

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DIMITRI KANEVSKY,
CLIFFORD ALAN PICKOVER,
WLODEK ZADROZNY,
and ALEXANDER ZLASTIN

Appeal No. 2006-0620
Application 09/343,758¹

ON BRIEF

Before SCHAFER, BARRETT, and TIERNEY, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-5, 7-21, 23-25, and 33-37. Claims 6, 22, and 26-32 are canceled.

We affirm-in-part.

¹ Application for patent filed June 30, 1999, entitled "System and Method for Information Transfer Over a Network."

BACKGROUND

The invention relates to transferring objects (which may be images, audio, animations, 2-D and 3-D graphics, etc.) over a network, such as the Internet or World Wide Web. The speed of transfer depends on the amount of data. In order to save time, instead of retrieving the entire Web page from a remote computer, the invention replaces an original object (such as an image) on the Web page with a "code" for a "generic" object (such as a generic image) and the "interface device" (Internet browser) displays the generic object. The generic object may be a general representation of the original object; e.g., an image of a particular dog may be replaced by a code for a generic dog image which is displayed by the browser (example, specification, p. 9). The generic object may be stored in the user's local database of generic information or may be cached after being downloaded from the remote computer. The generic object may be replaced by the original object when the original object is subsequently received. The generic mode may be turned on and off depending on data transfer constraints, such as high traffic, the user selection of a "quick mode," and the importance of the data (Fig. 1).

Claim 1 is reproduced below.

1. A method of transferring data across a computer network, said computer network including a plurality of computers, a database stored on one of said plurality of computers, said method comprising the steps of:

requesting transfer of data stored on a remote computer system;

identifying at least one object included in said requested data as being associated with a generic object, wherein each said at least one object is a species object of its associated said generic object; and

substituting a corresponding said generic object for each said associated at least one object, substituted said corresponding generic objects being transferred with said data before associated objects.

THE REFERENCE

The Examiner relies on the following reference:

Phil James, *Official Netscape Navigator 3.0 Book, Windows Edition: The Definitive Guide to the World's Most Popular Internet Navigator* (Ventana Comm. Grp., Inc. 1996) (hereinafter James), pp. 337-377.

THE REJECTION

Claims 1-5, 7-21, 23-25, and 33-37 stand rejected under 35 U.S.C. § 102(a) as being anticipated by James.

We refer to the Final Rejection and the Examiner's Answer (pages referred to as "EA__") for a statement of the Examiner's rejection, and to the Brief (pages referred to as "Br__") and Reply Brief (pages referred to as "RBr__") for a statement of Appellants' arguments thereagainst.

DISCUSSION

Content of James

James discloses (pp. 359-361):

You really see how important words are when you have a modem connection to the Net. If you have a slow modem and have been following the various links in this chapter, you're probably growing tired of waiting for some of the documents to transfer. In fact, if you have a modem that operates at less than 28.8 kbps, you may already be working on next year's letter to Santa. But besides speeding up your Internet connection, there is another approach: you can bypass graphics altogether.

Netscape Navigator 3.0 gives you the option of turning off the automatic display of graphics by deselecting the Auto Load Images option on the Options menu (see Figure 8-15). When this option is turned off, a small icon appears as a placeholder wherever an image is supposed to display. Figure 8-16 shows a Web document in text-only mode, with several placeholders for graphics.

If you then come across a particular document whose graphics you want to view, you can easily display them by clicking the Images button. This reloads the document with graphics displayed.

As shown in Fig. 8-16, the browser displays the location and size of the graphic with a rectangular box having a small icon in the upper left-hand corner of the box. Next to the icon is user defined alternate text for the image.²

Although not expressly described by James, the remote computer system inherently must transmit an image code indicating the size and position of an image, instead of the image, which is interpreted by the browser to display the box, icon, and text in James.

² It was well known in the art of creating Web documents using HTML (hypertext markup language) at the time of the invention, that the ALT attribute with an IMG tag is used to define "alternate text" for an image. The value of ALT is author-defined text, enclosed in double-quotes, and ALT text can be any amount of plain text, long or short. For example, a warning symbol could be marked up as follows:

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<IMG SRC="warning.gif" ALT="Warning!!!">
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This ALT text will have no effect whatsoever in a graphical browser with image loading turned on. However, ALT improves the display and usefulness of the document for people who have text-only browsers, or who have turned image loading off. Since these users cannot see graphics, the browser will substitute a marker such as "[IMAGE]" or the icon in James for any image tag. This is, in effect, a placeholder, but a frustrating one, since there isn't any way for the user to tell what the image is, or what it says, or what its purpose is. However, if ALT text has been defined, the browser will display that text instead of or in addition to the placeholder. This makes the display a lot nicer and more useful for users who can't see the graphics, and doesn't affect users who can see the graphics. Alternate text is what is displayed next to the icon in James.

Anticipation

Initially, it is noted that we address only the arguments actually made by Appellants. Arguments not made by Appellants are considered to be abandoned. *See* 37 CFR § 41.37(c)(1)(vii) (2004) ("Any arguments or authorities not included in the brief or a reply brief . . . will be refused consideration by the Board, unless good cause is shown."). *Cf. In re Baxter Travenol Labs.*, 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) ("It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art."); *In re Watts*, 354 F.3d 1362, 1367, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004) ("Just as it is important that the PTO in general be barred from raising new arguments on appeal to justify or support a decision of the Board, it is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board." (Footnote omitted.)).

Species object associated with generic object

Appellants argue that "James does not teach a web browser wherein specific objects are replaced by generic objects such that the result represents the original with the data content discernable from the representation provided [as claimed]" (Br12). It is argued that "the placeholder icon of [James] [is not] 'a species object of its associated said generic object' as recited in [claims 1, 14, and 17-19]" (Br13). It is argued that the placeholder icons in James convey nothing more than location and size and "[w]hile under some circumstances with images blocked . . . the placeholder icons may indeed be substituted for different specific objects of the

same genus; that is quite different [than] affirmatively substituting generic objects for different species as recited in [claims 1, 14, 17, 19, 24, 25, 33-35, and 37]" (Br14). Appellants argue that a user in James identifies graphics he or she wants by the text next to the icon, whereas "the present invention would include a generic representation of the omitted image" (Br15).

The Examiner responds that "James teaches a web browser (Netscape) wherein specific objects (Images) are replaced by generic objects (placeholders) such that the results represent the original with the data content discernable from the representation (one can easily see that placeholders in Fig. 8-16 are discernable from the representation by having different locations and dimensions)" (EA11).

Appellants reply that this speaks to a different result than is described in the present specification, citing *Kemco Sales Inc. v. Control Papers Co.*, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000) (RBr2). It is further argued that one would not send a modified digital image with generic rather than specific objects to a client system for display in Netscape (RBr3).

Appellants seem to rely on *Kemco* for the argument that James is not "equivalent" to the claimed invention because it does not perform the identical function in substantially the same way to produce the same results. This is legally incorrect. *Kemco* deals with equivalents under 35 U.S.C. § 112, sixth paragraph, means-plus-function limitations. This has nothing to do with the present claims since they are not in means-plus-function format. Equivalents is a legal theory that is pertinent to obviousness under § 103, not to anticipation under § 102. *See Richardson v. Suzuki Motor Co., Ltd.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920-21 (Fed. Cir. 1989).

A "species object" is recited in claims 1, 14, and 17-19: claim 1 recites that each "object is a species object of its associated generic object"; claim 14 recites that each "corresponding original object is a species object of a corresponding said stored generic object"; claim 17 recites that each of the "identified objects is a species object of substituted said generic object"; claim 18 recites that each of the "corresponding objects is a species object of an identified one of said generic objects"; and claim 19 recites that one "object is a species object of its associated said generic object." Contrary to Appellants' argument, claims 24, 25, 33-37 do not recite a "species object," but only recite substituting a generic object for an object.

The terms "species" and "species object" do not appear in the original specification and are not defined. Appellants apparently interprets "generic" to be a representation of the original "species," such as a generic dog image being a representation of a particular dog "species" image, as described in the example on page 9. However, the broadest reasonable interpretation is not so limited because no limitations require or imply that the data content of the species image is discernable from the representation of the generic image, as argued, and this limitation will not be implicitly read into the claims. An icon is a generic image which represents all possible species of images. Appellants have not shown any error in the Examiner's finding that the icon in James is a "generic object" indicating an image, and that the "species object" can be any image. Since this is the only argument with respect to claims 17, 19, 24, 33, 35, and 37, and since claims 2-5, which depend on claim 33, have not been separately argued, the rejection of claims 2-5, 17, 19, 24, 33, 35, and 37 is sustained.

Plurality of generic objects

Appellants argue that "[s]ubstituting the placeholder icon for every image, regardless of what the image portrays, certainly is not 'storing a plurality of generic objects, each stored generic object corresponding to an original object in data requested from said remote computer system' as recited in claims 14 and 34" (Br13). Claim 20 also refers to a plurality of generic objects (Br13).

The Examiner responds that the claims do not recite the limitation "image portrays," and the placeholder in James appears at the very position at which the image is supposed to display and, so, the placeholder is associated with the image (EA11-12).

Appellants respond that "this difference certainly shows that the alleged anticipating reference does not perform 'the identical function specified in the claim(s) in substantially the same way,' and produce 'substantially the same results as the corresponding element disclosed in the specification'" (footnote to *Kemco*) (RBr3).

Again, appellants' reliance on *Kemco* is legally incorrect because the present claims are not in means-plus-function format.

The Examiner does not address the argument about a "plurality." James discloses only a single icon which is used for all images and does not disclose a "plurality of generic objects," as recited in claims 14, 20, and 34. Claims 15 and 16 depend from claim 34, and claims 21 and 23 depend from claim 20. The rejection of claims 14-16, 20, 21, 23, and 34 is reversed.

Transmitting the generic object

Appellants argue that "although James does not indicate how the placeholder icon is generated, it is equally clear, that the James placeholder icon is resident in Netscape Navigator and [is] not supplied independently, e.g., by the originating site" (Br13) and that there is no need for storing a plurality of generic objects.

The Examiner responds that "the claims do not recite how a generic object (corresponding to icon or placeholder in James' teaching) is generated" (EA12) and "the claims do not recite that generic object (corresponding to icon or placeholder in James' teaching) is being supplied independently by the originating site" (EA12).

Appellants respond that "[c]laim 1 et seq., clearly recite that 'substituted said corresponding generic objects [are] transferred with said data before associated objects'" (RBr3).

Since Appellants did not identify the claims or claim language that they were relying upon in the brief, we can understand the Examiner dismissing the arguments. Nevertheless, since the argument was made in the reply brief, we agree with Appellants that James does not transfer generic objects to the requesting computer as recited in claim 1, but stores the generic object (the icon) at the requesting computer. Although only indirectly argued by Appellants (Br13), this limitation also appears in claim 13 ("the remote computer system is further transferring additional generic objects associated with said related images"). Although not noted by Appellants, this limitation also appears in claim 25 ("transferring additional generic objects associated with related images" and "substituting said additional objects for said related object when a related object is displayed"). The rejection of claims 1, 13, and 25 is reversed.

Restoring a compressed image

Appellants argue that James does not teach the substitution in claims 18 and 36 (Br14), which we interpret to mean that James does not teach substituting later received "corresponding objects" for a generic object in the methods of restoring a compressed image in claims 18 and 36.

James discloses replacing all images with a placeholder icon (generic object) and a box showing the size of the image, but does not teach then automatically substituting "corresponding objects in subsequently received data" for the "generic objects in said received image data to form an uncompressed image" as recited in claims 18 and 36. That is, when the Auto Load function is turned off, only icons are displayed. James discloses (page 361): "If you then come across a particular document whose graphics you want to view, you can easily display them by clicking the Images button. This reloads the document with graphics displayed." This teaches reloading a whole document with images and not substituting objects for generic objects.

Although we believe that Netscape Navigator temporarily used icons and boxes as placeholders for images (as in Fig. 8-16) and then replaced those icons and boxes with the actual images after they were received during the normal Auto Load operation when the browser was set to display images after they were completely transferred (*see* p. 359), this is not expressly described in James. If this mode of operation was known, claims 18 and 36 would, of course, be met.

Dependent claim 7, and claims 8-12 which depend therefrom, also have this limitation ("replacing and displaying each said corresponding generic object with each said requested

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object when said requested object is received"). The rejection of claims 7-12, 18, and 36 is reversed.

Evidence of a still-existing need

Appellants argue that they have presented evidence that the present invention is sorely needed, even more than 5 years after filing the present application (Br15). The Web shots of the current dial up Internet accelerator from Juno (Exhibit E to the brief) and NetZero (Exhibit F to the brief) describe compressing text and graphics, but do not teach using a generic image. Juno and NetZero do not affect the outcome of the anticipation analysis.

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CONCLUSION

The rejection of claims 2-5, 17, 19, 24, 33, 35, and 37 is sustained. The rejection of claims 1, 7-16, 18, 20, 21, 23, 25, 34, and 36 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (2004).

AFFIRMED-IN-PART

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