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4 UNITED STATES PATENT AND TRADEMARK OFFICE
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7 BEFORE THE BOARD OF PATENT APPEALS
8 AND INTERFERENCES
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11 *Ex parte* SUSANN MARIE KOEHANE and
12 JOHNNY MENG-HAN SHIEH
13

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15 Appeal 2008-0235
16 Application 09/998,396¹
17 Technology Center 2100
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20 Decided: May 30, 2008
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24 Before JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and
25 CAROLYN D. THOMAS, *Administrative Patent Judges*.

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27 THOMAS, C., *Administrative Patent Judge*.

28
29 DECISION ON APPEAL

30 I. STATEMENT OF THE CASE

31 Appellants appeal under 35 U.S.C. § 134 from a final rejection
32 of claims 1-20 mailed May 4, 2005. We have jurisdiction under
33 35 U.S.C. § 6(b).

¹ Application filed November 15, 2001. The real party in interest is International Business Machines Corporation (IBM).

1 We affirm.

2

3 A. INVENTION

4 Appellants invented a system, method, and computer readable
5 medium for managing HTML documents by highlighting certain parts of an
6 HTML document based on an intended reader. (Spec., 1:7-11.)

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8 B. ILLUSTRATIVE CLAIMS

9 The appeal contains claims 1-20. Claims 1, 4, 7, and 10 are
10 independent claims. Claims 1, 2, and 14 are illustrative:

11 1. A method of displaying a document having at least one
12 section that is to be highlighted based on an intended user comprising
13 the steps of:

14 displaying the document;

15 displaying at least one button with the document, the at
16 least one button being associated with the at least one section of the
17 document and indicating the intended user; and

18 highlighting the at least one section of the document
19 when the at least one button is asserted.

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21 2. The method of Claim 1 wherein highlighting the section
22 entails graying out the document except the section.

23

24 14. The method of Claim 13 wherein when the at least one
25 button is asserted, a string is sent to a search engine, the string
26 indicating the tags for which the search engine is to search.

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28 C. REFERENCES

29 The references relied upon by the Examiner in rejecting the claims on
30 appeal are as follows:

1 *Adobe® GoLive™ 5.0 User Guide for Windows® and Macintosh*
2 (*Adobe*), Adobe Systems Incorporated, 2000, pp. 109-110.

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4 *Microsoft® Word® 2000 Screenshots* (Word), Figures 1-7.

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D. REJECTIONS

7 The Examiner entered the following rejections which are before us for
8 review:

9 Claims 1, 4, 7, 10, 13, 15, 17, and 19 are rejected under 35 U.S.C.
10 § 102(a) as being anticipated by Adobe; and

11 Claims 2, 3, 5, 6, 8, 9, 11, 12, 14, 16, 18, and 20 are rejected under
12 35 U.S.C. § 103(a) as being unpatentable over Adobe in view of Word.

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II. PROSECUTION HISTORY

15 Appellants appealed from the Final Rejection and filed an Appeal
16 Brief (Br.) on January 5, 2007. The Examiner mailed an Examiner's
17 Answer (Ans.) on March 23, 2007. No Reply Brief is in the record.

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III. ISSUE

20 Whether the printed matter limitations recited in the rejected claims
21 distinguish the claimed "button" from Adobe's option to highlight in the
22 Mark Style menu.

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IV. FINDINGS OF FACT

25 The following findings of fact (FF) are supported by a preponderance
26 of the evidence.

1 *Adobe*

2 1. Adobe discloses that “[y]ou can select viewing options for your
3 Web page using the View Controller and General User Interface preferences.
4 The options that you select in the View Controller are only applied to the
5 open page. General User Interface preferences are applied to every page that
6 you open until you change them.” (109: Selecting viewing options.)

7 2. Adobe discloses “[c]hoose an option from the Mark Style menu to
8 highlight elements on the page formatted with a specific class or ID.” (110:
9 item 11.)

10 3. Adobe discloses “[c]hoose an option from the Mark Element menu
11 to highlight elements on the page formatted with a specific tag.” (110: item
12 12.)

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V. PRINCIPLES OF LAW

15 “[A]nticipation of a claim under § 102 can be found only if the prior
16 art reference discloses every element of the claim” *In re King*, 801
17 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik*
18 *GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir.
19 1984)). “[A]bsence from the reference of any claimed element negates
20 anticipation.” *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571
21 (Fed. Cir. 1986).

22 Appellants have the burden on appeal to the Board to demonstrate
23 error in the Examiner’s position. See *In re Kahn*, 441 F.3d 977, 985-86
24 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a
25 rejection [under § 103] by showing insufficient evidence of prima facie
26 obviousness or by rebutting the prima facie case with evidence of secondary

1 indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355
2 (Fed. Cir. 1998)).

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VI. ANALYSIS

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Grouping of Claims

6 In the Brief, Appellants argue claims 1, 4, 7, 10, 13 15, 17, and 19 as a
7 group (Br. 4-6). In other words, for claims 4, 7, 10, 13 15, 17, and 19,
8 Appellants merely repeat the same argument made for claim 1. Thus, the
9 Board selects representative claim 1 to decide the appeal for this group.
10 Accordingly, the remaining claims in this group stand or fall with claim 1.

11 Appellants argue claims 2, 5, 8, and 11 as a group. For claims 5, 8,
12 and 11, Appellants repeat the same argument made for claim 2. We will,
13 therefore, treat claims 5, 8, and 11 as standing or falling with claim 2.

14 Appellants argue claims 14, 16, 18, and 20 as a group. For claims 16,
15 18, and 20, Appellants repeat the same argument made for claim 14. We
16 will, therefore, treat claims 16, 18, and 20 as standing or falling with claim
17 14.

18 No separate arguments were made for claims 3, 6, 9, and 12.

19 *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Young*, 927 F.2d 588,
20 590 (Fed. Cir. 1991).

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The Anticipation Rejection

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Claims 1, 4, 7, 10, 13, 15, 17, and 19

24 We first consider the Examiner’s rejection of claims 1, 4, 7, 10, 13,
25 15, 17, and 19 under 35 U.S.C. § 102(a) as being anticipated by Adobe.

26 Appellants contend:

1 Applicants disclose that each button is labeled with an intended
2 user and that when a button is asserted the label used to indicate
3 the intended user is used by the invention as a search term in
4 order to determine which part of the text is to be highlighted.
5 Thus and as mentioned above, having buttons indicating
6 intended users is a rather important part of the invention and
7 should not be overlooked as the Examiner seems to have done.

8 (Br. 6.)

9 The Examiner concluded that “the feature upon which applicant relies
10 are not recited in the rejected claim(s)” (Ans. 10). We agree.

11 Claim 1 is directed to displaying a document comprising displaying at
12 least one button with the document, the at least one button being associated
13 with at least one section of the document, and highlighting the at least one
14 section when the at least one button is asserted. Adobe discloses selecting
15 viewing options for an opened document by choosing from a menu to
16 highlight elements on the page that are formatted with a specific class, ID, or
17 tag (FF 1-3).

18 Thus, we find that Adobe meets all of the display related structural
19 limitations of claim 1. The remainder of claim 1’s description is directed
20 either to the intended use of the button or to nonfunctional printed material
21 printed on the button which we find is not entitled to patentable weight in
22 determining patentability because the nonfunctional descriptive material
23 does not change the step of displaying which is taught by Adobe.

24 Specifically, the preamble of claim 1 states that the claimed at least
25 one section is to be “highlighted based on an intended user.” This preamble
26 language does not limit the step of displaying (although it might help to
27 visually direct information to an intended user, an issue we will review
28 shortly). “[W]here a patentee defines a structurally complete invention in

1 the claim body and uses the preamble only to state a purpose or intended use
2 for the invention, the preamble is not a claim limitation.” *Rowe v. Dror*, 112
3 F.3d 473, 478 (Fed. Cir. 1997). Here, we find that Appellants have defined
4 complete steps of displaying and highlighting in the claim body and uses the
5 preamble only to indicate an intended user.

6 The same is true of the claim language stating “the at least one button
7 . . . indicating the intended user.” Although this language appears in the
8 body of the claim, it also does nothing more than recite an intended use for
9 the claimed button and therefore is not a structural limitation. The weight to
10 be given to this claim limitation is the central issue in this appeal. We find
11 that “*indicating the intended user*” limitation is nothing more than
12 nonfunctional printed matter not functionally related to the substrate.

13 *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983), provides an appropriate
14 test for determining whether limitations defining descriptive material should
15 be given patentable weight. The court stated that limitations reciting printed
16 matter cannot be ignored but “[w]here the printed matter is not functionally
17 related to the substrate, the printed matter will not distinguish the invention
18 from the prior art in terms of patentability. Although the printed matter must
19 be considered, in that situation it may not be entitled to patentable weight.”
20 *Id.* at 1385. The “critical question is whether there exists any new and
21 unobvious functional relationship between the printed matter and the
22 substrate.” *Id.* at 1386.

23 In *Gulack*, the court held that the substrate and printed matter had
24 such a relationship because the looped structure of the substrate in that case
25 and the particular digits printed on it interrelated to give the claimed article a
26 property it would not have had if either the structure or the digits were

1 changed. Therefore, the content of the printed matter was held to produce a
2 nonobvious difference between the claimed product and the prior art.

3 Now, we must ask ourselves whether the printed matter (e.g.,
4 *indicating an intended user*) and substrate (*the display*) of claim 1 share a
5 “novel and unobvious functional relationship” like that of the product of
6 *Gulack*. In our view, the printed matter and the substrate of the method of
7 claim 1 have the same relationship as any other “*indication*” has with its
8 display: the *indicating an intended user* printed on the button of the
9 substrate provides only a visual indication to the user of what material will
10 be highlighted, it does not change whether or not the substrate is highlighted.
11 Claim 1 merely requires the step of “highlighting the at least one section of
12 the document when the at least one button is asserted.” This function is
13 performed whether or not the button indicates an intended user. The printed
14 matter in the claimed invention is not linked to the highlighting feature itself,
15 asserting the button is. Therefore, we see a disconnect between the alleged
16 patentable distinguishing feature and the additional features recited in each
17 of the independent claims. Thus, we find that there is no “new and
18 unobvious functional relationship” between the printed matter and the
19 substrate. As such, the printed matter is not given any patentable weight in
20 the method of independent claim 1.

21 Therefore, we do not find that Appellants have shown error in the
22 Examiner’s rejection of illustrative claim 1. Instead, we find the Examiner
23 has set forth a sufficient initial showing of anticipation.

24 Therefore, we affirm the rejection of independent claim 1 and of
25 claims 4, 7, 10, 13, 15, 17, and 19, which fall therewith.

26

The Obviousness Rejection

Claims 2, 5, 8, and 11

Regarding claims 2, 5, 8, and 11, Appellants contend:

By contrast and based on the Examiner's assertions, when the teachings of the Adobe GoLive™ 5.0 User Guide are combined with those of Microsoft™ Word™, a user can assert a button to highlight all items tagged with a specific class, ID, or tags. Then, the user can select the header/footer of the document to gray out the body of the document. This is quite different from the claimed invention.

(Br. 7.)

The Examiner found that "Word discloses the method of graying out the document in sections not currently selected (Figure 5: Here, the header/footer of the document is selected and the body of the text is grayed out accordingly)" (Ans. 6-7). We agree.

Claim 2 recites "*wherein highlighting the section entails graying out the document except the section.*" As pointed out by the Examiner, Word discloses graying out sections not currently selected. Thus, we find that in the claimed invention since the highlighted section is the section being selected, in essence every other section is grayed out except the selected section. As such, we do not find that Appellants have shown error in the Examiner's rejection. Instead, we find the Examiner has set forth a sufficient initial showing of obviousness.

Therefore, we affirm the rejection of claim 2 and of claims 5, 8, and 11, which fall therewith.

1 *Claims 14, 16, 18, and 20*

2 Regarding claims 14, 16, 18, and 20, Appellants contend that the
3 combination of Adobe and Word does not teach the claimed invention
4 because “[t]he invention calls for a string to be sent to a search engine. The
5 string indicates the tags for which the search engine is to search” (Br. 8).

6 The Examiner found that “Adobe fails to specifically disclose the
7 method wherein when the at least one button is asserted, a string is sent to a
8 search engine, the string indicating the tags for which the search engine is to
9 search” (Ans. 8). We disagree.

10 We find that in order for Adobe to highlight elements on the page
11 formatted with a specific tag, its process must necessarily include a search
12 technique for finding the tags. In other words, we find that Adobe inherently
13 discloses within its option a string indicating the tags for which a search
14 engine is to search.

15 The Examiner relies upon Word’s “Find” feature to disclose the
16 above-noted string to a search engine limitations. However, we find that
17 such a teaching, although setting forth a known technique, is not necessary
18 and is merely cumulative in this case.

19 Therefore, we do not find that Appellants have shown error in the
20 Examiner’s rejection of illustrative claim 14. Instead, we find the Examiner
21 has set forth a sufficient initial showing of obviousness.

22 Therefore, we affirm the rejection of claim 14 and of claims 16, 18,
23 and 20, which fall therewith.

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1 *Claims 3, 6, 9, and 12*

2 We note that no separate arguments were presented for claims 3, 6, 9,
3 and 12. Arguments which Appellants could have made but chose not to
4 make in the Brief has not been considered and are deemed to be waived.

5 Therefore, we affirm the rejection of claims 3, 6, 9, and 12 and group
6 these claims with their respective parent claims.

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8 VII. CONCLUSIONS

9 We conclude that Appellants have not shown that the Examiner erred
10 in rejecting claims 1-20.

11 Thus, claims 1-20 are not patentable.

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13 VIII. DECISION

14 In view of the foregoing discussion, we affirm the Examiner's
15 rejection of claims 1-20.

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