

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte BRENT HAILPERN and PHILIP S. YU

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Appeal No. 2006-2316  
Application No. 09/565,395

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ON BRIEF

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Before KRASS, JERRY SMITH, and BLANKENSHIP, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-18, 21-23, and 25-30, which constitute all the claims pending in this application.

The disclosed invention pertains to locating URLs on the World Wide Web based on incomplete or partially specified URL entries. Specifically, a search request handler handles partially entered URL addresses and matches complete URL addresses to partial URL addresses having a wildcard symbol. In one

embodiment, an electronic network is crawled for various URL addresses that are then stored along with respective related keywords in a database. Upon receipt of an incorrectly spelled or partially specified URL address, matching URLs are retrieved.

Representative claim 1 is reproduced as follows:

1. A system for providing service to a user for searching URL addresses on an electronic network, comprising:
  - a server node having:
    - a CPU, a storage device operatively connected to said network for storing a website URL database containing a plurality of URL addresses, and a user profile database for storing user profiles;
    - a server logic stored in the storage device, said server logic for processing, ranking, and returning search results; and
    - a search request handler for handling partially entered URL addresses and matching complete URL addresses to partial URL addresses having a wildcard symbol.

The examiner relies on the following references:

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|--------------------------|--------------|--|
| Kisor et al. (Kisor)     | 5,978,847    | Nov. 2, 1999                           |
| Berstis et al. (Berstis) | 6,092,100    | Jul. 18, 2000<br>(filed Nov. 21, 1997) |
| Gupta et al. (Gupta)     | 2001/0020242 | Sept. 6, 2001<br>(filed Nov. 16, 1998) |
| Judd et al. (Judd)       | 6,360,215    | Mar. 19, 2002<br>(filed Nov. 3, 1998)  |
| Baldonado                | 2002/0147880 | Oct. 10, 2002<br>(filed Nov. 17, 1999) |
| Bunney                   | 6,487,584    | Nov. 26, 2002<br>(filed Mar. 17, 1999) |

The following rejections are on appeal before us:

1. Claims 1-7 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Baldonado in view of Bunney.

2. Claims 8, 10-12, 22, 23, 25, 26, and 28-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Judd in view of Baldonado.

3. Claims 9, 14, 15, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Judd in view of Baldonado and further in view of Gupta.

4. Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Judd in view of Baldonado, Gupta, and further in view of Bunney.

5. Claims 16 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Judd in view of Baldonado and further in view of Bunney.

6. Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Judd in view of Baldonado and further in view of Kisor.

7. Claims 8 and 25 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of Berstis in view of Judd.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

### OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness and obviousness-type double patenting relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our

decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections 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 have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. We also find that the examiner has established a prima facie case of obviousness-type double patenting. Accordingly, we affirm.

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 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). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343, 61 USPQ2d at 1433-33. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner 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). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). See also In re Thrift, 298 F.3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). 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 considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

Regarding independent claim 1, the examiner's rejection essentially finds that Baldonado teaches every claimed feature except for a user profile database for storing user profiles. The examiner cites Bunney as teaching assigning multiple addresses corresponding to user preferences and profiles in a communication system in addition to providing a user profile database. The examiner finds that it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate user profiles in Baldonado's ranking process to rank word search results in accordance with user preferences [answer, pages 3 and 4].

Appellants argue that the references do not disclose, among other things, a search request handler for handling partially entered URL addresses and matching complete URL addresses to partial URL addresses having a wildcard symbol [brief, page 5, emphasis in original]. According to appellants, Baldonado is concerned with only fully-specified URLs – not partially entered URLs. Although appellants acknowledge that Baldonado uses a wildcard in the URL, the wildcard only accounts for substructures of a known URL [brief, page 6].

The examiner responds that in light of the specification, the limitation calling for “partially entered URLs” can be reasonably construed broadly as URLs

“which can contain wildcard characters” [answer, page 20]. The examiner further notes that Baldonado teaches broadening URLs with wildcards [id.].

Appellants also argue that the examiner failed to show any suggestion, motivation, or teaching in the references to combine the references [brief, page 7]. According to appellants, Bunney’s user profile is a very specific application for users with multiple addresses, and one cannot infer that such user profiles are conventionally employed in all searches [brief, page 8].

The examiner responds that Baldonado teaches allowing a user to search from a standard browser, and Bunney teaches that user profiles can filter searches. According to the examiner, it would have therefore been obvious to one of ordinary skill in the art at the time of the invention to incorporate such profiles into Baldonado’s search process to rank search results in accordance with user preferences [answer, page 21].

We will sustain the examiner’s rejection of claim 1. We agree with the examiner that the scope and breadth of the limitation “partially entered URL addresses” fully reads on Baldonado’s URL address that includes wildcards (e.g., http://\*.example.com) [Baldonado, ¶ 0043]. The URL (http://\*.example.com) is “partially entered” in that the URL itself is not a complete URL address, but rather represents a number of different URLs with different prefixes. Upon execution, the search request handler of Baldonado matches complete URL addresses (i.e., URLs with various prefixes using the “example.com” domain name) to the “partially entered” URL with a wildcard.

In addition, Baldonado teaches broadening a URL (context information) used in a results page [Baldonado, ¶ 0077]. Although Baldonado does not specify the exact location of this broadening wildcard, we find no reason why the skilled artisan would not reasonably include the wildcard in any position in the URL to further broaden the search in any manner desired.

We also agree with the examiner that the skilled artisan would have reasonably combined the teachings of Baldonado and Bunney essentially for the reasons noted by the examiner. Bunney expressly states that user profiles can filter keyword searches to rank the search results according to preferences suggested by the user profile [Bunney, col. 3, lines 26-28; col. 5, lines 1-3]. We see no reason why the skilled artisan would not apply such a user-oriented filtering technique in the search system of Baldonado so that search results were ranked in a manner tailored to the user's preferences.

We conclude that the combined teachings of Baldonado and Bunney reasonably teach or suggest all limitations of claim 1, and the references would have been reasonably combinable. Accordingly, the examiner's rejection of claim 1 is sustained. Since appellants have not separately argued the patentability of dependent claims 2-7 and 27, these claims fall with independent claim 1. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). See also 37 CFR § 41.37(c)(1)(vii).

Regarding independent claims 8 and 25, the examiner's rejection essentially finds that Judd discloses all claimed features except for an incorrectly

spelled or partially specified URL. The examiner cites Baldonado as receiving incorrectly spelled or partially specified URLs through a network. The examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to allow the user in Judd to enter incorrect or partially specified URLs to implement contextual document searches without the need to use complete search terms [answer, pages 7, 8, and 11].

Appellants argue that the references do not disclose storing the URL addresses and respective related user-specified keywords of the different sites in a database as claimed in claim 8 [brief, page 8, emphasis in original]. According to appellants, Judd's index 16 is not user-specified since indexer 20 creates the index [brief, page 9]. The examiner responds by noting that the limitation "user-specified keywords" was broadly construed as "keywords (or words)" in light of the specification. With this construction, the examiner argues that Judd teaches storing URLs and related keywords of different sites in a database [answer, page 22].

Appellants also argue that the references do not teach nor suggest searching the website URL database for URL addresses that match the incorrectly spelled URL address by accessing the website URL database as claimed in claim 25 and essentially claimed in claim 8 [brief, page 9]. Appellants note that Judd receives data -- not URLs -- in which at least a portion of the data is in a wildcard format [brief, page 9]. Appellants further argue that a wildcard is

not an incorrect spelling, but rather a proper spelling representing a valid character string [brief, pages 9 and 10].

The examiner responds that an incorrectly spelled URL is a partially specified URL that can contain wildcards in light of appellants' specification [answer, page 22]. The examiner argues that because Judd (1) uses wildcards for document specifications or URLs, and (2) allows a tag word to be associated with multiple URLs without identifying each URL, Judd therefore discloses searching the website URL database for URLs that match incorrectly spelled URLs [answer, pages 22 and 23].

Appellants also argue that no motivation exists to combine the references since Judd pertains to retrieving a document from multiple documents based on information not derived from the literal document content, but Baldonado combines crawl and index searches in a search engine [brief, pages 10 and 11]. The examiner responds that because Baldonado broadens a search string via wildcards, the skilled artisan would have reasonably incorporated such wildcards in Judd's search process [answer, pages 23 and 24].

We will sustain the examiner's rejection of claims 8 and 25. Regarding claim 8, we note that the scope and breadth of the limitation "user-specified keywords" does not preclude the tag words in Judd that are added to the index. In short, the term "user-specified" in claim 8 is very broad because the claim does not specify the user. Thus, a "user-specified keyword" need not originate with the searcher, but can include keywords provided by other "users" of the

system, such as document authors, indexers, programmers, or others associated with the system.

Judd's tag words constitute any character string associated with a document for search purposes, including dedicated code words, titles, abstracts, labels that indicate the web page's content (e.g., an advertisement), etc. [Judd, col. 9, lines 1-13]. Even assuming that such unique tag words are not specified by the searcher, but rather originate from document authors, indexers, programmers, or others associated with the system, Judd's tag words nevertheless fully meet "user-specified keywords" as claimed given the term its broadest reasonable interpretation.<sup>1</sup>

We also conclude Judd and Baldonado reasonably suggest searching the website URL database for URL addresses that match the incorrectly spelled URL address by accessing the website URL database as claimed in claim 25. We agree with the examiner that an incorrectly spelled URL can reasonably constitute a partially specified URL containing wildcards given the term "incorrectly spelled" its broadest reasonable interpretation.<sup>2</sup> For example, Judd lists three examples of URLs with embedded wildcards [Judd, col. 11, lines 52-55]. The first example, [http://www.childsafe.com/IC\\*](http://www.childsafe.com/IC*), is a partial URL, but also is "misspelled" with respect to word forms using "IC" as a root (e.g., "ICE", "ICING",

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<sup>1</sup> Our interpretation also applies to claim 25 since the commensurate limitation in that claim is broader than claim 8. That is, claim 25 does not require that the keywords are "user-specified," but rather broadly recites that the keywords are "related." See claim 25, line 6.

<sup>2</sup> Our interpretation also applies to claim 8 since the commensurate limitation in claim 8 does not limit the URL address to incorrectly spelled URL addresses, but rather recites that such URL addresses are either incorrectly spelled or partially specified. See claim 8, lines 10-13.

etc.). Thus, the URL [http://www.childsafe.com/IC\\*](http://www.childsafe.com/IC*) is incorrectly spelled with respect to the URL <http://www.childsafe.com/ICE> since the characters do not match. Similarly, the partial URL in the second example, <http://www.netguide.com/part?.html> is misspelled with respect to URLs with words that use “part” as a root (e.g., “party,” “parts,” etc.) [see Judd, col. 11, line 54].

We also agree with the examiner that the skilled artisan would have ample motivation to combine Judd and Baldonado essentially for the reasons noted by the examiner. We add, however, that both documents pertain to web-based search and retrieval of information. We see no reason why the skilled artisan would not have reasonably referred to the teachings of Baldonado to further broaden search strings in Judd’s search process as the examiner indicates.

The examiner’s rejection of independent claims 8 and 25 is therefore sustained. Since appellants have not separately argued the patentability of dependent claims 10-12, 22, 23, 26, and 28-30, these claims fall with independent claims 8 and 25. See In re Nielson, 816 F.2d at 1572, 2 USPQ2d at 1528 (Fed. Cir. 1987). See also 37 CFR § 41.37(c)(1)(vii).

We next consider the rejection of claims 9, 14, 15, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Judd in view of Baldonado and further in view of Gupta. We find that the examiner has established at least a prima facie case of obviousness of those claims that appellants have not persuasively rebutted. The examiner has (1) pointed out the teachings of Judd and

Baldonado, (2) pointed out the perceived differences between those references and the claimed invention, and (3) reasonably indicated how and why those references would have been modified by the teachings of Gupta to arrive at the claimed invention [answer, pages 12-15]. Once the examiner has satisfied the burden of presenting a prima facie case of obviousness, the burden then shifts to appellants to present evidence or arguments that persuasively rebut the examiner's prima facie case. Appellants did not persuasively rebut the examiner's prima facie case of obviousness, but merely noted that the suggestion to combine the references is not found in the recited portion of the references and therefore such a combination is based solely on impermissible hindsight reasoning [brief, page 12]. But we find ample evidence on this record that would have reasonably motivated the skilled artisan to combine the references essentially for the reasons noted by the examiner. The rejection is therefore sustained.

We next consider the rejection of claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Judd in view of Baldonado, Gupta, and further in view of Bunney. We find that the examiner has established at least a prima facie case of obviousness on page 15 of the answer. Appellants, however, have not persuasively rebutted the examiner's prima facie case, but merely reiterated that the suggestion to combine the references is not found in the recited portion of the references and therefore such a combination is based solely on impermissible hindsight reasoning [brief, page 14]. But we find ample evidence on this record

that would have reasonably motivated the skilled artisan to combine the references essentially for the reasons noted by the examiner. The rejection is therefore sustained.

Likewise, we will sustain the examiner's rejection of claims 16 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Judd in view of Baldonado and further in view of Bunney. Here again, we find that (1) the examiner has established at least a prima facie case of obviousness for these claims on pages 15-17 of the answer. Appellants, however, have not persuasively rebutted the examiner's prima facie case, but once again reiterated that the suggestion to combine the references is not found in the recited portion of the references and therefore such a combination is based solely on impermissible hindsight reasoning [brief, page 14]. But we find ample evidence on this record that would have reasonably motivated the skilled artisan to combine the references essentially for the reasons noted by the examiner. The rejection is therefore sustained.

We will also sustain the examiner's rejection of claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Judd in view of Baldonado and further in view of Kisor. In particular, we find that (1) the examiner has established at least a prima facie case of obviousness for this claim on pages 17 and 18 of the answer. Appellants, however, have not persuasively rebutted the examiner's prima facie case, but merely noted that the suggestion to combine the references is not found in the recited portion of the references and therefore such a

combination is based solely on impermissible hindsight reasoning [brief, page 15]. But we find ample evidence on this record that would have reasonably motivated the skilled artisan to combine the references essentially for the reasons noted by the examiner. The rejection is therefore sustained.

We next consider the examiner's rejection of claims 8 and 25 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of Berstis in view of Judd. The examiner's rejection essentially finds that claim 9 of Berstis discloses all of the claimed subject matter except for crawling the electronic network and building an index as claimed [answer, pages 18 and 19]. The examiner cites Judd as disclosing such features and concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to provide such features in Berstis to enable quick and efficient searching [answer, page 19].

Appellants reiterate that Judd does not teach "user specified" keywords claimed in claim 8 [brief, page 15]. Appellants also argue that Berstis<sup>3</sup> does not recite storing the URL addresses and respective related user specified keywords of the different sites in a database as claimed. Appellants reiterate that the suggestion to combine the references is not found in the recited portion of the references and therefore such a combination is based solely on impermissible hindsight reasoning [brief, page 16]. The examiner responds by reiterating that the broadest reasonable interpretation of "user specified keywords" does not

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<sup>3</sup> Although appellants refer to claim 1 of Berstis in connection with the examiner's obviousness-type double patenting rejection [see brief, page 15], the rejection was based on claim 9 of Berstis – not claim 1 [see answer, pages 18 and 19].

preclude keywords (or words) in light of the specification and that Judd teaches the disputed limitations [answer, page 27].

We will sustain the examiner's obviousness-type double patenting rejection essentially for the reasons stated by the examiner. Our previous discussion of Judd applies equally here and we incorporate that discussion by reference.<sup>4</sup> In short, we agree with the examiner that Judd reasonably discloses "user specified" keywords and storing URL addresses and respective related user specified keywords of the different sites in a database as claimed for the reasons previously discussed. Furthermore, we find ample evidence on this record that would have reasonably motivated the skilled artisan to combine the references essentially for the reasons noted by the examiner. Because the examiner has established a prima facie case of obviousness-type double patenting that appellants have not persuasively rebutted, the rejection is therefore sustained.

In summary, we have sustained the examiner's rejection with respect to all claims on appeal. Therefore, the decision of the examiner rejecting claims 1-18, 21-23, and 25-30 is affirmed.

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<sup>4</sup> See pages 10-12, supra, of this opinion.

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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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|                             | ) |                 |
| JERRY SMITH                 | ) | BOARD OF PATENT |
| Administrative Patent Judge | ) | APPEALS AND     |
|                             | ) | INTERFERENCES   |
|                             | ) |                 |
|                             | ) |                 |
| HOWARD B. BLANKENSHIP       | ) |                 |
| Administrative Patent Judge | ) |                 |

JS/jaj/eld

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Application No. 09/565,395

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