

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JONATHAN J. HULL and KURT W. PIERSOL

Appeal No. 2006-2986
Application No. 09/571,949

ON BRIEF

Before JERRY SMITH, SAADAT, and HOMERE, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-5, 8-16, 19-27, 30-38, 41-49 and 52-62.

Claims 6, 7, 17, 18, 28, 29, 39, 40, 50 and 51 have been cancelled.

The disclosed invention pertains to a method and apparatus for publication of unconsciously captured documents.

Representative claim 1 is reproduced as follows:

1. A method comprising:
 - selecting on an electronic system one or more documents from a set of unconsciously captured documents displayed as a search result in response to a search query, the search result by a user displayed with a button, which when activated, causes transmission of the selected one or more documents to a publicly accessible Web server; and
 - publishing the one or more documents in response to an activation on the button displayed within the search result by a user by sending the one or more documents to the publicly accessible Web server over a network separated from the electronic system.

The examiner relies on the following references:

Cullen et al.	(Cullen)	5,893,908	Apr. 13, 1999
Davis et al.	(Davis)	5,937,160	Aug. 10, 1999
Howerton et al.	(Howerton)	US2001/0049701	Dec. 6, 2001
		(claims priority from 09/325,251, filed June 3, 1999)	
Freeman et al.	(Freeman)	6,638,313	Oct. 28, 2003
			(filed Sep. 17, 1999)

The following rejections are on appeal before us:

1. Claims 1-5, 8-16, 19-27, 30-38, 41-49, 52-55, 57 and 61 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Freeman [answer, page 4].

2. Claim 56 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Freeman in view of Cullen [answer, page 13].
3. Claim 58 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Freeman in view of Howerton [answer, page 14].
4. Claims 59 and 60 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Freeman in view of facts within the personal knowledge of the examiner [answer, page 15].
5. Claim 62 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Freeman in view of Davis [answer, page 18].

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof. We note that because the reply brief is presented as a substitute brief (i.e., containing all the material submitted in the original brief, plus additional responses to the examiner's answer), we will generally refer to the reply brief infra.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and

obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer. 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 briefs have not been considered and are deemed to be waived. See 37 C.F.R.

§ 41.37(c)(1)(vii)(2004). See also In re Watts, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

It is our view, after consideration of the record before us, that the evidence relied upon by the examiner does not support the examiner's rejections of claims 8, 19, 30, 41, 52 and 58-60 but does support the examiner's rejections of claims 1-5, 9-16, 20-27, 31-38, 42-49, 53-57, 61 and 62. Accordingly, we affirm-in-part.

ANTICIPATION REJECTION (Freeman)

I. We consider first the anticipation of the following logical groups of claims, as separately argued by appellants in the briefs:

GROUP A: Claims 1, 12, 23, 34 and 45.

GROUP B: Claims 2, 13, 24, 35 and 46.

GROUP C: Claims 3, 14, 25, 36 and 47.

GROUP D: Claims 4, 15, 26, 37 and 48.

GROUP E: Claims 5, 16, 27, 38, 49 and 57.

GROUP F: Claims 8, 19, 30, 41 and 52.

GROUP G: Claims 9-11, 20-22, 31-33, 42-44, 53-55 and 61.

Claim 62

With respect to GROUP G we note that appellants have erroneously included claim 62 as part of this group in the briefs [brief, page 5, reply brief, page 5]. We note that the examiner has rejected claim 62 under 35 U.S.C. § 103 and not under 35 U.S.C. § 102 [see answer, pages 18 and 19]. See GROUP K infra.

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. Perricone v. Medicis Pharmaceutical Corp., 432 F.3d 1368, 1375-76, 77 USPQ2d 1321, 1325-26 (Fed. Cir. 2005), citing Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 1565, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992). 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.” Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). “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." In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (internal citations omitted). To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). Anticipation of a patent claim requires a finding that the claim at issue "reads on" a prior art reference. Atlas Powder Co. v. IRECO, Inc., 190 F.3d 1342, 1346, 51 USPQ2d 1943, 1945 (Fed. Cir. 1999) ("In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.") (internal citations omitted).

GROUP A, claims 1, 12, 23, 34 and 45

We consider the examiner's rejection of claims 1, 12, 23, 34 and 45 as being anticipated by Freeman. Since Appellants' arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will select independent claim 1 as the representative claim for

this rejection because it is the broadest independent claim. See 37 C.F.R. § 41.37(c)(1)(vii)(2004).

Appellants argue that Freeman fails to disclose publishing one or more unconsciously captured documents in response to an activation of a control or button displayed within the search result where the activation of the control or button sends the selected one or more documents to a publicly accessible server (e.g., a server other than the system displaying the search result), such that everyone can access the published documents [reply brief, page 7]. Appellants acknowledge that Freeman discloses automatic archiving, but assert that archived documents are not the same as unconsciously captured documents [reply brief, page 8]. Appellants argue there is no transmission of a document within Freeman from a first computer to a publicly accessible server over a network in response to an activation of a control or button displayed within a search result listing a set of unconsciously captured documents [reply brief, page 9, cont'd page 10].

The examiner disagrees [answer, page 20]. The examiner points out that Freeman discloses a multi-server architecture (col. 14, lines 21-24) where a stream may be placed on the Internet as a web site [id.]. The examiner asserts that such web sites are publicly accessible [id.]. The examiner argues that Freeman discloses unconsciously captured documents in the form of documents that are automatically archived into streams,

pointing to col. 2, lines 21-41 [id.]. The examiner notes that Freeman allows a user to search for particular documents from a set of documents (i.e., a document stream) where a substream is generated that contains the documents meeting the search criteria [answer, page 21]. The examiner asserts that the “Xfer” button allows a user to copy documents from one stream to a second stream embodied as a publicly accessible web site [answer, page 22]. Likewise, the examiner asserts that Freeman’s “Clone” button can also be used to move documents to a stream that functions as a web site [id.]. The examiner further asserts that the user may copy selected documents from one stream and place the documents into a “web site” stream when the user is in the web site management mode [id.].

We begin by construing the meaning and scope of the recited term: “unconsciously captured documents” [claim 1]. We note that the Court of Appeals for the Federal Circuit has determined that “the specification ‘acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication.’” Phillips v. AWH Corp., 415 F.3d 1303, 1321, 75 USPQ2d 1321, 1332 (Fed. Cir. 2005) (en banc) (internal citations omitted). In the instant case, we note that appellants have provided a definition for the term “unconscious capture” in the specification at page 12, lines 19 through page 13, line 6, as shown infra:

Unconscious Capture

Unconscious capture is an operation in which a device (e.g., FMA 150) requests an archiving device (e.g., data storage device 140) to archive a document. In general, unconscious capture refers to FMA 150, or other device, automatically capturing documents processed by network 100 or devices coupled to network 100 without user intervention. In one embodiment, a user can optionally prevent capture of one or more documents or modify which documents are automatically captured.

Unconscious capture can be performed by any network entity or device. In one embodiment, unconscious capture utilizes standard Internet protocols and allows the capture of multiple files associated with a single document. In another embodiment, simultaneous capture of multiple documents is supported.

When we consider the meaning and scope of the recited “unconsciously captured documents” in accordance with the definition set forth in the instant specification, we find that the language of the claim is met by Freeman’s disclosure of automatic archiving and file storage that is transparent to the user [col. 2, lines 25-28 and lines 39-40]. We also agree with the examiner that Freeman discloses publishing one or more unconsciously captured documents in response to an activation of a button displayed within the search result where the activation of the control or button sends the selected one or more documents to a publicly accessible server. We note that Freeman discloses lists of time-ordered documents referred to as “streams” [col. 4, lines 9-14]. We note that Freeman explicitly discloses a search query to find documents [col. 4, line 53]. We

further note that Freeman explicitly discloses: "streams are used as Web sites" [col. 9, line 48]. We further note that Freeman explicitly discloses a "user-managed web site embodiment" [col. 10, line 31]. Therefore, we find the weight of the evidence supports the examiner's position that Freeman's transfer operation (and associated "Xfer" button shown in fig. 1) copies a document from one stream to another stream where publishing to a web site is effected when the target stream of documents is implemented as a web site [see col. 4, lines 43-45]. With respect to the issue of whether transmission of the selected documents is to a publicly accessible web server, we note that Freeman explicitly discloses: (1) "Streams of the present invention are designed to work with conventional World Wide Web browsers" [col. 13, lines 22 and 23] and, (2) "visitors can be given customized access levels so that friendly visitors [to the personal web site] get to see more" [col. 13, lines 19 and 20]. Therefore, we find that the breadth of Freeman's disclosure supports at least some level of public access to Internet web sites, as argued by the examiner. We note that Freeman also discloses "a client/sever architecture running over the Internet" [col. 6, line 13]. We find that Freeman's disclosure of a client/sever architecture supports the examiner's contention that transmission between different computer systems is effected, e.g., between clients and servers. In particular, we note that the client computers in Freeman's document stream

operating system “need not be independent data storage devices, but also act as ‘viewpoints’ to data stored and maintained on external systems such as the INTERNET” [Freeman, col. 2, lines 56-60]. Because we find that Freeman teaches all that is claimed, we will sustain the rejection of representative claim 1 as being anticipated by Freeman for essentially the same reasons argued by the examiner. We note that appellants have not presented any substantive arguments directed separately to the patentability of independent claims 12, 23, 34 and 45. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). See also 37 C.F.R. § 41.37(c)(1)(vii)(2004). Therefore, we will also sustain the examiner’s rejection of independent claims 12, 23, 34 and 45 as being anticipated by Freeman for the same reasons set forth in the rejection and in the discussion above.

GROUP B, claims 2, 13, 24, 35 and 46

We consider next the examiner’s rejection of claims 2, 13, 24, 35 and 46 as being anticipated by Freeman. Since Appellants’ arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will consider dependent claim 2 as the representative claim for this rejection. See 37 C.F.R. § 1.37(c)(1)(vii)(2004).

Appellants argue that Freeman's "New" or "Clone" buttons do not teach a single click operation of a button within the search result that sends the selected unconsciously captured documents to a publicly access server for publication [reply brief, page 12].

In response, the examiner disagrees [answer, page 23]. The examiner argues that both the "Xfer" and "Clone" buttons allow the user to send the user-selected documents to the web site stream [id.].

We agree with the examiner that a user click of the "Clone" button will duplicate an existing document and add the duplicate to a stream and will also effect publishing (i.e., copying) to a stream implemented as a web site, as discussed supra with respect to claim 1 [see Freeman, col. 4, lines 41-43; col. 6, lines 64-65]. We note that appellants have failed to address the "Xfer" button with respect to this rejection in the briefs. We also agree with the examiner that a user click of the "Xfer" button will copy an existing document and add the copy to a stream and will also effect publishing (i.e., copying) to a stream implemented as a web site, as discussed supra with respect to claim 1 [see Freeman, col. 4, lines 43-45]. Accordingly, we will sustain the examiner's rejection of dependent claim 2 as being anticipated by Freeman. Because dependent claims 13, 24, 35 and 46 each contain essentially equivalent limitations, we will also sustain the examiner's rejection of these claims as being anticipated by Freeman.

GROUP C, claims 3, 14, 25, 36 and 47

We consider next the examiner's rejection of claims 3, 14, 25, 36 and 47 as being anticipated by Freeman. Since Appellants' arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will consider dependent claim 3 as the representative claim for this rejection. See 37 C.F.R. § 41.37(c)(1)(vii) (2004).

Appellants argue that the cited sections of Freeman are related to a voice interface using a phone to manipulate the objects [reply brief, page 13]. Appellants further argue that there is no disclosure or suggestion within Freeman that the voice interface can be used to publish by sending a document to a publicly accessible server over a network [id.].

The examiner disagrees [answer, pages 23 and 24]. The examiner asserts that the "Xfer" button and the "Clone" button disclosed in Freeman allow the user to send the user-selected documents to the web site stream [answer, page 24].

We note that Freeman explicitly discloses: "A stream according to the present invention can be controlled by a voice-interface as well as a computer and thereby be accessed via a conventional phone" [col. 11, lines 43-45]. We note that we have found supra that Freeman discloses publishing a document to a publicly accessible server over a network [see

GROUP A, discussion of claim 1]. Therefore, we agree with the examiner that Freeman discloses a voice interface that can control the transmission of one or more documents to a document stream that is implemented as a web site. Accordingly, we will sustain the examiner's rejection of dependent claim 3 as being anticipated by Freeman. Because dependent claims 14, 25, 36 and 47 each contain essentially equivalent limitations, we will also sustain the examiner's rejection of these claims as being anticipated by Freeman.

GROUP D, claims 4, 15, 26, 37 and 48

We consider next the examiner's rejection of claims 4, 15, 26, 37 and 48 as being anticipated by Freeman. Since Appellants' arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will consider dependent claim 4 as the representative claim for this rejection. See 37 C.F.R. § 41.37(c)(1)(vii) (2004).

Appellants argue that Freeman does not teach dragging and dropping to select one or more documents to a designated area of the display prior to sending the selected documents for publication [reply brief, pages 14 and 15.]. Appellants acknowledge that Freeman discloses grouping of the documents when creating a sub-stream (see, e.g., Freeman, col. 8, lines 32-41) [id.]. However, appellants assert that such a grouping is unrelated to publishing the grouped documents [id.].

The examiner disagrees [answer, pages 24 and 25]. The examiner asserts that Freeman's "Xfer" and "Clone" buttons both allow the user to send the selected documents to the web site stream [id.]. Thus, the examiner concludes that the grouped (i.e., user-selected) documents are published [id.].

We note that we have found supra that Freeman discloses publishing a document to a publicly accessible server over a network [see GROUP A, discussion of claim 1]. In the rejection of representative claim 4, we note that the examiner relies upon Freeman's disclosure of documents that are specifically selected by the user and placed into a new substream (col. 8, lines 32-41 and col. 14, lines 40-53) [answer, page 7]. The examiner further points out that Freeman's document stream system operates within a WINDOWS environment, from which the examiner infers that "drag and drop" operations for manipulating objects are supported by the WINDOWS graphical user interface [id.]. Thus, the examiner asserts that the breadth of Freeman's disclosure supports an operation where documents selected by the user are "dragged and dropped" into a "dedicated field" before the documents are published [id.].

We note that Freeman explicitly discloses a document stream system that in one embodiment utilizes the WINDOWS operating system where the user marks and selects documents [col. 14, line 48; col. 8, line 33]. After

carefully considering all of the evidence before us, we find that appellants have failed to adequately rebut the examiner's finding that grouped (i.e., user-selected) documents are published. Accordingly, we will sustain the examiner's rejection of dependent claim 4 as being anticipated by Freeman for essentially the same reasons argued by the examiner in the answer. Because dependent claims 15, 26, 37 and 48 each contain essentially equivalent limitations, we will also sustain the examiner's rejection of these claims as being anticipated by Freeman.

GROUP E, claims 5, 16, 27, 38, 49 and 57

We consider next the examiner's rejection of claims 5, 16, 27, 38, 49 and 57 as being anticipated by Freeman. Since Appellants' arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will consider dependent claim 5 as the representative claim for this rejection. See 37 C.F.R. § 41.37(c)(1)(vii) (2004).

Appellants argue that Freeman fails to disclose a search conducted using certain attributes in a database having both unconsciously captured documents and regular documents, where only the unconsciously captured documents are published [reply brief, page 15]. Appellants further argue that Freeman fails to disclose the manipulation of any unconsciously

captured documents [id.]. Appellants argue that the term “unconsciously captured documents” is defined in the instant specification [id., page 16].

The examiner disagrees [answer, pages 25 and 26]. The examiner argues that Freeman automatically archives documents into streams, with no action required by the user [answer, page 25]. The examiner again asserts that Freeman allows the user to publish user-selected documents that are selected from a group of unconsciously captured documents to a web site stream [id.].

We note that Freeman explicitly discloses: “streams may be created on demand and documents may belong to as many streams as seems reasonable or to none” [col. 2, lines 37-39; emphasis added]. Therefore, we find that Freeman discloses the “regular documents” argued by appellants (i.e., not belonging to a stream – corresponding to the instant claimed “consciously captured documents”). We note that Freeman discloses the result of a search query is a stream “view” that contains all documents that are relevant to the search query [col. 4, lines 53-60]. We further note that Freeman discloses the use of Boolean attributes in the context of the “find” search query operation [col. 4, line 67, cont’d col. 5, line 1]. After carefully considering all of the evidence before us, we again find that appellants have failed to adequately rebut the examiner’s finding that Freeman allows the user to publish user-selected documents that are selected from a group of

unconsciously captured documents to a web site stream. Accordingly, we will sustain the examiner's rejection of dependent claim 5 as being anticipated by Freeman for essentially the same reasons argued by the examiner in the answer. Because dependent claims 16, 27, 38, 49 and 57 each contain essentially equivalent limitations, we will also sustain the examiner's rejection of these claims as being anticipated by Freeman.

GROUP F, claims 8, 19, 30, 41 and 52

We consider next the examiner's rejection of claims 8, 19, 30, 41 and 52 as being anticipated by Freeman. Since Appellants' arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will consider dependent claim 8 as the representative claim for this rejection. See 37 C.F.R. § 41.37(c)(1)(vii) (2004).

Appellants argue that claim 8 requires that the organization running the publicly accessible server is different than the organization hosting or storing the unconsciously captured documents being searched, according to access terms negotiated between the two organizations [reply brief, page 16]. Appellants assert that the sections of Freeman cited by the examiner are related to opening a web interface of a server to allow a user to view the stream of documents over the Internet [reply brief, page 17]. Appellants argue that there is no disclosure or suggestion within Freeman that the

computer storing the documents being searched and the server that publishes the selected documents are operated by different organizations [id.].

The examiner disagrees [answer, page 26]. The examiner notes that Freeman's system utilizes a multi-server architecture [id.; see also Freeman col. 14, line 22]. The examiner asserts that Freeman discloses automatically archiving documents into streams and also allowing the user to publish user-selected documents from the streams to a web site stream [answer, page 26]. The examiner concludes that Freeman implies the streams are stored at one server from which the documents are selected and the server for publishing the user-selected documents is a different server [id.].

In response, we do not agree with the examiner's conclusion that Freeman's use of multiple servers implies (i.e., suggests) that operationally independent organizations are associated with each server. We note that to sustain the examiner on this point would require speculation on our part. Even if we assume arguendo that the examiner's contention is correct, we note that a mere suggestion in a reference is not sufficient for an anticipation rejection. In the alternative, if the examiner is arguing inherency, we note that our reviewing court has clearly stated: "[i]nherency, however, may not be established by probabilities or possibilities." In re Robertson, 169 F.3d at 745, 49 USPQ2d at 1950-51 (internal citations

omitted). Therefore, we find that the portion of the reference relied upon by the examiner fails to provide the support necessary to affirm. Accordingly, we will reverse the examiner's rejection of dependent claims 8, 19, 30, 41 and 52 as being anticipated by Freeman.

GROUP G, claims 9-11, 20-22, 31-33, 42-44, 53-55 and 61

We consider next the examiner's rejection of claims 9-11, 20-22, 31-33, 42-44, 53-55 and 61 as being anticipated by Freeman. As noted supra, we note that appellants erroneously included claim 62 in this group in the briefs [brief, page 5, reply brief page 5]. We note that claim 62 is addressed under Group K infra. Since Appellants' arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will consider claim 9 as the representative claim for this rejection. See 37 C.F.R. § 41.37(c)(1)(vii) (2004).

Appellants argue that claim 9 requires when the selected documents are published, a link linking to the publicly accessible server is generated and stored, such that a user can subsequently use the link to access the published documents [reply brief, page 18]. Appellants assert that this limitation is not taught by Freeman [id.]. Appellants acknowledge that Freeman discloses a hyperlink, however, appellants assert that the purpose of Freeman's link is not for publication of an unconsciously captured document [id.].

The examiner disagrees [answer, page 27]. The examiner restates the argument that Freeman automatically archives documents into streams, with no action required by the user [answer, page 27]. The examiner again argues that Freeman allows the user to publish user-selected documents selected from a group of unconsciously captured documents to a web site stream [id.]. The examiner specifically points out that Freeman discloses generating hyperlinks for streams, as expressly indicated at col. 13, lines 1-12 [id.].

We again note that we have found supra that Freeman discloses publishing a document to a publicly accessible server over a network [see GROUP A, discussion of claim 1]. We further note that Freeman explicitly discloses the use of a hyperlink, as pointed out by the examiner [col. 13, line 8]. Therefore, we agree with the examiner that Freeman discloses “generating a link to the one or more published documents” and “placing the link in a storage of the electronic system to allow a user to obtain the link to access the published documents on the Web server via the link,” as claimed [claim 9]. Accordingly, we will sustain the examiner’s rejection of dependent claim 9 as being anticipated by Freeman for essentially the same reasons argued by the examiner in the answer. We note that appellants have not presented any substantive arguments directed separately to the patentability of dependent claims 10, 11, 20-22, 31-33, 42-44, 53-55 and 61. See In re

Nielson, 816 F.2d at 1572, 2 USPQ2d at 1528. See also

37 C.F.R. § 41.37(c)(1)(vii)(2004). Therefore, we will also sustain the examiner's rejection of these claims as being anticipated by Freeman for the same reasons set forth in the rejection and the discussion above.

OBVIOUSNESS REJECTIONS

II. We consider next the obviousness of the following logical groups of claims, as separately argued by appellants in the briefs:

- GROUP H:** Claim 56.
- GROUP I:** Claim 58.
- GROUP J:** Claims 59 and 60.
- GROUP K:** Claim 62.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343, 61 USPQ2d at 1433-34.

The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000)). See also In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir.

1992). If that burden is met, the burden then shifts to the applicant 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 relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 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).

GROUP H, claim 56

We consider the examiner's rejection of claim 56 as being unpatentable over the teachings of Freeman in view of Cullen [answer, pages 13 and 14].

Appellants argue that there is no suggestion to combine Freeman and Cullen [reply brief, page 19]. Appellants assert that Cullen is related to capturing an image of a document while Freeman is related to managing a stream of documents [id.]. Appellants argue it is improper to combine Freeman with Cullen because these two references do not need the features of the other [id.].

The examiner disagrees [answer, page 28]. The examiner asserts that an artisan would have been motivated to modify Freeman's document stream system with Cullen's teaching of physical documents that are scanned into an electronic filing system [id.]. The examiner proffers that an

artisan would be motivated so that physical documents could be added to Freeman's electronic document system for the purpose of facilitating electronic document filing to enable users to subsequently search and retrieve the physical documents electronically [id.].

We note Cullen explicitly discloses that for every document copied, copy machine 104 captures digital information representing the document [col. 3, lines 35-37]. Therefore, we agree with the examiner that this advantage would facilitate electronic document filing to enable users to subsequently search and retrieve the physical documents electronically. Accordingly, we will sustain the examiner's rejection of claim 56 for essentially the same reasons argued by the examiner in the answer.

GROUP I, claim 58

We consider next the examiner's rejection of dependent claim 58 as being unpatentable over the teachings of Freeman in view of Howerton [answer, pages 14 and 15]. We note that claim 58 depends upon claim 8 that further depends upon independent claim 1. We note that we have reversed the examiner's rejection of dependent claim 8 supra. Therefore, we will also reverse the examiner's rejection of claim 58 as being obvious over Freeman in view of Howerton because dependent claim 58 contains all the limitations of claim 8.

GROUP J, claims 59 and 60

We consider next the examiner's rejection of claims 59 and 60 as being unpatentable over the teachings of Freeman in view of the examiner's personal knowledge [answer, pages 15-18].

Appellants assert that it is improper for the examiner to reject a claim based on the examiner's personal knowledge [reply brief, page 21]. We note that 37 C.F.R. § 1.104(d)(2) sets forth the requirements with respect to a rejection where the examiner relies upon personal knowledge:

(2) When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

In the instant case, we note that appellants have not called for the examiner to provide an affidavit to support the examiner's reliance upon personal knowledge. However, we note that our reviewing court has stated: "[w]ith respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings." In re Zurko,

258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See also

MPEP § 2144.03(C):

If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding.

Therefore, we decline to consider the examiner's personal knowledge as evidence because the examiner has failed to provide an affidavit or declaration setting forth specific factual statements with an explanation to support the finding of record. Accordingly, we will pro forma reverse the examiner's rejection of dependent claims 59 and 60.

GROUP K, claim 62

Lastly, we consider the examiner's rejection of claim 62 as being unpatentable over the teachings of Freeman in view of Davis [answer, pages 18 and 19].

Appellants argue that Freeman does not disclose authenticating a user at a publicly accessible server who is about to publish an unconsciously captured document [reply brief, page 22]. Appellants assert that Davis is related to authenticating an email having a hyperlink to a server hosting the content of the hyperlink (see Abstract of Davis) [id.]. Appellants argue that Davis is not related to publishing a document, particularly, an unconsciously captured document [id.].

In response, the examiner agrees that Davis does not teach publishing an unconsciously captured document [answer, page 32]. However, the examiner notes that Davis is not relied upon to teach this limitation [id.]. The examiner maintains that Freeman discloses this limitation, as indicated in the rejection for claim 1 [id.].

We note that we have found supra that Freeman discloses publishing unconsciously captured documents [see GROUP A, discussion of claim 1]. We note that appellants have not traversed the examiner's finding that Freeman inherently teaches specifying a location of a web server with a URL associated with the web server, as required by the language of claim 62. We agree with the examiner that the cited portion of Davis discloses performing authentication of a user with respect to a web server [see Davis, col. 8, lines 40-59, col. 9, lines 19-26]. We further note that appellants have failed to traverse the examiner's proffered motivation setting forth why an artisan would be led to modify Freeman with the teachings of Davis. Therefore, we agree with the examiner that the combination of Freeman and Davis teaches all that is claimed. Accordingly, we will sustain the examiner's rejection of claim 62 for essentially the same reasons set forth by the examiner in the rejection.

In summary, we have sustained the examiner's rejections of claims 1-5, 9-16, 20-27, 31-38, 42-49, 53-57, 61 and 62 in view of the prior art of

record, but we have not sustained the examiner's rejection of claims 8, 19, 30, 41, 52 and 58-60. Therefore, the decision of the examiner rejecting claims 1-5, 8-16, 19-27, 30-38, 41-49 and 52-62 is affirmed-in-part.

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-IN-PART

JERRY SMITH
Administrative Patent Judge

MAHSHID D. SAADAT
Administrative Patent Judge

JEAN R. HOMERE
Administrative Patent Judge

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