

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID T. SHUPING and WILLIAM R. JOHNSON

Appeal 2008-0467
Application 09/985,415
Technology Center 2100

Decided: February 6, 2008

Before JAMES D. THOMAS, LANCE LEONARD BARRY, and
JAY P. LUCAS, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-82. (Ans. 2) The Appellants appeal therefrom under 35 U.S.C. § 134(a). An oral hearing was held on January 23, 2008. We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

The invention at issue on appeal is a web browser. Often called the "World Wide Web," the Internet provides a user with a host of "web pages." (Spec. 1.) "Web browsing" refers to the actions of selecting a web page, retrieving data associated therewith, rendering the data, and displaying the web page. (*Id.*)

The Appellants complain that conventional web browsers typically display only one web page at a time. (*Id.* 2) In contrast, their invention displays a current web page along with past and future web pages. (*Id.* 1.)

B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows.

1. A method for browsing web pages comprising the steps of:

in response to a user action, requesting first web page data from a source of web page data;

receiving said first web page data including a reference to second web page data;

locating said reference to said second web page data in said first web page data;

automatically requesting said second web page data using said reference;

rendering a first web page in a first panel using said first web page data; and

rendering a second web page in a second panel using said second web page data.

C. REJECTIONS

Claims 1-43 and 49-82 stand rejected under the judicially-created doctrine of double patenting over claims 1-41 of U.S. Patent No. 6,313,855.

Claims 1-3, 15, 25, 27, 38, 39, 44, 47, 69, and 72-77 stand rejected under 35 U.S.C. § 103(a) as obvious over International Publication WO 97/29414 ("AT&T") and U.S. Patent No. 6,133,916 ("Bukaszar").

Claims 4-11, 16, 19-21, 23, 24, 26, 40, 45, 70, and 71 stand rejected under § 103(a) as obvious over AT&T; Bukaszar; and U.S. Patent No. 6,177,936 ("Cragun").

Claims 12, 17, 46, and 48 stand rejected under § 103(a) as obvious over AT&T; Bukaszar; and U.S. Patent No. 5,838,326 ("Card").

Claims 13, 14, 18, 22, 28-37, 41-43, and 78-81 stand rejected under § 103(a) as obvious over AT&T, Bukaszar, Cragun, and Card.

II. DOUBLE PATENTING REJECTION OF CLAIMS 1-43 AND 49-82

The Appellants do not contest "these rejections [sic] in the Appeal Brief." (Br. 9.) Therefore, we summarily affirm the double patenting rejection of claims 1-43 and 49-82.

III. OBVIOUSNESS REJECTIONS OF CLAIMS 1-3, 15, 17,
25-28, 38, 39, 69, AND 73-77

"Rather than reiterate the positions of parties *in toto*, we focus on the issue therebetween." *Ex parte Filatov*, No. 2006-1160, 2007 WL 1317144, at *2 (BPAI 2007). The Examiner makes the following finding and conclusion.

[I]t would have been obvious to a person having ordinary skill in the art at the time of appellant's invention to modify the web browser and montage arrangement of AT & T, where linked "web page" imagery is jointly displayed with the original page having the links, to use the graphical representation of an entire "web page" as per Bukszar's graphical representation of pages, the motivation being to create a fuller and more readily - appreciated and - useful representation in the browser view of the overall context of history that is produced in the AT & T linked page view.

(Ans. 6.) In what their attorney characterized as their "key argument" during the oral hearing, the Appellants argue that "one of ordinary skill in the art would not be motivated to combine AT&T with a reference such as Bukszar, that teaches rendering all the web page data - not just the image data - because AT&T clearly **teaches away from such a combination.**" (Br. 11.) Therefore, the issue is whether the Appellants have shown that AT&T teaches away from combining teachings of Bukszar therewith.

"A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir.1994). Teaching an alternative or equivalent method, however,

does not teach away from the use of a claimed method. *In re Dunn*, 349 F.2d 433, 438 (CCPA 1965). To coin a phrase, "teaching a way is not teaching away." See "Teaching a Way is not Teaching Away," 79 J. Pat. & Trademark Off. Soc'y 867 (1997).

Here, the premise of the Appellants' argument is that "[w]hen read as a whole, AT&T apparently teaches that during browsing, it is desirable to render just the images from the multiple web pages rather than to render the web pages themselves." (Br. 10.) To support that premise the Appellants rely on the reference's identification of "a problem with conventional web browsing" (*Id.* 9.) More specifically, AT&T complains that "accessing web pages with interesting inlined images typically involves browsing through web pages of material by clicking on hypertext links. Although browsing in this way is often rewarding, it requires a good deal of attention on the part of the person who is browsing and can be burdensome." (P. 1, ll. 20-26.)

We are unpersuaded that the problem identified by the reference comprises "rendering all the web page data - not just the image data" (Br. 10.) To the contrary, the problem focuses on the "way" (AT&T, p. 1, l. 23) in which conventional browsing is done, viz., a user manually "click[s] on hypertext links." (*Id.* ll. 22-23.) AT&T solves the problem by what the Appellants' attorney termed automated "forward crawling" during the hearing. Although AT&T happens to forward crawl to just images from web pages (Abs. l. 1), the reference would not have actively discouraged a person

of ordinary skill from forward crawling to entire web pages. Instead, we view AT&T's rendering of an image from a web page as a mere alternative or equivalent teaching to Bukszar's teachings of rendering of an entire web page, not as a teaching away therefrom. Consequently, the Appellants have not shown that the AT&T teaches away from combining teachings of Bukszar therewith. Therefore, we affirm the obviousness rejections of claims 1-3, 15, 17, 25-28, 38, 39, 69, and 73-77.

IV. OBVIOUSNESS REJECTION OF CLAIMS 4-9

The Examiner concludes that "it would have been . . . obvious . . . to permit a set of linked windows as per AT & T, which depict 'web pages' as per Bukszar, to be modified according to user browsing of links within the web pages as per Cragun" (Ans. 9.) He offers the following findings to support his conclusion.

Cragun represents a motivation that derives from the nature of the Bukszar "web page" display to show context as per AT & T, since in each of these references, there is a desire to produce a useful and coherent set of related images, and allowing navigation within such an image improves user interaction and operability to find the desired browsing results.

(*Id.* 14.) The Appellants argue, "Neither AT&T nor Bukszar, alone or in combination with one another, deal with such mechanisms or structured display of related web pages to support the combination suggested by the Examiner." (Br. 12.) Therefore, the issue is whether the Appellants have shown error in the Examiner's reason to combine teachings from Cragun with those of AT&T.

The presence or absence of a reason "to combine references in an obviousness determination is a pure question of fact." *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 1000 (Fed. Cir. 1999)). A reason to combine teachings from the prior art "may be found in explicit or implicit teachings within the references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved." *WMS Gaming Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1355 (Fed. Cir. 1999) (citing *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

Here, AT&T employs web pages interconnected by hyperlinks. (P. 1, ll. 20-23.) For its part, Cragun identifies a problem troubling such web pages. To wit, "all of these web pages connected by hyperlinks are unorganized, and there is no table-of-contents. Thus, it can be very difficult for a user to determine the context of a web page, especially when the user has jumped to the web page from a search engine." (Col. 1, ll. 54-58.) The latter reference also offers a solution to the problem in the form of "a mechanism for providing contextual information for a web page." (Col. 2, ll. 5-6.)

Because AT&T employs web pages interconnected by hyperlinks, and Cragun identifies a problem troubling such web pages and offers a solution thereto, we agree with the Examiner that the references themselves and the nature of the problem to be solved would have provided a reason to combine teachings from Cragun with those of AT&T. Any other alleged omission of

AT&T does not persuade us of error in the Examiner's reason to combine teachings.

Furthermore, Bukszar's "FIG. 4 illustrates a preferred embodiment of a user interface 40 displayed on the display 30 by the web browser 28." (Col. 3, ll. 37-39.) "The display includes a content area 42 that displays the contents of a web page and a tiled screen area 44 that displays graphical representations of web pages 46A-E downloaded over the network 34 and stored in the cache 2[6]." (*Id.* ll. 39-42.) "The user may select one of the pages 46A-E to display in the content area 42 by selecting the graphical representation of the page 46A-E with the input means 32, e.g., double-clicking the graphical representation 46A-E." (Col. 4, ll. 5-8.) We find that this selection of one of the pages 46A-E to display in the content area 42, in combination with the teachings of AT&T, would have suggested claim 4's "step of rendering said second web page in said first panel in response to said user selecting said second web page." Therefore, we affirm the obviousness rejection of claims 4-9.

V. OBVIOUSNESS REJECTIONS OF CLAIMS 10, 11, 16, 18-24, 34, 36, AND 70-72

The Examiner finds that it in the combination of AT&T, Bukszar, and Cragun "one will have . . . a 'third web page' in a 'third panel', should the AT&T depth include such a predecessor 'web page' that is placed into a past historical position in relation to the 'first', using Bukszar's technique of a series of page-images." (Ans. 15.) The Appellants argue, "None of the three modes of Cragun" (Br. 13) "teaches moving the third web page from the first

panel to the third panel." (*Id.*) Therefore, the issue is whether the Appellants have shown error in the Examiner's findings about what the combined teachings of AT&T, Bukszar, and Cragun would have suggested.

"Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references." *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)). In determining obviousness, furthermore, a reference "must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole." (*Id.*) The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991) (citing *Keller*, 642 F.2d at 425).

Here, the Examiner bases his rejection on the combined teachings of AT&T, Bukszar, and Cragun. The Appellants, however, only attack the latter reference. Such a piecemeal attack does not persuade us of error in the Examiner's findings. Therefore, we affirm the obviousness rejections of claims 10, 11, 16, 18-24, 34, 36, and 70-72.

VI. OBVIOUSNESS REJECTIONS OF CLAIMS 12-14

The issue is whether the Appellants have shown error in the Examiner's reason for combining teachings of AT&T and Card. Just as "[i]t is not the function of [the U.S. Court of Appeals for the Federal Circuit] to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art" *In re Baxter Travenol Labs.*,

952 F.2d 388, 391 (Fed. Cir. 1991), "it is not the function of this Board to examine claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art." *Ex parte Post*, No. 2005-2042, 2006 WL 1665399 at *4 (BPAI 2006). Furthermore, a "reply by the applicant or patent owner [to a rejection] must . . . distinctly and specifically points out the supposed errors in the examiner's action The reply must present arguments pointing out the specific distinctions believed to render the claims . . . patentable over any applied references." 37 C.F.R. § 1.111(b)(2005).¹

Here, the Examiner specifically explains why it would have been obvious at the time of the invention to a person of ordinary skill in the art to have modified AT&T to arrive at the claimed subject matter. To wit, he offers the following finding and conclusion.

[I]t would have been still further obvious to the person having ordinary skill in the art at the time of appellant's invention to produce a "three-dimensional" distribution of document objects as per Card to represent the linked "web page" information as per AT&T, the motivation being to make the information more intuitively accessible to the user, who must comprehend a number of related representations at one time.

(Ans. 11.) The Appellants respond, "Other than these assertions, there is no motivation from the references themselves to combine them in the manner suggested by the Examiner." (Br. 14.)

¹ We cite to the version of the Code of Federal Regulations in effect at the time of the Appeal Brief. The current version includes the same rules.

Without specifically addressing the Examiner's finding, the Appellants' response amounts to a general allegation that the claims define a patentable invention. It shows no error in the Examiner's finding.

Furthermore, "[t]he obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents. The diversity of inventive pursuits and of modern technology counsels against limiting the analysis in this way." *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). A reason to combine teachings from the prior art "may be found in explicit or implicit teachings within the references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved." *WMS Gaming*, 184 F.3d at 1355 (citing *Rouffet*, 149 F.3d at 1355). Here, based on the premise that teachings from the references themselves must provide an explicit motivation to combine, the Appellants' allegation is unpersuasive. Therefore, we affirm the obviousness rejections of claims 12-14.

VII. OBVIOUSNESS REJECTION OF CLAIMS 29-33, 35, 37, AND 41

The Examiner makes the following findings.

[A] sequence that can be described as "past", "current" and "future" will exist within any browsing history that goes to three levels, as is possible in all of AT & T, Bukszar and Cragun, since this is an order over time by which they are readily accessed. Card even more specifically uses the notion

of the three times, with the "current" (focus), "past" (tiers) and "future" (bookcase) "page" objects.

(Ans. 16.) The Appellants argue that "it is not clear how one of ordinary skill in the art would combine them to achieve at least the temporal aspects of the claimed invention." (Br. 17.) Therefore, the issue is whether the combined teachings of AT&T, Bukszar, Card, and Cragun would have suggested displaying a current web page, a past web page, and a future web page.

The question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently" *In re Zurko*, 258 F.3d 1379, 1383-84 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *Dembiczak*, 175 F.3d at 998; *In re Napier*, 55 F.3d 610, 613 (Fed. Cir. 1995)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976)).

Here, the Examiner bases his rejection on the combined teachings of AT&T, Bukszar, Card, and Cragun. The Appellants admit, "AT&T apparently teaches current web pages having links to future web pages" (Br. 17.) Furthermore, the primary reference discloses that "web pages corresponding to links appearing on the web pages for the depth of 0 case are retrieved in addition to the web pages for the depth of 0 case" (p. 18, ll. 23-26), and that a "montage applet 134 displays the transmitted images on

the display" (P. 19, ll. 15-16.) We find that these disclosures teach the retrieval and display of the future web pages recognized by the Appellants.

It is uncontested that Bukszar also displays a current web page in its content area 42. Because the secondary reference discloses that "[t]he graphical representation of pages 46A-E may represent the most recently visited web pages" (col. 4, ll. 14-15), moreover, we find that the Bukszar also teaches past web pages.

Because Card discloses a "Focus Space . . . where a document object that a user is directly interacting with is shown" (col. 6, ll. 25-26), we find that the latter reference teaches displaying current work. Because Card discloses that "the most recently used document objects are placed on the desk 202" (col. 7, ll. 17-18), we find that the latter reference teaches displaying past work.

Lastly, the Appellants admit Cragun "teaches using a URL [i.e., uniform resource locator] address of a current web page" (Br. 17.)

In view of these admissions and findings, we agree with the Examiner that the combined teachings of AT&T, Bukszar, Card, and Cragun would have suggested displaying a current web page, a past web page, and a future web page. Therefore, we affirm the obviousness rejection of claims 29-33, 35, 37, and 41.

VIII. OBVIOUSNESS REJECTION OF CLAIM 40

The Examiner finds, "Especially using the teachings of Card, 'a trimonitor' will appear" (Ans. 16.) The Appellants argue that "none of the references, alone or in combination with one another teach or suggest a trimonitor having first, second and third display device" (Br. 18.) Therefore, the issue is whether the combined teachings of AT&T, Bukszar, and Cragun would have suggested a trimonitor having first, second, and third display devices.

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)).

Here, the Examiner bases his rejection on the combined teachings of AT&T, Bukszar, and Cragun. (Ans. 8.) The Examiner's reliance on teachings of Card, which is not part of the combination, is improper. Even if Card were part of the combination, moreover, the latter reference teaches a single display 107. (Fig. 1.)

The Examiner does not allege, let alone show, that AT&T, Bukszar, or Cragun cures the aforementioned deficiency of Card. Absent a teaching or suggestion of a trimonitor having first, second, and third display devices, we are unpersuaded of a *prima facie* case of obviousness having been established. Therefore, we reverse the obviousness rejection of claim 40.

IX. OBVIOUSNESS REJECTION OF CLAIMS 42, 43, AND 78-81

The Examiner finds that "the persistence of object placement within the Card three-dimensional environment causes the reference to read upon 'sticky' objects as in the claims." (Ans. 17.) The Appellants respond that "the notion of a 'sticky web page' is not taught or suggested by Card" (Br. 19-20.) Therefore, the issue is whether the Appellants have shown error in the Examiner's findings about what Card would have suggested.

"A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements [of § 1.111(b)]." 37 C.F.R. § 1.111(b).

Without specifically addressing the Examiner's findings, the Appellants' response amounts to a general allegation that the claims define a patentable invention. It shows no error in the Examiner's finding. Therefore, we affirm the obviousness rejection of claims 42, 43, and 78-81.

X. OBVIOUSNESS REJECTIONS OF CLAIMS 44-46

The Examiner finds that "when a bookmarked location is called as per Bukszar in the combined arrangement with AT&T, . . . a 'scene' will be created, when linked to pages are then included in the display." (Ans. 17.) The Appellants argue, "Bukszar stores individual references to web pages, not collectively as a single bookmark." (Br. 20.) Therefore, the issue is whether the Appellants have shown error in the Examiner's findings about

what the combined teachings of AT&T, Bukszar, and Cragun would have suggested.

Here, the Examiner bases his rejections on a combination of references that includes AT&T and Bukszar. The Appellants, however, only attack the latter reference. Such a piecemeal attack does not persuade us of error in the Examiner's findings. Therefore, we affirm the obviousness rejections of claims 44-46.

XI. OBVIOUSNESS REJECTIONS OF CLAIMS 47 AND 48

The Examiner finds, "Upon such retrieval, the AT & T display will then have 'a display location for said first web page' . . . in the browser." (Ans. 8.) The Appellants argue, "All of the references relied upon by the Examiner in rejecting these claims, including Bukszar are silent with regard to storing a display location for said first web page." (Br. 20.) Therefore, the issue is whether the Examiner has shown that combined teachings of the references would have suggested storing a display location for a first web page. The Examiner does not allege, however, let alone show, that the combined teachings of the references would have suggested the feature. Therefore, we reverse the obviousness rejections of claim 47 and 48.

XII. ORDER

In summary, the rejection of claims 1-43 and 49-82 under the judicially-created doctrine of double patenting is affirmed. The rejections of claims 1-39, 41-46, and 69-81 under § 103(a) are also affirmed. The rejections of claims 40, 47, and 48 under § 103(a), however, are reversed.

"Any arguments or authorities not included in the brief or a reply brief filed pursuant to [37 C.F.R.] § 41.41 will be refused consideration by the Board, unless good cause is shown." 37 C.F.R. § 41.37(c)(1)(vii). Accordingly, our affirmance is based only on the arguments made in the brief. Any arguments or authorities omitted therefrom are neither before us nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1367 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.")

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

AFFIRMED-IN-PART

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