

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD A. PINEAU, ANISH N. PURI, and
MICHAEL J. VIGNEAU

Appeal 2007-2091
Application 10/191,161
Technology Center 2100

Decided: October 31, 2007

Before JOSEPH L. DIXON, ANITA PELLMAN GROSS and
MAHSHID D. SAADAT, *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 1-9. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

BACKGROUND

Appellants' invention relates to a method and apparatus for providing output from remotely located digital files using a remote printer. An understanding of the invention can be derived from a reading of exemplary claims 1 and 5, which are reproduced below.

1. A method comprising steps of:

- (A) receiving from a transaction server, data in a structure that is tailored to at least one capability of a printer, the at least one capability selected from the group consisting of spatial resolution and color depth;
- (B) processing, rearranging and converting the data into a form suitable for output by the printer; and
- (C) providing the processed, rearranged and converted data to the printer over a network.

5. A system comprising:

means for receiving from a transaction server, data in a structure that is tailored to at least one capability of a printer, the at least one capability selected from the group consisting of spatial resolution and color depth;

means for processing, rearranging and converting the data into a form suitable for output by the printer; and

means for providing the processed, rearranged and converted data to the printer over a network.

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Claims 1-5, 7-9, 11-15, 17-20, 22-28, and 30 of copending Application No. 09/870,538 (Prueitt).

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|---------|--------------------|---------------|
| Kaneko | US 6,856,412 B1 | Feb. 15, 2005 |
| Todaka | US 6,785,022 B1 | Aug. 31, 2004 |
| Picoult | US 2002/0065101 A1 | May 30, 2002 |

REJECTIONS

Claims 1-9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5, 7-9, 11-15, 17-20, 22-28, and 30 of copending Application No. 09/870,538 (hereinafter ‘538) in view of Kaneko.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Picoult in view of Todaka.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and Appellants regarding the above-noted rejections, we make reference to the Examiner's Answer (mailed December 12, 2006) for the reasoning in support of the rejections, and to Appellants' Brief (filed November 15, 2006) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellants' Specification and claims, to the applied prior art references, and to the respective positions articulated by Appellants and the

Examiner. As a consequence of our review, we make the determinations that follow.

While we note that Appellants have not provided the requisite Summary of the Claimed Invention for independent claim 5, which contains means plus function limitations, we will not remand the case for clarification since Appellants have not provided separate arguments for patentability with respect to independent claim 5 (*see* 37 CFR § 41.37(c)(1)(v)). We leave it to the Examiner and Appellants to determine the appropriate correlation of the corresponding structure, acts, and materials in the Specification for these claim limitations.

Obviousness-Type Double Patenting

With respect to the rejection of claims 1-9 under obviousness-type double patenting, Appellants maintain that only the claims of the patent application may be relied upon. Appellants contend that here the claims of the copending application do not suggest the method and the system recited in the present claims as amended (Br. 8). Appellants contend that there is no suggestion to be found in the claims of the ‘538 application which would provide any incentive to one skilled in the art to tailor the output from the transaction server to the spatial resolution or color depth of a printer in order to arrive at the subject matter of claims 1-9 of the present application.

Appellants argue that the Examiner has conceded that the ‘538 application claims do not “disclose that the data is tailored to at least the spatial resolution of a printer” (Br. 10). Appellants argue that the Examiner’s reliance on Kaneko is in error and that the Examiner’s reliance upon an

isolated teaching of a reference out of context is not permissible (Br. 11). We disagree with Appellants' argument and conclusion.

The Examiner maintains that claim 1 of the '538 application discloses the use of information to produce the "optimal quality print." However, independent claim 1 of the '538 application does not state what this particular data specifically is, or how it is formatted. The Examiner contends that this generic data would have provided enough motivation for one of ordinary skill in the art to search the art for other inventions which "tailor data" to the output device, and to eventually find the Kaneko reference, which also deals with retrieved data with respect to the type of printer used (Ans. 4). We find the Examiner's line of reasoning to be reasonable in light of the broad scope of independent claim 1. Since Appellants have not shown error in the Examiner's rejection, nor have Appellants set forth a sufficient rebuttal to the rejection, we will sustain the rejection of independent claim 1 and claims 2-9 grouped therewith.

35 U.S.C. § 103(a)

With respect to the rejection of claims 1-9 under 35 U.S.C. § 103(a), Appellants argue that claim 1 is drawn to a method wherein data are received in a structure that is tailored to the spatial resolution and/or color depth of the printer, is processed, rearranged, and converted into a form suitable for printing by the printer, and are then provided to the printer over a network (Br. 12). Appellants contend that in the claimed invention (1) the data are received in a structure that is tailored to the printer's resolution or color depth, but the structure is not ready for printing; and (2) the data are processed into a form suitable for output by the printer. Thus, according to the invention, although the data are initially received in a structure that is

tailored to the printer's spatial resolution or color depth, the data are not provided to the printer in this structure (Br. 12). Rather, the data are first processed into a form suitable for the output by the printer before the data are provided to the printer (Br. 12).

Appellants argue that the Examiner concedes that Picoult does not disclose receiving data in a structure that is tailored to the printer's spatial resolution or color depth and that Todaka does not disclose the same limitation to receive data in a structure that is tailored to the printer's spatial resolution or color depth (Br. 13). Appellants maintain that Todaka, at best, could disclose steps (b) and (c) of Appellants' independent claim 1, but does not teach or suggest step (a) (Br. 13). We disagree with Appellants' contention and find that Todaka teaches storing the abilities of each printer in correspondence with the network address of the printer. We find that Todaka additionally stores a resolution, a usable paper size, a compatible image format, and a usable number of colors (Todaka col. 3, ll. 11-14).

Additionally, we find that Todaka teaches a converting unit for converting data received by the reception unit in accordance with the processing ability stored in the storage unit (Todaka Abstract, ll. 5-7). We find this teaching in Todaka to teach the processing, rearranging, and confirming of data into a form suitable for output by the printer and providing the processed, rearranged, and converted data to the printer over the network, as recited in independent claim 1 in steps (b) and (c). Since Todaka teaches the use of resolution and also the number of usable colors which are stored for each printer, we find that the information received from the network would have been tailored to at least one capability concerning spatial resolution and color depth when received from its source.

While the language of independent claim 1 recites “tailored to at least one capability of a printer,” the language “... neither recites nor requires the absence of additional processing, rearrangement, or conversion of that capability. Therefore, we find that the data from the source or transaction server Todaka is structured (as it would have to be for recognition and further processing). We additionally find that the received data contains content concerning spatial resolution or color depth, which it must, since Todaka stores resolution and usable number of colors for each printer for use in the conversion of image data in various formats into image data of a specific format in accordance with the abilities of each printer (Todaka col. 3, ll. 16-20).

We find that the conversion from the various received formats to the specific format for the printer would have necessarily involved formatted data at the time of reception, which we find to be tailored to at least one capability of a printer. As discussed, the structured data that is “tailored” is not recited to be unchanged in the final output.

Therefore, we find the Examiner’s position to be reasonable, and we do not find that Appellants have shown error in the Examiner’s *prima facie* case of obviousness. Therefore, we will sustain the rejection of independent claim 1 and independent claim 5, which has been grouped with independent claim 1. Additionally, we will sustain the rejection of dependent claims 2-4 and dependent claims 6-9 which are grouped with their respective independent claims.

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CONCLUSION

To summarize, we have sustained the rejection of claims 1-9 under provisional nonstatutory obviousness-type double patenting, and we have sustained the rejection of claims 1-9 under 35 U.S.C. § 103(a).

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

AFFIRMED

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