

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte GERALD W. INGRAM and STEVE MANSFIELD

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Appeal No. 2004-2266  
Application No. 09/847,999<sup>1</sup>

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HEARD: MARCH 10, 2005

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Before KRASS, BARRY and SAADAT, Administrative Patent Judges.  
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 31-33, which are all of the claims pending in this application. Claims 1-30 have been canceled.

We affirm.

BACKGROUND

Appellants' invention is directed to the use of an enhanced hyperlink that enables users to either save an intended hyperlink

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<sup>1</sup> Application for patent filed May 4, 2001, which claims the filing priority benefit under 35 U.S.C. § 119 of the provisional Applications No. 60/202,029, filed May 4, 2000 and No. 60/283,142, filed April 12, 2001, is a continuation-in-part of Application No. 09/594,784, filed June 16, 2000, now abandoned.

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for viewing at a later time while following a hyperlink. Thus, choosing either options, a user may continue on a particular path on the web or break away from that path while saving the hyperlink or the path for later use.

Representative independent claim 31 is reproduced below:

31. A method of operating a computer, comprising:

providing a visual display;

displaying digital content in a first window on the visual display, the digital content including a hyperlink;

providing a graphical interface on the visual display that is operative to effectuate a designation of a hyperlink;

visually generating a plurality of individually selectable user options on the visual display in response to the designation of the hyperlink, including at least one option for performing the non-linking functionality of automatically copying the hyperlink to a second window in a manner that permits the copied hyperlink to be independently activated and processed; and

selecting the individually selectable user option of copying the hyperlink to a second window and automatically performing such non-linking functionality of automatically copying the hyperlink to a second window in response to the selection;

wherein the non-linking functionality further comprises copying any associated graphical elements corresponding to the hyperlink to the second window, and further wherein the associated graphical element comprises a graphical image embedded in the hyperlink.

The Examiner relies on the following references in rejecting the claims:

Gennaro et al. (Gennaro)	<u>U.S. Patent</u> 5,742,768	Apr. 21, 1998
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Jain Published Patent Application  
US 2003/0030679 A1 Feb. 13, 2003  
(filed Jan. 6, 2000)

Symposium Proceedings  
Dale Newfield et al. (Newfield), "Scratchpad: Mechanisms for Better Navigation in Directed Web Searching," Proceedings of the 11<sup>th</sup> annual ACM symposium on User Interface Software and Technology, 1998, pp. 1-8.

Claims 31-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Newfield, Gennaro and Jain.

Claims 31-33 stand provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 174, 175 and 176 of copending Application No. 09/594,786.

We make reference to the answer (Paper No. 19, mailed March 23, 2004) for the Examiner's reasoning and to the appeal brief (Paper No. 18, filed February 17, 2004) and the reply brief (Paper No. 21, filed May 28, 2004) for Appellants' arguments thereagainst.

#### OPINION

With respect to the 35 U.S.C. § 101 rejection, we note that Appellants have not contested the position presented by the Examiner (brief, page 9). Accordingly, we sustain the 35 U.S.C. § 101 rejection of the claims pro forma.

Appellants argue that, instead of visual generation of options upon designation of a hyperlink, Newfield only allows

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copying of the hyperlink to a list for later viewing when the "Scratchpad" program is activated and the user selects a hyperlink (brief, page 5). Appellants further assert that Gennaro provides a selectable drop-down menu that consists only of linking functionality options rather than the claimed graphical image embedded in the hyperlink (brief, page 6). With respect to Jain, Appellants argue that the user manually selects an image to be associated with the hyperlink without having anything to do with copying of graphical elements of the hyperlink to the second window or whether any graphical image is embedded in the hyperlink (brief, page 6; reply brief, page 2). Appellants further point out that the image embedded in the hyperlink is not the same as an image in the target webpage to which the hyperlink points (brief, page 9).

In response to Appellants' arguments, the Examiner asserts that since the user can click on image 1002 in Figure 10 of Jain, the image is indeed a "graphical image embedded in the hyperlink" (answer, page 8). Furthermore, the Examiner asserts that by copying the hyperlink to a second window (i.e., the bookmark window), the embedded image 1002 or 1003 is copied to a second window (answer, page 9). With respect to Newfield, the Examiner argues that the use of "other graphical form" mentioned in page 5 of the reference is a suggestion to use embedded graphical images

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(id.) and concludes that since the link comprises some text or image, "any text or image" embedded in the link is also copied (answer, page 10).

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). To reach a conclusion of obviousness under § 103, the examiner must produce a factual basis supported by teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Such evidence is required in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The Examiner must not only identify the elements in the prior art, but also show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

A review of the applied prior art confirms that Newfield relates to a navigation mechanism and includes a feature for storing the pending links and displaying them as text lists (page 5, left-hand column). Gennaro, on the other hand, discloses a method for navigating by providing a web page having an embedded

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menu in the form of user selectable links (col. 2, lines 39-54). However, as pointed out by the Examiner (answer, page 4), neither of these references teaches the non-linking functionality comprising copying the graphical image embedded in the hyperlink to a second window.

Turning now to the teachings of Jain, we note that the reference is directed to storing URLs as bookmarks wherein the user may select one of the images displayed on a web page to be stored together with the locator address as the website bookmark (abstract; paragraphs 0022 and 0023). Although Jain teaches that the image is resized and placed in front of the URL address (paragraph 0023), the image is not actually embedded in the hyperlink as the link may also be stored without the image if the BWI is not turned on by the user (paragraph 0021). Thus, although we agree with the Examiner that an image is associated with the URL address in Jain, we do not find ourselves in agreement with the Examiner's conclusion that selecting an image to be stored next to the bookmark makes the image embedded in the hyperlink.

As indicated by Appellants (reply brief, page 2), the image selected by the user to be placed next to the main "Yahoo" web page is a part of that web page and at the best, could be embedded in the "What's new" hyperlink. In concluding that this

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user selected image is embedded in the stored hyperlink, the Examiner ignores the claim requirement that the hyperlink and the image embedded in the hyperlink be automatically copied to a second window. Thus, assuming, arguendo, that it would have been obvious to combine Jain with Newfield and Gennaro, as held by the Examiner, the combination would still fall short of teaching or suggesting the claimed copying of graphical elements of the hyperlink to the second window or the fact that graphical element comprises a graphical image embedded in the hyperlink.

In view of our analysis above, we find that the Examiner has failed to set forth a prima facie case of obviousness because the necessary teachings and suggestions related to the claimed embedded images in the hyperlink are not shown. Accordingly, we do not sustain the 35 U.S.C. § 103 rejection of independent claim 31, nor of claims 32 and 33 dependent thereon.

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CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1-9 under 35 U.S.C. § 103 is reversed, but is affirmed with respect to their provisional rejection under 35 U.S.C. § 101.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

ERROL A. KRASS	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
LANCE LEONARD BARRY	)	APPEALS
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MAHSHID D. SAADAT	)	
Administrative Patent Judge	)	

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