UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/432,070	05/11/2006	Richard E. Nesbitt	END920050172US1	8625

30449 7590 02/04/2013
SCHMEISER, OLSEN & WATTS
22 CENTURY HILL DRIVE
SUITE 302
LATHAM, NY 12110

EXAMINER
GEORGANDELLIS, ANDREW C

ART UNIT	PAPER NUMBER
2453	

MAIL DATE	DELIVERY MODE
02/04/2013	PAPER

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

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RICHARD E. NESBITT, BRIAN M. O'CONNELL,
HERBERT D. PEARTHREE, and KEVIN E. VAUGHAN

Appeal 2010-009761
Application 11/432,070
Technology Center 2400

Before ALLEN R. MacDONALD, GEORGIANNA W. BRADEN and MIRIAM L. QUINN, *Administrative Patent Judges*.

QUINN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) (2002) from a final rejection of claims 1-3, 5, 7-9, 11, 12, 14-16, and 20. We have jurisdiction under 35 U.S.C. § 6(b). Claims 4, 6, 10, 13, 17-19 have been cancelled.

We AFFIRM-IN-PART and enter a NEW GROUNDS OF REJECTION UNDER 37 C.F.R. § 41.50(b).

STATEMENT OF THE CASE

Appellants' Invention

According to Appellants, the invention relates to a method, system and computer program product for collecting web metric data over a computer network without substantially increasing the load time for a web page. (Spec. 1, ll. 5-7.)

Representative Claim

Independent claim 1 is representative and reads as follows:

> 1. A method of collecting web usage data over a computer network, said method comprising the steps of:
>
> inserting a script at the top of each web page of a plurality of web pages to be metered, wherein said script identifies a list of metric servers to be contacted in a priority order for recording web usage data collected, and wherein said inserting said script step consists essentially of inserting said script at the beginning of said each web page of said plurality of web pages to be metered;
>
> sending a web page request over a computer network to a web server for a web page of said plurality of web pages;
>
> loading said web page while executing said script inserted within said web page for collecting said web usage data without substantially increasing load time for said web page;
>
> establishing an asynchronous connection to a first metric server listed in said list of metric servers according to said priority order provided in said script for sending a record request for recording said web

usage data collected for said web page after said web page is loaded; and

transmitting, upon establishment of said asynchronous connection to said first metric server, said web usage data as part of said record request using a method such that said record request is not cached at an intermediate proxy.

References

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Allard	US 6,018,619	Jan. 25, 2000
Mankude	US 6,223,231 B1	Apr. 24, 2001
Russell	US 2002/0099818 A1	Jul. 25, 2002
Jorgenson	US 6,813,635 B1	Nov. 2, 2004

Rejections[1]

Claims 1, 2, 3, 5, 9, 11, 12, 15, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Russell in view of Mankude. (Ans. 4-8.)

Claims 7, 8, 14, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Russell, Mankude, and Jorgenson, as applied to claim 6, and in further view of Allard. (Ans. 8-9.)

[1] The Examiner's Answer includes a rejection of claims 15-20 under 35 U.S.C. § 101 for being directed to non-statutory subject matter. (Ans. 3.) We note, however, that this rejection was deemed overcome in the Advisory Action mailed 6/10/2009, and, therefore, we treat it as having been withdrawn.

ISSUES

Based on Appellants' arguments, and emphasizing the disputed claim language as provided in Appellants' Brief, the dispositive issues on appeal are:

(1) Whether Russell teaches or suggests "establishing an asynchronous connection to a first metric server . . . **after** said web page is loaded," as recited in claim 1 (Br. 13-15);

(2) Whether Russell in view of Mankude teaches or suggests the limitation "**said script including a list of available metric server machines** to be contacted in a priority order for recording web metric data collected," as recited in claim 15 (Br. 30-32);

(3) Whether Russell in view of Mankude teaches or suggests "second program instructions to **execute said script for collecting said web metric data associated with a web page of said plurality of web pages being loaded** without substantially increasing load time for said web page," as recited in claim 15 (Br. 32-33);

(4) Whether Russell in view of Mankude teaches or suggests "using a method such that **said request is not cached at an intermediate proxy**," as recited in claim 15 (Br. 33-34); and

(5) Whether the Examiner has erred in rejecting claims 7, 8, 14, and 20 under 25 U.S.C. § 103(a) as being unpatentable over Russell, Mankude, and Jorgenson, as applied to claim 6, and in further view of Allard. In particular, the substantive issue turns on whether the disclosure in Allard that "the client will . . . send or ***post*** (via HTTP) the session usage log" meets the claimed "POST method." (Br. 36-40 (emphasis added).)

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants' contentions that the Examiner has erred. Further, we have reviewed the Examiner's response to Appellants' arguments.

Issue 1

We first address the limitation of "establishing an asynchronous connection to a first metric server . . . for recording said web usage data collected for said web page after said web page is loaded," as recited in claim 1. We note that independent claim 9 recites a similar limitation, but independent claim 15 does not. In the Final Rejection, and for the first time, the Examiner finds that Russell, although teaching the establishment of an asynchronous connection for purposes of transmitting collected data, does not "explicitly indicate when the asynchronous connection is established." (Final Rej. 4.) The Examiner determined, nevertheless, that one of ordinary skill in the art would have been "motivated at the time of the invention to try establishing Russell's asynchronous connection before, during, and after the web page has loaded because doing so would have been easy to try, i.e., there are only three permutations." (Final Rej. 4, 8.) Appellants challenge that determination arguing that the Examiner is unable to show evidence of knowledge in the prior art of establishing the asynchronous connection to a first metric server *after* the web page is loaded. (Br. 13-15.) The Examiner responds that Appellants failed to traverse the Examiner's official notice in accordance with MPEP § 2144.03. (Ans. 13.) And, therefore, the limitation of "establishing an asynchronous connection to a first metric server . . . after

said web page is loaded," is deemed admitted prior art. (*Id*.) We do not agree with the Examiner.

While an Examiner's notice of a fact being common knowledge or well known in the art must be adequately traversed per MPEP § 2144.03, that traverse is required in the *next reply* to the Office action in which the common knowledge finding was made. MPEP § 2144.03. In this case, the Examiner first made that finding in the Final Rejection. The first response thereto being Appellants' Appeal Brief, which traverses the Examiner's finding by demanding authority evidencing the existence in the prior art of the fact. (Br. 13-15.) Though in this case Appellants filed an Amendment After Final to narrow the issues on appeal, that amendment is not a response of right. *See* 37 C.F.R. § 1.113(c) (limiting a reply to a final rejection of unallowed claims to cancellation of the rejected claims or appeal from the rejection of those claims); 37 C.F.R. § 1.116 (allowing amendment of claims and/or admission of evidence after final rejection and before appeal in limited circumstances).

Therefore, we find that Appellants traversed the Examiner's notice in their Appeal Brief and that the Examiner erred in failing to adequately respond to that traverse. Accordingly, we do not sustain the rejection of claim 1 under 35 U.S.C. § 103(a) over Russell, in view of Mankude. We also do not sustain the rejection of independent claim 9 based on the analysis above, because that claim recites language similar to claim 1 and Appellants challenge the Examiner's rejection on the same grounds (Br. 24-25).

Issue 2

We now turn to issues affecting independent claim 15, the first of which deals with the following claim language: "insert[ing] a script at the top of each web page . . . said script including a list of available metric server machines." (Br. 30.) Acknowledging that Mankude discloses that primary and secondary servers are in a priority order for processing an I/O request, Appellants, however, contend that Mankude does not disclose *a list of servers* that includes the primary and secondary servers. (Br. 31 (emphasis added).) Appellants further contend that the Examiner failed to provide a reason for determining it would have been obvious for an ordinarily skilled artisan to identify the list of servers in the script that is inserted at the top of a web page. (Br. 31-32.) We do not agree with Appellants' conclusions.

As to the first contention, the Examiner construed the claim term "list" according to the broadest reasonable interpretation consistent with the specification. (Ans. 9-10.) Under that interpretation, the Examiner finds that Mankude's disclosure – of a primary server to be contacted first and a secondary server to be contacted in the event of failure to contact the primary server – meets the claimed "list of servers." (Ans. 9-10.) We find no error in the Examiner's analysis concerning Mankude's disclosure of a *list of servers*.

As to the second contention, we find the Examiner provided a reasonable rationale for determining that a person of ordinary skill in the art would modify Russell's system so that the script identifies the list of servers taught in Mankude. (Ans. 5.) According to the Examiner, allowing Russell to record collected data at a secondary server, even if the primary server

fails, adds failover capabilities to Russell's system. (*Id*.) We find that the Examiner's stated reasoning is reasonable. And we find unpersuasive Appellants' argument that Russell need not be informed of the list of servers using a script because "Russell merely has to be informed ***in any manner***." (Br. 23.) That argument does not show error in the Examiner's finding, such as by stating why one of ordinary skill in the art at the time of the invention, motivated to provide a failover feature in Russell, *would not* be capable of providing that list of servers in the script disclosed in Russell. *See DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1368 (Fed. Cir. 2006) ("[T]he proper question is whether the ordinary artisan possesses knowledge and skills rendering him *capable* of combining the prior art references.").

Accordingly, we find that the disclosure of Russell in view of Mankude, as relied on by the Examiner, discloses the limitation of "insert[ing] a script at the top of each web page . . . said script including a list of available metric server machines," as recited in claim 15. We also find that claim 16, dependent on claim 15, is argued by Appellants on the basis of the "existence of the list of available metric server machines provided in the script" (Br. 35), as discussed above. Therefore, we reach the same conclusion with regard to that claim.

Issue 3

Next we decide the issue concerning the claimed limitation of "second program instructions **to execute said script for collecting said web metric data associated with a web page of said plurality of web pages being loaded**," as recited in claim 15. (Br. 32.) Appellants agree that Russell "impliedly discloses executing the script in a manner that does not delay

delivery of the web page to the end user." (Br. 33.) Appellants contend, however, that (a) non-delay of delivery of the web page to the user is accomplished if the script is executed *after* the web page is loaded; and (b) non-delay of delivery of the web page to the end user *is not guaranteed* to be accomplished if the script is executed *while* the web page is loaded. (*Id.* (emphasis added).) We do not agree with Appellants' conclusions.

First, we agree with the Examiner's conclusion that Russell teaches "that the script is executing while the page is loaded." (Ans. 12.) The Examiner supports that conclusion with the following findings:

(1) Russell discloses that a Javascript code for collecting performance metrics is appended to the web page code or is included in annotation "towards the beginning of the HTML document." (Ans. 11-12.)

(2) Russell discloses the collection of the "render latency" metric (which measures the amount of time it takes to load the page from start to finish). (Ans. 12.)

(3) Russell's metrics "can only be collected if the script is executing while the page is loading, while other metrics such as 'dwell time' only require that the script be executing once the page has loaded." (Ans. 12.)

The Examiner points to Table 1, and paragraphs 47-49, 55, and 76 in Russell to support these findings. (Ans. 11-12.) We find the disclosure in Russell supports the Examiner's findings and conclusion that the limitation at issue is met by Russell.

With regard to Appellants' contentions, we agree with the Examiner's response as stated in the Answer, and adopt it as our own. (Ans. 12.) We

also note that paragraph 24 of Russell, pointed out by Appellants as supporting their contentions, teaches to not execute the script *before* loading the web page, but does not teach that the script must be executed *after* loading the web page, as Appellants argue. (Br. 33; Russell [0024].)

In conclusion, we find the disclosure of Russell as relied on by the Examiner teaches or suggests the limitation of a "second program instructions to execute said script for collecting said web metric data associated with a web page of said plurality of web pages being loaded without substantially increasing load time for said web page," as recited in claim 15.

Issue 4

We now turn to the final issue affecting claim 15, the issue concerning the limitation that "**said request is not cached at an intermediate proxy**," a negative limitation. (Br. 33-34.) Appellants contend that Russell does not disclose, explicitly or inherently, the negative limitation, at least in part "because there is no disclosure in Russell that negates the possibility of having the record request cached at an intermediate proxy." (Br. 34.) Appellants also contend the Examiner's rationale improperly focuses on "caching the metric data at an intermediate proxy" and not on the negative limitation as claimed. (*Id.*) We find Appellants' arguments in support of these contentions unpersuasive and do not agree with Appellants' conclusions. Instead, we agree with the Examiner's comprehensive findings and conclusions in response to the Appellants' arguments and adopt said response as our own. (Ans. 14-16.)

Issue 5

The Examiner rejects claims 7, 8, 14, and 20 under 35 U.S.C. § 103(a) over a combination of Russell, Mankude, and Jorgenson, as applied to claim 6, and in further view of Allard. (Ans. 8-9.) Appellants present two arguments concerning the alleged Examiner error in that rejection. As for the substance of the rejection, Appellants contend that Allard does not disclose a method for a record request as claimed. (Br. 37-40.) As for the form of the rejection, Appellants contend that claim 6 has been cancelled, and that the rejection is, therefore, improper. (Br. 36-40.)

Concerning the first argument, we focus on whether the substance of the rejection is proper with respect to claim 20, which depends on claim 16. Appellants argue that, although Allard discloses that the client sends or *posts* (via HTTP) the session usage log, Allard does not disclose the claimed "POST method." (Br. 40 (emphasis added).) The Examiner finds that Allard teaches "utilizing POST to record a session log to a server, which is identical to Appellants' use of POST to record metric data to a server." (Ans. 20.) Appellants quibble over the grammatical effect of the description in Allard, but fail to show that the Examiner's finding is in error. The passage in Allard on which the Examiner relies expressly teaches the use of the HTTP protocol to "post" a session usage log. (Ans. 20 (citing Allard, col. 12, ll. 38-42).) The Examiner's conclusion is further supported by Allard, col. 6, ll. 43-45, which states that "a usage tracking data object is sent by the client to the designated usage tracking server by means of an HTTP 'post' operation." Accordingly, we are not persuaded by Appellants' argument that the Examiner erred in finding that Allard teaches the use of the claimed POST method.

Turning to the argument concerning the form of the rejection, we agree with Appellants that the rejection of claim 20 is improperly stated. (Br. 39.) We also note that the rejection is improper because, as pointed out by the Examiner, the prior art cited as the basis for that rejection is incorrectly stated. (Ans. 19.) Therefore, exercising our authority under 35 C.F.R. § 41.50(b), we make the following new grounds of rejection of claim 20 to correct the statement of the Examiner's rejection:

Claim 20 is rejected as being unpatentable under 35 U.S.C. § 103(a) over Russell in view of Mankude, and in further view of Allard.

CONCLUSIONS

On the record before us, we conclude that the Examiner erred in rejecting independent claims 1 and 9 under 35 U.S.C. § 103(a) over Russell in view of Mankude. Therefore, we do not sustain the rejection of independent claims 1 and 9, as well as dependent claims 2, 3, 5, 7, 8, 11, 12, and 14.

Further, we find that the Examiner did not err in rejecting independent claim 15, and dependent claim 16 under 35 U.S.C. § 103(a) over Russell in view of Mankude. Therefore, we sustain the rejection of claims 15 and 16.

Concerning dependent claim 20, although we agree with the Examiner's analysis on the substance of the rejection, we correct the form of the rejection and state a new grounds of rejection under 35 U.S.C. § 103(a) over Russell in view of Mankude, and in further view of Allard, using our authority under 37 C.F.R. § 41.50(b).

DECISION

We reverse the rejection of claims 1-3, 5, 7, 8, 9, 11, 12, and 14 under 35 U.S.C. § 103(a) over Russell in view of Mankude.

We affirm the rejection of claims 15 and 16 under 35 U.S.C. § 103(a) over Russell in view of Mankude.

In a new ground of rejection, we reject claim 20 as being unpatentable under 35 U.S.C. § 103(a) over Russell in view of Mankude, and in further view of Allard.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (2010). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
>
> (2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2011).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

tj