



# 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.
12/015,270	01/16/2008	Patrick J. O'Sullivan	RSW920070483US1	2063
106324	7590	02/11/2020	EXAMINER	
IBM Corp. - Fishkill Drafting Center SVL 650 Harry Road, Almaden Research Center C4TA/J2B San Jose, CA 95120			ELL, MATTHEW	
			ART UNIT	PAPER NUMBER
			2145	
			NOTIFICATION DATE	DELIVERY MODE
			02/11/2020	ELECTRONIC

**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.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

fdciplaw@us.ibm.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* PATRICK J. O’SULLIVAN, EDITH H. STERN,  
ROBERT C. WEIR, and BARRY E. WILLNER

---

Appeal 2019-001130  
Application 12/015,270  
Technology Center 2100

---

Before ST. JOHN COURTENAY III, THU A. DANG, and  
LARRY J. HUME, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a) from a final rejection of claims 1, 3–8, 10, 12–14, 16, 18, and 20, which are all the claims pending in this application. Claims 2, 9, 11, 15, 17, and 19 are canceled. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We reverse.

---

<sup>1</sup> We use the word “Appellant” to refer to Applicant as defined in 37 C.F.R. § 1.42(a). The real party in interest is International Business Machines Corporation. Appeal Br. 2.

## STATEMENT OF THE CASE <sup>2</sup>

### *Introduction*

Appellant’s claimed invention “relates to the field of bookmarking content and more particularly to social bookmarking.” Spec. ¶ 3.

### *Exemplary Independent Claim 1*

1. A method for automatically surfacing tagged content adjunct to a vertical application, the method comprising:

**establishing a hook** by auto-surfacing logic executing in a host server into an end-user application in a client computing device in order to pull content from and to direct visual emphasis of portions of the content matching social bookmarks and associated metadata;

detecting, by the auto-surfacing logic in the host server, an attempt by the client computing device to display content in the end-user application;

retrieving into the auto-surfacing logic from the client computing device the screen display for the end-user application upon detecting the attempt to display content;

forwarding the content from the auto-surfacing logic in the host server to a social bookmarking system executing in a memory of a different server, the social bookmarking system saving links to memorable content on the Internet and publishing the links on the Internet for public inspection so as to provide a communal repository of bookmarks;

---

<sup>2</sup> We herein refer to the Final Office Action, mailed Dec. 28, 2017 (“Final Act.”); Appeal Brief, filed June 8, 2018 (“App. Br.”); the Examiner’s Answer, mailed Sept. 21, 2018 (“Ans.”), and the Reply Brief, filed Nov. 21, 2018 (“Reply Br.”).

receiving, at the auto-surfacing logic in the host server and subsequently forwarding to the client computing device, text from the social bookmarking system resulting from a matching of content parsed from the screen display with words and phrases of one or more social bookmarks in the social bookmarking system that have been assigned only a high value; and,

directing the client computing device to visually emphasize the received text from the content in the end user application by determining a frequency of match of the received text to the at least one social bookmark and adjusting a font size of the received text proportionately based upon the determined frequency of match so as to visually differentiate the received text from the content.

Appeal Br. 16–17, “CLAIMS APPENDIX.” (Emphasis added regarding the contested dispositive limitations under 35 U.S.C. § 103).

### *Rejection*

Claims 1, 3–8, 10, 12–14, 16, 18, and 20 are rejected under pre-AIA 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of Hubert et al. (US 7,133,862 B2; iss. Nov. 7, 2006) (“Hubert”), Kei Shiratsuchi, et al. “Finding unknown interests utilizing the wisdom of crowds in a social bookmark service”, Proceedings of the 2006 IEEE/WIG/ACM International Conference on Web Intelligence and Intelligent Agent Technology, (“Shiratsuchi”), Blanchard et al. (US 2008/0072145 A1; pub. Mar. 20, 2008) (“Blanchard”), and further in view of Hong et al. (US 2008/0201651 A1; pub. Aug. 21, 2008) (“Hong”).

*Prior PTAB Decision*

Appeal No. 2012-011855, corresponding to Application No. 12/015,270, decided Aug. 3, 2015 (Examiner Affirmed).

ANALYSIS

We have considered all of Appellant’s arguments and any evidence presented. Based upon our review, and for the reasons discussed below, Appellant provides sufficient argument and evidence to persuade us the Examiner erred with respect to the single rejection under 35 U.S.C. § 103(a) over the cited combination of Hubert, Shiratsuchi, Blanchard, and Hong.

*Rejection of Independent Claim 1 under 35 U.S.C. § 103(a)*

*Contentions*

Appellant contends:

Hong does not describe Appellants’ claim elements, as Appellants[’] claims require the establishment of **a hook** by auto-surfacing logic (in the server) into an end-user application in a client computing device in order to pull content from and to direct visual emphasis of portions of the content matching social bookmarks and associated metadata.

Appeal Br. 14 (emphasis added).

Appellant urges that “[n]o **hook** is taught in Hong that is established by logic in a server that pulls content and directs visual emphasis of portions of the content that match social bookmarks and associated metadata.” *Id.*

In support, Appellant points to Hong ¶¶ 30–32, 37, and urges:

Furthermore, [the] Examiner, while neglecting to map any portion of the “establishing” claim limitation to any portion of the cited art, does provide mere argument without evidence at page 6 of the New Final Office Action in stating, “For a plug-in to function as described in Hong, said plug-in

necessarily creates or interacts with a hook”. Appellants disagree and believe that plug-ins do not necessarily create or interact with a hook and say so with evidence. Indeed, Hong teaches at paragraph [0037] that the “annotation plug-in” gratuitously receives events and therefore does not "pull" anything. In other words, there is no need for a hook for the annotation plug-in to hook the underlying web browser because the plug-in annotation receives the events from the web browser.

Appeal Br. 14–15.

**Issue:** Under 35 U.S.C. § 103(a), did the Examiner err by finding Hubert, Shiratsuchi, Blanchard, and Hong collectively teach or suggest the disputed dispositive “establishing a hook” limitation:

**establishing a hook** *by auto-surfacing logic executing in a host server into an end-user application in a client computing device in order to pull content from and to direct visual emphasis of portions of the content matching social bookmarks and associated metadata[,]*

within the meaning of independent claim 1?<sup>3</sup> (emphasis added).

The Examiner disagrees with Appellant, and further explains the basis for the rejection:

The use of a hook has been addressed earlier[:] basically plugins use hooks and even with a narrower definition of hook using a plugin to change the way established software performs regular tasks **requires that the plugin use a hook**. Establishment is not clearly defined by the specification. Hence the loading/initialization of the plug-in cited in the reference portions of Hong, paragraph 30 and Figure 3 (more specifically parts 302 and 324, shown below) **could fall** under the initialization or establishment spoken. And hence[,]Applicant's

---

<sup>3</sup> We give the contested claim limitations the broadest reasonable interpretation (“BRI”) consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

arguments that Examiner did not map the claim language to the cited art is incorrect.

Ans. 12–13.

We note in the Final Action the Examiner made a finding of inherency under § 103: “Hong teaches the use of browser plug-ins to send requested URLs or entire documents to an annotation server to annotate documents and to allow for their further annotation (see Hong, paragraphs 30 and 32).” Final Act. 5. Based upon this evidence, the Examiner finds: “For a plug-in to function as described in Hong, said plug-in **necessarily** creates or interacts with a hook.” Final Act. 6 (emphasis added).

Turning to the Specification for *context* regarding the intended meaning of the claim term “hook” we note the following description of usage that we find is consistent with the term “hook” as known and understood by artisans (computer programmers) as a term of art: “The server-side auto-surfacing logic 280ALT1 can establish a **hook** into each of the applications 270 in order to pull the content 290A and to visually emphasize the portions 290B of the content 290A matching the social bookmarks and associated metadata 250.” Spec. ¶ 23 (emphasis added).

In the Reply Brief, Appellant provides several online references for the claim term “hook.” We decline to rely on online sources such as Wikipedia and “WhatIs.com” for definitions, as provided by Appellant.<sup>4</sup>

---

<sup>4</sup> For example, Wikipedia is generally not considered to be as trustworthy as traditional sources because: (1) it is not peer reviewed; (2) the authors are unknown; and (3) anyone can contribute to the source definition. *See, e.g., Tchradium, Inc. Blackboard Connect Inc.*, 2009 WL 1152985 \*4 n. 5 (E.D. Tex. 2009)(“The Court agrees with Blackboard that Wikipedia disclaims any validity of the content listed on its website, and is therefore not a reliable source of technical information.”)

However, Appellant provides a description of “hooks” as found in US Pat. 7,225,430 (issued on May 29, 2007) that we find is consistent with the claim term “hook” at the time of the invention (filed Jan. 16, 2008), and as understood by artisans as a term of art: “Once installed, the hook function can **monitor messages**, and even alter them. System-wide hook functions can **intercept** all messages that enter a system. Application-specific hook functions allow **interception** only of messages directed at a specified window or application.” Eatough et al. (US 7,225,430 B2; iss. May 29, 2007) col. 7, ll. 4–9 (emphasis added).<sup>5</sup>

In reviewing Hong ¶ 37 (as pointed to by Appellant, Appeal Br. 15), we find the following description:

Subsequent to augmenting the web page at 326, the web page is displayed at 330 and made available to the user for (a) viewing annotations previously applied to similar content by the user or identified co-users and (b) further annotation. At 332, an event handler in the annotation plug-in receives and responds to events associated with input received from the user directed at the displayed web page.

Although paragraph 37 (*id.*) describes the “event handler in the annotation plug-in receives and responds to events associated with input

---

<sup>5</sup> We consider US Pat. 7,225,430 to Eatough et al. only to the extent that it provides evidence of the ordinary and plain meaning of the well-known computer programming term “hook” just prior to the time of Appellant’s invention. In the event of further prosecution of this application, including any review prior to allowance, we leave it to the Examiner to consider whether this reference could also be used as evidence to support a new ground of rejection under § 103(a). Although the Board is authorized to reject claims under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so. *See* Manual of Patent Examining Procedure (MPEP) § 1213.02.

received from the user directed at the displayed web page,” without more evidence in support, we cannot determine whether “hooks” are involved, or normal function or procedure calls.

Moreover, we find the Examiner contradicts his finding of inherency (“a plug-in **necessarily** creates or interacts with a hook” Final Act. 6 (emphasis added)) by stating: “the loading/initialization of the plug-in cited in the reference portions of Hong, paragraph 30 and Figure 3 (more specifically parts 302 and 324, shown below) **could fall** under the initialization or establishment.” Ans. 12–13 (emphasis added).

“The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness.” *In re Napier*, 55 F.3d 610, 613 (Fed. Cir. 1995) (affirmed 35 U.S.C. § 103 rejection based in part on inherent disclosure in one of the references). The question of obviousness is “based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently.” *In re Zurko*, 258 F.3d 1379, 1383 (Fed. Cir. 2001) (citations omitted). Our reviewing court has also “recognized that inherency may supply a missing claim limitation in an obviousness analysis.” *PAR Pharmaceutical, Inc. v TWI Pharmaceuticals, Inc.* 773 F.3d 1186, 1194-95 (Fed Cir. 2014). However,

[t]he mere fact that a certain thing *may result from a given set of circumstances is not sufficient*. If, however, the disclosure is sufficient to show that the *natural result flowing from the operation as taught* would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient. *In re Oelrich*, 666 F.2d at 581 (emphasis added) (citations and quotation marks omitted). Thus, our early precedent, and that of our predecessor court, established that the concept of inherency must be limited when applied to obviousness, and is present only when the

limitation at issue is the “natural result” of the combination of prior art elements. *Id.*

*PAR Pharmaceutical, Inc.*, 773 F.3d at 1195 (quoting *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981)) (emphasis added).

This guidance is applicable here. Therefore, on this record, we find a preponderance of the evidence, and applicable case law, support Appellant’s argument in the Reply Brief:

In any event, as can be seen, [the] Examiner appears to have pivoted from a direct comparison of the claimed “hook” to a “plug-in” and more recently indicates the presence of a “hook” to be inherent to the presence of a plug-in to a function. Under the law, to establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

Reply Br. 6.

Thus, failure to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily flows from the teachings of the applied prior art* amounts to mere speculation on the part of the Examiner and mere speculation as to the *inherent* presence of claimed element in cited art is a basis for reversal on appeal.

Reply Br. 7 (emphasis added).

To the extent that the Examiner finds the “plug-in **necessarily** creates or interacts with a hook” (Final Act. 6), we find the evidence cited by the Examiner (Final Act. 5, 8, citing Hong ¶¶ 30, 32) is insufficient to show “the natural result flowing from the operation as taught would result in the performance of the questioned function.” *PAR Pharm.*, 773 F.3d at 1194–

95. Moreover, we find that to affirm the Examiner on this record would require some degree of speculation on our part. We decline to engage in speculation.<sup>6</sup>

Therefore, for essentially the same reasons argued by Appellant (Appeal Br. 14–15; Reply Br. 1–8), as further discussed above, we are constrained on this record to reverse the Examiner’s obviousness rejection of independent claim 1 over the cited combination of Hubert, Shiratsuchi, Blanchard, and Hong. Because remaining independent claims 5 and 10 recite the disputed limitations using similar language of commensurate scope, we also reverse the Examiner’s rejection of independent claims 5 and 10.

Because we have reversed the rejection of each independent claim on appeal, we also reverse the Examiner’s obviousness rejection for each dependent claim on appeal.

Accordingly, we reverse the Examiner’s obviousness rejection of all claims 1, 3–8, 10, 12–14, 16, 18, and 20 on appeal.

## CONCLUSION

The Examiner erred in rejecting claims 1, 3–8, 10, 12–14, 16, 18, and 20, as being obvious under pre-AIA 35 U.S.C. § 103(a), over the cited combination of Hubert, Shiratsuchi, Blanchard, and Hong.

---

<sup>6</sup> “A rejection . . . must rest on a factual basis . . .” *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). “The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not . . . resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.” *Id.*

DECISION SUMMARY

<b>Claims Rejected</b>	<b>Pre-AIA 35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 3-8, 10, 12-14, 16, 18, 20	103(a)	Hubert, Shiratsuchi, Blanchard, Hong		1, 3-8, 10, 12-14, 16, 18, 20
<b>Overall Outcome</b>				1, 3-8, 10, 12-14, 16, 18, 20

REVERSED