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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte TIMOTHY W. BICKMORE, WILLIAM N. SCHILIT, ANDREAS GIRGENSOHN, and JOSEPH W. SULLIVAN

Appeal No. 2004-0171
Application No. 09/239,295

ON BRIEF[1]

Before JERRY SMITH, BARRY, and SAADAT, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claims 1-11, 17-20, 24, 25, 47-51, and 57-70. The appellants appeal therefrom under 35 U.S.C. § 134(a). We reverse.

BACKGROUND

The invention at issue on appeal displays documents from the world-wide web ("Web") on personal digital assistants ("PDAs") and cellular telephones ("cell-phones"). According to the appellants, most documents on the Web are designed for

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[1]An oral hearing was waived. (Paper No. 24.)

display on desktop computers with color monitors having at least 640x480 resolution. Most PDAs and cell-phones, however, feature smaller displays. More specifically, the difference in displays can lead to ratios of designed vs. available display area from 4-to-1 to 100-to-1. The appellants opine that such ratios make direct presentation of most Web documents on PDAs and cellular telephones "aesthetically unpleasant, un-navigable, and in the worst case, completely undecipherable." (Spec. at 1.)

Accordingly, the appellants' invention "re-authors" a Web document for display on a PDA or cell-phone. More specifically, the document and re-authoring parameters, such as the size of a display and a default font, are input. The document is converted into pages, where each page is fully displayable with almost no scrolling on the display of the PDA or cell-phone. At each stage of re-authoring, transformations are applied to the original document or to a "re-authored" page. The re-authored page is the best page resulting from the previous re-authoring stage. At each stage, the best page is determined based on the re-authoring parameters and the content of the document being re-authored. (*Id.* at 53.)

A further understanding of the invention can be achieved by reading the following claim.

> 58. A document re-authoring system that automatically re-authors a document, comprising
>
> a parse tree generating circuit;
>
> a document size evaluation circuit; and
>
> a transform circuit.

Claims 1-3, 11, 18, 19, 24, 25, 51, 58, 61, and 62 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 5,887,133 ("Brown"). Claims 4, 5, 59, and 60 stand rejected under § 103(a) as obvious over Brown and U.S. Patent No. 6,366,933 ("Ball"). Claims 6-9, 17, 47-50, and 57 stand rejected under 35 U.S.C. § 103(a) as obvious over Brown and U.S. Patent No. 6,226,642 ("Berenice"). Claims 10 and 63-70 stand rejected under § 103(a) as obvious over Brown, Berenice, and Spyglass, *Concepts and Applications: Spyglass Prism* (1997).[2] Claim 20 stands rejected under § 103(a) as obvious over Brown and Spyglass.

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[2]Although the examiner's statement of the rejection omits claims 64-70, (Examiner's Answer at 15), the claims depend from claim 63. Accordingly, we include claims 64-70 in the same rejection as claim 63.

OPINION

Rather than reiterate the positions of the examiner or the appellants *in toto*, we address a dispositive point of contention therebetween. The examiner asserts, "Brown teaches transform [sic] an original document to another document by modifying the original document, such as substituting or inserting portions (Brown, column 3, lines 26-30, 'a system and method for modifying documents, and specially for replacing an original document portion with a substitute document portion or inserting a substitute document portion')." (Examiner's Answer at 18.) The appellants argue, "[a]s Brown merely discloses a method and system for *swapping* an original document portion with a substitute document portion, Brown does not *re-author* a document as that term would be understood by one of ordinary skill in the art, as defined in the specification" (Reply Br. at 4.)

In addressing the point of contention, the Board conducts a two-step analysis. First, we construe claims at issue to determine their scope. Second, we determine whether the construed claims are anticipated or would have been obvious.

1. CLAIM CONSTRUCTION

"Analysis begins with a key legal question -- *what* is the invention *claimed*?" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed.

Cir. 1987). In answering the question, "[c]laims are not interpreted in a vacuum, but are part of and are read in light of the specification." *Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1116, 1 USPQ2d 1563, 1566 (Fed. Cir. 1987) (citing *Hybritech Inc. v. Monoclonal Anti-bodies, Inc*., 802 F.2d 1367, 1385, 231 USPQ 81, 94-95 (Fed. Cir. 1986); *In re Mattison*, 509 F.2d 563, 565, 184 USPQ 484, 486 (CCPA 1975)).

Here, independent claim 1 recites in pertinent part the following limitations: "[a] method for automatically re-authoring a document. . . ." Similarly, independent claim 58 recites in pertinent part the following limitations: "[a] document re-authoring system that automatically re-authors a document. . . ." The appellants' specification describes the automatic re-authoring as follows.

> Automatic document re-authoring involves developing software that can take an arbitrary document, such as an HTML [i.e., Hypertext Markup Language[3]] document, designed to be displayed on a desktop-sized monitor, along with characteristics of the target display device, and re-author the arbitrary document through a series of transformations, so that the arbitrary document can be appropriately displayed on the target display device.

(Spec. at 3-4.) More specifically, the specification explains that the document designed to be displayed on a desktop-sized monitor is transformed for "display on a smaller display screen, such as those used with a PDA or a cellular telephone." (*Id.* at 53, ll. 2-

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[3]HTML is "a standard page description language," Berenice, col. 1, 11. 25-26, which "provides basic document formatting and allows the developer to specify 'links' to other servers and files." *Id.* at ll. 27-28.

3.) Reading the limitations in light of the specification, the independent claims require inputting characteristics of a device (e.g., PDA, cell-phone) having a display smaller than that of a desktop-sized monitor and applying a series of transforms to a document (e.g., a document written in HTML) designed to be displayed on such a monitor so that the document can be accurately displayed on the device's smaller display.

2. ANTICIPATION AND OBVIOUSNESS DETERMINATIONS

"Having construed the claim limitations at issue, we now compare the claims to the prior art to determine if the prior art anticipates those claims." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (citing *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 715, 223 USPQ 1264, 1270 (Fed. Cir. 1984); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983); *Kalman v. Kimberly-Clark Corp.*, 713 F.2d760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983)). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.,* 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986).

Here, Brown "determin[es] the information contents of document portions and replac[es] undesired document portions with substitute document portions. . . ." Col. 1, ll. 9-12. Such portions "conform to the widely accepted and well-known hyper-text mark-up language (HTML)." Col. 6, ll. 51-52. The examiner has not shown, however, that the reference inputs characteristics of a device on which the portions are to be displayed. Nor has he shown that such a device features a display smaller than that of a desktop-sized monitor. To the contrary, rather than displaying documents on a PDA or a cell-phone, Brown displays documents on "a computer, a television set, or any other suitable end terminal with a display screen." Col. 4, ll. 15-16.

The absence of inputting characteristics of a device (e.g., PDA, cell-phone) having a display smaller than that of a desktop-sized monitor and applying a series of transforms to a document (e.g., a document written in HTML) designed to be displayed on such a monitor so that the document can be accurately displayed on the device's smaller display negates anticipation. Therefore, we reverse the anticipation rejection of claim 1; of claims 2, 11, 18, 19, 24, 25, and 51, which depend therefrom; of claim 58; and of clams 61 and 62, which depend therefrom.

"In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531,

1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "'A *prima facie* case of obviousness is established when the teachings from the prior art itself would . . . have suggested the claimed subject matter to a person of ordinary skill in the art.'" *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, the examiner does not allege, let alone show, that the addition of Ball, Berenice, or Spyglass cures the aforementioned deficiency of Brown. Absent a teaching or suggestion of inputting characteristics of a device (e.g., PDA, cell-phone) having a display smaller than that of a desktop-sized monitor and applying a series of transforms to a document (e.g., a document written in HTML) designed to be displayed on such a monitor so that the document can be accurately displayed on the device's smaller display negates anticipation, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the obviousness rejections of claims 4-10, 17, 20, 47-50, 57, 59, 60, and 63-70.

CONCLUSION

In summary, the rejection of claims 1-3, 11, 18, 19, 24, 25, 51, 58, 61, and 62 under § 102(e) is reversed. The rejections of claims 4-10, 17, 20, 47-50, 57, 59, 60, and 63-70 under § 103(a) are also reversed.

REVERSED

JERRY SMITH Administrative Patent Judge	)	
LANCE LEONARD BARRY Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
MAHSHID D. SAADAT Administrative Patent Judge	)	

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