

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 KEITH R. LAWRENCE

Appeal 2007-0458
Application 10/247,533
Technology Center 2100

Decided: April 11, 2007

Before LANCE LEONARD BARRY, ALLEN R. MACDONALD, and
JOHN A. JEFFERY, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-28. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

Appellant invented a distributed network browser viewable interface for assisting users to more easily and quickly search on the internet. Specifically, the interface includes a directory of displayed items and a drop down menu with multiple selectable keywords. When a user selects a keyword, at least one displayed item is highlighted based on the respective relationship with the keyword. *See generally* Specification ¶¶ 0006-7.

Claim 1 is illustrative:

1. A distributed network browser viewable interface, comprising:
a directory of displayed items; and
a first drop down button relating to a search topic viewable on the interface, the first drop down button having a respective drop down menu capable of being actuated via the first drop down button, the drop down menu having a plurality of selectable keywords;
wherein when one of the keywords is selected by a user, one or more displayed items will be highlighted based on their respective relationships with the selected keyword.

The Examiner relies on the following prior art references to show unpatentability:

Yagasaki	US 6,125,353	Sep. 26, 2000
Rebane	US 6,539,392 B1	Mar. 25, 2003 (filed Mar. 29, 2000)
Coombs	US 6,603,490 B1	Aug. 5, 2003 (filed Dec. 10, 1999)
Brown	US 6,665,838 B1	Dec. 16, 2003 (filed Jul. 30, 1999)

B. Shneiderman, *Dynamic Queries for Information Seeking*, in *Readings in Information Visualization: Using Vision to Think*, Stuart K. Card et al. eds., at 235-43 (1999) (“Card”).

The Examiner's rejections are as follows:

1. Claims 1-3, 6, and 24-28 are rejected under 35 U.S.C. § 103(a) as unpatentable over Yagasaki in view of Card.
2. Claims 4 and 5 are rejected under 35 U.S.C. § 103(a) as unpatentable over Yagasaki in view of Card and further in view of Brown.
3. Claim 23 is rejected under 35 U.S.C. § 103(a) as unpatentable over Yagasaki in view of Card and further in view of Gennaro.
4. Claims 7-9, 11, 14, and 17-22 are rejected under 35 U.S.C. § 103(a) as unpatentable over Coombs in view of Rebane.
5. Claims 10 and 16 are rejected under 35 U.S.C. § 103(a) as unpatentable over Coombs in view of Rebane and further in view of Brown.
6. Claims 12 and 13 are rejected under 35 U.S.C. § 103(a) as unpatentable over Coombs in view of Rebane and further in view of Card.
7. Claim 15 is rejected under 35 U.S.C. § 103(a) as unpatentable over Coombs in view of Rebane and further in view of Gennaro.

Rather than repeat the arguments of Appellant or the Examiner, we refer to the Brief and the Answer for their respective details. In this decision, we have considered only those arguments actually made by Appellant. Arguments which Appellant could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

OPINION

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 invention set forth in the claims on appeal. Accordingly, we affirm.

We first consider the Examiner's rejection of claims 1-3, 6, and 24-28 under 35 U.S.C. § 103(a) as unpatentable over Yagasaki in view of Card. 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 must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). If that burden is met, the burden then shifts to the Appellant 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 In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Regarding independent claims 1 and 24, the Examiner's rejection indicates that Yagasaki teaches a "mall server" that enables users to search for and buy desired products. According to the Examiner, Yagasaki comprises essentially every claimed feature except for a directory of displayed items such that when the user selects one of the keywords, one or more displayed items is highlighted based on their respective relationships with the selected keyword as claimed. The Examiner cites Card as teaching displaying search results in a graphical user interface. The Examiner notes that Card's system displays a list of all items and highlights items within the

list that satisfy the search criteria. The Examiner finds that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Yagasaki's system to display all stores within the screen and highlight stores with products satisfying the search conditions as suggested by Card (Answer 6-8).

Regarding independent claims 1 and 24, Appellant argues that the prior art does not teach or suggest any process wherein when one of a list of keywords is selected by the user, one or more displayed items will be highlighted based on their respective relationships with the selected keyword as claimed (Br. 6-8). The Examiner responds that Yagasaki and Card collectively teach this limitation since (1) Yagasaki invokes a search query by selecting a keyword from a drop down list, and (2) Card teaches highlighting displayed items responsive to a query -- the highlighting being based on the items' respective relationships with selected search parameters (Answer 21).

We will sustain the Examiner's rejection of independent claims 1 and 24. At the outset, we note that the scope and breadth of these claims does not preclude the teachings of Yagasaki alone. That is, we find that Yagasaki actually anticipates claims 1 and 24. In this regard, Yagasaki discloses in Fig. 7 a drop down menu 52b, 52ba comprising multiple selectable "keywords" pertaining to a product category (e.g., "FOOD & DRINK," "FASHION," "HOLIDAY SEASON," etc.). When one of these keywords is selected (e.g., "HOLIDAY SEASON" as shown in Fig. 8), the per-store hit count screen 53 displays each individual store and the numbers of products for each store (hit count) that match the selected product category (Yagasaki, Fig. 8; col. 7, ll. 13-28).

In our view, Yagasaki's displaying the hit count associated with each respective store in Fig. 8 fully meets "highlighting" one or more displayed items based on their respective relationships with the selected keyword as claimed giving the term "highlighting" its broadest reasonable interpretation. For example, "Store B" is indicated as having the highest hit count (7) for all stores satisfying the search conditions (i.e., "STORE B" is "highlighted" as having the most products within the "HOLIDAY SEASON" category).

Our interpretation of "highlighting" fully comports with Appellant's specification. Significantly, Appellant's specification notes that an example of highlighting can include dropping the listing of merchants into another web page (Specification ¶ 0043) – an example commensurate with the list of stores in display area 53b in Fig. 8 of Yagasaki. In addition, the specification indicates that forms of highlighting include, among other things, "...any...change that will temporarily distinguish the merchant from the other merchants on the web page" (*Id.*). In our view, indicating the respective hit counts associated with each merchant in Fig. 8 of Yagasaki would at least temporarily distinguish the stores having the most (e.g., "STORE B") and the fewest ("STORE E") products in the specified category from the other stores in the list.

For at least these reasons, we conclude that Yagasaki fully meets all limitations of independent claims 1 and 24 and therefore anticipates those claims.¹ We reach this conclusion since obviousness rejections can be based

¹ We further note that the scope and breadth of at least independent claims 1 and 24 does not preclude the selective highlighting feature in an automated search tool used by patent examiners and the public – the Examiner Automated Search Tool (EAST). *See generally* <http://www.uspto.gov/web/offices/ac/ido/pssd> (last visited Apr. 4, 2007)

on references that happen to anticipate the claimed subject matter. *In re Meyer*, 599 F.2d 1026, 1031, 202 USPQ 175, 179 (CCPA 1979).

Moreover, we sustain the Examiner’s obviousness rejection based on the teachings of Yagasaki alone since we may rely on fewer references than the Examiner in affirming a multiple-reference rejection under 35 U.S.C. § 103.

(noting that EAST is available to the public in the USPTO Public Search Facility).

Specifically, in EAST, the user can select individual terms of a text search query to highlight when displaying the search results. Such a feature enables the user to dictate specifically which terms of the query will be highlighted when reviewing the search results.

For example, for the text search query “CAT AND DOG,” the user can select either search term (“CAT” or “DOG”) to highlight from a dropdown menu. This selective highlighting feature is shown in a screenshot from EAST as shown in Figure 1 below:

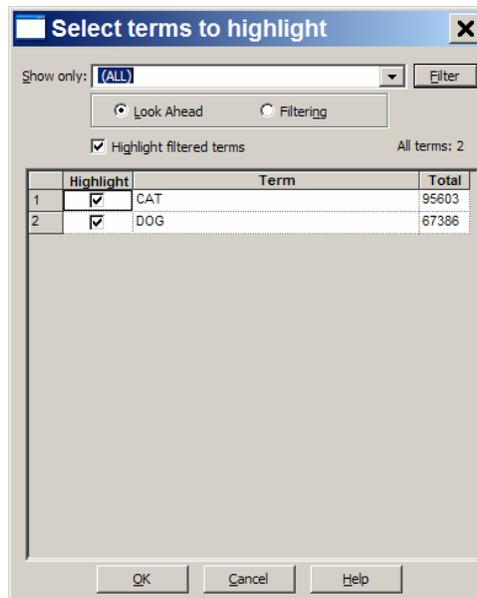


Figure 1: Screenshot from EAST Showing Selective Highlighting Feature

In re Bush, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961); *In re Boyer*, 363 F.2d 455, 458 n.2, 150 USPQ 441, 444 n.2 (CCPA 1966).

Notwithstanding this conclusion, we nevertheless agree with the Examiner that the teachings of Card would have been reasonably combinable with Yagasaki essentially for the reasons stated by the Examiner. Appellant argues that Card -- a teaching tool designed to provide insights to various relationships -- is non-analogous art since (1) the reference is not in Appellant's field of endeavor (searching and marketing over the internet), nor is the reference reasonably pertinent to the problem which Appellant is concerned (Br. 8-9). The Examiner argues that Card is analogous art since (1) the claims are not limited to internet shopping or marketing, and (2) even if they were, Card's dynamic queries have interface functionality similar to internet shopping applications. The Examiner adds that Card's dynamic queries are applicable to a wide variety of applications requiring searching or querying, including internet shopping (Answer 21-22).

We agree with the Examiner that Card constitutes analogous art. "Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved." *In re Bigio*, 381 F.3d 1320, 1325, 72 USPQ2d 1209, 1212 (Fed. Cir. 2004).

First, Card's viewable interface is in the same field of endeavor -- interfaces for viewing search results. In our view, Appellant's field of endeavor is not limited to searching and marketing over the internet, but

involves a wide variety of viewable interfaces for displaying search results. Moreover, the claims are hardly limited to internet searching and marketing.

But even assuming, without deciding, that Card is somehow not in the same field of endeavor, Card nevertheless is reasonably pertinent to the Appellant's problem – namely, highlighting certain displayed items in a search result set. We see no reason why Card's teachings would not have been reasonably pertinent to a wide variety of applications involving displaying search result sets, including internet commerce applications. Accordingly, Card constitutes analogous art.

Appellant also contends that the Examiner failed to provide the requisite motivation to make the specific claimed combination. Specifically, Appellant argues that there would be no apparent advantage in modifying Yagasaki's interface in view of Card (i.e., with slide controls or highlighting) since Yagasaki's interface already allows the user to ascertain stores with products that satisfy the user's search condition (Br. 9-10). Appellant also notes even if Yagasaki were modified by the teachings of Card, the skilled artisan would apply slide controls – a favored approach over highlighting (Br. 10-11). Appellant further notes that Card teaches away from highlighting since Card indicates that displaying only the items matching the query (i.e., the “expand/contract” approach) is significantly faster than highlighted displays (Br. 11).

The Examiner responds by noting that Yagasaki's online mall produces a list of merchants that satisfy specific search criteria, and Card teaches highlighting certain items in a list of alphanumeric data in Figs. 6 and 7. Although the Examiner acknowledges Card's teaching that the expand/contract approach is faster than highlighting, the Examiner indicates

that the reference nonetheless does not teach away from highlighting. Specifically, the Examiner notes several benefits of using highlighting including, among other things, providing more information in response to a query and revealing the proportion of items satisfying a query (Answer 25-28).

We agree with the Examiner that the teachings of Card would have been reasonably combinable with Yagasaki essentially for the reasons stated by the Examiner. In our view, in light of Card's teaching of highlighting matches with color or asterisks in the result sets in Fig. 6 and 7 (i.e., alphanumeric display), the skilled artisan would have reasonably been motivated to highlight certain items in the displayed result sets in Yagasaki with color or asterisks to at least more clearly distinguish certain displayed items.

Although Card discloses using slide controls in some embodiments and indicates that the expand/contract interface is faster in some instances,² the reference nevertheless teaches highlighting matches in a result set with color and asterisks. Even if we assume, without deciding, that slide controls and the expand/contract technique are preferred approaches, it is well settled that the teaching of a prior art reference is not limited to its preferred embodiment. *Pfizer, Inc. v. Apotex, Inc.*, No. 2006-1261, 2007 WL 851203, at *18 (Fed. Cir. Mar. 22, 2007) (“[T]he fact that a specific [embodiment] is taught to be preferred is not controlling, since all disclosures of the prior art, including unpreferred embodiments, must be considered”) (quoting *Merck*

² Card indicates that the “statistically significant speed advantage” for the expand/contract interface occurred only with medium-sized directories -- not with smaller, one-screen directories (Card, paragraph bridging Pages 238 and 239).

& Co., Inc. v. Biocraft Labs., Inc., 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989)).

In short, we find ample motivation on this record for the skilled artisan to have utilized highlighting as suggested by Card in Yagasaki's system. As the Examiner indicates, the skilled artisan would have recognized the benefits of using highlighting including, among other things, providing more information in response to a query and illustrating the proportion of items satisfying a query.

For at least these reasons, we will sustain the Examiner's rejection of independent claims 1 and 24. Since Appellant has not separately argued the patentability of dependent claims 2, 3, 6, and 25-28, these claims fall with independent claims 1 and 24. *See In re Nielson*, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987); *see also* 37 C.F.R. § 41.37(c)(1)(vii).

We next consider the Examiner's rejection of claims 4 and 5 under 35 U.S.C. § 103(a) as unpatentable over Yagasaki in view of Card and further in view of Brown. We find that the Examiner has established at least a prima facie case of obviousness of those claims that Appellant has not persuasively rebutted. Specifically, the Examiner has (1) pointed out the teachings of Yagasaki and Card, (2) noted the perceived differences between these references and the claimed invention, and (3) reasonably indicated how and why the references would have been modified to arrive at the claimed invention (Answer 10-11). Once the Examiner has satisfied the burden of presenting a prima facie case of obviousness, the burden then shifts to Appellant to present evidence or arguments that persuasively rebut the Examiner's prima facie case. Appellant did not persuasively rebut the Examiner's prima facie case of obviousness, but merely noted that the

addition of Brown fails to teach or suggest highlighting one or more displayed items responsive to selecting a keyword as claimed as previously argued in connection with independent claim 1 (Br. 7-8). For the reasons previously discussed, however, the rejection is therefore sustained.

Likewise, we will sustain the examiner's rejection of claim 23 under 35 U.S.C. § 103(a) as unpatentable over Yagasaki in view of Card and further in view of Gennaro. We find that (1) the Examiner has established at least a prima facie case of obviousness for this claim (Answer 11-12), and (2) Appellant has not persuasively rebutted the Examiner's prima facie case. In this regard, Appellant merely noted that the addition of Gennaro fails to teach or suggest highlighting one or more displayed items responsive to selecting a keyword as claimed as previously argued in connection with independent claim 1 (Br. 8). For the reasons previously discussed, however, the rejection is therefore sustained.

We next consider the Examiner's rejection of claims 7-9, 11, 14, and 17-22 under 35 U.S.C. § 103(a) as unpatentable over Coombs in view of Rebane. Regarding independent claim 7, the Examiner's rejection essentially finds that Coombs discloses a distributed network browser viewable interface with every claimed feature except for a drop down menu having at least one selectable keyword as claimed. The Examiner cites Rebane as disclosing this feature and concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to include a drop down menu in the website taught by Coombs to aid the user in finding a merchant of interest (Answer 12-13).

Regarding independent claim 7, Appellant argues that the prior art does not teach using a drop down menu working in concert with an interface

where linking members are rotated between their respective positions at a predetermined time (Br. 12-13). Appellant also contends that the Examiner failed to provide the requisite motivation to make the specific claimed combination (Br. 13-14). Additionally, Appellant argues that the Examiner's proposed combination would render the Coombs device unsatisfactory for its intended purpose. Appellant emphasizes that Coombs' purpose is to achieve equitable exposure of all names on the list to the visitor. According to Appellant, culling or otherwise organizing the list based on some parameter would defeat this purpose (Br. 14).

We will sustain the Examiner's rejection of independent claim 7. We agree with the Examiner's thorough and cogent analysis on Pages 30-34 of the Answer that the skilled artisan would have ample motivation on this record to provide a drop down menu with at least one selectable keyword in the web site listings of Coombs.

Coombs teaches an interface comprising a list of individuals and companies that is divided over multiple screens that are rotated frequently and periodically to more equitably expose the individuals and companies in the list (Coombs, col. 1, ll. 55-63). Similarly, Rebane discloses a website that comprises a list of merchants satisfying search criteria that is divided over four screens as indicated at the bottom of Fig. 18. *See* Rebane, Fig. 18 (including links to Screens 2-4). Rebane also provides drop down menus to search or find other categories or merchants (Rebane, col. 36, ll. 24-30; Fig. 18).

Given these collective teachings, we see no reason why the skilled artisan would not have provided a drop down menu in the web page listings of Coombs to at least provide an additional search capability for merchants

of interest. We recognize that that if the Examiner's proposed modification renders the prior art unsatisfactory for its intended purpose, the Examiner has failed to make a prima facie case of obviousness. *See In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). But we fail to see how providing an additional search tool on the displayed pages of Coombs would somehow defeat or obviate Coombs' screen rotation feature. In our view, providing an additional search tool in Coombs' system, such as a drop down menu, would only enhance its capability. Moreover, we see no reason why the skilled artisan would not have rotated the four screens of merchants in Fig. 18 of Rebane in view of the teachings of Coombs to more equitably expose the merchants listed among the four screens.

For at least these reasons, the collective teachings of Coombs and Rebane amply teach or suggest all limitations of independent claim 7. Also, there is ample motivation on this record to combine the references. Therefore, the Examiner's rejection of independent claim 7 is sustained. Since Appellant has not separately argued the patentability of dependent claims 8-22 with particularity, these claims fall with independent claim 7. *See In re Nielson*, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987); *see also* 37 C.F.R. § 41.37(c)(1)(vii).

DECISION

We have sustained the Examiner's rejections with respect to all claims on appeal. Therefore, the Examiner's decision rejecting claims 1-28 is affirmed.

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).

Appeal 2007-0458
Application 10/247,533

AFFIRMED

ELD

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