

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 BRETT GREEN

Appeal 2007-1245
Application 09/950,253
Technology Center 2100

Decided: June 27, 2007

Before JOSEPH F. RUGGIERO, ANITA PELLMAN GROSS, and JOHN A. JEFFERY, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-15. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Appellant invented a method and system for photocopying documents under control of a user browser. In particular, the photocopying device comprises an embedded server that is connected to a network. The browser can be used to initiate photocopying and adjust various settings of the photocopying device. A photocopy of the document is then generated in accordance with the user's selections.¹

Claim 1 is illustrative:

1. A method for photocopying a document, comprising:

receiving a request from a user browser to photocopy a document with a photocopying device;

uploading content to the user browser;

receiving photocopying selections made with the user browser; and

generating at least one photocopy of the document with the photocopying device in accordance with the user selections.

The Examiner relies on the following prior art reference to show unpatentability:

Kuwata	US 2003/0072031 A1	Apr. 17, 2003 (filed Mar. 25, 2002) ²
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¹ See generally Specification 3:11-20 and 5:1-6:14.

² Although the filing date of this published application is after the filing date of the present application (Sept. 10, 2001), the published application nonetheless claims the benefit of Provisional Application No. 60/278,180, filed Mar. 23, 2001 – a date prior to the present application's filing date. Although Appellant argues that “much of the content” of Kuwata's published application does not appear in the corresponding provisional application (Br. 6-7), the Examiner nonetheless relies on specific findings in

Appellant's admitted prior art on Page 1 of the specification ("APA").

1. Claims 12, 13, and 15 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kuwata.
2. Claims 1-11 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Kuwata in view of APA.
3. Claim 14 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Kuwata.

Rather than repeat the arguments of Appellant or the Examiner, we refer to the Briefs and the Answer for their respective details. In this decision, we have considered only those arguments actually made by Appellant. Arguments which Appellant 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).

Kuwata's provisional application as support for the corresponding findings from the published application (Answer 9-20).

We recognize that Kuwata's published application constitutes prior art only for subject matter properly supported by the provisional application in accordance with 35 U.S.C. § 112, first paragraph. *See* MPEP § 2136.03(III); *see also* MPEP § 706.02(V)(D). Nevertheless, we rely exclusively on Kuwata's provisional application in this opinion – a document whose qualification as prior art is undisputed.

In any event, to the extent that certain content of Kuwata's published application may differ from the corresponding provisional application, such perceived differences are simply not germane to our findings regarding the disclosure of Kuwata – findings based solely on the provisional application. We therefore express no opinion regarding any apparent differences between Kuwata's published and provisional applications.

OPINION

The Anticipation Rejection

We now consider the Examiner's rejection of claims 12, 13, and 15 under 35 U.S.C. § 102(e) as being anticipated by Kuwata. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984); *W.L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983).

The Examiner has indicated how the claimed invention is deemed to be fully met by the disclosure of Kuwata (Answer 4-5, 9-11). Regarding independent claim 12, Appellant argues that Kuwata does not teach a "photocopying device" comprising "photocopying hardware" and "an embedded server" as claimed. Appellant contends that Kuwata's server merely copies files stored on the server. Appellant adds that Kuwata does not disclose logic for generating at least one control screen that can be uploaded to a user browser as claimed, but rather merely enables management of electronic image files with the server (Br. 11).

The Examiner responds that Kuwata discloses a server accessible via the internet that functions as a document scanner (i.e., a photocopying device comprising photocopying hardware). The Examiner adds that this "photocopying device" comprises an "embedded server" since the device (1) scans and copies documents, and (2) can be accessed through a network to

perform user functions. According to the Examiner, since the user can control the photocopying device via a browser by sending print jobs to the server, the reference fully meets the limitation calling for “logic for generating at least one control screen that can be uploaded to a browser” (Answer 10-11).

We will sustain the Examiner’s anticipation rejection of independent claim 12. At the outset, we note that the scope and breadth of the limitation “photocopying hardware” as claimed does not preclude a system which utilizes conventional digital technology to make duplicate copies of scanned paper documents, such as a scanner and printer coupled to a computer.³

With this interpretation, we turn to Kuwata. Kuwata discloses a network-based electronic document organizing system, known as “Proof Buddy,” that enables a client to perform a number of functions with respect to electronic documents using a browser. Not only can the user send print jobs to the server through the browser, the user can also view, edit, and copy electronic documents stored on a server with the browser. The server can also function as a document scanner (Kuwata Specification 2, “FIELD OF THE INVENTION” section; 4, second full paragraph; Fig. 3). To this end, users can manage images of pages from separate documents with a web browser, split or merge the files to a new document, and configure the document for printing, faxing, or emailing. Moreover, the system integrates the scanning function to allow the user to combine print job and scan job documents (Kuwata Specification 9, ¶¶ 2-4). Once users scan hardcopy

³ See, e.g., *Photocopying*, at <http://en.wikipedia.org/wiki/Photocopying> (last visited June 13, 2007) (“Low-end [photo]copiers...use digital technology, but they tend to consist of a standard PC scanner coupled to an inkjet or low-end laser printer....”).

documents into the system repository, users can then manage or edit the scanned files using a web browser (Kuwata Specification 12-13, “From the Scanner” section).

We find Kuwata’s network-based document management and printing system reasonably comprises a “photocopying device” as claimed giving the term its broadest reasonable interpretation. Specifically, nothing in the claim precludes the “photocopying hardware” to include the combination of the scanner, server, and printer in Kuwata – components that collectively enable the user to create any number of copies of scanned paper documents.

Although Appellant acknowledges that Kuwata discloses a photocopier, Appellant’s argument that Kuwata’s server is not a “photocopying device” (Reply Br. 6) is simply not commensurate with the scope of the limitation. In our view, Kuwata’s scanner, server, and printer collectively function as a “photocopying device.” We further note that the computer that functions as Kuwata’s server inherently comprises a memory with an “embedded server” – software that enables the computer to function as a server.

The server also inherently contains a “copy control module” that interfaces with the user’s browser. Such copy control functionality enables the user to utilize the browser to control the process of printing documents stored on the server. To print a document, the user accesses the System Explorer. A printer properties form is then shown in the user’s browser that enables the user to configure printing by selecting desired settings (Kuwata Specification 29, “Printing” section). This system-specific form that is displayed in the user’s browser reasonably constitutes a control screen that is

generated, at least in part, by data uploaded to the user's browser from the server.

Although Appellant acknowledges that Kuwata's server can generate screens that can be uploaded to the user's browser, Appellant nevertheless argues that the reference does not teach that Kuwata's *photocopier* performs this function (Reply Br. 6). But as we indicated previously, Kuwata's "photocopier" includes the server with the scanner and printer coupled thereto.

Regarding claim 15, we find that Kuwata amply discloses a multifunction peripheral as claimed. Specifically, we note that the Copier/Scanner/Fax/Printer shown in Fig. 3 certainly performs multiple functions as its label suggests – namely copying, scanning, faxing, and printing.

For at least these reasons, we will sustain the Examiner's rejection of claims 12 and 15. Since Appellant has not separately argued the patentability of dependent claim 13, it falls with independent claim 12. *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).

The Obviousness Rejections

We now consider the Examiner's rejection of claims 1-11 under 35 U.S.C. § 103(a) as unpatentable over Kuwata in view of APA. 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 must make the factual determinations set forth in

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Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

If the Examiner’s burden is met, the burden then shifts to the Appellant 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 In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Regarding independent claim 1, the Examiner's rejection essentially finds that Kuwata teaches every claimed feature except for using the browser to photocopy a document. The Examiner cites APA as teaching that it is known in the art to access and use a photocopier from a host computing device. The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kuwata to use the browser to photocopy a document to allow remote users to photocopy documents (Answer 5-6, 12-13).

Appellant argues that Kuwata does not teach a photocopying device that receives a request or photocopying selections from a user browser as claimed. Although Appellant acknowledges that Kuwata’s *server* could receive such a request, the *photocopier* does not receive this request (Br. 13-

14; Reply Br. 7). Appellant also contends that Kuwata does not control photocopying via a browser. In this regard, Appellant emphasizes that printing is significantly different than photocopying: unlike photocopying, print jobs are handled by a print server (Reply Br. 7). The Examiner disagrees and refers to various passages within Kuwata that are said to disclose the disputed limitations (Answer 12-13).

We will sustain the Examiner's rejection of independent claim 1. As we indicated with respect to claim 12, we find Kuwata's scanner, server, and printer collectively constitute a "photocopying device" giving the term its broadest reasonable interpretation. As such, the "photocopying device" receives a request from the user's browser to photocopy a document as claimed. That is, a paper document can be scanned into Kuwata's system and stored on the server. When the user prints the stored image of this paper document, the user sends a request to print the document from the browser to the server. Since a duplicate copy of the paper document is printed, it is effectively "photocopied" giving the term its broadest reasonable interpretation.

Appellant's argument regarding the distinction between copying and photocopying is simply not commensurate with the scope and breadth of the limitation. As we indicated previously, "photocopying" reasonably includes digital technologies that duplicate documents by scanning and printing the documents.⁴ In any event, Appellant has offered no evidence on this record to establish any substantive distinction between copying a document digitally using a scanner and printer and "photocopying" such a document.

⁴ See p. 5, *supra*, of this opinion.

In addition, “photocopying selections” are made with the user’s browser as claimed. In this regard, the user makes such selections via the “printer properties form” displayed in the browser that enables the user to configure printing by selecting desired settings (Kuwata Specification 29). Regarding claim 4, these selections are ultimately delivered to the “photocopying device” under our interpretation noted previously.

Regarding claims 6-8 and 9-11, Appellant essentially reiterates the arguments pertaining to Kuwata’s failure to disclose a photocopying device that receives requests from a user browser, controlling photocopying with a browser (claims 6 and 9), and the photocopying device comprising an embedded server (claims 7 and 10) (Br. 15-17; Reply Br. 8-9). For the reasons previously discussed, however, we find these arguments unpersuasive and the limitations fully met by Kuwata.

For the foregoing reasons, we find that Kuwata satisfies all limitations of claims 1, 3, 4, 6, 7, 9, and 10 with APA being merely cumulative to the teachings of Kuwata. We sustain the Examiner’s obviousness rejection based on the teachings of Kuwata alone since we may rely on fewer references than the Examiner in affirming a multiple-reference rejection under 35 U.S.C. § 103. *In re Bush*, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961); *In re Boyer*, 363 F.2d 455, 458 n.2, 150 USPQ 441, 444 n.2 (CCPA 1966).

Since Appellant has not separately argued the patentability of claims 2, 5, 8, and 11, these claims fall with independent claims 1, 6, and 9. *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).

We now consider the Examiner's rejection of claim 14 under 35 U.S.C. § 103(a) as unpatentable over Kuwata. The Examiner argues that Kuwata discloses all limitations except for transmitting a confirmation notice to the browser once a photocopy has been generated. To cure this deficiency, the Examiner notes that transmitting confirmation notices to browsers upon completion of specific tasks is well known in the art and cites Page 4, ¶ 63 of Kuwata as an example of such confirmation notices (Answer 7-8). Appellant reiterates the previous arguments regarding the lack of a photocopying device, but adds that Kuwata fails to teach a confirmation notice once a photocopy has been generated by the photocopying device as claimed (Br. 17-18).

We will sustain the Examiner's obviousness rejection of claim 14. At the outset, we reiterate that Kuwata's scanner, server, and printer collectively function as a "photocopying device." In our view, transmitting confirmation notices to the user's browser upon completing a print job (i.e., generating a photocopy) to inform the user of the status of the job would have been well within the level of the skilled artisan, particularly since printing in Kuwata can occur remote from the user (i.e., over a network). As is well known in the art, such notifications are routinely used to inform users that a print job is complete and therefore ready to retrieve from the printer.

Although we find the Examiner's reliance on the confirmation prompt when deleting a folder in Kuwata problematic for supporting the Examiner's position, we nevertheless conclude that transmitting confirmation notices upon completing a print job would have been well within the level of skilled artisans for the foregoing reasons. The Examiner's rejection of claim 14 is therefore sustained.

DECISION

We have sustained the Examiner's rejections with respect to all claims on appeal. Therefore, the Examiner's decision rejecting claims 1-15 is affirmed.

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).

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AFFIRMED

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