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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRETT M. ERROR, CHRISTOPHER REID ERROR, and CHRISTOPHER LUBY

Appeal 2015-007174[1]
Application 10/795,079
Technology Center 2600

Before JEAN R. HOMERE, ST JOHN COURTENAY III, and JAMES R. HUGHES, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

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[1] Appellants identify the real party in interest as Adobe Systems Incorporated. App. Br. 2. The present appeal relates to an earlier appeal (2010-003491, decided June 29, 2012) in which we affirmed the Examiner's rejections of claims 1–4, 6–13, 15, 20–26, 28–35, 37, 42–54, and 61–63. Dec. 8. Appellants did not identify the earlier appeal as being related to the present appeal. Appellants are reminded of their duty to identify:

> all other prior and pending appeals, interferences, trials before the Board, or judicial proceedings . . . [that] involve an application or patent owned by the appellant or assignee, are known to appellant, the appellant's legal representative, or assignee, and may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

37 C.F.R. § 41.37(c)(1)(ii).

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner's final rejection of claims 1–4, 6, 7, 9–13, 15, 20, 21, 23–26, 28, 29, 31–35, 37, 42, 43, 45–48, 50–54, 56, 61, and 62. App. Br. 1. Claims 5, 8, 14, 16–19, 22, 27, 30, 36, 38–41, 44, 49, 55, 57–60, and 63 have been canceled. Claims App'x. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' Invention

Appellants invented a method and system for locally storing usage data describing the behavior of a user (112) on a webpage thereby delaying the transmission of the collected usage data to a data collection server website (106). Spec. ¶ 0004, Fig. 1. In particular, upon receiving at a client computer (107) a webpage including a web beacon code describing a user's interactions with the webpage, the client executes the web beacon code to thereby store the interactions locally. In response to a trigger event (e.g., the user clicking on a hyperlink, hovering the mouse away from the current webpage), the client computer (107) transmits the stored interactions to the collection server, and subsequently deletes them from the client computer. *Id.* ¶¶ 43-45.

Illustrative Claim

Independent claim 1 is illustrative, and reads as follows:

1. A method comprising:

receiving, at a client, a web page embedded with web beacon code; in response to displaying the web page, executing the web beacon code on the client, wherein the web beacon code, when executed causes the client to both detect a plurality of user interactions with one or more elements of the web page, and store descriptions of the interactions, wherein the descriptions identify each individual user interaction, and wherein the descriptions are stored in anticipation of a request for a new web page; and

in response to detection of the anticipated new web page request, transmitting, from the client to a data collection server, the descriptions stored by the web beacon code, and, after transmitting the descriptions, deleting the descriptions.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatentability:

Allard	US 6,018,619	Jan. 25, 2000
Daoud	US 2002/0093529 A1	Jul. 18, 2002
Viavant	US 2002/0184363 A1	Dec. 5, 2002
Itoh	US 2003/0033367 A1	Feb. 13, 2003
Lu	US 2004/0015580 A1	Jan. 22, 2004

Rejections on Appeal[2]

1. Claims 1–4, 6, 7, 9, 11–13, 15, 23–26, 28, 29, 31, 33–35, 37, 45–48, 50, 52–54, and 56 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Daoud, Lu, and Itoh.

2. Claims 10, 32, and 51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Daoud, Lu, Itoh, and Allard.

3. Claims 20, 21, 42, 43, 61, and 62 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Daoud, Lu, Viavant, and Itoh.

ANALYSIS

We consider Appellants' arguments *seriatim*, as they are presented in the Appeal Brief, pages 13–19, and the Reply Brief, pages 1–7.[3]

Appellants argue the Examiner erred in finding that the combination of Daoud, Lu, and Itoh renders claim 1 unpatentable. App. Br. 13–16, Reply Br. 2–6. First, Appellants argue that the proposed combination of references does not teach or suggest "receiving, at a client, a web page embedded with web beacon code," as recited in the claim. Reply Br. 2, App. Br. 14. In particular, Appellants argue Daoud discloses an interaction profile generated and stored at a client computer is transferred to an Internet site by way of a

[2] The Examiner has withdrawn the 35 U.S.C. § 112 rejections previously entered against the claims on appeal. Ans. 3.

[3] Rather than reiterate the arguments of Appellants and the Examiner, we refer to the Appeal Brief (filed December 19, 2014), the Reply Brief (filed July 30, 2015) and the Answer (mailed June 3, 2015) for their respective details. We have considered in this Decision only those arguments Appellants actually raised in the Briefs. Any other arguments Appellants could have made but chose not to make in the Briefs are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2013).

cookie, as opposed to the interaction profile being transferred from the internet site to the client. *Id.* (citing Daoud ¶ 46). That is, Daoud shows that data flows in the opposite direction from what is recited in the disputed claim limitation. *Id.* Further, Appellants argue although Daoud discloses transferring to the client computer individual response policies stored at an Internet site, the disclosed cookie is not an executable object capable of causing the client to perform an operation (e.g., display a webpage). Instead, Daoud merely uses the cookie for transferring factors of the interaction from the client to the Internet site. App. Br. 14, Reply 2–3 (citing Daoud ¶ 46). Although we agree with Appellants' general characterization of Daoud, we do not agree with Appellants that the combination of Daoud, Lu, and Itoh does not teach or suggest the disputed limitations.

We consider herein the scope and meaning of the claim limitation "web beacon code," which must be given its broadest reasonable interpretation consistent with Appellants' disclosure, as explained in *In re Morris*:

> [T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.

In re Morris, 127 F.3d 1048, 1054 (Fed. Cir. 1997). *See also In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) (stating that "claims must be interpreted as broadly as their terms reasonably allow."). In particular, Appellants' Specification states the following:

> A web beacon (also known as a web bug) is a particular type of embedded content where the content itself is irrelevant, but the request for content carries useful information. For example, *a web beacon is often a transparent image having very small dimensions, such as 1 pixel by 1 pixel. This image is small enough to be invisible to the user*. When a client is rendering a web page that includes a web beacon, the web beacon causes the client to send a resource request to a server such as a data collection server. The web beacon may include a script (or other code) that causes the client to include, in the resource request, additional information about the user and the user's environment. The additional information can include the data from a cookie, or other information about the client's operating environment or status. Where the server indicated by the web beacon code is a data collection server, the data collection server may, in response to the request, cause the client to set an additional cookie for identification for tracking purposes. In this manner, the web beacon request can be used to indicate to a data collection server that a particular web page is being rendered.

Spec. ¶ 7 (emphasis added).

> {T]he beacon code causes client machine 107 to store descriptions of such intra-page interactions locally. Any type of local storage mechanism can be used such as for example a cookie file …

Id. at ¶43

Consistent with the quoted textual portions above of Appellants' Specification, we broadly and reasonably construe a "web beacon code" as a type of content (e.g. small 1pixel by 1 pixel image) including a script embedded in a web page causing a client recipient thereof to perform a desired function upon being executed.

Lu discloses a system for reporting traffic activity on a website whereby a cookie is stored at a visitor computer by way of a script (e.g. 1

pixel by 1 pixel image) embedded within a webpage downloaded by the visitor. Abstr, ¶59. When the visitor computer makes a subsequent request to the website, the cookie previously stored on the visitor computer is sent along with the request to the website. Lu ¶¶55, 58. We find Lu's disclosure of a script embedded in a webpage teaches or suggests the "web beacon code" as construed hereinabove. Further, we find Lu's disclosure of the web site storing on a visiting computer a cookie containing a script embedded within a webpage downloaded by the visitor computer teaches a client a webpage embedded with a web beacon code, as recited in claim 1.

Second, Appellants argue that the combination of Daoud, Lu, and Itoh does not teach or suggest "transmitting descriptions from a client to a collection data server *in response to detection of an anticipated new web page request*." App. Br. 15, Reply Br. 6. In particular, Appellants argue although Lu discloses a client executing a script embedded in a downloaded webpage thereby causing the client node to transmit cookie data to a web tracking service, Lu does not contemplate that the script could be executed to continuously monitor the user's interactions with the webpage. App. Br. 16. This argument is not persuasive because it is not commensurate with the scope of the claim, which does not require continuously monitoring the user's interactions. Likewise, we find unpersuasive Appellants' argument that Lu does not teach transmitting the cookie to the web tracking service in response to detecting an anticipated new page request. *Id.* We find Lu's disclosure of the client sending to the tracking server a subsequent webpage request along with a previously stored cookie teaches that the transmission was performed in anticipation to detecting the new page request.

On the record before us, and by a preponderance of the evidence, we are not persuaded of error regarding the Examiner's ultimate legal conclusion of obviousness, that the combination of Daoud, Lu, and Itoh renders claim 1 unpatentable.

Regarding claims 2–4, 6, 7, 9–13, 15, 20, 21, 23–26, 28, 29, 31–35, 37, 42, 43, 45–48, 50–54, 56, 61, and 62, because Appellants reiterate substantially the same arguments as those previously discussed regarding the patentability of claim 1 above, we sustain these claims for essentially the same reasons discussed above regarding claim 1.

DECISION

We affirm the Examiner's rejections of claims 1–4, 6, 7, 9–13, 15, 20, 21, 23–26, 28, 29, 31–35, 37, 42, 43, 45–48, 50–54, 56, 61, and 62 as set forth above.

Because our analysis of the Daoud-Lu combination differs from the Examiner's application of the cited references in the Answer, we designate our affirmance of the Examiner's rejection as a new ground of rejection. Pursuant to 37 C.F.R. §§ 41.50(b) and 41.52(a)(1), we treat this new Decision as containing a new ground of rejection of claims 1–4, 6, 7, 9–13, 15, 20, 21, 23–26, 28, 29, 31–35, 37, 42, 43, 45–48, 50–54, 56, 61, and 62.

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 the appellant, 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 period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

37 C.F.R. § 41.50(b)