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EXAMINER	
Andrew Caldwell	
ART UNIT	PAPER NUMBER

2151

16

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Please find below and/or attached an Office communication concerning this application or proceeding.

10/16/2004



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AUG 16 2004

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/006,831.

PATENT NO. 5838906.

ART UNIT 2151.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(e)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(e)).

<b>Office Action in Ex Parte Reexamination</b>	Control No. 90/006,831	Patent Under Reexamination 5838906	
	Examiner Andrew Caldwell	Art Unit 2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

- a ☒ Responsive to the communication(s) filed on 11 May 2004.      b ☐ This action is made FINAL.  
c ☐ A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire 2 month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).** If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

- |   |   |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 3. <input type="checkbox"/> Interview Summary, PTO-474. |
| 2. <input type="checkbox"/> Information Disclosure Statement, PTO-1449.                 | 4. <input type="checkbox"/> _____.                      |

**Part II SUMMARY OF ACTION**

- 1a. ☒ Claims 1-10 are subject to reexamination.
- 1b. ☐ Claims \_\_\_\_\_ are not subject to reexamination.
2. ☐ Claims \_\_\_\_\_ have been canceled in the present reexamination proceeding.
3. ☐ Claims \_\_\_\_\_ are patentable and/or confirmed.
4. ☒ Claims 1-10 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ The drawings, filed on \_\_\_\_\_, are acceptable.
7. ☐ The proposed drawing correction, filed on \_\_\_\_\_, has been (7a) ☐ approved (7b) ☐ disapproved.
8. ☐ Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some\*    c) ☐ None      of the certified copies have  
1 ☐ been received.  
2 ☐ not been received.  
3 ☐ been filed in Application No. \_\_\_\_\_.  
4 ☐ been filed in reexamination Control No. \_\_\_\_\_.  
5 ☐ been received by the International Bureau in PCT application No. \_\_\_\_\_.  
\* See the attached detailed Office action for a list of the certified copies not received.
9. ☐ Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.
10. ☐ Other: \_\_\_\_\_

cc: Requester (if third party requester)

1

2

***Claim Rejections - 35 USC § 103***

3

4

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

5

6

7

8

9

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10

11

This application currently names joint inventors. In considering patentability of

12

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

13

the various claims was commonly owned at the time any inventions covered therein

14

were made absent any evidence to the contrary.

15

16

**The Prior Art as Applied to Claims 1-10:**

17

18

Berners-Lee, T., et al., Hypertext Markup Language (HTML),  
Internet Draft, IETF, pages 1-40, (June 1993).

19

20

21

Raggett, D., HTML+ (Hypertext Markup Language), (July 23, 1993).  
Hereinafter referred to as "Raggett I."

22

23

24

Raggett, D., Posting of Dave Raggett, dsr@hplb.hpl.hp.com  
to www-talk@nxoc01.cern.ch (WWW-TALK public mailing list),  
(Posted June 14, 1993). Hereinafter referred to as "Raggett II."

25

26

27

28

29

Toye, G., et al., SHARE : A Methodology and Environment for  
Collaborative Product Development, Proceedings, Second  
Workshop on Enabling Technologies: Infrastructure for  
Collaborative Enterprises, 1993, IEEE, pp. 33-47, April 22, 1993.

30

31

32

33

1           Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the  
2   admitted prior art in the '906 patent and the teachings of Berners-Lee, Raggett I,  
3   Raggett II, and Towe.

4  
5           Regarding claim 1 of the '906 patent, the admitted prior art teaches a portion of  
6   the claimed invention of claim 1 of the '906 patent, namely a method comprising:

7  
8           "providing at least one client workstation" (See USP '906: Figure 2, element  
9           130; Col. 4, Lines 32-40 which indicate that "small computer" 130 can be a  
10          client) "and one network server" (See USP '906: Figure 2, element 132)  
11          "coupled to a network environment" (See USP '906: Figure 2, element 100  
12          Internet), "wherein the network environment is a distributed hypermedia  
13          environment" (See USP '906: Col. 5 lines 24-25);

14  
15          "executing, at the client workstation, a browser application" (See USP '906: Col.  
16          3 lines 9-13), "that parses a first distributed hypermedia document to identify text  
17          formats included in the distributed hypermedia document and for responding to  
18          predetermined text formats to initiate processing specified by the text formats"  
19          (See USP '906: Col. 1, lines 1-Col. 3, line 51, with particular emphasis on  
20          Col. 2, line 63-Col. 3, line 25 showing a browser executing on client that  
21          parses and then displays a hypermedia document; where the user clicks on  
22          a link/image icon causing the browser to invoke a viewer application  
23          displaying the image in a separate window); and

24  
25          "utilizing the browser to display, on the client workstation, at least a portion of a  
26          first hypermedia document received over the network from the server, wherein  
27          the portion of the first hypermedia document is displayed within a first  
28          browser-controlled window on the client workstation." (See USP '906: Figure 1,  
29          element 10 as hypermedia document displayed on client; Col. 2 lines  
30          28-36).

31  
32          While the admitted prior art describes a method in which a hypermedia page  
33          (See USP '906: Figure 1, element 10) is displayed in a browser (See USP '906: Col.  
34          1, lines 1-Col. 3, line 51, particularly Col. 2, line 63-Col. 3, line 25), the admitted prior  
35          art does not teach, as in claim 1 of the '906 patent, the particular steps used by the  
36          browser in order to process and display the hypermedia page. To summarize, the  
37          admitted prior art does not teach a method wherein the browser application parses a  
38          first distributed hypermedia document to identify text formats included in the distributed  
39          hypermedia document and for responding to predetermined text formats to initiate  
40          processing specified by the text formats.

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1  
2 Nevertheless, Berners-Lee teaches that HTML browsers parse HTML. (See  
3 **Berners-Lee at p. 2 as printed - paragraph starting; "Implementations of ..."**) The  
4 parsing is used to identify characters interpreted as markup elements, such as the  
5 various tags (see **Berners-Lee at page 5**) in the structured text example, and to  
6 associate text with various tags. These tags correspond to the claimed "text formats."  
7 Berners-Lee also teaches that the browser processes the HTML by rendering it into a  
8 displayable form. (See **Berners-Lee at p. 3, definition of rendering**). Berners-Lee  
9 also discusses how specific markup elements are to be rendered. (See for example,  
10 **Berners-Lee at p. 14, typical rendering of address tag; p.15 typical rendering of**  
11 **block quote**). Berners-Lee therefore teaches a method in which a browser application  
12 parses a first distributed hypermedia document to identify text formats included in the  
13 distributed hypermedia document and for responding to predetermined text formats to  
14 initiate processing specified by the text formats.

15  
16 It would have been obvious to a skilled artisan to combine (1) the teachings of  
17 Berners-Lee regarding the processing of HTML documents performed by a browser,  
18 with (2) the HTML browser of the admitted prior art in light of the statement made by the  
19 admitted prior art that its hypermedia system is designed to handle hypermedia  
20 documents according the HTML markup standard. (See **USP '906: Col. 5, lines**  
21 **28-31**).

22  
23 Regarding the processing of the claimed "text formats," patentee acknowledges  
24 that the prior art teaches a method wherein a browser invokes an external viewer  
25 program to process various file formats not handled directly by the browser. (See **USP**  
26 **'906: Col. 3, lines 13-20**). Specifically, the prior art describes an example wherein the  
27 file format not handled by the browser is an image file in ".TIF" or ".GIF" format and the  
28 browser invokes an image viewer program to display the full image in a separate  
29 window. (See **USP '906: Col. 3 lines 13-20**). While the prior art teaches that certain  
30 tags may cause the browser to invoke external applications to process particular file  
31 formats, these applications do not display their data in the browser window. Therefore,  
32 the admitted prior art does not teach the portion of the method of claim 1 of the '906  
33 patent wherein:

34  
35 "Said first distributed hypermedia document includes an embed text format,  
36 located at a first location in said first distributed hypermedia document, that  
37 specifies the location of at least a portion of an object external to the first  
38 distributed hypermedia document;

39  
40 Said object has type information associated with it utilized by said browser to  
41 identify and locate an executable application external to the first distributed  
42 hypermedia document, and  
43

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1 Said embed text format is parsed by said browser to automatically invoke said  
2 executable application to execute on said client workstation in order to display  
3 said object within a display area created at said first location within the portion of  
4 said first distributed hypermedia document being displayed in said first  
5 browser-controlled window."  
6

7 However, Raggett I teaches various extensions to the HTML specification including  
8 an EMBED tag that provides a simple form of object level embedding. (See Raggett I:  
9 p. 6 "Embedded data in an external format" and p. 26 embedded.) For example,  
10 Raggett I teaches an HTML document including an EMBED tag that identifies embedded  
11 data in a foreign format. (See Raggett I: p. 6 <embed ...> and <embed> tags.) This  
12 embedded data is an object that cannot be directly processed by the browser. The  
13 foreign format data, or object, is embedded in the HTML document by placing it  
14 between the <embed ...> and </embed> tags. (See Raggett I: p. 6 "2 pi int sin  
15 (omega t)dt" as an example of embedded foreign data.) Raggett I describes the  
16 example of an embedded equation, where the browser calls a program for rendering an  
17 equation by providing ascii character information to an external program and receives a  
18 pixmap image of the equation from the external program that is then displayed in the  
19 browser window. (See Raggett I: p. 6, particularly the last ten lines.) Raggett I  
20 therefore teaches "a first distributed hypermedia document that includes an embed text:  
21 format, located at a first location in said first distributed hypermedia document," that is  
22 used to identify embedded foreign data. Raggett I also teaches that the embed tags  
23 include a type attribute specifying a registered MIME content type that is used by the  
24 browser to identify the appropriate external filter to use to render the embedded foreign  
25 data. (See Raggett I: p. 6 type="application/eqn".) Raggett I thus teaches a method  
26 wherein "the object has type information associated with it utilized by said browser to  
27 identify and locate an executable application external to the first distributed hypermedia  
28 document and wherein said embed text format is parsed by said browser to  
29 automatically invoke said executable application to execute on said client workstation in  
30 order to display said object."  
31

32 It would have been obvious to a skilled artisan to combine (1) Raggett I's teachings  
33 regarding extensions to the HTML standard (i.e., the proposed HTML+ Specification)  
34 allowing the embedding of data in foreign formats within web pages with (2) the method  
35 as taught by patentee's admitted prior art. This combination would have been obvious  
36 based on Raggett I's acknowledgment that this particular extension to HTML is  
37 advantageous and it represents a "substantial improvement." (See Raggett I: p. 1 2nd  
38 paragraph of abstract).  
39

40 The combination of patentee's admitted prior art in view of Berners-Lee and Raggett  
41 I does not explicitly teach a method wherein "the embed text format specifies the  
42 location of at least a portion of an object external to the first distributed hypermedia  
43 document." Raggett I describes a method in which the object itself is embedded in the  
44 HTML document. (See Raggett I: p. 6 embedded data in an external format - see

1 **example on the last two lines of the page where the object, the text representation**  
2 **of the equation, is within the embed tags).**

3  
4 Raggett II, though, teaches putting the foreign data in a separate file and then  
5 referencing that file by a URL in the HTML+ embed tag. **(See Raggett II: last line.)** It is  
6 thus argued that Raggett II describes a system wherein "the embed text format specifies  
7 the location of at least a portion of an object external to the first distributed hypermedia  
8 document."  
9

10 It would have been readily apparent to a skilled artisan to modify the method  
11 discussed above, combining the teachings of the admitted prior art in view of  
12 Berners-Lee and Raggett I, by further substituting a URL which references a separate  
13 file containing foreign data for the embedded foreign data within the hypermedia  
14 document of the combination. Such a further modification would have been apparent  
15 based on Raggett II's explicit suggestion to make such a substitution. **(See Raggett II:**  
16 **last line).**

17  
18 The combination of patentee's admitted prior art in view of Berners-Lee, Raggett I,  
19 and Raggett II does not explicitly teach a method that "enables interactive processing of  
20 said object." The combination teaches a method that embeds static objects, as  
21 opposed to dynamic objects, within distributed hypermedia documents.  
22

23 Toye on the other hand discloses a distributed hypermedia system in which a  
24 hypermedia browser allows a user to interactively process an object embedded within a  
25 distributed hypermedia document **(See Toye: p. 40 description of NoteMail,**  
26 **particularly p. 40, col. 2, first complete paragraph).**

27  
28 It would have been readily apparent to a skilled artisan to modify the method  
29 discussed above, combining the teachings of the admitted prior art in view of  
30 Berners-Lee, Raggett I, and Raggett II, by further modifying the combination's static  
31 embedded object to be a dynamic embedded object as taught by Toye. Such a further  
32 modification would have been apparent based on Toye's teaching that its architecture  
33 provides openness and flexibility **(See Toye: p. 40 col. 2 second complete**  
34 **paragraph).**

35  
36 Regarding claim 2 of the '906 patent, Toye teaches a method wherein "said  
37 executable application is a controllable application" and the method further comprises  
38 the step of "interactively controlling said controllable application on said client  
39 workstation via interprocess communications between said browser and said  
40 controllable application." **(See Toye: p. 40, col. 2 first complete paragraph**  
41 **describing editing or updating data without leaving the notebook environment).**

42  
43 Regarding claim 3 of the '906 patent, the combination of patentee's admitted prior  
44 art in view of Berners-Lee, Raggett I, and Raggett II, and Toye teaches the invention



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1 substantially as claimed. (See the rejection of claim 2, above.) However, the  
2 combination of the patentee's prior art in view of Berners-Lee, Raggett I, Raggett II, and  
3 Toye does not explicitly teach the additional limitation of claim 3. Nevertheless, Toye  
4 teaches that selecting the displayed data within a page will restart the original  
5 application so that data can be edited or updated without leaving the notebook  
6 environment. (**See Toye: p. 40, col. 2 first complete paragraph**). The term editing  
7 suggests a continued and interactive process controlled by the browser user. Toye  
8 teaches that this editing occurs without leaving the notebook environment. (**See Toye:**  
9 **p. 40, col. 2 first complete paragraph**). A skilled artisan would therefore reasonably  
10 infer that the combination of the admitted prior art in view of Berners-Lee, Raggett I,  
11 Raggett II, and Toye teaches a method wherein "communications to interactively control  
12 said controllable application continue to be exchanged between the controllable  
13 application" (i.e., Toye's "appropriate application") and the browser even after the  
14 controllable application program has been launched.

15  
16 Regarding claim 4, the combination of the admitted prior art in view of Berners-Lee,  
17 Raggett I, Raggett II, and Toye teaches the invention substantially as claimed. (See the  
18 rejection of claim 3, above.) The combination also describes a method wherein  
19 additional instructions for controlling said controllable application reside on a network  
20 server (**See Toye: p. 40 col. 2 first complete paragraph describing how the needed**  
21 **application, if not locally resident, will be run remotely over the network; where**  
22 **the computer remotely executing the needed application is the network server**).  
23 As to the remaining steps introduced in the claim, these steps all flow logically from the  
24 movement of the controllable application from the client workstation to a network server.  
25 The step of issuing, from the client workstation, one or more commands to the network  
26 server flows logically from the fact that user editing commands entered at the browser  
27 computer must be transmitted from the client workstation to the controllable application  
28 executing on the remote machine. The step of executing, on the network server, one or  
29 more instructions in response to the commands is taught by the controllable application  
30 executing on the remote machine. The step of sending information from said network  
31 server to said client workstation in response to said executed instructions is taught by  
32 the controllable application returning a result of the editing process to the client  
33 workstation. The step of processing said information at the client workstation to  
34 interactively control said controllable application is taught by the client workstation  
35 rendering the result of the edit in the browser window, thus allowing the user to see the  
36 results of the editing operation so the user can decide what editing operation to perform  
37 next.

38  
39 Regarding claim 5, the combination of the admitted prior art in view of Berners-Lee,  
40 Raggett I, Raggett II, and Toye teaches that the results returned by the controllable  
41 application residing on the network server are displayed in the browser window. The  
42 instructions performing this function are additional instructions for controlling said  
43 controllable application reside on said client workstation.

44

1 Regarding claims 6-10 of the '906 patent, they are computer program product claims  
2 corresponding to method claims 1-5, respectively. Since they do not teach or define  
3 above the information in the corresponding method claims, the discussion and  
4 application, supra, of the admitted prior art in combination with Berners-Lee, Raggett I,  
5 Raggett II, and Toye to method claims 1-5 is applied to claims 6-10, respectively.

6  
7  
8

***Response to Arguments***

9 As to the rejection of the claims under 35 U.S.C. 103(a), the patentee's  
10 arguments filed on May 11, 2004 (paper no. 14) have been fully considered.

11 As to Part I of the traverse (pages 10-15 of the response), the patentee argues  
12 that the specific examples of embedded objects in Raggett I and II are static and that  
13 the external applications (e.g., TeX and eqn) that render those objects only return a  
14 single static image to the browser (Response filed May 11, 2004, p. 12 first four  
15 complete paragraphs after item b; Felten paragraphs 36-41). This argument as been  
16 fully considered and is deemed persuasive. Therefore, the rejection has been  
17 withdrawn. However, upon further consideration, a new ground(s) of rejection is made  
18 in view of the admitted prior art in the '906 patent and the teachings of Berners-Lee,  
19 Raggett I, Raggett II, and Toye.

20 As to Part II of the traverse (pages 15-16 of the response), the patentee's  
21 arguments have been considered but are not deemed persuasive. The patentee argues  
22 that the Examiner has used impermissible hindsight by using the '906 patent as a  
23 roadmap to modify the teachings of the references. In response to applicant's argument  
24 that the examiner's conclusion of obviousness is based upon improper hindsight  
25 reasoning, it must be recognized that any judgment on obviousness is in a sense  
26 necessarily a reconstruction based upon hindsight reasoning. But so long as it takes

1 into account only knowledge which was within the level of ordinary skill at the time the  
2 claimed invention was made, and does not include knowledge gleaned only from the  
3 applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d  
4 1392, 170 USPQ 209 (CCPA 1971). In this case, the rejection is based solely upon the  
5 teachings of the references and the admitted prior art and, therefore, is not based on  
6 improper hindsight.

7 As to Part III of the traverse (pages 16-17 of the response), the patentee's  
8 arguments have been considered but are not deemed persuasive. The patentee argues  
9 that secondary evidence supports the conclusion of nonobviousness and cites  
10 evidence in the Doyle declaration showing professional approval, in the Felten  
11 declaration showing the failure of others to follow Raggett I and II to implement the  
12 claimed technology, and in the Krueger declaration.

13 As to the Doyle declaration, the patentee argues that the declaration shows  
14 evidence of favorable reactions by experts that supports a conclusion of  
15 nonobviousness. Although the Doyle declaration describes the reaction of various  
16 audiences and experts as favorable, the declaration usually states these reactions were  
17 favorable without explaining what the reactions were and the reason they were  
18 favorable (Doyle items 3 and 6-10). There are many possible explanations for the  
19 favorable reactions. For example, the favorable reactions may have been due to the  
20 failure to conceive the possibility of interactive embedded objects displayed within a  
21 browser window of hypermedia system. The favorable reactions may have been due to  
22 the inability to figure out how to reduce to practice a preexisting conception of

1 interactive embedded objects displayed within a browser window of hypermedia system.  
2 Or, the favorable reactions may have been due to the inventors' allocation of resources  
3 to implement an obvious function that the WWW community had so far been unable to  
4 devote resources to implementing. This latter interpretation of the favorable reactions is  
5 consistent with Raggett's testimony that the group working on the HTML+ Specification  
6 felt that there were higher priorities (Raggett – cross, p. 1884 lines 18-24). System  
7 design is often incremental, and designers, having limited resources, must prioritize  
8 which functions to implement first. In such a situation, just because an improvement is  
9 innovative, in the sense of never having been implemented, does not mean that the  
10 improvement is nonobvious. After considering the declaration's lack of specificity, the  
11 declarant's obvious bias in favor of confirming the claims subject to reexamination, and  
12 the other possible explanations for the favorable reactions, the Examiner concludes that  
13 these facts have little probative value as to whether the technology of the '906-  
14 enhanced Web browser was novel and nonobvious.

15 In items 4-5 of the Doyle declaration, the reaction of various unnamed Silicon  
16 Graphics Corporation employees is characterized as "very enthusiasitic about the  
17 *innovative* character" of the '906-enhanced Web browser technology (Doyle – p. 2 item  
18 4 "SIGWEB") and is said to have resulted in an invitation to demonstrate the '906-  
19 enhanced Web browser technology (Doyle – p. 2 item 5 "Silicon Graphics"). The  
20 description of the reaction of the unnamed Silicon Graphics employees differs from the  
21 reactions to the other demonstrations discussed above because a specific reaction is  
22 described. However, the declaration fails to recite particular facts establishing how the

1 declarant established personal knowledge of these employees' states of mind. As to  
2 this fact, the declaration is therefore given no weight because the declaration fails to  
3 establish facts showing how the declarant's established personal knowledge of the  
4 unnamed Silicon Graphics employees' states of mind. Furthermore, even if this portion  
5 of the declaration should be given weight, the facts have little probative value. The  
6 declaration fails to identify particular individuals who believed the '906-enhanced Web  
7 browser technology to be innovative. When the declaration does name a particular  
8 employee of Silicon Graphics, by stating that John Flynn invited the declarant to give an  
9 on-site demonstration of the '906-enhanced Web browser technology, the declaration is  
10 carefully worded to not include John Flynn in the group of unnamed Silicon Graphics  
11 employees who believed the '906-enhanced Web browser technology to be innovative.  
12 Given this lack of specificity and the declarant's obvious bias in favor of confirming the  
13 claims subject to reexamination, the Examiner concludes that these facts have little  
14 probative value as to whether the technology of the '906-enhanced Web browser was  
15 novel and nonobvious.

16 As to the Doyle declaration, the declaration states in item 10 at page 3 that Dr.  
17 Scott Baldwin spent several months trying to recruit Dr. Doyle to join the University of  
18 Pennsylvania faculty as a result of a demonstration of the '906-enhanced Web browser.  
19 The declaration is unclear as to whether this job offer was a result of the '906-enhanced  
20 Web browser or the personal attributes of Dr. Doyle himself. Having met Dr. Doyle in  
21 the interview on April 27, 2004, the Examiner concludes it is equally possible that Dr.

1 Baldwin would have attempted to recruit Dr. Doyle even if Dr. Baldwin thought the '906-  
2 enhanced Web browser was not a patentable improvement over the prior art.

3 As to the Doyle declaration, the patentee argues that the invitation to write a  
4 cover article for Dr. Dobbs Journal is evidence of a favorable reaction that supports a  
5 conclusion of nonobviousness. The declaration describes how the inventors of the '906  
6 patent were invited to submit an article about their "innovative 906-based browser  
7 technology" (Doyle p. 3 item 11). It is unclear from the declaration who believed the  
8 '906-based browser to be innovative. On the one hand, the editor of Dr. Dobbs Journal  
9 may have considered the '906-based browser to be innovative and therefore extended  
10 an invitation to submit an article. Or, the editor of Dr. Dobbs Journal may have invited  
11 an article about the 906-based browser without expressing any opinion as to whether it  
12 was innovative. There is nothing in the cited portions of Dr. Dobbs Journal indicating  
13 the reason why the article was published. The declaration's description of the '906-  
14 based browser as innovative may merely be the opinion of the declarant. After  
15 considering the declaration's lack of specificity and the declarant's obvious bias in favor  
16 of confirming the claims subject to reexamination, the Examiner concludes that this  
17 portion of the declaration has little probative value as to whether the technology of the  
18 '906-enhanced Web browser was novel and nonobvious.

19 As to the Felten declaration, the patentee argues that it shows the failure of  
20 others to follow Raggett I and II to implement the combination used in the rejection and  
21 is therefore objective evidence supporting the conclusion of nonobviousness (Felten,  
22 paragraphs 45, 63). Assuming without conceding that Dr. Felten's knowledge of the

1 hypermedia art is complete, the failure of others to implement Raggett I and II's  
2 proposed embed tag is not necessarily evidence that the combination is nonobvious. In  
3 a standards-based technology, like the World Wide Web, there are economic and  
4 practical reasons for conforming to standards. The standards process is driven by  
5 consensus and the practical constraints on what is feasible to implement given limited  
6 resources (Raggett – cross, p. 1884 lines 18-24 indicating that the group working on  
7 the HTML+ Specification felt that there were higher priorities). The standards process  
8 restricts future systems complying with the standard because new features must be  
9 incorporated into the standard. Stotts, P., et al., Hyperdocuments as Automata: Trace-  
10 based Browsing Property Verification, UNC CS Technical Report, TR92-038,  
11 [citeseer.ist.psu.edu/stotts92hyperdocument.html](http://citeseer.ist.psu.edu/stotts92hyperdocument.html), p. 1, 1992. The failure of others to  
12 implement Raggett I and II's proposed embed tag could therefore have been due to the  
13 desire to implement systems conforming with the standard as opposed to any technical  
14 limitation. The declaration ignores the fact that the World Wide Web is standards driven  
15 and fails to provide any evidence that the failure to implement the combination is due to  
16 technical reasons as opposed to the economic and practical reasons for conforming to  
17 the standard. These portions of the declaration therefore have little probative value as  
18 to whether the technology of the '906-enhanced Web browser was novel and  
19 nonobvious.

20 The response also argues that secondary evidence of nonobviousness is the fact  
21 that the author of Raggett I and II never contemplated the functionality described in  
22 claims one and six and points to a particular portion of the trial testimony of Mr. Raggett

1 (response p. 17 after "FURTHER RECROSS EXAMINATION BY MR.  
2 BAUMGARTNER"). This testimony must be considered in view of the totality of Mr.  
3 Raggett's testimony that is presented in Appendix A to the Kreuger declaration. Mr.  
4 Raggett's testimony indicates that not all ideas in the HTML+ Specification were his  
5 (Raggett – direct, p. 1806 lines 12-13, p. 1809 lines 5-8, p. 1867 line 22 to p. 1868 line  
6 11). Mr. Raggett's statement that *he* did not envision the functionality of Netscape  
7 plugins developing the HTML+ Specification appears to be an attempt to not claim credit  
8 for someone else's ideas. The fact that Mr. Raggett was unwilling to take credit for an  
9 idea that he did not believe was his has no probative value to the question of whether  
10 the claimed invention is obviousness.

11 The patentee also argues that it is secondary evidence of nonobviousness that  
12 the embed tag proposed in Raggett I and II was abandoned for technical reasons  
13 (response p. 17 – 2<sup>nd</sup> complete paragraph after Raggett's testimony). In reviewing  
14 Raggett's testimony, the technical reason for not pursuing the functionality of the  
15 HTML+ Specification's embed tag in version 2.0 of the HTML Specification was security  
16 (Raggett direct – p. 1867 lines 5-15). The fact that the group working on the HTML+  
17 Specification was uncertain as to how to securely implement embedded objects has  
18 little probative value to the question of whether an insecure system, like the one  
19 described in the '906 patent, is obvious.

20 The patentee also argues that it is secondary evidence of nonobviousness that  
21 that the author of Raggett I and II never pointed to the HTML+ Specification as relevant  
22 prior art when editing the W3C working draft "Inserting Objects into HTML," which was



1 published a few years after the HTML+ Specification. In essence, the patentee is  
2 arguing that it is evidence of nonobviousness that Mr. Raggett failed to describe his own  
3 work. When characterizing the working draft, the patentee argues that the working draft  
4 says that "developers have been experimenting with *new* ideas for dealing with new  
5 media." In examining the copy of the working draft provided by the patentee, the  
6 Examiner fails to see where the ideas are described as new. The working draft only  
7 says that "developers have been experimenting with ideas for dealing with new media."  
8 The working draft is not, as suggested by the patentee's argument, an assertion by Mr.  
9 Raggett that the idea of an HTML document containing active embedded objects is  
10 new. Furthermore, Raggett's testimony indicates that the working draft was an attempt  
11 to generate consensus between companies on a standard way of embedding objects in  
12 web pages (Raggett redirect p. 1894 lines 7-21). Since the purpose of the working draft  
13 was to reconcile the approach of the major players (i.e., Sun, Microsoft, and Netscape),  
14 it has little probative value to the question of obviousness that the working draft only  
15 discusses the solutions of Microsoft, Sun and Netscape and fails to exhaustively list all  
16 possible solutions.

17 In view of the foregoing, when all of the evidence is considered, including the  
18 evidence cited in the new grounds of rejection, the totality of the rebuttal evidence of  
19 nonobviousness fails to outweigh the evidence of obviousness.

20 As to the patentee's arguments with respect to the dependent claims (pages 17-  
21 19 of the response), they have been fully considered but are moot in view of the  
22 new grounds of rejection.

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**Conclusion**

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The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a), to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 5,838,906 throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

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In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents must be submitted in response to this Office action. Submissions after the next Office action, which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116, which will be strictly enforced.

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A shortened statutory period for response to this action is set to expire two months from the mailing date of this action.

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**Extensions of time under 37 CFR 1.136(a) do not apply in reexamination proceedings.** The provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Further, in 35 U.S.C. 305 and in 37 CFR 1.550(a), it is required that reexamination proceedings "will be conducted with special dispatch within the Office."

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**Extensions of time in reexamination proceedings are provided for in 37 CFR 1.550(c).** A request for extension of time must be filed on or before the day on

1 which a response to this action is due. The mere filing of a request will not effect any  
2 extension of time. An extension of time will be granted only for sufficient cause, and for  
3 a reasonable time specified.

4 Any inquiry concerning this communication or earlier communications from the  
5 examiner should be directed to Andrew Caldwell, whose telephone number is (703)  
6 306-3036. The examiner can normally be reached on M-F from 9:00 a.m. to 5:30 p.m.  
7 EST.

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9 Any inquiry of a general nature or relating to the status of this application should  
10 be directed to the Group receptionist at (703) 305-9600.

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17 Andrew Caldwell  
18 703-306-3036  
19 August 15, 2004

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<b>Notice of References Cited</b>	Application/Control No. 90/006,831	Applicant(s)/Patent Under Reexamination 5838906	
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**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-			
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
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	K	US-			
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**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
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	O					
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	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	Toye, G., et al., SHARE : A Methodology and Environment for Collaborative Product Development, Proceedings, Second Workshop on Enabling Technologies: Infrastructure for Collaborative Enterprises, 1993, IEEE, pp. 33-47, April 22, 1993.
	V	Lin, J., MediaMosaic - A Multimedia Editing Environment, Proc. of the 5 <sup>th</sup> Annual ACM Symposium on User Interface Software and Technology, ACM Press, pp. 135-141, 1992.
	W	Halasz, F., Reflections on NoteCards: Seven Issues for the Next Generation of Hypermedia Systems, ACM Journal on Computer Documentation, vol. 25, no. 3, pp. 71-87, August 2001, reprinting article published in 1988.
	X	Felner, S., et al., An Experimental System for Creating and Presenting Interactive Graphical Documents, ACM Transactions on Graphics, vol.1, no. 1, pp. 59-77, January 1982.

\*A copy of this reference is not being furnished with this Office action (See MPEP § 707 05(a) )  
 Dates in MM-YYYY format are publication dates. Classifications may be US or foreign

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	Q					
	R					
	S					
	T					

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*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	Engelbart, D., Knowledge-Domain Interoperability and an Open Hyperdocument System, Proc. of the 1990 ACM Conference on Computer-Supported Cooperative Work, ACM Press, pp. 143-156, 1990.
	V	Meyrowitz, N., Intermedia: The Architecture and Construction of an Object-Oriented Hypermedia System and Applications Framework, Proc. of the Conf. on Object Oriented Programming Systems, Languages, and Applications, ACM Press, pp. 186-201, 1986.
	W	Will, U., Issues in the Design of EHTS: A Multuser Hypertext System for Collaboration, Proc. of the 25 <sup>th</sup> Hawaii Int'l. Conf. on Systems Sciences, vol. 2, pp. 629-639, January 1992.
	X	Celentano, A., et al., A Multiple Presentation Document Management System, Proc. of the 10th Annual Int'l. Conf. on Systems Documentation, ACM Press, pp. 63-71, 1992.

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a) )  
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	N					
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	P					
	Q					
	R					
	S					
	T					

## NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	Garg, P., et al., A Hypertext System to Manage Life Cycle Documents, Proc. of the 25th Annual Hawaii Int'l. Conf. on System Sciences, 1988, IEEE, vol. 2, pp. 337-346, January 1988.
	V	Kahn, P., Webs, Rees, and Stacks: How Hypermedia System Design Effect Hypermedia Content, Designing and Using Human-Computer Interfaces and Knowledge Based Systems, Elsevier Science Publishers, pp. 443-449, 1989.
	W	Strelitz, N., et al., Hypertest: Concepts, Systems, and Applications, Cambridge Univ. Press, pp. 1-12, 356-359, 367-369, 1990.
	X	Stotts, P., et al., Hyperdocuments as Automata: Trace-based Browsing Property Verification, UNC CS Technical Report, TR92-038, citeseer.ist.psu.edu/stotts92hyperdocument.html, p. 1, 1992.

A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
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U.S. Patent and Trademark Office  
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  - Attachment - PTO Form-1449 (10/30/2003)
  - Attachment - References (10/30/2003)
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8. Second Notification of Court Proceedings (01/30/2004)
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  - Attachment - References (02/26/2004)
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11. Notification of Prior Art Citation (03/26/2004)
12. Interview Summary(Request) (04/22/2004)
13. Letter Interview Summary (04/27/2004)
14. Letter Response (05/11/2004)
15. Letter Affidavits (05/11/2004)
  - Attachment - Declarations (05/11/2004)
16. RXR.NF (08/16/2004)
  - Attachment - 892 (08/16/2004)