

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* VICTOR ERUHIMOV

Appeal 2007-0471  
Application 10/423,307  
Technology Center 2100

Decided: May 15, 2007

Before JAMES D. THOMAS, ALLEN R. MACDONALD, and  
JEAN R. HOMERE, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge.*

## DECISION ON APPEAL

29           Appellant appeals under 35 U.S.C. § 134 from a final rejection of  
30 claims 1-30. We have jurisdiction under 35 U.S.C. § 6(b). Claims 1-30 are  
31 rejected. However, the rejections of claims 1-4, 7, 10-17, 20-27, and 30, are  
32 not argued and we affirm these rejections as a matter of form.<sup>1</sup>

<sup>1</sup> Contrary to Appellant's statement (Reply Br. 1), claims 1-30 are the subject of this appeal. See the Notice of Appeal filed by Appellant on April 28, 2006. Appellant's statement (Br. 5) does not change this fact.

1 INVENTION

2 Appellant invented a method, system, and a medium for automatically  
3 generating a path to an item depending on its access history.  
4 (Specification 1).

5 Claims 1, 5 and 8 are representative of the claimed invention and are  
6 reproduced as follows:

7 1. A method comprising:  
8 detecting a number of times an item is accessed; and  
9 automatically generating a more direct path to the item based at least  
10 in part on how often the item is accessed.

11  
12 5. The method of claim 1 including generating a more direct path  
13 further based at least in part on the manner in which the item is accessed.

14  
15 8. The method of claim 1 including providing a more direct path to an  
16 item based on the number of times it is accessed and the number of  
17 interfaces that must be used in order to access said item.

18  
19 REFERENCES

20 The references relied on by the Examiner are as follows:

21 Gifford	US 5,301,314	Apr. 5, 1994
22 Horvitz	US 6,233,570	May 15, 2001
23 Clifton-Bligh	US 2003/0050906 A1	Mar. 13, 2003
24		(Filed Dec. 28, 1999)

25 REJECTIONS

26 Claim 5 stands rejected under 35 U.S.C. § 102 as being anticipated by  
27 Gifford.

28 Claims 1-4, 6, 11-16, and 21-26 also stand rejected under 35 U.S.C.  
29 § 102 as being anticipated by Gifford.

30 Claims 7, 17, and 27 stand rejected under 35 U.S.C. § 103 as being  
31 obvious over the combination of Gifford and Horvitz.

Claims 8, 9, 18, 19, 28, and 29 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Gifford and Clifton-Bligh.

3       Claims 10, 20, and 30 also stand rejected under 35 U.S.C. § 103 as  
4 being obvious over the combination of Gifford and Clifton-Bligh.

Throughout our opinion, we make references to the Appellant's briefs, and to the Examiner's Answer for the respective details thereof.<sup>2</sup>

OPINION

With full consideration being given to the subject matter on appeal,  
the Examiner’s rejections and the arguments of the Appellant and the  
Examiner, for the reasons stated infra, we affirm the Examiner’s rejection of  
claims 1-6, 11-16, and 21-26 under 35 U.S.C. § 102, we affirm the  
Examiner’s rejection under 35 U.S.C. § 103 of claims 7, 10, 17, 20, 27, and  
30 under 35 U.S.C. § 103, and we reverse the Examiner’s rejection of claims  
8, 9, 18, 19, 28, and 29 under 35 U.S.C. § 103.

15 I. Whether Appellant has established the Examiner erred in rejecting  
16 claim 5 under 35 U.S.C. § 102.

17 It is our view, after consideration of the record before us, that the  
18 disclosure of Gifford does fully meet the invention as recited in claim 5.  
19 Accordingly, we affirm.

20 It is axiomatic that anticipation of a claim under § 102 can be found  
21 only if the prior art reference discloses every element of the claim. See *In re*  
22 *King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and  
23 *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730  
24 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

<sup>2</sup> Appellant filed an Appeal Brief on May 30, 2006. Appellant filed a Reply Brief on August 22, 2006. The Examiner mailed an Examiner's Answer on July 17, 2006.

1       With respect to dependent claim 5, Appellant argues that Gifford “has  
2 nothing to do with generating a more direct path based on the manner in  
3 which an item is accessed” (Br. 11.). We disagree.

4       Gifford describes generating a more direct path (“the most useful of  
5 documents [ ] are listed first” Col. 4, ll. 36-37) based on the manner in which  
6 an item is accessed (“ranks and presents the most frequently used  
7 Documents” Col. 4, ll. 30-31).

8       Therefore, we will sustain the Examiner’s rejection under  
9 35 U.S.C. § 102.

10      II.     Whether Appellant has established the Examiner erred in rejecting  
11           claims 8, 9, 18, 19, 28, and 29 under 35 U.S.C. § 103.

12       It is our view, after consideration of the record before us, that the  
13       evidence relied upon and the level of skill in the particular art would not  
14       have suggested to one of ordinary skill in the art the invention as set forth in  
15       claims 8, 9, 18, 19, 28, and 29. Accordingly, we reverse.

16       The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 17-18, 148  
17       USPQ 459, 467 (1966), stated that three factual inquiries underpin any  
18       determination of obviousness:

19       Under § 103, the scope and content of the prior art are to be  
20       determined; differences between the prior art and the claims at  
21       issue are to be ascertained; and the level of ordinary skill in the  
22       pertinent art resolved. Against this background, the obviousness  
23       or nonobviousness of the subject matter is determined. Such  
24       secondary considerations as commercial success, long felt but  
25       unsolved needs, failure of others, etc., might be utilized to give  
26       light to the circumstances surrounding the origin of the subject  
27       matter sought to be patented. As indicia of obviousness or  
28       nonobviousness, these inquiries may have relevancy.

1 In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial  
2 burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977  
3 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re*  
4 *Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The  
5 Examiner can satisfy this burden by showing some articulated reasoning  
6 with some rational underpinning to support the legal conclusion of  
7 obviousness. *KSR Int'l. v. Teleflex Inc.*, No. 04-1350, 2007 WL 1237837 at  
8 13, 82 U.S.P.Q.2d 1385, 1396 (Apr. 30, 2007) (*citing In re Kahn*, 441 F.3d  
9 977, 988, 78 USPQ2d 1329 (Fed. Cir. 2006)). Only if this initial burden is  
10 met does the burden of coming forward with evidence or argument shift to  
11 the Appellants. *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. *See also*  
12 *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788.

13 An obviousness analysis commences with a review and consideration  
14 of all the pertinent evidence and arguments. “In reviewing the [E]xaminer’s  
15 decision on appeal, the Board must necessarily weigh all of the evidence and  
16 argument.” *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. “[T]he Board  
17 must not only assure that the requisite findings are made, based on evidence  
18 of record, but must also explain the reasoning by which the findings are  
19 deemed to support the agency’s conclusion.” *In re Lee*, 277 F.3d 1338,  
20 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

21 With respect to dependent claims 8, 9, 18, 19, 28, and 29, Appellant  
22 argues Clifton-Bligh “teaches nothing about generating different paths to an  
23 item based on the number of interfaces that must be used” (Br. 11) and “does  
24 not change the way an item is accessed” (Br. 12). We agree.

25 We recognize that the Examiner relies on Gifford to teach generating  
26 different paths to an item based on the number uses, and Gifford does

1 change the way an item is accessed. Further, Clifton-Bligh teaches counting  
2 the number of click (links) required to reach a file (web page).

3 With respect to why it would have been obvious to combine the  
4 references to generate different paths based on the number of interfaces  
5 used, the articulated reasoning of the Examiner (Answer 7) points to a  
6 motivation to combine at Paragraph 0022 of Clifton-Bligh. However, the  
7 cited motivation relates to “displaying” rather than the claimed “generating”  
8 and the Examiner fails to articulate why Paragraph 0022 would lead one to  
9 modify the “generating” of Gifford based on the number of interfaces used  
10 to access an item (i.e., how difficult it is to access an item). At most we  
11 have before us a conclusory statement using Paragraph 0022 and rejections  
12 on obviousness grounds cannot be sustained by mere conclusory statements.

13 *KSR Int'l. v. Teleflex Inc.*, No. 04-1350, 2007 WL 1237837 at 13, 82  
14 U.S.P.Q.2d 1385, 1396 (Apr. 30, 2007) (*citing In re Kahn*, 441 F.3d 977,  
15 988, 78 USPQ2d 1329 (Fed. Cir. 2006)).

16 Therefore, we will not sustain the Examiner’s rejection under 35  
17 U.S.C. § 103 for the same reasons as set forth above.

## 18 OTHER ISSUES

19 The Board brings to Appellant’s and the Examiner’s attention the  
20 following prior art reference:

21 Hochmuth US 6,377,286 B1 Apr. 23, 2002

22 We leave it to the Examiner to determine if Hochmuth and similar prior art  
23 describes the limitations recited in claims 8, 9, 18, 19, 28, and 29.

## 24 CONCLUSION

25 In view of the foregoing discussion, we have sustained the rejection  
26 under 35 U.S.C. § 102 of claims 1-6, 11-16, and 21-26, we have sustained

Appeal 2007-0471  
Application 10/423,307

1 the rejection under 35 U.S.C. § 103 of claims 7, 10, 17, 20, 27, and 30, and  
2 we have not sustained the rejection under 35 U.S.C. § 103 of claims 8, 9, 18,  
3 19, 28, and 29.

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

6

7 **AFFIRMED-IN-PART**

8

9

10 tdl/ce

11

12

13

14

15 TROP PRUNER & HU, PC  
16 1616 S. VOSS ROAD, SUITE 750  
17 HOUSTON TX 77057-2631