

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. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ATSUSHI YOSHIDA and  
TOYOAKI FURUSAWA

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Appeal No. 2003-1605  
Application No. 08/982,934

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HEARD: March 18, 2004

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Before MARTIN, RUGGIERO, and LEVY, Administrative Patent Judges.  
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-37, which are all of the claims pending in the present application.

The claimed invention relates to an interactive hypertext information reference system including a server which manages the hypertext information and a client processor which references the hypertext information through communication with the server. More particularly, provision is made for counting a reference frequency

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path which corresponds to an activated hyperlink in a received hypertext document and which includes a reference start and a reference destination.

Claim 1 is illustrative of the invention and reads as follows:

1. An information reference frequency counting apparatus in an interactive hypertext document reference system, comprising:

a server managing hypertext documents, each hypertext document including at least one hyperlink;

a client processor requesting a hypertext document, through a requesting program, and receiving from said server the requested hypertext document; and

a count program counting and accumulating a reference total for a reference path based on the reference path including a reference start and a reference destination, concerned with an activated hyperlink of the received hypertext document, provided by an informing program at the client processor.

The Examiner relies on the following prior art:

Cole et al. (Cole)	5,933,827	Aug. 03, 1999 (filed Sep. 25, 1996)
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Claims 1-37, all of the appealed claims, stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Cole.

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Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs<sup>1</sup> and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-37. Accordingly, we reverse.

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

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<sup>1</sup> The Appeal Brief was filed December 9, 2002 (Paper no. 26). In response to the Examiner's Answer dated February 10, 2003 (Paper No. 27), a Reply Brief was filed April 7, 2003 (Paper No. 28), which was acknowledged and entered by the Examiner as indicated in the communication dated May 5, 2003 (Paper No. 29).

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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 must stem from some teaching, suggestion or implication 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, 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).

With respect to the rejection of each of the appealed independent claims 1, 11, 15, 21, 27, 31, and 37, Appellants' arguments in response assert a failure by the Examiner to establish

a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied Cole reference. In particular, Appellants contend (Brief, pages 8-11; Reply Brief, pages 2 and 3) that, contrary to the Examiner's stated position, Cole has no teaching or suggestion of an information reference system which provides for the monitoring or counting of a reference total for a reference path wherein the path includes a reference start and a reference destination as claimed.

After reviewing the Cole reference in light of the arguments of record, we are in general agreement with Appellants' position as stated in the Briefs. Our interpretation of the disclosure of Cole coincides with that of Appellants, i.e., while Cole provides for the counting of the number of web site categories a user may access, there is no clear disclosure of the counting of a reference path, including a reference source and reference destination, by which a user may have arrived at a particular selected category. Although the Examiner (Answer, page 3) makes reference to the illustration in Figure 6 of Cole along with the accompanying description beginning at column 4, line 57 as disclosing the claimed reference path counting feature, we find that, in our view, this portion of Cole at best discloses only the number of times a category is selected by a user. For example, while Cole's Figure 6

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illustration indicates that the "golf" category has been selected four times, there is no disclosure in the described operation of Cole that would provide any indication of the navigational path a user may have taken to arrive at the "golf" destination.

It is further our view that even assuming, arguendo, that the disclosure of Cole can somehow be construed as disclosing the claimed reference path counting feature, the Examiner has not provided any basis for the assertion of obviousness to the skilled artisan of including an "informing program" at the client processor, a feature present in each of the appealed independent claims. The Examiner, while recognizing that Cole has no teaching of any such informing program, nevertheless asserts (Answer, page 3) that the skilled artisan would have been motivated and found it obvious to include such an informing program " . . . because such a modification would allow Cole's system to have a Web browser tool that is executed on the client computer and keeps track of which URLs/Web pages the user has previously accessed."

The mere fact, however, 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). Further, despite the Examiner's attempt

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(Answer, page 11) to buttress the obvious modification rationale by relying on an unsupported assertion of "common knowledge" in the art, it is well settled that "the Board cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See also In re Lee, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), in which the court required evidence for the determination of unpatentability by clarifying that the principles of "common knowledge" and "common sense" may only be applied to analysis of evidence, rather than be a substitute for evidence. The court has also recently expanded their reasoning on this topic in In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002).

We note that, in the present factual situation before us, we do not dispute the Examiner's contention that the ultimate result of including an informing program at a client processor would be the ability to track user access to web pages. It is clear from the record before us, however, that any suggestion to include such an informing program at a client processor could come only from

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Appellants' own disclosure and not from any teaching in the Cole reference itself.

In conclusion, since we are of the opinion that the prior art applied by the Examiner does not support the obviousness rejection, we do not sustain the rejection of independent claims 1, 11, 15, 21, 27, 31, and 37, nor of claims 2-10, 12-14, 16-20, 22-26, 28-30, and 32-36 dependent thereon. Therefore, the decision of the Examiner rejecting claims 1-37 under 35 U.S.C. § 103(a) is reversed.

REVERSED

JOHN C. MARTIN	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
JOSEPH F. RUGGIERO	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
STUART S. LEVY	)	
Administrative Patent Judge	)	

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