

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 LEIGH L. KLOTZ, JR., GLEN W. PETRIE, ROBERT S. BAUER,  
DANIEL DAVIES, and JULIA A. CRAIG

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Appeal No. 2005-0052  
Application No. 09/192,014

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ON BRIEF

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Before RUGGIERO, BARRY, and LEVY, Administrative Patent Judges.  
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-6, 11, 14, and 15, which are all of the claims pending in the present application. Claims 7-10, 12, and 13 have been canceled.

The claimed invention relates to a method and system for processing hard copy documents based on information in user

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interface tags which are affixed to the documents. A document with an affixed user interface tag is scanned and the user interface tag, which contains user identification and service information, is located in the scanned image. The user interface tag is decoded to retrieve identity and service codes and the service is subsequently performed for the particular user.

Representative claim 1 is reproduced as follows:

1. A method for processing a document based on information in a user interface tag, comprising the steps of:

scanning the document to produce an image representative of the document;

locating the user interface tag in the image;

decoding data represented in the user interface tag;

associating the data with a service and a user identity; and

performing the specified service on the image representative of the document.

The Examiner relies on the following prior art:

Barton et al. (Barton)	5,998,752	Dec. 07, 1999 (filed Mar. 16, 1998)
Irons	6,192,165	Feb. 20, 2001 (filed Dec. 30, 1997)

"Xerox touts DataGlyphs for paper data,"  
Seybold Report on Desktop Publishing, 9(5), at  
[http://www.seyboldseminars.com/seybold\\_reports/D0905001.HTM](http://www.seyboldseminars.com/seybold_reports/D0905001.HTM) (last visited Dec. 6, 2001)(hereinafter referred to as "Xerox").

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Claims 1-6, 11, 14, and 15 all of the appealed claims, stand finally rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner offers Irons in view of Xerox with respect to claims 1-6, and Irons in view of Barton with respect to claims 11, 14, and 15.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (Paper No. 18 dated November 6, 2003) and Answer (Paper No. 19 mailed January 28, 2004) for the respective details.

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, the arguments in support of the rejection, and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Brief along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the

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particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 1-6, 11, 14, and 15. Accordingly, we affirm.

Appellants' arguments in response to the Examiner's rejection of the appealed claims are organized according to a suggested grouping of claims indicated at page 6 of the Brief. We will consider the appealed claims separately only to the extent separate arguments for patentability are presented. Any dependent claim not separately argued will stand or fall with its base claim. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived (see 37 CFR § 41.37(c)(1)(vii)).

As a general proposition in an appeal involving a rejection under 35 U.S.C. § 103, an Examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to Appellants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the

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relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039-40, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

With respect to independent claim 1, the representative claim for Appellants' first suggested grouping (including claims 1-6), Appellants' arguments in response to the Examiner's 35 U.S.C. § 103(a) rejection assert a failure to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art references. After careful review of the disclosure of Irons and Xerox in light of the arguments of record, we are in general agreement with the Examiner's position as stated in the Answer.

We find no error in the Examiner's assertion of obviousness (Answer, pages 3 and 4) to the skilled artisan of modifying the document scanning disclosure of Irons by adding Xerox's disclosed feature of embedding machine readable information on documents to enable a service to be performed on a scanned image of the document. In particular, Appellants' contrary arguments that no benefit would accrue to the user of Irons' system

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notwithstanding, it is our view that one of ordinary skill would have been motivated and found it obvious, for the reasons articulated by the Examiner, to utilize Xerox's disclosed signature verification feature (Xerox, page 2) in Irons, especially since Irons discloses the scanning of invoice forms with incorporated handwritten signatures.

We are further in agreement with the Examiner (Answer, pages 9 and 10) that Appellants' arguments in response to the obviousness rejection of claim 1 are not commensurate with the scope of the claim. As pointed out by the Examiner, although Appellants contend (Brief, page 9) that the embedded information in the incorporated document tag 400 in Irons does not call for services such as "scan and fax," "scan and send via e-mail," etc., no such required services are set forth in appealed claim 1. In actuality, the language of claim 1 requires only that decoded data from the document tag be associated with a service, i.e., one that is undefined and unidentified, and that such undefined and unidentified service be performed on the scanned image of the document. In our opinion, Appellants' arguments improperly attempt to narrow the scope of the claim by implicitly

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adding disclosed limitations which have no basis in the claim.  
See In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28  
(Fed. Cir. 1997).

With the above discussion in mind, our own independent review of the disclosure of Irons reveals that, in actuality, all of the limitations of claim 1 are present in the disclosure of Irons. As illustrated in the flow chart of Irons' Figure 7, along with the accompanying description beginning at column 12, lines 18 of Irons, a document is scanned and a user interface tag is located (775), the data represented in the tag is decoded and associated with a service and a user identity (780), and the specified service, i.e., electronic archiving or filing, is performed (785) on the image representative of the document. We fail to see why the operation of archiving or filing, as specified in the location indicated on the user tag, is not a "service," at least as broadly set forth in appealed claim 1.<sup>1</sup>

In view of the above discussion and analysis of the disclosure of the Irons reference, it is our opinion that,

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<sup>1</sup> We make the observation that Appellants' own arguments during prosecution of the instant application appear to support the interpretation of the filing or archiving operations described in Irons as the performance of a "service" on the scanned document image. At page 4 of the amendment filed April 30, 2002 (Amendment "A," Paper No. 8), Appellants state "[t]he Applicant [sic, Applicants] respectfully submits [sic, submit] that in Irons the service being performed is the indexing and filing of scanned documents themselves."

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although we found no error in the Examiner's proposed combination of Irons and Xerox as discussed supra, the Xerox reference is not necessary for a proper rejection of claim 1 since all of the claimed elements are in fact present in the disclosure of Irons. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974). Accordingly, for all of the above reasons the Examiner's 35 U.S.C. § 103(a) rejection of representative claim 1, as well as claims 2-6 not separately argued by Appellants and which fall with claim 1, is sustained.

Turning to a consideration of the Examiner's 35 U.S.C. § 103(a) rejection of independent claims 11, 14, and 15 based on the combination of Irons and Barton, we sustain this rejection as well. We note, initially, that, while previously discussed appealed claim 1 is directed to a service performed on an image of a hard copy document, claims 11, 14, and 15 are directed to a service performed on the hard copy document itself. As with the Examiner's rejection of claim 1 based on the combination of Irons

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and Xerox, we simply find no persuasive arguments from Appellants that convince us of any error in the Examiner's assertion of obviousness to the skilled artisan of combining the teachings of Barton with those of Irons. In our view, the skilled artisan would have been motivated and found it obvious, as set forth in the Examiner's line of reasoning (Answer, pages 6-8), to include coded routing information, as taught by Barton, on the hard copy document processed in Irons to direct proper disposition of the document.

We are also of the view that, as previously discussed with regard to the Examiner's proposed combination of Irons and Xerox with respect to claim 1, our own independent review of Irons reveals that the addition of Barton to Irons is not necessary for a proper rejection of claims 11, 14, and 15 since all of the claimed features are in fact present in the disclosure of Irons. As alluded to by the Examiner in the responsive arguments portion of the Answer at page 9, Irons discloses that, as part of the data encoded on the document tag, information indicative of instructions related to the disposal of the hard copy document is

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included. For example, Irons, at column 11, lines 22-26, discloses that "information on document disposition . . ." can be included in the coded portion of the document tag. Again, we fail to see, in the absence of any language defining the claimed performed service, why disposition of the hard copy document would not be considered a "service" performed on the hard copy document.

In summary, we have sustained the Examiner's 35 U.S.C. § 103(a) rejection of all of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-6, 11, 14, and 15 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(effective September 13, 2004; 69 Fed. Reg. 49960 (August 12, 2004); 1286 Off. Gaz. Pat. and TM Office 21 (September 7, 2004)).

AFFIRMED

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JOSEPH F. RUGGIERO	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
LANCE LEONARD BARRY	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
STUART S. LEVY	)	
Administrative Patent Judge	)	

JRF:hh

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