

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* TIMOTHY F. DONAHUE

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Appeal 2008-0641  
Application 10/177,784  
Technology Center 2100

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Decided: January 30, 2008

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Before JAMES D. THOMAS, JOSEPH L. DIXON, and  
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-19. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

## THE INVENTION

The disclosed invention relates generally to proof reading personalized print jobs. More particularly, Appellant's invention relates to an approach to a scatter proofing process of the content elements of a personalized print job that automates the content element selection process (Spec. 1).

Independent claim 1 is illustrative:

1. A method of automatically preparing a scatter proof of a personalized print job, said method comprising:

analyzing a personalized print job file to identify recurring content elements;

extracting copies of at least some of said recurring content elements; and

arranging said recurring copies of said recurring content elements to generate a scatter proof print image.

## THE REFERENCES

The Examiner relies upon the following references as evidence in support of the rejections:

Spence	US 5,293,539	Mar. 8, 1994
Hug	US 5,806,078	Sept. 8, 1998
Bourbakis	US 2003/0145279 A1	July 31, 2003

## THE REJECTIONS

1. Claims 1-6 and 8-13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bourbakis in view of Spence.

2. Claims 7 and 14-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bourbakis in view of Spence, and further in view of Hug.

#### PRINCIPLES OF LAW

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740. Appellant has the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellant’s Brief to show error in the proffered *prima facie* case.

#### Combinability under 35 U.S.C. § 103

Regarding all claims 1-19 on appeal, Appellant contends there is no motivation for combining Spence with Bourbakis (App. Br. 12). In particular, Appellant contends that one skilled in the art would not have looked to combine the teachings of the Bourbakis with the teachings of Spence (or any other teachings pertaining to scatter proofing), because Bourbakis teaches modifying original documents — something that

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Appellant contends is counterproductive and harmful to scatter proofing techniques (*Id.*).

We disagree. After reviewing the record before us, we conclude that Appellant has misinterpreted the Bourbakis reference. We find a reasonable interpretation of Bourbakis comports with the Examiner's finding that Bourbakis reconstructs new documents from old documents (Ans. 7; *see* Bourbakis ¶[0008]). Thus, while redundant sections of text or images are represented by pointers in the new document (¶[0008]), we agree with the Examiner that nothing in Bourbakis indicates that the old document is modified (*see* Ans. 7). Moreover, Bourbakis appears to be directed to an environment that uses web pages as input documents, as pointed out by the Examiner (*see* Ans. 7; *see* Bourbakis ¶ [0003]). Therefore, we find the weight of the evidence does not support Appellant's contention that Bourbakis is not combinable with either Spence or Hug because Bourbakis purportedly teaches modifying original documents.

Elements under 35 U.S.C. § 103

Independent claims 1, 8, and 14

We consider the Examiner's rejection of independent claims 1, 8, and 14. Appellant expressly indicates in the Brief that claim 1 is representative of independent claims 1, 8, and 14 (App. Br. 9, ll. 5-6).

Appellant contends that neither Bourbakis nor Spence teaches the claim limitations of "extracting copies of at least some of said recurring content elements." (App. Br. 9; *see also* claim 1 and the equivalent language found in independent claims 8 and 14). In particular, Appellant

asserts that Bourbakis teaches modifying an original document, e.g., by removing redundant information from digital documents (App. Br. 10).

We disagree. We find a reasonable interpretation of Bourbakis comports with the Examiner's finding that Bourbakis reconstructs new documents from old documents, as discussed *supra* (Ans. 7; *see* Bourbakis ¶[0008]). Moreover, we agree with the Examiner that Appellant is arguing limitations that are not claimed, e.g., not altering a personalized print job (*see* Ans. 6, *see also* App. Br. 9). These arguments are not commensurate in scope with what is claimed. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) ("Many of appellant's arguments fail from the outset because, . . . they are not based on limitations appearing in the claims . . ."). Here, the claimed method does not include a step of not altering a personalized print job, as argued by Appellant (*see* App. Br. 9; *see also* representative claim 1).

For at least the aforementioned reasons, we conclude Appellant has not established that the Examiner erred with respect to establishing a prima facie case of obviousness. Therefore, we sustain the Examiner's rejection of claim 1 as being unpatentable over the teachings of Bourbakis in view of Spence.

Pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(vii), we have decided the appeal with respect to the remaining claims in this grouping on the basis of the selected representative claim alone. Thus, we sustain the Examiner's rejection of independent claim 8 as being unpatentable over Bourbakis in view of Spence for the same reasons discussed *supra* with respect to representative claim 1. We note that Appellant does not present separate arguments directed to independent claim 14 within this group (*see*

App. Br. 9, “In regard to this section, Independent Claim 1 will be treated as representative of independent Claims 8 and 14.”<sup>1</sup> Therefore, we sustain the Examiner’s rejection of independent claim 14 as being unpatentable over Bourbakis in view of Spence and Hug for the same reasons discussed *supra* with respect to representative claim 1.

#### Claims 7 and 15-19

We consider next the Examiner’s rejection of claims 7 and 15-19 as being unpatentable over the teachings of Bourbakis in view of Spence, and further in view of Hug. Since Appellant’s arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will select dependent claim 7 as the representative claim for this rejection (*see* discussion of overlapping groups defined by Appellant *infra*). *See* 37 C.F.R. § 41.37(c)(1)(vii)(2006).

Appellant begins by stating that “Independent Claim 14, *which is treated as representative of Claim 7 in this section*, requires removing previously proofed content elements from identified recurring content elements.” (App. Br. 13, ¶2, emphasis added). Regarding the tertiary reference to Hug, Appellant does not agree that “storing changes between versions of documents in lieu of entire documents for each version [as taught

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<sup>1</sup> *See* 37 C.F.R. § 41.37(c)(1)(vii) (2006) (“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.”).

by Hug] would teach someone of ordinary skill in the art to exclude recurring content elements that have been previously proofed and approved from a scatter proof, as required by Claims 7 and 14.” (App. Br. 14, ¶1).

We begin by noting that Appellant has included claim 14 in this argued group (App. Br. 14). However, we have addressed the Examiner’s rejection of claim 14 *supra* in the context of Appellant’s own grouping of independent claims 1, 8, and 14, where Appellant expressly states that “Independent Claim 1 will be treated as representative of independent Claims 8 and 14.” (App. Br. 9, ll. 5-6). Thus, independent claim 14 falls with independent claims 1 and 8, as discussed above. Nevertheless, we note that the *argued* limitations of claim 14 are equivalent to the limitations of claim 7 that we address here. Appellant has confused the issues before us by arguing the claims in the context of overlapping groups.

Regarding representative claim 7, we find the weight of the evidence supports the Examiner’s rationale regarding the rejection of both claims 7 and 14 as being unpatentable under *Bourbakis* in view of *Spence* and *Hug*.

We note that our reviewing court has determined that the test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *In re Kahn*, 441 F.3d 977, 987-88 (Fed. Cir. 2006) (*citing In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000)). Moreover, the Supreme Court has stated that the analysis under §103 “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*, 127 S. Ct. at 1741.

This reasoning is applicable here. In particular, we note that Spence expressly teaches the use of scatter proofs (col. 15, l. 5). Spence also teaches the use of multiple proof requests (col. 16, ll. 6-7) and the deletion of proof requests (col. 16, ll. 21-22). The Examiner relies upon Hug as teaching and/or suggesting the general concept of processing a content element only once (Ans. 10, ¶2). Thus, we conclude that an artisan possessing ordinary skill, creativity, and common sense, would have (in light of the teachings of Bourbakis, Spence, and Hug) found it obvious to remove previously proofed content elements from further consideration by the proofreader.<sup>2</sup>

For at least the aforementioned reasons, we conclude Appellant has not established that the Examiner erred with respect to establishing a prima facie case of obviousness. Therefore, we sustain the Examiner’s rejection of representative claim 7 as being unpatentable over the teachings of Bourbakis in view of Spence and Hug.

Pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(vii), we have decided the appeal with respect to the remaining claims in this group on the basis of the selected claim alone. Therefore, we sustain the Examiner’s

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<sup>2</sup> *See In re Hoeschele*, 406 F.2d 1403, 1406-07 (CCPA 1969) (“[I]t is proper to take into account not only specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom . . .”).

rejection of claims 15-19 for the same reasons discussed *supra* with respect to representative claim 7.

### Claims 2 and 9

We consider next the Examiner's rejection of claims 2 and 9 as being unpatentable over Bourbakis in view of Spence. While Appellant has included claim 15 in this argued group (App. Br. 14), we have addressed the Examiner's rejection of claim 15 *supra*. Moreover, the limitations of claim 15 are equivalent to the limitations of claims 2 and 9 that we address here. Appellant has confused the issues before us by arguing the claims in the context of a group that includes more than one rejection.

Appellant contends that "rearranging a queue of scatter-proof print jobs is not the selecting of a subset of identified recurring content elements from which copies are to be extracted and arranged on a scatter proof print image." (App. Br. 15). Appellant further contends that "[t]o the extent that the Office Action is taking the position that a 'proof request', according to the Spence Patent, is a single image in a scatter proof, Appellants have not found any support for such a position within the Spence Patent itself." (*Id.*).

We disagree. We find Appellant's second argument is directly contravened by Spence's teaching that "[a] scatter proof is a proof that contains *a number of non-overlapping images, here arising from separate proof requests*, that are printed on a common proof sheet." (Spence, col. 16 ll. 5-8, emphasis added). Thus, we find that Spence teaches that "proof requests" correspond to a single image in a scatter proof, albeit in the form

of metadata (i.e., “data about data”) that identifies the files that store the image data.<sup>3</sup>

Regarding Appellant’s first argument, we find Spence’s teaching of “non-overlapping images” teaches and/or suggests using just one image to represent and proof multiple copies of the same image as found in a source document to be printed. Moreover, we agree with the Examiner that Spence’s teaching of deleting proof requests (col. 16, l. 21) suggests selecting a subset, as claimed (*see* Ans. 10). Finally, because every set is a subset of itself, we conclude that the language of Appellant’s claim 2 broadly encompasses selecting *any* set of identified recurring content elements.

For at least the aforementioned reasons, we conclude Appellant has not established that the Examiner erred with respect to establishing a prima facie case of obviousness. Therefore, we sustain the Examiner’s rejection of representative claim 2 as being unpatentable over the teachings of Bourbakis in view of Spence. Because dependent claim 9 recites equivalent limitations, we also sustain the Examiner’s rejection of claim 9 as being unpatentable over the teachings of Bourbakis in view of Spence. We note that our findings here apply equally to the equivalent language of claim 15 that we have addressed in a preceding group.

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<sup>3</sup> *See* Spence, col. 15, ll. 45-47, “Note, however, that the proof request does not however contain the image data itself but only an identification of the

Claims 3, 4, 10, and 11

We consider next the Examiner's rejection of claims 3, 4, 10, and 11 as being unpatentable over Bourbakis in view of Spence.

While Appellant has included dependent claims 16 and 17 in this argued group (App. Br. 14), we have addressed the Examiner's rejection of these claims in a preceding group, as discussed above. Moreover, the limitations of claims 16 and 17 are equivalent to the limitations of claims 3 and 4 that we address here. We find Appellant has again confused the issues before us by arguing the claims in the context of a group that includes more than one rejection.

Regarding claims 3 and 4 (and the equivalent language of claims 10 and 11), Appellant contends:

The Bourbakis publication's teaching of the replacement of content with pointers to the content that has been extracted is not the teaching of meta data that identifies content as a recurring element. In other words, Appellants respectfully submit that a pointer is merely a "dumb" pointer to a location in memory, and does not contain additional information that identifies the content as a recurring image element. (App. Br. 15-16).

We disagree. We note that Bourbakis teaches maintaining pointers to at least one copy of the "same or similar images" (i.e., recurrent images) such that reconstruction of the original documents is possible:

This invention also examines all the image related with the set of original documents and removes the *same or similar images*

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files(s) which stores that data." *See also* Figs. 3A-3D.

while keeping *pointers that could assist a future reconstruction of the original documents* [emphasis added].  
(Bourbakis, ¶[0008]).

Because pointers are addresses pointing to the location of data (i.e., “data about data”), we conclude that the Examiner has reasonably read the claimed “metadata” on the pointers taught by Bourbakis. We find the Examiner’s reasoning is consistent with the teachings of the reference and the meaning of the term “metadata” as that term is used in the art. Moreover, we have found *supra* that Spence also teaches the use of metadata that identifies files that store “non-overlapping” image data (col. 16, l. 6). We find Spence’s metadata identifies at least one “non-overlapping” image file that represents recurrent images as found in a source document (*see* Footnote 3 *supra*).

For at least the aforementioned reasons, we conclude Appellant has not established that the Examiner erred with respect to establishing a prima facie case of obviousness. Therefore, we sustain the Examiner’s rejection of dependent claims 3 and 4 as being unpatentable over the teachings of Bourbakis in view of Spence. Because dependent claims 10 and 11 recite equivalent limitations, we also sustain the Examiner’s rejection of these claims as being unpatentable over the teachings of Bourbakis in view of Spence. We note that our findings here apply equally to the equivalent language of dependent claims 16 and 17 that we have addressed in a preceding group.

Dependent claims 5, 6, 12, and 13

Appellant has not presented any substantive arguments directed to the separate patentability of dependent claims 5, 6, 12, and 13. Therefore, we sustain the Examiner's rejection of claims 5, 6, 12, and 13 as being unpatentable over Bourbakis in view of Spence for the same reasons discussed *supra* with respect to independent claims 1 and 8, respectively. *See In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii)(2006).<sup>4</sup>

OTHER ISSUE

In the event that prosecution is reopened in this application, we leave it to the Examiner to consider whether the subject matter of claims 1-19 constitutes eligible subject matter under 35 U.S.C. § 101 in view of *In re Comiskey*, 499 F.3d 1365 (Fed. Cir. 2007). Here, we note that all claims on appeal recite a process or system for manipulating information (i.e., a personalized print job) without integrating a machine (e.g., a printer), or constituting a process of manufacture, or altering a composition of matter. The nature of the subject matter claimed may be considered to be a mental process since the claims do not recite a tangible embodiment. Because the claims on appeal are not tied to a machine or other statutory subject class,

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<sup>4</sup> We cite to the version of the Code of Federal Regulations in effect when the Appeal Brief was filed. The current version includes the same rules.

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the Examiner should consider a rejection of claims 1-19 under 35 U.S.C. § 101.

#### CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellant has not shown the Examiner erred in rejecting claims 1-19 under 35 U.S.C. § 103(a) for obviousness.

#### DECISION

The decision of the Examiner rejecting claims 1-19 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).

AFFIRMED

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