

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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL M. TSO, DAVID A. ROMRELL, and
BIKRAM S. BAKSHI

Appeal No. 2002-2115
Application No. 09/000, 709

ON BRIEF

Before DIXON, GROSS, 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, 2, 7, 8, 16, and 18-31, which are all of the claims pending in this application.

We **REVERSE**.

Appellants' invention relates to a system for delivery of dynamic content to a client device. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method for presenting dynamic content to a user of a client device, wherein the client device is configured to access a plurality of content servers through a network proxy, said method being performed by the network proxy and comprising the steps of:

receiving at the network proxy a request for a first data object from a user of the client device;

retrieving the first data object from a content server;

embedding a dynamic executable module in the first data object, the dynamic executable module comprising executable instructions;

downloading the first data object with the embedded dynamic executable module from the network proxy to the client device;

executing the dynamic executable module to retrieve dynamic content from the network proxy, said execution and retrieval being transparent to a user of the client device and not interfering with servicing of additional requests for data objects by the user; and

presenting the retrieved dynamic content to the user concurrently with one or more data objects requested by the user, wherein said dynamic content comprises information that was not requested by the user.

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

Simmons	5,974,451	Oct. 26, 1999 (filed May 30, 1997)
Renshaw	6,065,024	May 16, 2000 (filed Mar. 24, 1997)

Claims 1, 2, 7, 8, 16, and 18-31 stand rejected under 35 U.S.C. § 103 as being unpatentable over Simmons in view of Renshaw.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 27, mailed Jun. 28, 2002) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 26, filed Apr. 15, 2002) and reply brief (Paper No. 28, filed Jul. 26, 2002) for appellants' arguments thereagainst.

OPINION

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

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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**, 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, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against

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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-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer 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 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, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to 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.

Independent claim 1 recites "executing the dynamic executable module to retrieve dynamic content from the network proxy, said execution and retrieval being transparent to a user of the client device and not interfering with servicing of additional request for data objects by the user." [Emphasis added.] Appellants argue that Simmons fails to teach or suggest "embedding a dynamic executable module . . ." and "executing the dynamic executable module to retrieve dynamic content from the network proxy . . ." (See brief at pages 10 and 11.) The examiner maintains that Simmons teaches the embedding of executable modules, by embedding bulletins and then maintains that Simmons does not specifically disclose the dynamic executable module comprising executable instructions. (See answer at page 3-4.) The examiner further maintains that Simmons teaches executing the dynamic executable module to retrieve dynamic content from the network proxy. (See answer at page 4.) We agree with appellants that Simmons does not teach or fairly suggest embedding an

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executable module nor the execution of an executable module to retrieve content from the network proxy. From our review of the teachings of Simmons, the content (bulletin) is either attached/embedded, sent separately or determined that a bulletin is not to be sent at all, in which case the received information is forwarded without a bulletin. We find no teaching or suggestion in Simmons that the client will use the executable module to retrieve the content from the network proxy. The examiner maintains that Renshaw teaches the use of executable modules with executable instructions since Renshaw teaches the use of embedded JAVA applets. (See answer at page 7.) While we agree with the examiner that Renshaw teaches the use of embedded modules which are executed at the client, the execution of the module merely presents the content on the display and does not perform the function “to retrieve dynamic content from the network proxy” as recited in the language of independent claim 1. Therefore, we agree with appellants that the combination of Simmons and Renshaw does not teach or fairly suggest all of the claimed limitations, and we cannot sustain the rejection of independent claim 1 and its dependent claims 2, 7, and 8. Independent claims 16, 20, and 29 contain similar limitations which are not taught or fairly suggested by the combination of Simmons and Renshaw, and therefore, we cannot sustain the rejection of these claims and their dependent claims 18, 19, 21-28, 30, and 31.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 7, 8, 16, and 18-31 under 35 U.S.C. § 103 is reversed .

REVERSED

JOSEPH L. DIXON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ANITA PELLMAN GROSS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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LANCE LEONARD BARRY)	
Administrative Patent Judge)	

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