APPENDIX

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APPENDIX A

Note: This disposition is nonprecedential.

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

DROPLETS, INC.,
Appellant

v.

JOSEPH MATAL, PERFORMING THE FUNCTIONS AND DUTIES OF THE UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, U.S. PATENT & TRADEMARK OFFICE,
Intervenor

No. 2016-2140

Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No. 95/002,330

Filed: October 11, 2017

Before DYK, REYNA, and WALLACH, Circuit Judges.

JUDGMENT

THIS CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

PER CURIAM (DYK, REYNA, and WALLACH, *Circuit Judges*).

AFFIRMED. *See* Fed. Cir. R. 36.

ENTERED BY ORDER OF THE COURT

October 11, 2017	/s/ Peter R. Marksteiner
Date	Peter R. Marksteiner
	Clerk of Court

APPENDIX B

UNITED STATES PATENT AND
TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND
APPEAL BOARD

GOOGLE INC. and FACEBOOK INC.
Requester

v.

DROPLETS, INC.
Patent Owner and Appellant

Filed: March 30, 2016

Appeal 2015-007929
Reexamination Control 95/002,330
Patent US 7,502,838 B2
Technology Center 3900

Before RICHARD M. LEBOVITZ, JEFFREY B. ROBERTSON, and ANDREW J. DILLON, *Administrative Patent Judges.*

DILLON, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Patent Owner appeals under 35 U.S.C. § 134(b) (2002) from the final decision of the Examiner adverse to the patentability of claims 1–38. We have jurisdiction under 35 U.S.C. § 315 (2002).

We affirm.

Invention

The '838 patent describes a method and system for delivering interactive links for presenting applications and second information at a client computer from remote resources in a network-configured computer processing system. Abstract.

Claims

Claims 1–38 are subject to reexamination and have been rejected. Claims 1–38 are original patent claims. Claims 1, 15, 29, and 33 are independent.

Claim 1 is illustrative (emphasis added).

1. A method for presenting an application in a networked computer processing system having a plurality of client computers and a plurality of host computers, the method comprising:

   retrieving, in response to a request of a client computer, a content item having computer program code embedded therein, execution of the embedded computer program code establishing a communication connection to a host computer;

sending operating environment information regarding the client computer from the client computer to the host computer;

retrieving presentation information to present an application and content, the presentation information being based on the operating environment information and comprising at least one of instructions for rendering components of the application, default parameters and data values exhibited within the components, and application-specific business logic for processing input to the presented application; and

presenting, at the client computer, the application and the content based upon the presentation information.

Prior Art

Davis	US 5,796,952	Aug. 18, 1998
Frese	US 5,909,545	June 1, 1999
Hickman	US 6,173,332 B1	Jan. 9, 2001
Orenshteyn	US 6,393,569 B1	May 21, 2002

ArcView Internet Map Server, Map Publishing on the Web, pp. 1–60, Environmental Systems Research Institute, Inc., United States (1996–97) (hereinafter "ArcView").

Livingston and Straub, Windows 98 Secrets, pp. 1–1207, Hungry Media, Inc., United States (March 24, 1998) (hereinafter "Livingston").

The Santa Cruz Operation Technical White Paper, Tarantella—The Universal Application Server, pp. 1–13 (July 1997) (hereinafter "Tarantella").

Hahn, The Internet Complete Reference, Second Edition, pp. 1–161 and 176–199, Osborne McGraw-Hill, United States (1996) (hereinafter "Hahn").

Neibauer, Running Microsoft Outlook 98, pp. 1–239, Microsoft Press, United States (1998) (hereinafter "Neibauer").

Owner's Contentions

Patent Owner contends that the Examiner erred in entering the following grounds of rejection against claims 1–38 (App. Br. 7–44; Reb. Br. 2–22):

A. The rejection of claims 1, 15, 29–36, and 38 under 35 U.S.C. § 102(b) as anticipated by Frese. App. Br. 7–11; Reb. Br. 17–18.

B. The rejection of claims 2, 4–8, 12–14, 16, 18–22, 26–28, 31, 32, and 37 under 35 U.S.C. § 103(a) as unpatentable over Frese in view of Hickman. App. Br. 11–15; Reb. Br. 2–5, 13–15.

C. The rejection of claims 3 and 17 under 35 U.S.C. § 103(a) as unpatentable in view of Frese, Hickman, and Admitted Prior Art ("APA"). App. Br. 15–16.

D. The rejection of claims 2, 3, 6, 9, 12, 16, 17, 20, 23, and 26 under 35 U.S.C. § 103(a) as unpatentable in view of Frese and Windows Secrets. App. Br. 16–19; Reb. Br. 5–6, 15.

E. The rejection of claims 9, 10, 23, and 24 under 35 U.S.C. § 103(a) as unpatentable over Frese in view of Hickman in view of Outlook98. App. Br. 19–20.

F. The rejection of claims 11 and 25 under 35 U.S.C. § 103(a) as obvious in view of Frese, Hickman, Outlook 98, and Hahn. App. Br. 20–21.

G. The rejection of claims 1, 2, 4, 5, 7–9, 15, 16, 18, 19, 21–23, 29, 30, and 33–38 under 35 U.S.C. § 103(a) as unpatentable in view of Tarantella and Frese. App. Br. 21–31; Reb. Br. 6–8, 18–21.

H. The rejection of claims 3, 9, 17, and 23 under 35 U.S.C. § 103(a) as unpatentable in view of Tarantella, Frese, and Windows Secrets. App. Br. 31–32.

I. The rejection of claims 2, 4, 5, 7, 8, 12–14, 16, 18, 19, 21, 22, and 26–28 under 35 U.S.C. § 103(a) as unpatentable in view of Tarantella, Frese, and Orenshteyn. App. Br. 32–34; Reb. Br. 8–9.

J. The rejection of claims 3, 9, 17, and 23 under 35 U.S.C. § 103(a) as unpatentable in view of the combination of Tarantella, Frese, Orenshteyn, and Windows Secrets. App. Br. 34–35.

K. The rejection of claims 10, 11, 24, and 25 under 35 U.S.C. § 103(a) as unpatentable in view of Tarantella, Frese, Orenshteyn, Windows 98, and Davis. App. Br. 35–36.

L. The rejection of claims 1, 2, 4–6, 15, 16, 18–20, 29, and 31–38 under 35 U.S.C. § 102(a) as anticipated by the published document ArcView. App. Br. 36–41; Reb. Br. 9–11, 15–16, 21–22.

M. The rejection of claims 2, 4–6, 16, and 18–20 under 35 U.S.C. § 103(a) as unpatentable in view of the combination of ArcView and Orenshteyn. App. Br. 41–42; Reb. Br. 11–12, 16–17.

N. The rejection of claims 3, 9, 17, and 23 under 35 U.S.C. § 103(a) as unpatentable in view of ArcView, Orenshteyn, and Windows Secrets. App. Br. 42–43.

O. The rejection of claims 2, 12–14, 16, and 26–28 under 35 U.S.C. § 103(a) as unpatentable in view of ArcView and Windows Secrets. App. Br. 43; Reb. Br. 12–13.

P. The rejection of claims 9, 10, 23, and 24 under 35 U.S.C. § 103(a) as unpatentable in view of ArcView and Outlook 98. App. Br. 44.

Q. The rejection of claims 11 and 25 under 35 U.S.C. § 103(a) as unpatentable in view of ArcView, Outlook 98, and Hahn. App. Br. 44.

ANALYSIS

Ground of Rejection A

Patent Owner argues the Examiner erred in rejecting claims 1, 15, 29–36, and 38 under 35 U.S.C. § 102(b) as anticipated by Frese because Frese fails to disclose "sending operating environment . . . to the host computer." Patent Owner argues that the Examiner asserted that remote application server (RAS) 20 in Frese depicts the host computer and that user system 16 depicts the client computer. Patent Owner points out that Frese requires remote control service publisher (RCSP) 12 to be the intermediary "because the RAS 20 operates to execution the application 22 and mirror the user system 16." App. Br. 8. Consequently, Patent Owner argues that Frese teaches sending operating environment information to RSCP 12, which is not the host computer, but rather operates as an intermediary. App. Br. 7–9.

Patent Owner also argues that Frese fails to disclose "presenting, at the client computer, the application and the content based upon the presentation information." Specifically, Patent Owner argues that Frese operates to insulate application 22 on the RAS 20 and consequently,

the remote display module (RDM) cannot be properly interpreted as the claimed "application," as replied upon by the Examiner. *Id.* at 10–11; Reb. Br. 17–18.

In response to Patent Owner's first argument above, the Examiner notes that in one embodiment, at column 8, lines 5–8, Frese expressly teaches that RAS 20 "'may reside on the same computer implementing RCSP 12'" and consequently does disclose "sending operating environment" to the "host computer" in that embodiment. Ans. 9.

Regarding Patent Owner's second argument that RDM "cannot be properly interpreted as the claimed 'application,'" the Examiner points out that Frese, at column 5, lines 26–29 expressly states "[b]ecause the RDM is identified as an application program for the user's computer, it is provided with its own communication access to the local resource interface for the user's computer." *Id.* at 13.

In view of the above cited express statements within the Frese reference, which we find support the exact interpretation adopted by the Examiner, Patent Owner's arguments with respect to Ground of Rejection A are unavailing. Accordingly, we affirm the Examiner's decision to reject the claims as anticipated by Frese.

Ground of Rejection B

Patent Owner argues the Examiner erred in rejecting claims 2, 4–8, 12–14, 16, 18–22, 26–28, 31, 32, and 37 under 35 U.S.C. § 103(a) as being unpatentable over Frese in view of Hickman.

Specifically, Patent Owner argues the cited references fail to show or suggest "storing on the client com-

puter, a link for re-establishing the communication connection." Claim 2. The basis for Patent Owner's position is a belief that the URL disclosed by Hickman cannot be interpreted as the claimed "link" because a URL is a "location" and does not generate "some processor action," which Patent Owner asserts is an essential element of a "link." App. Br. 12–13; Reb. Br. 2–3.

Further, Patent Owner argues that Hickman fails to show or suggest the claimed "storing" the claimed link, but rather merely teaches that the client computer is "informed" of the URL. App. Br. 13–14.

Finally, Patent Owner argues that Hickman teaches the ability to access any of a number of network computers, and thus cannot be said to be "re-establishing **the communication connection to the host computer**." *Id.* at 14–15; Reb. Br. 3–4.

With regard to Patent Owner's arguments with respect to the alleged difference between a "link" and a "URL" the Examiner finds that Hickman teaches that in response to a request to connect to a "network accessible computer" (NAC), the URL of a NAC is provided, and by utilizing a Java Applet, converted to a "link," as depicted at reference numeral 78 in Figure 3A of Hickman ("Click Me To Connect"). Ans. 14–15.

With respect to Patent Owner's argument regarding "storing," the Examiner finds that "inform[ing]" the computer in Hickman of the URL of the NAC necessarily requires that the subject URL be "stored" within that computer. *Id.* at 17–18.

Finally, in response to Patent Owner's arguments regarding the existence of a number of network accessible

computers (NACs) and the consequent failure of Hickman to teach "re-establishing" the link, the Examiner points out that Hickman, at column 4, lines 62-66, teaches that the described cluster "can be reduced to a single network-accessible computer" rendering each subsequent connection to the NAC a "re-establishing" of the connection. *Id.* at 19.

We concur with the Examiner. We find the described "Click Me to Connect" disclosure within Hickman, in response to the provision of a URL, to be suggestive of the provision of a link. Further, we find "informing" a computer of any piece of data necessarily requires "storing" that data within the computer because storing would be necessary for the computer to receive the information. Finally, the express teaching of Hickman contemplates a cluster with a single network-accessible computer (NAC) rendering each subsequent connection a "re-establishing" of that connection.

Ground of Rejection C

Patent Owner argues the Examiner erred in rejecting claims 3 and 17 under 35 U.S.C. § 103(a) as unpatentable in view of Frese, Hickman, and Admitted Prior Art ("APA") in view of the failure of the cited references to show or suggest a "drag and drop" operation with respect to the claimed "link." App. Br. 15–16.

The Examiner finds that the URL of Hickman indeed suggests the claimed "link" and consequently, a "drag and drop" operation on the Hickman URL suggests the claimed feature.

We are not persuaded by Patent Owner's arguments. As we noted above, we find the provision of a URL by

Hickman to be equivalent to the claimed "link." because Hickman teaches the URL is converted to a "link" by means of a Java Applet. Further, we acknowledge that "drag and drop" operations are notorious in the art and find that a graphic indication of a URL may be subject to a "drag and drop" operation as claimed.

Ground of Rejection D

Patent Owner argues the Examiner erred in rejecting claims 2, 3, 6, 9, 12, 16, 17, 20, 23, and 26 under 35 U.S.C. § 103(a) as unpatentable in view of Frese and Windows Secrets.

Patent Owner argues error on the basis of the previously argued distinction between a "link" and a "URL." App. Br. 16–17: Reb. Br. 15.

Patent Owner also argues that the "**stateless nature of Frese**" prohibits any "link for re-establishing the communication connection." Patent Owner points out that Frese does not use client state information and teaches away from the use of client state information and cannot therefore "re-establish" a communication connection. *Id.* at 18–19.

Finally, Patent Owner argues that claims 6 and 20, which depend from claims 2 and 16, recite "storing further comprises storing instructions for rendering components of the application, default parameters and data values exhibited within the components, and application-specific business logic for processing input to the application." Patent Owner argues the claimed storing takes place on the client computer and that is not shown by the cited references. *Id.* at 19.

We find no patentable distinction between the claimed "link" and the disclosed "URL," especially in view of the express description within Windows Secrets of the creation of "link" and the description of that "link" as a "URL shortcut." Windows Secrets, p. 244.

The Examiner finds that Frese does not expressly prohibit any type of communication connection from being "re-established" and Patent Owner's assertions regarding the intentions of Frese are conclusory in nature. Ans. 25.

We agree with the Examiner. Aside from mere conclusions regarding reasons why Frese will not permit "re-establishing communication" Patent Owner has not pointed to any express basis for asserting that Frese prohibits the re-establishing of a communication connection.

With regard to the "storing" argument, the Examiner notes that although the cited portion of Frese describes functions which occur at the host, the data utilized to perform those functions is all stored at the client, as set forth in Frese at column 7, lines 40–62. When Frese is considered as a whole, the Examiner believes that the data stored at the client, even if utilized at the host, suggests the claimed "storing." Ans. 26–27.

We find the Examiner's position persuasive. While the host within Frese actually performs the various functions, that underlying data is stored within the client (as noted above) and thus meets the broadest reasonable interpretation of claims 6 and 20.

Ground of Rejection E

Patent Owner argues the Examiner erred in rejecting claims 9, 10, 23, and 24 under 35 U.S.C. § 103(a) as unpatentable over Frese in view of Hickman in view of Outlook 98.

Patent Owner urges error on the part of the Examiner based upon the failure of the cited references to disclose a "link."

For the same reasons we set forth above, we do not find Patent Owner's arguments persuasive.

Ground of Rejection F

Patent Owner argues the Examiner erred in rejecting claims 11 and 25 under 35 U.S.C. § 103(a) as unpatentable in view of Frese, Hickman, Outlook 98, and Hahn.

Specifically, Patent Owner argues the cited references fail to show or suggest "the information to track transmission of the link comprises a global unique identifier that is assigned to the link and information for identifying a given client computer that has received the link" as recited in claim 11. Patent Owner urges that the Examiner's reliance on the URL as a global unique identifier assigned to the link, and the email address as information identifying the client computer are erroneous because a URL is unique only to the server and the email address does not teach that a given client computer has received a link. App. Br. 20–21.

The Examiner finds that Hahn expressly discloses "every hypertext item on the Net has an address of its own . . . [W]ithin this system, there is a unique URL for

every hypertext item on the Net." The Examiner interprets this unique URL as a globally-unique identifier. (*See* Hahn, p.177) Further, the Examiner finds that Outlook 98 teaches that an email address can be used to identify a given client computer that received a particular link. Ans. 29–31.

We find the Examiner's interpretation to be reasonable and factually supported. Those skilled in the art will appreciate that a URL is indeed a globally-unique identifier for the reasons given by the Examiner. We find no more limiting definition within Patent Owner's Specification. Similarly, an email address, which is unique, can be utilized to identify a recipient of a link.

Ground of Rejection G

Patent Owner argues the Examiner erred in rejecting claims 1, 2, 4, 5, 7–9, 15, 16, 18, 19, 21–23, 29, 30, and 33–38 under 35 U.S.C. § 103(a) as unpatentable in view of Tarantella and Frese.

Patent Owner argues that Tarantella is not a valid prior art reference because it "**fails to include a technical description**." Specifically, Patent Owner urges that Tarantella is an "informal" document and fails as an enabling disclosure. Patent Owner argues that Tarantella includes only a general description of an Adaptive Internet Protocol and was incomplete until the issuance of U.S. Patent No. 6,104,392, filed on November 12, 1998. App. Br. 21–26.

Further, Patent Owner argues that Tarantella fails to disclose the claimed "operating environment information regarding the client computer," "sending operating environment information regarding the client computer to

the host computer," the "presentation information being based on the operating environment information," and "presenting, at the client computer, the application and the content based upon the presentation information." *Id.* at 26–30.

Finally, Patent Owner argues that Frese fails to cure the argued deficiencies of Tarantella and that Frese and Tarantella together fail to suggest the claimed "link for re-establishing" for the reasons set forth above. App. Br. 30–31.

First, the Examiner finds that Tarantella was not cited under 35 U.S.C. § 102, but rather under § 103 and is considered prior art for all that it teaches. Ans. 33. With respect to Patent Owner's argument that a subsequent issued patent based on Tarantella was not enabling, the Examiner again emphasizes that the Tarantella publication is being relied upon for its teachings. *Id.* at 34. With regard to Patent Owner's argument that Tarantella fails to disclose sending operating environment information regarding the client computer to the host computer, the Examiner points out that Tarantella, at page 12, recites "[t]he first phase in this link is to pass parameters identifying the characteristics of the client device and network connection" which is utilized to display the application on both the client and AIP monitors, which the Examiner interprets as operating environment/presentation information which is sent to the host. *Id.* at 36–37, 39, 40–41, and 42.

With regard to Patent Owner's arguments concerning the storage of a "link for re-establishing" the Examiner points out that Tarantella, at page 10, teaches that an "application session can be configured, by administrators, to be resumable. In this scenario users can disconnect

themselves from the Tarantella server but leave resumable applications running." The Examiner further finds that the "saved" application can be resumed by "clicking" on an icon, which the Examiner interprets as a "link." Ans. 44–45.

We agree with the Examiner. The Tarantella reference, despite Patent Owner's characterization as lacking "technical description" is still a valid reference for what it teaches. Further, we find that the "characteristics of the client device and network connection" in Tarantella to be a disclosure of passing parameters, which identify the characteristics of the client device and network connection. Finally, we find a "resumable" connection, as taught by Tarantella, to be a "link for re-establishing" a connection.

Ground of Rejection H

Patent Owner argues the Examiner erred in rejecting claims 3, 9, 17, and 23 under 35 U.S.C. § 103(a) as unpatentable in view of Tarantella, Frese, and Windows Secrets.

The basis for the alleged error is, once again, the alleged failure of the cited references to show or suggest the "link for re-establishing the communication connection" for the reasons set forth above. App. Br. 31–32.

We find no error in the Examiner's reliance on the teaching of a URL to suggest the claimed "link" for the same reasons set forth above.

Ground of Rejection I

Patent Owner argues the Examiner erred in rejecting claims 2, 4, 5, 7, 8, 12–14, 16, 18, 19, 21, 22, and 26–28 under 35 U.S.C. § 103(a) as unpatentable in view of Tarantella, Frese, and Orenshteyn.

Specifically, Patent Owner argues this combination of references fails to show or suggest "storing, on the client computer, a link for reestablishing" as set forth above. App. Br. 32.

Further, Patent Owner argues that Orenshteyn is not a valid prior art reference, urging that the Examiner has relied upon portions of Orenshteyn that were not present in the parent application. *Id.* at 33–34.

Finally, Patent Owner argues that the Examiner failed to provide any actual support for the rejection of claims 21, 22, and 26–28. *Id.* at 34.

The Examiner notes that Tarantella, rather than Orenshteyn, is relied upon for the storage of a link to reestablish a communication connection, reiterating that Tarantella expressly states that applications are designed to be resumable, upon the selection of an icon. Ans. 47.

With respect to Patent Owner's arguments regarding whether or not Orenshteyn is prior art, the Examiner acknowledges that Orenshteyn is a continuation-in-part, but asserts that those portions of Orenshteyn which were relied upon by the Examiner, exclude the new matter (Figures 4–8 and column 23, line 31 through column 25, line 37) added at filing of Orenshteyn. *Id.* at 49.

Finally, regarding the rejection of claims 20, 21, and 26–28, the Examiner acknowledges that these claims

were included only by virtue of a typographical error. *Id.* at 50.

We find that the Examiner has made a clear showing that Tarantella clearly demonstrates a link (selectable icon) that, upon activation, reestablishes a connection with the application. Consequently, we find no error in the Examiner's reliance on this combination of references.

Regarding the status of Orenshteyn, the Examiner has only relied upon those portions of the reference that are entitled to the filing date of the parent application. Ans. 49. We therefore find no merit in Patent Owner's argument.

Finally, in view of the Examiner's admission, we find that claims 20, 21, and 26–28 are not rejected over this cited combination of references; however, we note that those claims were rejected under Ground of Rejection B.

Ground of Rejection J

Patent Owner argues the Examiner erred in rejecting claims 3, 9, 17, and 23 under 35 U.S.C. § 103(a) as unpatentable in view of the combination of Tarantella, Frese, Orenshteyn, and Windows Secrets.

The basis for the alleged error is, once again, the alleged failure of the cited references to show or suggest the "link for re-establishing the communication connection" for the reasons set forth above. App. Br. 34–35.

We find no error in the Examiner's reliance on the teaching of a URL to suggest the claimed "link" for the same reasons we set forth above.

Ground of Rejection K

Patent Owner argues the Examiner erred in rejecting claims 10, 11, 24, and 25 under 35 U.S.C. § 103(a) as unpatentable in view of Tarantella, Frese, Orenshteyn, Windows 98, and Davis.

Patent Owner argues that Davis fails to teach or suggest transmissions between clients, and cannot therefore suggest the monitoring of inter-client communications. App. Br. 35–36.

Additionally, Patent Owner argues that Davis does not show or suggest a "**global unique identifier that is assigned to the link and information for identifying a given client computer that has received the link**." Patent Owner urges that Davis discloses two databases which are utilized to track browser activities. One database tracks user activities and the second database tracks web address activity. Patent Owner argues such activity is inconsistent with the claimed identification of clients receiving a link. *Id.* at 36.

In response, the Examiner finds that Patent Owner only argues the Davis reference, while the Examiner's rejection is based upon a combination of references. The Examiner notes that transmissions of links between clients is taught by the combination of Tarantella, Frese, Orenshteyn, and Windows Secrets, while Davis is relied upon merely to show the storing of information that tracks those transmissions. Consequently, the Examiner urges that Patent Owner's argument that Davis fails to show tracking transmissions of links is not persuasive. Ans. 53.

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Here the Patent Owner argues that Davis fails to show or suggest a global identifier assigned to a link and information for identifying a client computer which received that information. The Examiner finds that the transmission of links between clients is taught by the combination of Tarantella, Frese, Orenshteyn and Windows Secrets, while Davis is merely relied upon for a teaching that the information is stored to track that transmission. *Id.* We therefore find no error in the Examiner's position for the reasons set forth above.

Ground of Rejection L

Patent Owner argues the Examiner erred in rejecting claims 1, 2, 4–6, 15, 16, 18–20, 29, and 31–38 under 35 U.S.C. § 102(a) as anticipated by the published document ArcView.

Patent Owner argues that ArcView fails to disclose "execution of the embedded computer program code establishing a communication connection to a host computer." Specifically, Patent Owner argues that ArcView discloses a unitary call to the web server, which Patent Owner argues is not a communication connection and consequently, ArcView cannot be interpreted as disclosing the claimed invention. App. Br. 38–39.

Patent Owner also argues ArcView fails to disclose "presenting, at the client computer, the application and the content based upon the presentation information." Patent Owner argues that the web browser application of ArcView is the MapCafe, but Patent Owner argues that

downloading a Java Applet, by its very nature, is not based on the operating environment information, as required by claim 1. *Id.* at 40.

The Examiner finds that in at least one embodiment, disclosed at page 5 of ArcView, the Web Server resides in the same computer as the ArcView, as can thus be interpreted as the host, and therefore Patent Owner's argument that the web browser in ArcView is entirely unaware of the existence of the ArcView server is without merit. Ans. 55.

Regarding Patent Owner's arguments about the establishing of a communication connection, the Examiner finds that "communication connection" is a broad term and clearly encompasses the execution of MapCafe which establishes a communication connection with the host as depicted at page 34 of ArcView. *Id.* at 56–58.

We agree with the Examiner. In a single computer embodiment, where the Web Server resides in the same computer as ArcView, we find the embedded computer program establishes a communication connection with the host computer. In addition, the '838 Patent does not provide a definition of "communication connection" that would exclude the disclosure of ArcView as communication connection established between MapCafe and the host computer.

Ground of Rejection M

Patent Owner argues the Examiner erred in rejecting claims 2, 46, 16, and 18–20 under 35 U.S.C. § 103(a) as unpatentable in view of the combination of ArcView and Orenshteyn.

Patent Owner argues that the stateless operation of ArcView teaches away from a combination with Orenshteyn, since the ArcView server must be available for receipt of map display requests while Orenshteyn requires a direct client/server connection. App. Br. 41.

Patent Owner also argues Orenshteyn fails to show or suggest storing a "link" for re-establishing a communication connection and, as argued above, is not a valid prior art reference. *Id.* at 42.

The Examiner finds that the proper test for a cited combination of references is not whether or not the references may be physically combined, but what the combination would suggest to one of ordinary skill in that art. In the present matter the Examiner points out that Orenshteyn was cited merely to demonstrate the remote storage of a link for reconnecting to a host computer, a feature absent from ArcView.

The Examiner points out that Orenshteyn discloses the use of a graphical icon, which when selected can be utilized to "spawn" an application, which the Examiner interprets as re-establishing communications.

Finally, the Examiner reiterates that only those portions of Orenshteyn which were entitled to the earlier filing date of the parent application were relied upon by the Examiner.

The Examiner is correct that physical combination of the elements described in two references is not required, and that the proper test for such a combination is the suggestion that combination would raise in the mind of one have ordinary skill in the art. Consequently, it is our opinion that the teaching of a stored link for re-establishing a communication connection, taught by Orenshteyn, as

noted above, in combination with the teaching of ArcView would reasonably suggest the claimed limitations for the reasons given by the Examiner.

Further, we find that the transmission of selectable graphical icons, as taught by Orenshteyn, which may be utilized to spawn a corresponding application, suggests the re-establishing of a communication connection, as claimed. Additionally, those portions of Orenshteyn cited by the Examiner are those portions having a proper basis in the parent application, rendering Orenshteyn a valid prior art citation.

We therefore find no error by the Examiner.

Ground of Rejection N

Patent Owner argues the Examiner erred in rejecting claims 3, 9, 17, and 23 under 35 U.S.C. § 103(a) as unpatentable in view of ArcView, Orenshteyn, and Windows Secrets.

The basis for the alleged error is, once again, the alleged failure of the cited references to show or suggest the "link for re-establishing the communication connection" for the reasons set forth above. App. Br. 43.

We find no error in the Examiner's reliance on the teaching of a URL to suggest the claimed "link" for the same reasons we set forth above.

Ground of Rejection O

Patent Owner argues the Examiner erred in rejecting 2, 12–14, 16, and 26–28 under 35 U.S.C. § 103(a) as unpatentable in view of ArcView and Windows Secrets.

Patent Owner argues that the stateless operation of ArcView teaches away from a combination with Windows Secrets for the reasons set forth above in Ground of Rejection M. App. Br. 43.

Patent Owner also argues that Windows Secrets fails to teach or suggest a "link" as claimed, disputing the Examiner's reliance on the teaching of a "URL." *Id.*

For the same reasons we set forth above we find no basis for Patent Owner's argument that ArcView cannot be physically combined with the Windows Secrets reference. As we noted above, physical combinability is not the proper test.

Further, we have repeatedly found that the Examiner's reliance on a "URL" as suggestive of a "link" is within the broadest reasonable interpretation of Patent Owner's claims. We therefore find no error on the part of the Examiner.

Ground of Rejection P

Patent Owner argues the Examiner erred in rejecting claims 9, 10, 23, and 24 under 35 U.S.C. § 103(a) as unpatentable in view of ArcView and Outlook 98.

Patent Owner argues that ArcView fails to teach the claimed "link" and teaches away from such a limitation. Further, Patent Owner argues that the Examiner erred in relying upon Outlook 98 to cure that deficiency. App. Br. 44.

The Examiner notes that physical combination of the elements of references is not required and also finds that Outlook 98 expressly teaches transmitting a URL or a "link" within a message, citing pages 135 and 202.

In view of the fact that physical combination is not required, and in the absence of a clear teaching that expressly prohibits the combination of a reference, we find no error on the part of the Examiner. This is particularly true in view of the express teaching within Outlook 98 that a message may include a "link." See Outlook 98, pp. 135 and 202.

Ground of Rejection Q

Patent Owner argues the Examiner erred in rejecting claims 11 and 25 under 35 U.S.C. § 103(a) as unpatentable in view of ArcView, Outlook 98 and Hahn.

Specifically, Patent Owner argues the Hahn teaching of an email address does not teach or suggest a "unique identifier" assigned to a link. App. Br. 44.

The Examiner finds that under a broadest reasonable interpretation, Hahn discloses that a unique e-mail address as a global unique identifier and that each hypertext item on the internet has a unique address. Ans. 71.

In the absence of a narrow definition which would restrict the claim terms, we find no error in the Examiner's rejection of claims 11 and 25 over the cited references.

Summary/Conclusion

We sustain the Examiner's rejections of claims 1–38.

DECISION

The Examiner's decision adverse to the patentability of claims 1–38 is affirmed.

Requests for extensions of time in this proceeding are governed by 37 C.F.R. §§ 1.956 and 41.79(e).

AFFIRMED

PATENT OWNER:

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APPENDIX C

Note: This order is nonprecedential.

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

DROPLETS, INC.,
Appellant

v.

JOSEPH MATAL, PERFORMING THE FUNCTIONS AND DUTIES OF THE UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, U.S. PATENT & TRADEMARK OFFICE,
Intervenor

No. 2016-2140

Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No. 95/002,330

Filed: January 3, 2018

ON PETITION FOR REHEARING EN BANC

Before PROST, Chief Judge, NEWMAN, LOURIE, DYK, MOORE, O'MALLEY, REYNA, WALLACH, TARANTO, CHEN, HUGHES, and STOLL, Circuit Judges.

PER CURIAM.

ORDER

Appellant Droplets, Inc. filed a petition for rehearing en banc. The petition was first referred as a petition for rehearing to the panel that heard the appeal, and thereafter the petition for rehearing en banc was referred to the circuit judges who are in regular active service.

Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

The mandate of the court will issue on January 10, 2018.

FOR THE COURT

January 3, 2018
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court