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

Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK JOSEPH HAMZY

Appeal No. 2001-0677
Application No. 08/974,575

ON BRIEF

Before THOMAS, DIXON, and LEVY, **Administrative Patent Judges**.

DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-56, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

Appellant's invention relates to a method for providing a document with a button for network service. An understanding of the invention can be derived from a reading of exemplary claim 1, which are reproduced below.

> 1. A method for printing a document in a markup language, comprising the steps of:
>
> requesting a document from a web server by a web client;
>
> intercepting the requested document by an intermediate server;
>
> parsing the markup language of the requested document;
>
> inserting a markup language string in the requested document for a print button, including a path to a print server, to produce a modified document;
>
> sending the modified document to the requesting client;
>
> presenting the modified document at the requesting client on a display, including presenting the print button;
>
> responsive to selection of the print button, sending a print request to the print server; and
>
> printing the requested document at a printer associated with the print server.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Vertelney et al. (Vertelney)	5,341,293	Aug. 23, 1994
Harkins et al. (Harkins)	5,689,642	Nov. 18, 1997 (Filed Nov. 22, 1995)
Cuomo et al. (Cuomo)	5,861,883	Jan. 19, 1999 (Filed May 13, 1997)
Austin et al. (Austin)	5,946,458	Aug. 31, 1999 (Filed Mar. 24, 1997)

Claims 1, 2, 8, 11, and 13-56 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cuomo in view of Harkins. Claims 3-5, 9-10, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cuomo in view of Harkins, further in view of Vertelney. Claims 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cuomo in view of Harkins, further in view of Austin.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 9, mailed Nov. 7, 2000) for the examiner's reasoning in support of the rejections, and to appellant’s brief (Paper No. 8, filed Aug. 22, 2000) for appellant’s arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant’s specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations which follow.

At the outset, we note that the examiner has set forth a ***prima facie*** case of obviousness with respect to independent claim 1 addressing all the limitations recited in independent claim 1. The examiner maintains that the claimed invention would have been suggested by the combination of Cuomo and Harkins as set forth at pages 4-7 of the answer. Appellant argues that the examiner has not met the burden of showing that the invention as a whole was obvious in light of the prior art. (See brief at page 6.) Appellant argues further that it was not obvious to simply substitute one thing, such as a print button, into a web page in place of inserting an Applet without a teaching, suggestion or motivation to do so. (See brief at page 7.) We agree with appellant.

The examiner maintains that it would have been obvious to one of ordinary skill in the art to combine the teachings of Cuomo and Harkins since they each are related to collaborative applications and that such combination would allow each user the freedom to retrieve information. Appellant argues that this rationale conveniently ignores the fact that the users in Cuomo already have access to printers and would have no motivation to alter the original web page. (See brief at pages 7-8.) We agree with appellant. Appellant also argues that Cuomo teaches the use of a traditional web browser 205 to display the received data from a web server 206. (See brief at page 8 and Cuomo at col. 1.) Appellant argues that the Web Browser would have had a print

selection via a pull down menu and that adding a print button onto the display of a Web page would not have been necessary or motivated. (See brief at page 8.) We agree with appellant. Appellant argues that the skilled artisan would not have been motivated to add printing to the real time collaborative environment as taught by Cuomo. (See brief at page 8.) We agree with appellant.

From our review of Cuomo, Cuomo teaches that one of the objects of Cuomo's invention is to use proxies and shared state servers to enable collaboration within existing Web browsers. Additionally, Cuomo teaches that the Proxy 202 contains Forwarding Software 204 that requests Web pages, forwards them to the appropriate Web Server 206 and manipulates the retrieved data before delivering it to the Web Browser 205. (Cuomo at col. 3.) Cuomo uses an Applet 207 embedded by the Forwarding Software 204 and the Applet receives commands from the collaboration session and provides that information to the Client Software 203 that the Client Software can disseminate to the collaboration session. (Cuomo at col. 4.) From the teachings of Cuomo, we find no teaching or suggestion to modify a Web page and insert a print button.

Appellant argues that Harkins teaches a similar use of a print functionality, but from a "network services" icon on the display interface and that it would not have been

obvious to one of ordinary skill in the art to modify a Web page and insert a print button. (See brief at page 8.) We agree with appellant.

Appellant also argues that the examiner has pointed to no teaching, suggestion or incentive for one of ordinary skill in the art to combine or modify these references in a manner necessary to reach the presently claimed invention. (See brief at page 9.) We agree with appellant and find that even if the references were combined, the examiner has pointed to no teaching, suggestion or incentive for one of ordinary skill in the art to modify these references in a manner necessary to reach the presently claimed invention. Therefore, we find that appellant has adequately rebutted and shown error in the examiner's presentation of a ***prima facie*** case of obviousness, and we cannot sustain the rejection of independent claim 1 and its dependent claims. Independent claims 14, 27, and 34 contain similar limitations; therefore, we cannot sustain the rejection thereof along with their respective dependent claims.

With respect to independent claim 47, we note that the examiner relies upon the same rationale as used with respect to independent claim 1. Here, we note that the language of claim 47 is broader than claim 1 in that "network services" are recited rather than printing. Therefore, we do not find appellant's arguments to the presence of

a print functionality in the prior art to be distinguishing. With this said, we do not find that the examiner has addressed the limitations of this claim and therefore, the examiner has not set forth a ***prima facie*** case of obviousness in view of the applied prior art teachings, and we cannot sustain the rejection of claim 47 along with its respective dependent claims.

With respect to independent claims 41 and 52, appellant argues that these claims are similar to the other claims discussed above, except that the agent that inserts the print buttons is located at the client rather than at the proxy server, and that the examiner has not addressed this difference. (See brief at pages 20-21.) We agree with appellant that the examiner has not addressed this difference and has relied upon the combination as discussed above. Therefore, we find that the examiner has not established a ***prima facie*** case of obviousness with respect to independent claims 41 and 52, and we cannot sustain the rejection thereof along with their respective dependent claims.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-56 under 35 U.S.C. § 103(a) is reversed.

REVERSED

JAMES D. THOMAS Administrative Patent Judge	)
JOSEPH L. DIXON Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
STUART S. LEVY Administrative Patent Judge	)

jld/vsh

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