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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOUGLAS BRIAN MUELLER

Appeal No. 2002-0056
Application No. 08/868,201

ON BRIEF

Before HAIRSTON, BARRETT, and DIXON, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 13, 16, 19 and 22 through 27.

The disclosed invention relates to a method and apparatus for relating a hyper-text markup language (HTML) document to stored information that is associated with the HTML document and with a non-browser application program that is external of the browser.

Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A method for relating a hyper-text markup language (HTML) document to stored information that is associated with the HTML document and with a non-browser application program that is external of the browser, comprising the steps of:

computing the information associated with the HTML document utilizing the non-browser application program;

storing the computed information in a location accessible by an index reference;

searching the HTML document for an association tag, wherein the association tag includes the index reference;

reading the index reference;

retrieving the stored information that is associated with the HTML document and with the non-browser application program that is external of the browser utilizing the index reference; and

providing the retrieved information that is associated with the HTML document and with the non-browser application program that is external of the browser to an instance of the non-browser application program for utilization by the non-browser application program that is external of the browser to operate on the HTML document, such that the non-browser application program that is external of the browser need not recompute the stored information that is associated with the HTML document and with the non-browser application program that is external of the browser.

The references relied on by the examiner are:

Nielsen	5,659,729	Aug. 19, 1997 (filed Feb. 1, 1996)
Goldman et al. (Goldman)	5,684,951	Nov. 4, 1997 (filed Mar. 20, 1996)
Cordell et al. (Cordell)	5,893,915	Apr. 13, 1999 (filed Apr. 18, 1996)
Freivald et al. (Freivald)	5,898,836	Apr. 27, 1999 (filed Jan. 14, 1997)

Winter, "Microsoft Word 97 Quick Reference," Que, Apr. 18, 1997, pages 1 through 30.
Lemay et al. (Lemay), "JavaScript," Sams.net Publishing, (1996), pages 289 through 291.

Claims 1, 4 through 6, 8, 10, 12, 13, 16, 22, 24 and 26 stand rejected under 35 U.S.C.

§ 103(a) as being unpatentable over Nielsen in view of Winter.

Claims 2, 3, 11 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nielsen in view of Winter and Cordell.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Nielsen in view of Winter and Freivald.

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Nielsen in view of Winter and Goldman.

Claims 23, 25 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nielsen in view of Winter and Lemay.

Reference is made to the briefs (paper numbers 16 and 18) and the answer (paper number 21) for the respective positions of the appellant and the examiner.

OPINION

We have carefully considered the entire record before us, and we will reverse the obviousness rejection of claims 1 through 13, 16, 19 and 22 through 27.

Nielsen uses an anchor tag that enables a user to not only pull up the hot-linked document, but also to go to a specified portion of the hot-linked document. Nielsen explains (column 3, lines 48 through 63) that:

> Embodiments of the present invention use a new extension to the HTML language to support remotely specified named anchors. A remotely specified named anchor, when embedded within a source document, instructs a browser program to access a portion of a destination document indicated in the remotely specified named

> anchor . . . . In this way, an author of a source document can create a hot link which scrolls to an indicated portion of a destination document . . . .

In short, the user of Nielsen's system would be able to access a specified portion (e.g., the 10th Amendment) of the "THE AMERICAN CONSTITUTION" hot link (Figure 6), and to thereby avoid reviewing the whole document.

The examiner acknowledges (answer, pages 3 through 5) that Nielsen does not disclose the preamble, the first two steps and the last step of claim 1. The examiner states (answer, pages 4 and 5) that the Word 97 publication by Winter discloses that Word can read HTML file formats (page 6), can save a document as different file formats (page 8), and can take into account "designing or revising a document saved as a Web page" (page 21). The examiner concludes (answer, pages 4 and 5) that the combined teachings of Nielsen and Winter would have rendered obvious the invention set forth in claim 1.

Appellant argues (brief, page 7) that:

> . . . Nielsen relates to hyper-text links between two HTML documents and solves a specific problem of having a first document link to a specified portion of the second document rather than an entire document. Nielsen does not relate to the processing of an HTML document by a non-browser application program or the storing of information that is associated with the same HTML document and with the non-browser application program so that the application program need not recompute the stored information or obtain the stored information from a remote computer.

Appellant argues (brief, page 8) that neither Nielsen nor Winter describes or would have suggested the steps of claim 1. Appellant additionally argues (brief, page 13) that:

> In addition to the failure of the references to disclose or suggest all of the recitations of the independent claims, the references may not be properly combined.

> The rejection attempts to combine Nielsen, a reference which describes tags to relate HTML documents viewed by a browser, with Winter, a reference which describes a word processor for creating HTML documents . . . . As such, Appellant submits that the Official Action fails to make a *prima facie* case of obviousness as it has failed to provide a reasonable justification apparent from the art of record for combining the references. The proposed modification of Nielsen in view of Winter is merely the result of the impermissible use of hindsight in light of the teachings of the present invention. As such, there is no apparent motivation to combine the references to provide such an interaction and there is no indication of how the references could be combined to result in such an interaction.

We agree with appellant's arguments. The record before us does not support any of the reasons expressed by the examiner for combining the teachings of the references. The factual question of motivation should be resolved based on evidence of record, and not on the subjective belief and unknown authority expressed by the examiner. In re Lee, 277 F.3d 1338, 1343-44, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). Thus, the obviousness rejection of claims 1, 4 through 6, 8, 10, 12, 13, 16, 22, 24 and 26 is reversed because the examiner has not made a prima facie showing of obviousness.

The obviousness rejection of claims 2, 3, 7, 9, 11, 19, 23, 25 and 27 is likewise reversed because the teachings of Cordell, Freivald, Goldman and Lemay fail to cure the noted shortcomings in the teachings of Nielsen and Winter.

DECISION

The decision of the examiner rejecting claims 1 through 13, 16, 19 and 22 through 27 under 35 U.S.C. § 103(a) is reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)
LEE E. BARRETT Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
JOSEPH L. DIXON Administrative Patent Judge	)

KWH/lp

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