UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHELL S. SIMPSON, WARD S. FOSTER,
and KRIS R. LIVINGSTON

Appeal 2008-5912
Application 10/021,340
Technology Center 2600

Decided: January 14, 2009

Before MAHSHID D. SAADAT, JOHN A. JEFFERY,
and KEVIN F. TURNER, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's Final Rejection of claims 11-27. Claims 1-10 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellants' invention relates to a system for processing forms and to a method which allows accessing and retrieving form imaging data via a network. The data are used for printing the form imaging data along with static form data as a hard copy form (Spec. 2).

Claim 11 is illustrative of the claimed invention, and it reads as follows:

> 11. A method practiced by a printer for printing a form, the method comprising:
>
> accessing form imaging data from at least one store via a network with the printer;
>
> retrieving the form imaging data from the at least one store with the printer;
>
> merging the retrieved form imaging data with static form data already stored on the printer to generate a completed form; and
>
> printing the form imaging data along with the already stored static form data together as a hard copy form, such that printing a hard copy form is possible without the need to send the static form data to the printer and such that a copy of the static form data need only be stored on the printer.

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

Al-Hussein	US 5,809,167	Sep. 15, 1998
Lo	US 6,268,927 B1	Jul. 31, 2001
LeClair	US 6,636,891 B1	Oct. 21, 2003 (filed Nov. 6, 1998)
Pennell	US 6,910,179 B1	Jun. 21, 2005 (filed Nov. 9, 1999)

Claims 11-13, 15, 19, 24, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Al-Hussein in view of Lo.

Claims 14, 16-18, 20-23, 26, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Al-Hussein and Lo, and further in view of LeClair and Pennell.

We make reference to the Brief (filed Mar. 30, 2007) and the Answer (mailed Jul. 24, 2007) for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants did not make in the Brief have not been considered and are deemed waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103. Appellants do not dispute the Examiner's reading of most of the claimed features on the prior art teachings, they merely focus on whether Al-Hussein's PICS equipment, which identified as a facsimile machine, has properly been interpreted as a printer (Br. 9-12).

Therefore, the issue turns on whether there is a legally sufficient justification for combining the disclosures of Al-Hussein and Lo and if so, whether the combination of the applied references teaches the claimed subject matter related to a printer.

FINDINGS OF FACT

The following findings of fact (FF) are relevant to the issue involved in the appeal.

Appellants' Specification

1. Appellants describe the printing device as follows:

> The printing device 204 comprises any device that is capable of generating hardcopy forms. Although the term "printing device" is used herein, it is to be understood that the disclosure is not limited to any particular type of device that provides this functionality. Accordingly, the term is intended to include any appliance or printing device (e.g., printer, photocopier, *facsimile machine*, *multifunction peripheral* (MFP), etc.) that either inherently provides this functionality or which provides it when a suitable accessory is used in conjunction therewith.
> (Emphasis added.)
> (Spec. 5:14-20).

2. Appellants describe "imaging extension" as follows:

> As is further indicated in FIG. 7, the *imaging extension* 710 can form part of the browser 704.
> (Emphasis added.)
> (Spec. 17:11-12)
>
> The *imaging extension* 710 typically is implemented as one or more application programming instructions (APIs) that, preferably, act as interfaces in accordance with a system-wide standard.
> (Emphasis added.)
> (Spec. 17:17-19).

Al-Hussein

3. Al-Hussein relates to a personal imaging computer system, which identifies characters in a document on which the characters are formed. The imaging computer is a single stand-alone device that contains

document scanning, storage and processing equipment which is connectable to a computerized local area network or wide area network. (Abstract; col. 5, ll. 6-14).

4. The personal imaging of Al-Hussein includes a printing section 26 in one housing as a part of the equipment (col. 5, ll. 29-32) or connected to printers 45 and 56, which is connected to local area network via print servers 44 and 55 (Fig. 4; col. 6, ll. 12-16 and 39-42).

5. As shown in Fig. 8, the flow diagram indicates that the operation of PICS equipment 20 are executed by CPU 60 in accordance with stored program instruction steps stored on computer disk 75 (or other media) and transferred to RAM 79 for execution by CPU 60. (Col. 10, ll. 10-15).

6. An operator may scan a document so as to obtain a text file corresponding to text areas of the document, to store the document image and associated text file on network disk 42, to retrieve the document image and its associated text file for manipulation, if desired, at workstation 40, and print out the original or manipulated document image and text file on one of printers 45 (col. 6, ll. 16-25). Specifically, step S804 of Figure 8 shows that the lowered resolution document image, in compressed or uncompressed form as desired, is stored in association with the text file from step S802 (col. 10, ll. 40-45).

7. Thus, as shown in step S805 of Figure 8, the document image may be retrieved in response to query-based searches of the text file and presented to the operator for changes to be made in desired form, such as by display or by printing (col. 10, ll. 46-55).

8. Al-Hussein also provides for inputting a document image that was created elsewhere, for example, a document image scanned remotely

and transmitted to PICS equipment 20 via telephone line 29, local area network 31, or wide area network 32 (col. 11, ll. 11-18).

Lo

9. Lo relates to overlaying a data image on a form image by using a form enhancement module that interfaces to a PostScript driver and a forms overlay plug in module. (Abstract).

10. As depicted in Figures 3 and 4, Lo downloads and stores an image of an invoice or a business form an encapsulated PostScript (EPS) file on the storage device 3 of the printer 1. The image of the invoice corresponds to a blank form without new data from a user or may contain subsets of data, such as the operator's name and phone number, to be stored with the form. (Col. 5, ll. 20-42).

11. When a form that is already encoded in an EPS format is selected for print, the user data are overlaid on the EPS form image and a composite image of the form and the data is printed by the printer. (Col. 5, l. 64 through col. 6, l. 2).

12. When the forms overlaying operation is enabled, only the data page description is sent to the printer buffer, and when called thereby, the EPS form page description file is retrieved from the printer's storage device 3 without being separately downloaded from the computer 5 to the printer 1. (Col. 6, ll. 60-67).

LeClair

13. In a network comprising a server and an output device (col. 2, ll. 48-51) such as a printer with embedded server (col. 5, ll. 1-3; col. 7, ll. 7-15), a request to the device is formulated as an HTTP "POST" command (col. 7, ll. 54-65).

Pennell

14. Pennell relates to a method for entry of form data in a browser (Abstract).

15. As shown in Figure 4, Pennell provides for a pop up dialogue window in addition to the visited web site which allows the user to automatically place the information supplied in the pop up window, or a modified version of it, in the displayed form provided at the web site (col. 3, ll. 35-47).

PRINCIPLES OF LAW

To reach a conclusion of obviousness under § 103, the Examiner bears the burden of producing a factual basis supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a prima facie case. *In re Piasecki*, 745 F.2d 1468, 1471-72 (Fed. Cir. 1984).

Furthermore, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *See In re Kahn*, 441 F.3d 977, 987-88 (Fed. Cir. 2006), *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991) and *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

> "Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to

> a person having ordinary skill in the art to which said subject matter pertains.'"

KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1734 (2007).

"The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR*, 127 S. Ct. at 1739). "One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims." *KSR*, 127 S. Ct. at 1742.

The *KSR* Court further recognized that "[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp." *KSR*, 127 S. Ct. at 1742. In such circumstances, "the fact that a combination was obvious to try might show that it was obvious under § 103." *Id*.

ANALYSIS

1. Rejection of Claims 11-13, 15, 19, 24, and 25 over Al-Hussein in view of Lo

The Examiner asserts (Ans. 3) that Al-Hussein discloses all of the elements of claim 11, except for merging and printing the form data. The Examiner further relies on Lo for disclosing merging the retrieved form imaging data with the already stored static form data on the printer (*id.*).

The Examiner concludes (Ans. 4) that using the Lo's merging image data in combination with form data in Al-Hussein provides the benefit of facilitating file downloading and file management procedures (Ans. 4-5).

Appellants do not argue (Br. 9) that Al-Hussein discloses a PICS equipment having attributes of a computer and mainly assert that the disclosed PICS equipment is a facsimile machine that also has computing capabilities. Appellants further assert (Br. 11) that Al-Hussein, as described in column 6, lines 16-25, scans a hard copy document and transmits the scanned file to a workstation to be printed using one of the printers 45 and therefore, cannot be said to perform the claimed steps of accessing and retrieving form imaging data from a store by a printer (Br. 11-12). Lastly, Appellants assert (Br. 13) that, given the different functionalities performed by a facsimile machine, one of ordinary skill in the art would not have combined the printing functionalities of the printer described by Lo with the PICS equipment of Al-Hussein.

The Examiner responds that the presence of additional printers 45 or 56, as better quality printers, on the network does not negate the function of the PICS equipment as a printer (Ans. 15-16). The Examiner further asserts that while a document may be scanned, Al-Hussein in column 11, lines 11-18, provides for inputting the document image and data via a network to the PICS equipment 20 (Ans. 16). Further, the Examiner argues that such data are stored in RAM 79 of the PICS equipment 20 and, as discloses in column 10, lines 42-55, is later accessed and retrieved by the PICS equipment (Ans. 16-17). With respect to the combination of Lo and Al-Hussein, the Examiner argues that a facsimile is also a printer and would have benefited from the features described in Lo (Ans. 17-18). In particular, the Examiner

finds (Ans. 18) this similarity to be consistent with Appellants' disclosure on page 5 which identifies a printing machine to include any appliance or printing device such as a facsimile machine.

Based on our review of the reference and Appellants' disclosure, we agree with the Examiner that the PICS equipment in Al-Hussein functions as a printer which accesses and retrieves form image data, and in combination with Lo, prints a hard copy form, as claimed. Initially, as argued by the Examiner, we find that Appellants' disclosure considers a facsimile machine as a type of printing device (FF 1). Additionally, the PICS equipment of Al-Hussein is an imaging computer that includes the processing units and the storage units for receiving and storing image data as well as retrieving such data for producing a hard copy print (FF 3-5). As agued by the Examiner (Ans. 16-17), the image data may also be sent to the PICS equipment (FF 8) which is stored for later retrieval when an inquiry is received (FF 5-7). We also find unpersuasive Appellants' argument (Br. 10-11) that scanning a hard copy document in Al-Hussein is not the same as accessing and retrieving the imaging data based on our finding that Al-Hussein may access and retrieve imaging data already received via the network (FF 8) for printing based on query-based search (FF 7). We also find that Al-Hussein stores the document image and the manipulated associated text, which may be retrieved for printing (FF 6-7).

We also find Appellants' argument directed to lack of motivation or suggestion to combine the references (Br. 12-13) to be unpersuasive. As discussed above, the PICS equipment of Al-Hussein is a printing device which provides the form imaging data and the static form data as the document image and its associated text file (FF 6-7). Similarly, Lo provides

for generating a document by overlaying the image data of a blank form with user data (FF 9-11). Lo further discloses that only the data are sent to the printer while the form image data are retrieved from the printer storage device (FF 12). Therefore, we observe that, consistent with the principles outlined in the *KSR* and *Leapfrog* holdings, the evidence provided by the Examiner supports a finding that combining the familiar form printing of Lo with the printing device of Al-Hussein is based on an obvious solution to the known problem of printing a form by sending only the text file to the printer, produces predictable results, and would have been obvious to one of ordinary skill in the art.

Similar to claim 11 discussed above, Appellants challenge (Br. 13-14) the functionality of Al-Hussein's equipment 20 as a printer and the combinability of the references in rebutting the rejection of independent claims 19, and 24, which we found to be unpersuasive. In view of our analysis above, we find that the teachings of Al-Hussein and Lo, when considered as a whole, support the Examiner's 35 U.S.C. § 103 ground of rejection. Thus, we sustain the 35 U.S.C. § 103(a) rejection of independent claims 11, 19, and 24, as well as claims 12-15 and 25 argued together with their base claims, over the teachings of Al-Hussein and Lo.

2. Rejection of Claim 14, 16-18, 20-23, 26, and 27 over Al-Hussein and Lo and further in view of LeClair and Pennell

In addition to repeating the same arguments presented with respect to claim 1, Appellants specifically argue (Br. 14-15) that in rejecting claims 16-18, LeClair's general reference to invoking a browser to "submit information" is not the same as an "imaging extension" of a browser

"accessing" imaging data. The Examiner responds (Ans. 19-20) that the printer in LeClair includes an embedded Web server which may be accessed via a browser (*quoting* LeClair, col. 5, ll. 1-3; col. 7, ll. 7-15 and 55-59). The Examiner further relies on Pennell for disclosing a browser to provide a standard interface and concludes that, considering Appellants' disclosed definition of "imaging extension" on page 17 of the Specification, the browser meets the recited subject matter of claim 16 (Ans. 20).

We agree with the Examiner and find that LeClair does provide for a printer connected to a network server that provides the request for the device operation (FF 13). We also agree with the Examiner that to the extent disclosed (FF 2), the claimed "imaging extension" reads on the browser window in Pennell that is used to access the user data for entry into the displayed form (FF 14-15). As such, we do not find any error in the Examiner's position with respect to combining the teachings of LeClair and Pennell with those of Al-Hussein and Lo to access the imaging data through the pop up window of LeClair.

Therefore, for the same reasons discussed above with respect to independent claims 11, 19, and 24 and based on our analysis of LeClair and Pennell, we sustain the 35 U.S.C. § 103(a) rejection of claims 16-18, as well as claims 14, 20-23, 26, and 27 argued together with claims 16-18 as one group, over Al-Hussein and Lo and further in view of LeClair and Pennell.

CONCLUSION

Because Appellants have failed to point to any error in the Examiner's position, we sustain the 35 U.S.C. § 103 rejection of claims 11-13, 15, 19,

24, and 25 over Al-Hussein and Lo, and of claims 14, 16-18, 20-23, 26, and 27 over Al-Hussein, Lo, LeClair and Pennell.

DECISION

The decision of the Examiner rejecting claims 11-27 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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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