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 Steven C. Johnson and Shane R. Konsella

Appeal No. 2006-3134
Application No. 10/157,603
Technology Center 2100

ON BRIEF

Before KRASS, DIXON, and BLANKENSHIP, *Administrative Patent Judges.*

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-37, which are all of the claims pending in this application.

We REVERSE-in-PART, AFFIRM-in-PART and enter a NEW GROUND OF REJECTION under 37 C.F.R. § 41.50(b).

BACKGROUND

The Appellants' invention relates to a method and apparatus for formatting documents. An understanding of the invention can be derived from a reading of exemplary claim 1 which is reproduced below.

> 1. A processor-readable medium comprising processor executable instructions configured for:
>
> receiving an electronic document from a device;
>
> receiving processing instructions from the device, the processing instructions being associated with the electronic document and containing information regarding how to process the electronic document;
>
> reformatting the electronic document pursuant to the information contained in the processing instructions; and
>
> providing the reformatted electronic document to a destination device.

PRIOR ART

The prior art reference of record relied upon by the Examiner in rejecting the appealed claims is:

Sahota et al. (Sahota)	2001/0056460 A1	December 27, 2001

REJECTIONS

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants regarding the above-noted rejections, we make reference to the Examiner's answer (mailed May 12, 2006) for the reasoning in support of the rejection, and to Appellants' brief (filed Mar. 6, 2006) and reply brief (filed Jul. 12, 2006) for the arguments thereagainst.

Claims 1-37 stand rejected under 35 U.S.C. § 102 as being anticipated by Sahota.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by Appellants and the Examiner. As a consequence of our review, we make the determinations that follow.

We note that Appellants have indicated three separate headings to address three groupings of claims. We will address the representative claims 1, 8, and 13 from each of the groupings.

35 U.S.C. § 102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it." While all elements of the claimed invention must appear in a single reference, additional references may be used to interpret the anticipating reference and to shed light on its meaning, particularly to those skilled in the art at the relevant time. See Studiengesellschaft Kohle v. Dart Indus., Inc., 726 F.2d 724, 726-727, 220 USPQ 841, 842-843 (Fed. Cir. 1984).

We must point out, however, that anticipation under 35 U.S.C. § 102 is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

With respect to independent claim 1, Appellants argue that "Sahota does not teach or suggest receiving a document and processing instructions associated with that document from the same device" (Br. 6). [Emphasis added.]

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations as recited in independent claim 1. We agree with Appellants that the claimed invention requires that the same "device" that sends the electronic document must also be the same device that sends the processing instructions which are associated with the electronic document and contain information regarding how to process the electronic document.

At the outset, we note that it is quite difficult to follow the Examiner's rejection since the Examiner mentions many devices, sources of content and devices which process or reformat content for each element and then merely states "compare to. . . ." This is not sufficient to clearly set forth the Examiner's position. If we cannot understand the Examiner's correlation as to what teachings of Sahota teach each of the separate claimed elements of the instant claim, then how can we expect Appellants to understand and provide effective prosecution of the instant application? Additionally, we find that the Examiner does not respond to Appellants' arguments, but merely cuts and pastes the same language from the rejection. If the Examiner's position was not clear the first time, it does not clarify the record by merely restating the same language without rephrasing or clarification. A large problem seems to be that the Examiner seems to find various similar steps within the system of Sahota and then tries to piece them together to reject the claims. This is not sufficient to establish a prima facie case of anticipation (or obviousness).

The Examiner maintains that the content harvest and conversion platform provides processing instructions for the syndication server which transforms or reformats the electronic document (Answer 4, ll. 14-15). The Examiner maintains that the content harvest and conversion platform uses templates to harvest content from disparate content sources on multiple platforms. (Answer 4, l. 22- 5, l. 2). Here, the Examiner is correlating the disparate sources as to the device where the electronic document is received from. The Examiner does not give a specific correlation of the element in Sahota that meets the claimed first limitation.

Next, the Examiner maintains that the syndication server transforms or reformats the electronic document using processing instructions from the content harvest and conversion platform (Answer 5, ll. 15-16). This means that the content harvest and conversion platform must be the device from which the content is provided to meet the claim limitations. Next the Examiner discusses that content engine as generating code and instructions to exploit platforms and devices (Answer 5-6 and 22).

Next, the Examiner maintains that the content engine dynamically composes content for the syndication server (Answer 5-6) which implies that the same device receives the content generates the instruction and reformats the content. Therefore, the instructions are not received, but they are arguably associated with the electronic document.

The Examiner then maintains that the syndication server transforms an HTML web page into an XML file or document as the step of providing the reformatted document to a destination device. There is no “providing” in the Examiner’s correlation step, but now the Examiner indicates that the syndication server does the reformatting.

We find the Examiner’s correlation of elements in Sahota to the claim limitations and the responsive arguments to be confusing, and we cannot find that the Examiner has met the initial burden of establishing a prima facie case of anticipation. We note that we are not finding that Sahota CANNOT be used to establish a prima facie case of anticipation (or obviousness), but that the Examiner has not set forth prima facie case of

anticipation (or obviousness) in the written record before this panel. Therefore, we will not sustain the Examiner rejection of independent claim 1 and its dependent claims.

Similarly, with respect to independent claim 8, Appellants argue that "Sahota does not teach or suggest receiving a document reference and processing instructions associated with that document from the same device" (Br. 6 and 9). We do not find that the Examiner has set forth a prima facie case of anticipation since the Examiner merely relied upon the statement of the rejection for independent claim 1 which does not address the use of a reference for an electronic document and use thereof to retrieve the electronic document (Answer 8).

With respect to independent claim 13, Appellants argue that Sahota fails to teach or suggest "communicating an electronic document and processing instructions associated with the electronic document to a document formatting system (Br. 6 and 11). Here, we find that independent claim 13 does not contain the same limitation as discussed above, yet Appellants seem to also rely upon the "same device" argument. We cannot agree with Appellants and find that the Examiner has set forth a clearer argument and correlation of the claim limitations. We note that the instant claim language does not contain clear express or functional references that establish processing interrelationships as with the "same device" as with independent claims 1 and 8. The Examiner sets forth the interpretation of the teachings of Sahota at pages 10-12. Here, we find that the Examiner's correlation is sufficient to show that Sahota teaches the invention as recited in independent claim 13 and has established a prima facie case of anticipation. Therefore, we look to Appellants' briefs for rebuttal. We find only a brief argument at pages 11-12 of the Appeal brief and no argument in the Reply brief. Therefore, we find that Appellants have not shown error in the prima facie case of anticipation, and we will sustain the rejection of independent claim 13 and its dependent claims 14-16 and independent claim 31 which Appellants elected to group therewith.

Additionally, with respect to independent claim 13, we find that the claim does not require a same device from which the document is received. Additionally, we note that independent claim 13 is an apparatus with instructions, but no express/required sequence

in the instructions. Sahota teaches that the content harvest and conversion platform can be software modules [0035] which would have instructions for acquiring content and providing that content and generated reformatting instructions to the syndication server which reformats the electronic document and sends the reformatted electronic document to the set top box. Therefore, we find that Sahota teaches the invention recited in independent claim 13.

NEW GROUND OF REJECTION

With all of this said, we find that the Examiner has not set forth a prima facie case of anticipation of independent claim 1, but we do find that Sahota teaches the invention as recited in independent claim 1 and we will delineate this interpretation and application of Sahota as a NEW GROUND OF REJECTION.

We find that in Sahota, when the content harvest and conversion platform is interpreted as the "device" and the syndication server is the reformatting processor, and the set-top box or display is the destination device, then independent claim 1 reads on Sahota. The content harvest and conversion platform retrieves electronic documents from various sources and provides them to the syndication server. The content harvest and conversion platform device from which documents are received and the content harvest and conversion platform also provides processing instructions. The syndication server reformats the electronic document when the content harvest and conversion platform and syndication server are distinct elements [Sahota 0034-0035]. The syndication server then provides the reformatted electronic document to the set-top box/display. Therefore, we find that Sahota teaches the invention recited in independent claim 1. We leave it to the Examiner to further evaluate the propriety of applying the similar interpretation to the other independent claims.

With respect to independent claim 8, we leave it to the Examiner to consider and formulate a rejection based on Sahota, if appropriate, since the Examiner has not formulated a rejection in the answer that addresses the use of a document reference rather than the electronic document.

CONCLUSION

To summarize, we have reversed the rejections of claims 1-12, 17-30, and 32-37 under 35 U.S.C. § 102 and sustained the rejection of claims 13-16 and 31 under 35 U.S.C. § 102 and made a new ground of rejection of independent claim 1.

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
>
> (2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.1369(a) (1) (iv).

REVERSED-in-PART, AFFIRMED-in-PART
37 C.F.R. § 41.50(b)

ERROL A. KRASS Administrative Patent Judge	)
JOSEPH L. DIXON Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
HOWARD B. BLANKENSHIP Administrative Patent Judge	)

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