UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERCAN E. KURUOGLU, ALEX S. TAYLOR,
MAURITIUS SEEGER, and STUART A. TAYLOR

Appeal 2007-0666
Application 09/738,992
Technology Center 2100

Decided: September 6, 2007

Before JOHN C. MARTIN, LANCE LEONARD BARRY, and JAY P. LUCAS, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-22. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

The invention at issue on appeal "provides a collaborative annotation technique in which users can make handwritten annotations to original paper documents." (Specification 2.) According to the technique, each user employs a device to capture a digital image of a paper document including any handwritten annotations thereon. The image is processed to extract images corresponding to the annotations, and the extracted images are distributed to the other users for display. Each user may, therefore, view a combined image of the document on which the individual annotations are overlaid. Because users prefer to handle, and to make annotations on, a paper document rather than on an electronic representation thereof, assert the Appellants, theirs is "the most convenient technique for a user." (*Id.*)

B. CLAIM

Claim 1, which further illustrates the invention, follows.

> 1. A system for permitting collaborative annotation of a hardcopy document, the system comprising:
>
> a plurality of workstations each comprising a computer processor, a display, and a capture device for capturing a digital image of a hardcopy document; and
>
> a base computer communicating with the plurality of workstations;
>
> wherein the system is operative to:
>
> (a) identify handwritten annotations in digital images of the hardcopy document captured at each workstation;

> (b) communicate data representing the identified annotation images to each workstation to permit an annotation entered at a first workstation to the hardcopy document and an annotation entered at a second workstation to the hardcopy document to be distributed to the plurality of workstations;
>
> (c) use the data representing the identified annotations for display with the digital images of the hardcopy document at the plurality of workstations according to display criteria for each workstation; and
>
> (d) display the digital images of the hardcopy document at the workstations with one or more of the identified annotations entered at the first and second workstations;
>
> wherein the one or more of the annotations are selectively displayed in accordance with the display criteria for each workstation.

C. REJECTIONS

Claims 1-6, 8-17, and 19-22 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,781,727 ("Carleton"); U.S. Patent No. 6,054,990 ("Tran"); U.S. Patent No. 6,351,777 ("Simonoff"); and U.S. Patent No. 5,692,073 ("Cass"). Claims 7 and 18 stand rejected under § 103(a) as obvious over Carleton; Tran; Simonoff; Cass; and U.S. Patent No. 5,680,636 ("Levine").

II. ISSUE

Rather than reiterate the positions of the parties *in toto*, we focus on an issue therebetween. The Examiner makes the following admission about Carleton and assertion about Simonoff.

> Carleton in view of Tran doesn't expressly teach, but Simonoff teaches *communicate data representing the identified annotation images to each workstation to permit an annotation entered at a first workstation to the hardcopy document and an annotation entered at a second workstation to the hardcopy document to be distributed to the plurality of workstations*. For example, Simonoff discloses users at dissimilar computers can annotate the information presented to all users (col 1, lines 20-25).

(Answer 4.) He adds the following assertions about Cass.

> Cass further discloses the claimed limitation of *communicate data representing the identified annotation images to each workstation*. For example, Cass discloses in Fig 14, an instance of a document (item 700) where the user wants to input to an image of a document that was faxed to the processor and is unmarked (col 14, lines 25-30), and Fig 15 shows an instance (item 800') of document (item 700) which is a marked instance (item 810, item 820) of the document (col 14, lines 31-40). Cass further discloses a user situated at a fax machine located remotely to a host computer that is in connection with the web, where the computer runs software to support the Paper Web browser. The computer retrieves a Web page and faxes a hardcopy to the retrieved page to the user. The user marks the hardcopy (i.e., circles, underlines or other drawings) and then the user faxes the hardcopy marked back to the computer (col 16, lines 50-64; Fig 20 shows the printed web page marked by the user). Once the marked copy is saved as a document, another user can come later on and retrieve the web page and generate the hardcopy of the retrieved page that was marked by

> a previous user and fax the hardcopy back to the computer which is saved with the most recent user's marks.

(*Id.* 21.) The Appellants argue, "Simonoff discloses a system where annotations are shared that are made to an electronic white board." (Br. 12.) They also argue that "the examples of Cass cited in the Examiner's Answer on page 21 . . . are directed to a method for using arbitrary documents as computer readable forms. . . ." (Reply Br. 2.) Therefore, the issue is whether teachings from Carleton, Tran, Simonoff, Cass, and Levine would have suggested transmitting, to each of a plurality of workstations, data representing handwritten annotations that were made to a paper document via at least two of the workstations, and displaying at least one of the handwritten annotations at each of the workstations.

"Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. . . . The second step in the analyses requires a comparison of the properly construed claim to the prior art." *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933, 69 USPQ2d 1283, 1286 (Fed.Cir. 2003) (internal citations omitted).

III. CLAIM CONSTRUCTION

"Our analysis begins with construing the claim limitations at issue." *Ex Parte Filatov*, No. 2006-1160, 2007 WL 1317144, at *2 (B.P.A.I. 2007). "The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1031, 1034 (Fed. Cir.

1994) (citing *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983)).

Here, claim 1 recites in pertinent part the following limitations:

> (a) identify handwritten annotations in digital images of the hardcopy document captured at each workstation;
>
> (b) communicate data representing the identified annotation images to each workstation to permit an annotation entered at a first workstation to the hardcopy document and an annotation entered at a second workstation to the hardcopy document to be distributed to the plurality of workstations;
>
> (c) use the data representing the identified annotations for display with the digital images of the hardcopy document at the plurality of workstations according to display criteria for each workstation; and
>
> (d) display the digital images of the hardcopy document at the workstations with one or more of the identified annotations entered at the first and second workstations . . . .

Claims 11 and 12 include similar limitations. Considering all the limitations, the independent claims require transmitting, to each of a plurality of workstations, data representing handwritten annotations that were made to a paper document via at least two of the workstations, and displaying at least one of the handwritten annotations at each of the workstations.

IV. OBVIOUSNESS ANALYSIS

"Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious." *Ex Parte Massingill*, No. 2003-0506, 2004 WL 1646421, at *3 (B.P.A.I 2004). "In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden

of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "'A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.'" *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, a part of Simonoff cited by the Examiner, (Answer 5), explains that the reference " provide[s] . . . a machine readable code stored in memory for converting a general purpose computer system into a dedicated White Board system facilitating collaboration between a plurality of users." (Col. 7, ll. 3-6.) "[E]xecution of the machine readable code generates . . . a freehand drawing tool for generating freehand drawing objects which are displayable at user-selected locations on the White Board screen. . . ." (Abs. ll. 4-5, 14-16.) Execution thereof also generates "a transmission device for transmitting all generated ones of . . . the freehand drawing objects to each of the users, an accumulating device for accumulating . . . the freehand drawing objects. . . ." (*Id.* ll. 16-22.)

Although the reference transmits freehand drawing objects to each of the plurality of users, the objects do not appear on a paper document. Instead, we agree with the Appellants that these appear on "an electronic white board." (Br. 12.)

For its part, the last part of Cass cited by the Examiner describes "Paper Web," (col. 16, l. 42), "a new kind of Web browser." (*Id.*)

"[A]n example of how Paper Web can work," (*id.* l. 50), follows.

> Suppose [a] user is situated at a fax machine located remotely to a host computer that is in connection with the Web. The computer runs software to support a Paper Web browser having an integrated fax server. The computer retrieves a Web page and faxes a hardcopy of the retrieved page to the user. The user marks the hardcopy to indicate a particular hypertext link that the user wishes to follow. For example, the user circles, underlines, or draws an X over a graphical object, text string, or other active element representing the link. The user then faxes the hardcopy thus marked back to the computer. The computer determines what Web page the user has sent and what Web link the user has indicated. The computer then follows the indicated link to obtain a new Web page, which it faxes back to the user.

(*Id.* ll. 50-64.)

Although Paper Web allows a user to mark-up a hardcopy of a Web page and fax the marked-up hardcopy to a computer, the computer does not transmit data representing the mark-ups to other computers. Instead, it merely obtains the Web page indicated by the user's mark-ups and faxes the page back to the same user. Because the computer does not transmit data representing the mark-ups to other computers, Paper Web cannot display the mark-ups at a plurality of computers. In fact, we are unpersuaded that Paper Web even displays the mark-ups at the computer to which the hardcopy was faxed.

Absent a teaching or suggestion of transmitting, to each of a plurality of workstations, data representing handwritten annotations that were made to a paper document via at least two of the workstations, and displaying at least one of the handwritten annotations at each of the workstations, we are unpersuaded of a prima facie case of obviousness. Therefore, we reverse the rejection of claims 1, 11, and 12, and of claims 2-6, 8-10, 13-17, and 19-22, which depend therefrom.

The Examiner does not allege, let alone show, that the addition of Levine cures the aforementioned deficiency of Carleton, Tran, Simonoff, and Cass. Therefore, we also reverse the rejection of these claims.

V. ORDER

In summary, the rejections of claims 1-22 under § 103(a) are reversed.

REVERSED

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