

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MICHAEL MAN-HAK TSO

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Appeal No. 2002-0144  
Application No. 09/000,759

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ON BRIEF

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Before KRASS, BARRY and BLANKENSHIP, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-4, 6, 11-13 and 21-26.

The invention is directed to the filtering of network content to be downloaded to a network client in a computer system. While conventional blocking techniques were based on URL classifications, the instant invention bases the blocking of

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certain objects on the content itself. A data object to be rendered on a client device is dynamically filtered by scanning the object for content satisfying a predetermined selection criterion and, if the predetermined selection criterion is satisfied, the data object is selectively provided to the client in accordance with a predetermined filtering preference.

Representative independent claim 1 is reproduced as follows:

1. A method for dynamically filtering content in a data object to be rendered on a client device, said method comprising the steps of:

receiving a request for a user-specified data object from a client device;

retrieving the user-specified data object in response to the request from the client device;

scanning the user-specified data object for content satisfying a predetermined selection criterion;

modifying content in the user-specified data object in accordance with a predetermined filtering preference if said predetermined selection criterion is satisfied; and

providing the modified user-specified data object to the client device.

The examiner relies on the following reference:

|                    |           |                       |
|--------------------|-----------|-----------------------|
| Herz et al. (Herz) | 5,835,087 | Nov. 10, 1998         |
|                    |           | (filed Oct. 31, 1995) |

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Claims 1-4, 6, 11-13 and 21-26 stand rejected under 35 U.S.C. § 102(e) as anticipated by Herz.

Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

#### OPINION

At the outset, we note that claim 6, as reproduced in the appendix to the principal brief, depends from a non-existent claim 5.

We also note that, in accordance with the grouping of the claims at the top of page 6 of the principal brief, all claims will stand or fall together as a single group. Accordingly, we will focus on independent claim 1.

An anticipatory reference is one which describes all of the elements of the claimed invention so as to have placed a person of ordinary skill in the art in possession thereof. In re Spada, 911 F.2d 205, 15 USPQ2d 1655 (Fed. Cir. 1990).

We have reviewed the examiner's statement of the rejection as well as the rationale therefor and appellant's responses thereto and we will not sustain the rejection of claims 1-4, 6,

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11-13 and 21-26 under 35 U.S.C. § 102(e) because, in our view, the examiner has not established a prima facie case of anticipation.

We agree with appellant that, "[r]ather than being concerned with modifying the content of target objects, Herz is instead concerned with reducing the number of target objects presented to a user" (reply brief-page 5). Accordingly, Herz does not disclose the claimed "modifying content in the user-specified data object in accordance with a predetermined filtering preference if said predetermined selection criterion is satisfied." Herz customizes a list of objects presented to a user by enabling a user access to only those objects of interest without requiring the user to go through each and every object to determine those of interest. This is clearly set forth at column 4, lines 37-43, of Herz. While the number of objects presented to a user is reduced in Herz, it is in no way reasonable to conclude that this is equivalent to modification of the *content* of an object, as required by the instant claims.

One might say that Herz reasonably scans a user-specified data object for content satisfying a predetermined selection criterion because a user specifies certain types of objects

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(e.g., news articles relating to a certain subject) which the system then retrieves and inspects for such content before reducing the number of articles which may be of specific interest via a target profile. However, once this is done, Herz does not further modify the content of the user-specified data object, or news article, in accordance with any predetermined filtering preference, as required by the instant claims. The news articles themselves, albeit reduced in number, are provided to the user in Herz but the content of those news articles which are presented to the user is not modified before providing the data object to the client device.

In the response section of the answer, the examiner argues that the "active queries" of Herz are treated as any other target object (citing column 69, lines 10-13), that these active queries are used to determine the relevant ranking of target objects for the user and to generate a customized list of relevant target objects. The examiner further contends that various filters comprising user profiles are used to dynamically customize and modify a list which is then transmitted to the user (citing Herz, Figures 10 and 13A) (see answer-page 7).

If the examiner is arguing that the "list" presented to a user is modified, that may be so. However, the "list" of

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relevant target objects is not the "user-specified data object," as claimed. The user-specified data object in Herz is not the customized list of relevant target objects. Rather, the user-specified data objects in Herz are the news items of interest to the user. So, while the customized list in Herz may be modified, the list is not a user-specified data object and while Herz's news items of interest may be user-specified data objects, the news items are not modified. Accordingly, Herz does not anticipate the instant claimed subject matter.

It might even be argued that all of the news items retrieved by a general server in Herz comprise a universal set of all news items of the type specified by a user and that the filtered list results in a "modified" set of news items, the set of news items themselves being the user-specified data object, resulting in a modification of the "content" of the universal set by deleting some of the content of this universal set prior to display to the user. However, it is our view that such an interpretation of Herz would be strained. Though the claimed subject matter may be broad in scope, we simply do not view it as reasonable to contend that the entirety of the content of the list of objects retrieved in Herz is a "user-specified data object" which is then scanned for content satisfying a predetermined selection criterion and

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subsequently content-modified.

The examiner's decision rejecting claims 1-4, 6, 11-13 and  
21-26 under 35 U.S.C. § 102(e) is reversed.

REVERSED

|                             |   |                 |
|-----------------------------|---|-----------------|
| ERROL A. KRASS              | ) |                 |
| Administrative Patent Judge | ) |                 |
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|                             | ) |                 |
| LANCE LEONARD BARRY         | ) | BOARD OF PATENT |
| Administrative Patent Judge | ) | APPEALS AND     |
|                             | ) | INTERFERENCES   |
|                             | ) |                 |
|                             | ) |                 |
| HOWARD B. BLANKENSHIP       | ) |                 |
| Administrative Patent Judge | ) |                 |

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