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 ROGELIO ROBLES and HECTOR RODRIGUEZ-AVILES

Appeal 2007-1877
Application 09/887,306
Technology Center 2100

Decided: September 19, 2007

Before JAMES D. THOMAS, JOSEPH F. RUGGIERO, and HOWARD B. BLANKENSHIP, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 1-5, 7-9, 11-24, 26-29, 31, 34-37, and 39. Claims 6, 10, 25, 30, 32, 33, 38, and 40 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' claimed invention relates to the management of document production over a computer network in which a document production request is captured and user interfaces are generated for associating selected services and related options with the production request. The production request, the selected services, and the related options are merged into a production plan which is delivered to one or more selected document production devices. (Specification 2).

Claim 1 is illustrative of the invention and reads as follows:

1. A method for managing electronic document production over a computer network, the method comprising:

presenting, to a remote computing device, a first user interface with user accessible controls for selecting services for producing a production request captured on the remote computing device;

presenting, to the remote computing device, a second user interface having user accessible controls for selecting one or more, if any, document production devices identified as being capable of providing services selected through the first user interface;

merging the selected services and the captured production request into a production plan; and

delivering the production plan in a device specific format to one or more selected document production devices selected through the second user interface.

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

Van Der Linden	US 2001/0013947 A1	Aug. 16, 2001 (filed Dec. 28, 2000)

Suzuki	US 6,477,589 B1	Nov. 5, 2002 (filed Mar. 15, 1999)
Keeney	US 2004/0148335 A1	Jul. 29, 2004 (eff. filed Oct. 16, 2000)

Claims 1-5, 7-9, and 11-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Van Der Linden alone. Claims 19-24, 26-29, 31, 34-37, and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki in view of Keeney.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs and Answer for the respective details. 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)].

ISSUES

(1) Under 35 U.S.C § 103(a), with respect to appealed claims 1-5, 7-9, and 11-18, has the Examiner established a prima facie case of obviousness based on Van Der Linden alone?

(2) Under 35 U.S.C § 103(a), with respect to appealed claims 19-24, 26-29, 31, 34-37, and 39, would one of ordinary skill in the art have found it obvious to combine Suzuki and Keeney to render the claimed invention unpatentable?

PRINCIPLES OF LAW

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 *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). "[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). 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)).

ANALYSIS

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of appealed independent claims 1 and 9 based on Van Der Linden, Appellants' arguments in response assert a failure to set forth a prima facie case of obviousness since all of the claim limitations have not been taught or suggested by the applied Van Der Linden reference. Appellants' arguments focus on the alleged deficiencies of Van Der Linden in disclosing the

claimed second interface presented to a remote user which enables the user to select a production device.

According to Appellants (Br. 6-10; Reply Br. 3-5), in contrast to the claimed invention which permits a remote user to select production devices, the submission form 24 presented to the remote user in Van Der Linden enables the user to only select production printer services such as paper, color, and finishing options. As argued by Appellants, the actual selection of a printer device in Van Der Linden is performed by a reproduction center operator after receiving the selection of desired print services by the remote user.

After reviewing the disclosure of Van Der Linden in light of the arguments of record, however, we are in general agreement with the Examiner's interpretation of Van Der Linden as stated in the Answer. As explained by the Examiner (Answer 15), when a new printer is installed in Van Der Linden (in Van Der Linden's disclosed example, a printer which can print on transparent media), an updated interface, i.e., a second interface, is presented to a user at a remote terminal. (Van Der Linden, paragraph [0051]). Upon selection by the remote user of the transparent media print option, the newly added printer device is selected, at least indirectly, since the newly added printer is the only printer capable of printing to transparent media. While an operator at Van Der Linden's remote production center may actually implement the remote user's selection of the newly added transparent media printer, such an operation is not precluded by the language of independent claims 1 and 9.

For the above reasons, since it is our opinion that the Examiner has established a prima facie case of obviousness which has not been overcome

by any convincing arguments from Appellants, the Examiner's 35 U.S.C. § 103(a) rejection of independent claims 1 and 9, as well as dependent claims 2-5, 7, 8, and 11-18 not separately argued by Appellants, is sustained.

Turning to a consideration of the Examiner's obviousness rejection of independent claim 19 based on the combination of Suzuki and Keeney, we sustain this rejection, as well as that of dependent claims 20-24 and 26-28 not separately argued by Appellants. Appellants' arguments fail to convince us of any error in the Examiner's establishment of correspondence (Answer 7, 8, and 16) between the disclosure of Suzuki and the claimed production client set forth in claim 19. We agree with the Examiner that the selection of a "setting condition" such as the "print" option (Suzuki, Figures 24 (S13) and 26) corresponds to the claimed first user interface for selecting a service, i.e., "print."

The claimed second interface is also satisfied by the disclosure of Suzuki since, upon selection of the "print" option, a list of printers on the network is presented to the user enabling the user to select a particular printer to execute the print function (Suzuki, Figures 26 and 32). While Appellants contend (Br. 13; Reply Br. 8) that Suzuki merely teaches an interface which provides a selection of printing device as opposed to some other device, we do not find that the claimed production client language of claim 19 requires anything more. In other words, the system of Suzuki identifies devices, i.e., network printers, which can produce a production request, i.e., "print," captured by the production client.

With respect to the production server aspects of claim 19, the Examiner has turned to Keeney to address the claimed limitations. We find no error, and Appellants have provided no convincing arguments to the

contrary, in the Examiner's finding (Answer 8) that the network server teachings of Keeney would serve as an obvious enhancement to the printing system of Suzuki.

We also sustain the Examiner's 35 U.S.C. § 103(a) rejection of independent claim 29 in which the Examiner relies upon Suzuki alone, as well as that of dependent claims 31, 34-37, and 39 not separately argued by Appellants.[1] Appellants' arguments reiterate those made with respect to independent claim 19, which arguments we found to be unpersuasive as discussed *supra*. As we previously stated, a user in Suzuki at a first production client interface selects a "print" option upon which a list of available network printers is presented through a second user interface enabling the user to select a printer device to implement the print request captured by the production client.

CONCLUSION

In summary, we have sustained the Examiner's 35 U.S.C. § 103(a) rejections of all of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-5, 7-9, 11-24, 26-29, 31, 34-37, and 39 is affirmed.

[1] Although the Examiner's statement of the grounds of rejection includes claim 29 (and its dependent claims 31, 34-37, and 39) in the group of claims rejected over the combination of Suzuki and Keeney, the Examiner's analysis relies upon Suzuki alone in rejecting these claims.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

KIS

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, CO 80527-2400