

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. 22

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. 2003-1094
Application No. 09/131,063

ON BRIEF

Before KRASS, FLEMING, and OWENS, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from a nonfinal, third rejection of claims 1-38 and 46-50.¹ Claim 47 was canceled subsequent to the last rejection (examiner's answer, page 2). Claims 39-45 also have been canceled.

¹ In an appeal in which claims have been at least twice rejected, the board has jurisdiction as discussed in *Ex parte Lemoine*, 46 USPQ2d 1432 (Bd. Pat. App. & Int. 1995).

THE INVENTION

The appellants claim a method, apparatus and program product for displaying a hypertext document. Claims 1 and 46, directed toward the method, are illustrative:

1. A method of displaying a hypertext document, the method comprising:

(a) displaying at least a portion of a hypertext document on a computer display;

(b) accessing a comment data structure including a plurality of comments to locate a predetermined comment among the plurality of comments that is associated with the hypertext document;

(c) displaying a display representation of the predetermined comment on the computer display; and

(d) adding a new comment to the comment data structure by building the comment from information in a comment data tag embedded in the hypertext document.

46. A method of generating a hypertext document, the method comprising:

(a) authoring a hypertext document; and

(b) embedding within the hypertext document at least one comment data tag, the comment data tag including comment data that defines a plurality of comments, each comment associated with a predetermined storage location.

THE REFERENCES

Nielsen	5,937,417	Aug. 10, 1999 (filed May 7, 1996)
Hayashi et al. (Hayashi)	6,014,677	Jan. 11, 2000 (filed Jun. 10, 1996)

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THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1-5, 7-38, 46 and 48-50 over Hayashi, and claim 6 over Hayashi in view of Nielsen.

OPINION

We affirm the rejection of claim 46 and reverse the rejections of the other claims. We need to address only the independent claims, i.e., claims 1, 23, 35, 38, 46 and 48.²

Claim 46

Hayashi discloses a method for generating a hypertext document, comprising authoring a hypertext document having a comment tag which is displayed in the same window with the associated document data (col. 23, lines 61-63; figure 29). Because, when the hypertext document is displayed, the comment tag appears in the same window as the document data, the comment tag reasonably can be considered to be embedded in the hypertext document.

² The examiner does not rely upon Nielsen for any disclosure that remedies the deficiency in Hayashi as to independent claim 1 from which claim 6 indirectly depends.

Hayashi's comment tag may be a query that defines a set of comments to be combined and displayed as a virtually generated view when the comment tag is displayed (col. 11, lines 1-5).³ We therefore do not find convincing the appellants' argument that Hayashi does not disclose or suggest embedding in a hypertext document a single comment data tag that defines multiple comments (brief, page 11).

Accordingly we conclude that the method claimed in the appellants' claim 46 would have been obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103. Hence, we affirm the rejection of that claim.

Claims 1, 23, 35 and 38

Claims 1, 23, 35 and 38 require that a new comment is added to a comment data structure "by building the comment from information in a comment data tag embedded in the hypertext document." It is proper to use the specification to interpret what the appellants mean by a word or phrase in a claim. *See In re Morris*, 127 F.3d 1048, 1053-56, 44 USPQ2d 1023, 1027-30 (Fed. Cir. 1997). The specification indicates that by "building the comment from information in a comment data tag", the appellants

³ Each of these comments necessarily is associated with the storage location from which it is obtained.

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mean that the information used to build the comment is derived from the comment data tag itself (page 28, lines 12-16). The appellants' interpretation is consistent with this interpretation (brief, pages 7 and 9).

The examiner argues (answer, pages 14-15):

Hayashi et al fail to explicitly teach *(d) adding a new comment to the comment data structure by building the comment from information in a comment data tag*. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to have edited a comment, by adding new information to comment data already present in the comment located between HTML tags *building the comment from information in a comment*, document using well known HTML editing techniques, and then displaying because Hayashi et al teach the correction or editing of a comment tag template located in a database (Col. 14, lines 64-67), and therefore it would have been obvious to edit or correct the same comment information in an HTML version of the same comment.

The comment tag template referred to by the examiner has a tag name and a field list, and is a format for inputting the data used to create a comment data tag (col. 10, lines 60-63; col. 12, lines 40-43). The examiner apparently is arguing that Hayashi's disclosure of correcting the tag template so that comment data is inputted in a different format would have fairly suggested, to one of ordinary skill in the art, changing comment data already in a comment data tag embedded in a HTML document. The examiner,

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however, has not pointed out support in Hayashi for this argument, and such support is not apparent.

We therefore conclude that the examiner has not carried the burden of establishing a *prima facie* case of obviousness of the inventions claimed in the appellants' claims 1, 23, 35 and 38. Accordingly we reverse the rejections of these claims and the claims that depend therefrom.

Claim 48

In the rejection of claim 48 the examiner relies upon the argument advanced with respect to the rejection of claim 1 (answer, page 15). As discussed above, this argument is not persuasive. Moreover, the examiner has not provided evidence or reasoning which shows that Hayashi would have fairly suggested, to one of ordinary skill in the art, adding a comment to the data structure in response to retrieval of a comment data tag embedded in a hypertext document as required by claim 48.

We therefore reverse the rejection of claim 48.

DECISION

The rejection under 35 U.S.C. § 103 of claims 1-5, 7-38, 46 and 48-50 over Hayashi is affirmed as to claim 46 and reversed as to claims 1-5, 7-38 and 48-50. The rejection under 35 U.S.C. § 103 of claim 6 over Hayashi in view of Nielsen is reversed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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Errol A. Krass)	
Administrative Patent Judge)	
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Michael R. Fleming)	
Administrative Patent Judge)	APPEALS AND
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Terry J. Owens)	
Administrative Patent Judge)	

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Scott A. Stinebruner
Wood, Herron & Evans, LLP
2700 Carew Tower
441 Vine Street
Cincinnati, OH 45202-2917