

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* CHRISTOPHER ETHIER, JOHN P. BRINKMAN,  
GAVIN MCKENZIE and CARL W. ORTHLIEB

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Appeal 2008-0128  
Application 10/409,622  
Technology Center 2100

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Decided: April 8, 2008

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Before JAMES D. THOMAS, HOWARD B. BLANKENSHIP, and  
STEPHEN C. SIU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-66. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

#### A. INVENTION

The invention at issue involves conversion of document formats (Spec. 1). In particular, a document in a binary format is reformed into a markup language format using information selected from the electronic document in the binary format, and an encoded version of the electronic document in the binary format is inserted into the electronic document in the markup language format (*id.* 4).

#### B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows:

1. A method comprising:
  - obtaining an electronic document in a binary format;
  - transforming the electronic document into a markup language format by
    - extracting a subset of information from the electronic document in the binary format according to predefined extraction parameters,
    - incorporating the subset of the information into new portions of the electronic document in the markup language format, and
    - inserting an encoded version of the electronic document in the binary format into the electronic document in the markup language format; and
  - using the transformed electronic document.

### C. REJECTIONS

Claims 1-13, 16, 17, 21-37, 40-42, 44-50, 52-55, 57, 58, 61, 62, 65 and 66 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0131312 (“Dang”) and U.S. Patent No. 6,336,124 (“Alam”). Claims 14, 15, 38, 39, 51, 56, 59, and 60 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dang, Alam, and U.S. Patent No. 6,609,200 (“Anderson”). Claims 18-20, 42, 43, 63, and 64 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dang, Alam, and U.S. Patent Publication No. 2004/0103367 (“Riss”). As noted above, claim 42 stands rejected under 35 U.S.C. § 103(a) as being unpatentable both over Dang and Alam and over Dang, Alam, and Riss.

### II. CLAIM GROUPING

“When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must

consider the patentability of any grouped claim separately.” 37 C.F.R. § 41.37(c)(1)(vii) (2006).<sup>1</sup>

Appellants argue claims 1-66 as a group (App. Br. 7-13). We select claim 1 as the sole claim on which to decide the appeal of the group of claims 1-13, 16, 17, 21-37, 40, 41, 42, 44-50, 52-55, 57, 58, 61, 62, 65, and 66 (the first group); claim 14 as the sole claim on which to decide the appeal of the group of claims 14, 15, 38, 39, 51, 56, 59, and 60 (the second group); and claim 18 as the sole claim on which to decide the appeal of the group of claims 18-20, 42, 43, 63, and 64 (the third group).

### III. CLAIMS 1-13, 16, 17, 21-37, 40, 41, 42, 44-50, 52-55, 57, 58, 61, 62, 65, AND 66

As set forth above, we select claim 1 as the sole claim on which to decide the appeal of the first group. “Rather than reiterate the positions of parties *in toto*, we focus on the issue therebetween.” *Ex Parte Filatov*, No. 2006-1160, 2007 WL 1317144, at \*2 (BPAI 2007).

Appellants argue that “Dang could not teach or suggest a single reversible document with two distinct states” and therefore “does not render Claim 1 obvious” (App. Br. 8). First, we note that the Examiner has not

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<sup>1</sup> We cite to the version of the Code of Federal Regulations in effect at the time of the Appeal Brief. The current version includes the same rules.

rejected claim 1 as obvious over Dang alone. The Examiner states that “none of the independent claims recite ‘a single reversible document.’” (Ans. 24). We agree with the Examiner that claim 1 does not recite “a single reversible document.” “Moreover, limitations are not to be read into the claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)). Therefore, we find Appellants’ argument unpersuasive.

Appellants also argue that “Alam fails to teach or suggest that the intermediate/storage format document (or the final output document) includes an encoded version of the input document in binary format inserted into a document in the markup language format” (App. Br. 9) and that “Alam neither describes nor suggests inserting an encoded version of an electronic document in a binary format into an electronic document in a markup language format” (App. Br. 10-11). The Examiner defines the term “encode” to include putting “into code” and formatting electronic data “according to a standard format” (Ans. 26). Appellants do not dispute these definitions.

Alam discloses that document formats “may include one or more versions of HTML, XML, PDF, RTF, CSS, Netscape Layers, linked and separate pages, . . . TIFF . . . or any other image format . . .” (col. 5, ll. 29-32). Also, a “repository . . . stores the input documents in the input format as well as the one or more storage formats” (col. 22, ll. 21-23) such that “a single converted document may be generated containing the input

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document in multiple storage formats” (col. 22, ll. 26-27). Because Alam discloses that the document is formatted in any one of an input or storage format, we agree with the Examiner that Alam “encodes” the document (i.e., formats data according to a standard format). Additionally, Alam discloses “encoding” an input document (i.e., formatting according to a format) that is any input format including PDF format (i.e., binary format) or HTML format and inserting the encoded document into a “single converted document” that contains the document in “multiple storage formats” (col. 22, ll. 27-28). Because the “multiple storage formats” include “one or more versions of HTML, XML, . . .” (col. 5, ll. 29-30), we agree with the Examiner that the “encoded” PDF format is inserted into an electronic document in a markup language format (i.e., HTML or XML).

In addition, Appellants argue that because Alam discloses ““what is needed are accurate and efficient systems and methods for converting a document stored in one format to a different format . . .’ . . . This fails to provide a motivation to make the specific combination being proposed by the Examiner” (App. Br. 11-12). As discussed above, both Dang and Alam disclose systems and methods for converting documents between formats using elements that would have been known to those of ordinary skill in the art. Also as discussed above, the cited references disclose such known features as incorporating information into an electronic document in markup

language format and inserting an encoded version of a document in one format (such as binary format) into an electronic document in another format (such as markup language format), as recited in claim 1. Such rearrangement of known elements to achieve predictable results would have been obvious to one of ordinary skill in the art. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. . . . [W]hen a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR Intern Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739-40 (citing *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976)).

Appellants, while asserting that a need for “accurate and efficient systems and methods for converting a document . . . fails to provide a motivation to make the specific combination being proposed by the Examiner” (App. Br. 12), fail to provide a rationale as to how the combination of references providing predictable results using arrangements of known elements would not have been obvious to one of ordinary skill. Therefore, we are unconvinced by Appellants’ arguments.

Appellants also assert that Alam discloses “the intermediate/storage format ‘is preferably a format that can be easily utilized to transfer the data representing the contents of the documents to any other desired output format.’ (Alam: Col. 6, lines 50-52.)” (App. Br. 12). Based on this

contention, Appellants conclude that Alam “suggests that the included multiple formats are . . . not in encoded versions of those formats” (App. Br. 12) and that “encoding the multiple formats into a markup language format would run counter to the purpose of Alam, since this encoded data would then have to be unencoded before the output documents can be generated” (App. Br. 12). As discussed *supra*, we agree with the Examiner that Alam discloses “encoding” data.

It follows that Appellants have failed to demonstrate that the Examiner erred in rejecting claim 1. Therefore, we affirm the rejection of claim 1 and of claims 2-13, 16, 17, 21-37, 40, 41, 42, 44-50, 52-55, 57, 58, 61, 62, 65, and 66, which fall therewith.

#### IV. CLAIMS 14, 15, 38, 39, 51, 56, 59, AND 60

As set forth above, we select claim 14 as the sole claim on which to decide the appeal of the second group. Appellants have not argued any claim in this group.

Appellants argue that “Anderson and Riss, alone or in combination, fail to remedy the deficiencies of Dang and Alam, alone or in combination” (App. Br. 11). As set forth above, we find that Appellants have failed to establish deficiencies of Dang and Alam. Additionally, Riss is not used by the Examiner to reject these claims.

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It follows that Appellants have failed to demonstrate that the Examiner erred in rejecting claim 14. Therefore, we affirm the rejection of claim 14 and of claims 15, 38, 39, 51, 56, 59, and 60, which fall therewith.

#### V. CLAIMS 18-20, 42, 43, 63, AND 64

As set forth above, we select claim 18 as the sole claim on which to decide the appeal of the third group. Appellants have not argued any claim in this group.

“Anderson and Riss, alone or in combination, fail to remedy the deficiencies of Dang and Alam, alone or in combination” (App. Br. 11). As set forth above, we find that Appellants have failed to establish deficiencies of Dang and Alam. Additionally, Anderson is not used by the Examiner to reject these claims.

It follows that Appellants have failed to demonstrate that the Examiner erred in rejecting claim 18. Therefore, we affirm the rejection of claim 18 and of claims 19, 20, 42, 43, 63, and 64, which fall therewith.

#### VI. ORDER

In summary, the rejections of claims 1-66 under § 103(a) are affirmed.

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No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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