidence in support of an obviousness rejection.

For the foregoing reasons, the rejection of claims 9 and 16-17 as being unpatentable over Barrett cannot be sustained.

The examiner has rejected claims 22, 23 and 25 under 35 U.S.C. § 103 as being obvious over Barrett. Claims 23 and 25 each depends from claim 22 and thus includes all the limitations of claim 22. Under Graham v. John Deere Co., 383 U.S. at 17-18, 148 USPQ at 467, one of the underlying facts the examiner must determine is the differences between the claimed invention and the prior art. In that regard, the examiner found (Answer at 4):

Barrett does not explicitly show that the URLs are prefetched to a remote proxy server because URLs are prefetched to a remote client

To account for that difference, the examiner states (Answer at 8):

[H]owever, Barrett teaches the use of internet and suggests that the internet 12 includes numerous servers, storage, repositories, communication links, etc. Barrett further teaches that general architecture of the internet is well known in the art (see column 6, lines 51-58). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Barrett by sending URLs to a proxy server or any one of servers, storage, repositories, communication links in the internet environment because the use of proxy servers are old and well known in the art. In addition, sending URLs to a different destination is not a patentable distinction, and it is only a design choice.

The above-quoted rationale is unpersuasive. Most of the examiner's assertions are merely conclusory and without supporting evidence, e.g., the statement that sending URLs to a different (meaning remote in this context) destination is not a patentable distinction and is only a design choice. The examiner has not cited to any prior art which makes use of a remote server or remote platform as the destination for a pre-fetch operation for URLs. Even assuming that remote servers or remote platforms exist on the internet, that alone does not mean all uses or applications involving remote servers and platforms are without patentable distinction. It is incumbent upon the examiner to produce evidence to support an obviousness conclusion and not simply declare the claimed invention obvious.

The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d at 1266, 23 USPQ2d at 1783-84. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. Id. We also do not find that the examiner either has taken official notice or can take such official notice that it is common knowledge to pre-fetch URLs to a remote platform or a remote server. The matter is clearly in dispute. Ultimately, and in any event, it is still up to the examiner to produce evidence sufficient to make out a prima facie case of obviousness. The examiner must provide a factual basis to support an obviousness conclusion. In re Warner, 379 F.2d at 1017, 154 USPQ at 177. A determination of obviousness must be based on facts and not on unsupported

generalities. In re Freed, 425 F.2d at 787, 165 USPQ at 571. Here, the examiner has failed to set forth sufficient evidence in support of an obviousness rejection.

For the foregoing reasons, the rejection of claims 22, 23 and 25 as unpatentable over Barrett cannot be sustained.

C. The Obviousness Rejection Over Barrett and Hirai

The examiner has rejected claims 11-15 and 29 under 35 U.S.C. § 103 as being obvious over the combined teachings of Barrett and Hirai. Claim 29 depends from claim 9 and each of claims 11-15 depends, directly or indirectly, from claim 29. Accordingly, claim 29 includes all the limitations of claim 9 and each of claims 11-15 includes all the limitations of claim 29.

In Section B above, we have discussed the examiner's rejection of claim 9 as being obvious over Barrett and found that it has no merit. The examiner has applied Hirai only to account for the additional features recited in dependent claims 29 and 11. Thus, as is presented by the examiner, the addition of Hirai does not make up for the above-noted deficiencies with respect to Barrett in connection with independent claim 9. As for claims 12-15, the examiner further relies on Barrett to account for the features added by each of these claims relative to claim 9. However, the deficiencies of Barrett with respect to the features of independent claim 9 still remain. Accordingly, the rejection of claims 11-15 and 29 as unpatentable over Barrett and Hirai cannot be sustained.

Conclusion

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The rejection of claims 9, 16, 17, 22, 23 and 25 under 35 U.S.C. § 103 as unpatentable for obviousness over Barrett is **reversed**.

The rejection of claims 11-15 and 29 under 35 U.S.C. § 103 as being unpatentable for obviousness over Barrett and Hirai is **reversed**.

The rejection of claims 24 and 26 under 35 U.S.C. § 102(e) as being anticipated by Barrett is **reversed**.

REVERSED

JAMESON LEE)
Administrative Patent Judge)
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) BOARD OF PATENT
SALLY GARDNER LANE) APPEALS AND
Administrative Patent Judge) INTERFERENCES
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JAMES T. MOORE)
Administrative Patent Judge)

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