

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 SANAA F. ABDELHADI
AND HYPATIA ROJAS

Appeal No. 2006-1658
Application No. 09/801,617

ON BRIEF

Before HAIRSTON, BLANKENSHIP and HOMERE, **Administrative Patent Judges**.
HOMERE, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1 through 20, all of which are pending in this application.

We affirm.

Invention

Appellants' invention relates generally to a method and system for allowing users to preview portions of hypertext documents retrieved from the worldwide web (50). Particularly, authorized users access the worldwide web (50) through a plurality of data processors (57) to search and retrieve desired hypertext documents (57). Each retrieved hypertext document includes at least one display page containing text, images and a

plurality of hyperlinks (72) embedded therein. The user may select a hyperlink from within the hypertext document to display a corresponding textual portion of said document. Additionally, the user may save the retrieved portion of the hypertext document on his/her computer for viewing the same at a later date.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. In a World Wide Web (Web) communication network with user access via a plurality of data processor controlled interactive receiving display stations for displaying received hypertext documents of at least one display page containing text, images and a plurality of embedded hyperlinks, each hyperlink being user selectable to access and display a respective linked hypertext document, a system for enabling a user to selectively preview each hypertext document linked to the hyperlinks in each received hypertext document comprising:

means associated with one of said receiving display stations for enabling a user to select to view only a portion of a hypertext document linked to a hyperlink in any received hypertext document;

means for accessing and storing at said one receiving display station said portion of said linked hypertext document; and

means responsive to said means for enabling said user selection for displaying said stored portion of a linked document.

References

The Examiner relies on the following references:

Tracy et al. (Tracy)	6,199,753	March 13, 2001 (filed November 4, 1999)
Weiss et al. (Weiss)	2003/0014415	January 16, 2003 (filed February 22, 2001)

Rejections At Issue

- A. Claims 1 through 13, 15 and 17 through 20 stand rejected under 35 U.S.C. § 102 as being anticipated by Weiss.

B. Claims 14 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Weiss and Tracy.

Rather than reiterating the arguments of Appellants and the Examiner, the opinion refers to respective details in the Briefs¹ and the Examiner's Answer.² Only those arguments actually made by Appellants have been considered in this decision. Arguments, which Appellants could have made but chose not to make in the Briefs have not been taken into consideration. See 37 CFR 41.37(c)(1) (vii) (eff. Sept. 13, 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the Examiner's rejections, the arguments in support of the rejections and the evidence of anticipation and obviousness relied upon by the Examiner as support for the rejections. We have likewise reviewed and taken into consideration Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejections and arguments in the rebuttal set forth in the Examiner's Answer. We note that the Examiner has relied upon the Weiss reference (filed on February 22, 2001) to reject Appellants' claimed invention (filed on March 08, 2001) under 35 U.S.C. § 102 and 103. In response to the Examiner's rejections, Appellants rely on the declarations and exhibits filed September 8, 2004, pursuant to 37 CFR § 1.131 to antedate the February 22, 2001 filing date of the Weiss reference. The Examiner, in response, has found that Appellants'

¹ Appellants filed an Appeal Brief March 31, 2005. Appellants filed a Reply Brief on August 01, 2005.

² The Examiner mailed an Examiner's Answer on May 31, 2005. The Examiner mailed an office communication October 03, 2005, stating that the Reply Brief has been entered and considered.

Rule 131 declarations and accompanying exhibits are sufficient to show that Appellants' invention was conceived prior to the critical date of February 22, 2001. Thus, the sole issue before us is whether Appellants' Rule 131 declarations and accompanying evidence are sufficient to show due diligence from prior to the February 22, 2001 filing date of the Weiss reference to the March 08, 2001 filing date of Appellants' claimed invention.

After full consideration of the record before us, we agree with the Examiner that Appellants' Rule 131 declarations and supporting evidence are not sufficient to show due diligence from prior to the February 22, 2001 filing date of the Weiss reference to the March 08, 2001 filing date of Appellants' claimed invention.

Accordingly, we affirm the Examiner's rejections of claims 1 through 20 for the reasons set forth **infra**.

With respect to due diligence, at page 5 of the Appeal Brief, Appellants state the following:

Both the Examiner and Applicants agree that all that needs to be established is diligence toward the filing of the present Application during the 14 day period between just prior to February 22, 2001 and the March 8, 2001 filing date of the present Application.

During this period, all of the formal Application papers were being prepared, proof read, and read by the inventors. Any trier of facts would be expected to decide that 14 days was a reasonable period for carrying out such a procedure.

Appellants further reiterate this same argument in the Reply Brief. In particular, at page 3 of the Reply Brief, Appellants state the following:

Applicants needed only to show diligence during the fourteen day period between February 22 and March 8, 2001. It is submitted that a fourteen day period is not an unreasonable one during which a patent

application is processed from final draft to executed patent application filed in the U.S. Patent Office.

It has been held that where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. **Ex parte Hunter**, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence. The critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). **See Ex parte Merz**, 75 USPQ 296 (Bd. App. 1947). An applicant must account for the entire period during which diligence is required. **Gould v. Schawlow**, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); **In re Harry**, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter “was diligently reduced to practice” is not a showing but a mere pleading). **Kendall v. Searles**, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts.) A 2-day period lacking activity has been held to be fatal. **In re Mulder**, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983).

Upon our review of the record before us, we find that the character and the weight of the evidence submitted is not sufficient to substantiate Appellants’ allegation of due diligence from prior to the February 22, 2001 filing date of the Weiss reference to the March 08, 2001 filing date of Appellants’ claimed invention.

To show diligence, Appellants merely rely on the conclusory statements made in the declarations and the Briefs without providing any factual evidence in support thereof. Appellants' declarations merely indicate that prior to February 22, 2001, the draft patent application was completed, and that Appellants executed and filed the formal application papers on March 08, 2001. Further, as noted above, Appellants argue that during the stated 14-day period (from just prior to February 22, 2001 to March 8, 2001,) they were preparing, proof reading and reviewing the application papers.

While the declarations and the exhibits are in the form of testimonial and corroborating evidence, arguments of counsel are not evidence. See, e.g., **Meitzner v. Mindick**, 549 F.2d 775, 782, 193 USPQ 17, 22 (CCPA 1977); **In re Pearson**, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974). Further, Appellants have not "account[ed] for the entire critical period by showing either activity aimed at reduction to practice or legally adequate excuse for inactivity." 3 D Chisum, **Patents**, §10.07 at 10-120 (1986). Consequently, we find no error in the Examiner's stated position, which concludes that Appellants' Rule 131 declarations and accompanying exhibits have not, by any satisfactory evidence of facts, established due diligence from prior to the February 22, 2001 filing date of the Weiss reference to the March 08, 2001 filing date of Appellants' claimed invention.

CONCLUSION

In view of the foregoing discussion, we have sustained the Examiner's decision rejecting claims 1 through 13, 15 and 17 through 20 under 35 U.S.C. § 102. We have also sustained the Examiner's decision rejecting claims 14 and 16 under 35 U.S.C. § 103. Therefore, we affirm.

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

AFFIRMED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
HOWARD B. BLANKENSHIP)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JEAN R. HOMERE)	
Administrative Patent Judge)	

JRH/kis

Appeal No. 2006-1658
Application No. 09/801,617

VOLEL EMILE
INTERNATIONAL BUSINESS MACHINES CORPORATION
INTELLECTUAL PROPERTY LAW DEPARTMENT
11400 BURNET ROAD, INTERNAL ZIP 4045
AUSTIN, TX 78758