

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID L. LANDOM and BRAD S. RILEY

Appeal No. 1999-0828
Application No. 08/526,743

ON BRIEF²

Before LALL, LEVY, and BLANKINSHIP, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection³ of claims 1-4, 9, 11, 17, and 18.

BACKGROUND

Appellants' invention relates to a method of automatically supplying price quotes for barcode printing supply products.

² The Oral hearing set for January 8, 2002 has been waived by appellants in a communication received November 12, 2001.

³ An amendment filed subsequent to the final rejection (Paper No. 7, filed September 4, 1998), has been entered by the examiner.

Representative claim 1 is set forth as follows:

1. A method for operating a system to automatically provide price quotes for a plurality of different types of barcode printing supply products associated with different types of barcode printers, said system having a display for displaying information and an input device operable by a user to selectively change said displayed information, said method comprising:

displaying a default quote depicting a default value for each of a plurality of variables defining a barcode printing supply product;

storing for at least one of said barcode printing supply product defining variables a set of allowable options for other of said barcode printing supply product defining variables associated with said one variable;

changing said displayed default quote in response to a user input change of the default value of said one variable to automatically depict any necessary changes in said other variables associated with said one variable based upon said stored set of allowable options.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Greulich et al. (Greulich) 5,241,464 August 31, 1993

Claims 1-4, 9, 11, 17, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Greulich in view of Official notice taken by the examiner.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 11, mailed October 28,

1998) and the final rejection (Paper No. 6, mailed June 5, 1998) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 10, filed October 15, 1998) and reply brief (Paper No. 13, filed December 14, 1998) for appellants' 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 reference, and to the respective positions articulated by appellants and the examiner. Upon consideration of the record before us, we affirm-in-part.

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 is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion

or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

We begin with independent claim 1. The examiner's position⁴ (final rejection, page 3) is that Greulich "does not expressly teach that the [business form] products are barcode printing supply products." To overcome this deficiency in Greulich, the examiner takes Official notice (id.) that it "is old and well-known in the art that barcode printing supply products are similar to business forms and require much of the same specification definitions for custom ordering, such as size, punching and perforations, etc." The examiner asserts (final rejection, pages 3 and 4) that it would therefore have been obvious to modify the method of Greulich to provide price quotes for barcode printing supply products. The examiner notes (id., page 4) that although Greulich does not expressly teach that the initial quote displayed is a default quote, that Greulich teaches saving orders and opening saved orders. The examiner takes Official notice⁵ that the use of default values is old and well

⁴ The rejection of claims 1-4, 9, 11, 17, and 18 under 35 U.S.C. § 103(a), set forth in the final rejection has been incorporated, by reference, into the examiner's answer (answer, page 3).

⁵ The examiner (final rejection, page 8) adds a reference to Mastering Windows 3.1 to support the examiner's taking of Official notice. The examiner acknowledges (id.) that appellants have not specifically traversed the examiner's statement that default values are old and well known. On page 6 of the answer, the examiner refers to Mastering Windows 3.1, which appellants note (brief, page 8) has not been applied in the rejection under appeal.

We note the following principle. "Where a reference is relied on to

(continued...)

known in the art. The examiner further asserts (id.) that if a complete saved order is opened, a quote is clearly displayed without any interaction of the user.

Appellants assert (brief, page 6) that a prima facie case of obviousness has not been made because the cited prior art does not teach the display of a default quote as claimed. Appellants assert that in Greulich, before a quote is displayed, the parameters provided in the order software (second control means) must be provided. Appellants argue (brief, page 7) that from this disclosure of Greulich, it is clear that Greulich does not display a default quote, but merely displays a screen of information to prompt the user to enter sufficient information from which a quote can be provided.

We find that Greulich discloses a first computing means 10 at an order reception facility of a business forms manufacturer

⁵(...continued)

support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of rejection." In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). Here, although the examiner cites Mastering Windows 3.1 (examiner's answer, page 6), the examiner fails to positively include the reference in the statement of the rejection (answer, page 3 or final rejection, page 8). Accordingly, because the reference was not cited in response to a traverse by appellants and has not been included in the rejection, we will not consider the reference in deciding this appeal. See also Ex parte Raske, 28 USPQ2d 1304, 1305 (Bd. Pat. App. & Int. 1993).

(col. 4, lines 42-46). Second computing means 13 is provided at a customer's office (col. 4, lines 48-53). First control means are stored on disk 16, and controls second computer 13 for custom design of a plurality of first parameters of a business form (col. 4, lines 53-57). The number and type of first parameters depends on the sophistication of the software comprising the first control means. If sophisticated software is used, virtually all of the form parameters can be determined by the first plurality of parameters. If less sophisticated software is used, some of the parameters are not provided by the first plurality of parameters (col. 4, line 58 - col. 5, line 2).

Second control means, also on disk 16 in computer 13, controls second computing means 13 to display a second plurality of business form parameters, quantity, and delivery options (col. 5, lines 3-17). In addition (col. 6, lines 25 and 26), selection of option 30 (figure 3) allows a user to capture the selected custom form that has already been designed in the forms software (first control means).

As shown in figure 4 of Greulich:

FIG. 4

SHORT RUN BUSINESS FORMS -- MANUFACTURING AND ORDERING INFORMATION		
NAME OF FORM	0037.GEM	← 30
QUANTITY	1500	← 31
FORM TYPE	MULTIPART FORMS	← 32
PAPER SIZE	4 PART	
PAPER TYPE	4 1/4 X 8 1/2	← 33
PAPER TYPE	PORTRAIT/TOP	
INK	ALL WHITE PAPER	← 34
NUMBERING	PROCESS BLUE	← 35
PUNCH/PERF		← 36
BINDING		← 37
SHIPPING		← 38
COMMENTS		← 39
HELP		

ORDER STATUS:
NEW ORDER

PRICING SUMMARY:
PRODUCT PRICE: 0000.00
SALES TAX: 00.00
TOTAL ORDER: 0000.00

TAX EXEMPT

IF YOU ORDER ... PRICE

QUANTITY	PRICE
(QUANTITY 1)	0000.00
(QUANTITY 2)	0000.00
(QUANTITY 3)	0000.00

after selecting a form from the business form design software and entering the form name at 30, the form is captured into the order software (second control means), along with any of the parameters 32-38 that were determined in the forms design software (col. 6, lines 39-48). After entry of parameters 31-39, the second computing means calculates the price, sales tax, and the amount of the total order, as indicated at 41 in figure 4 (col. 6, line 67 - col. 7, line 5). In addition, to assist a customer in optimizing an order, display 42 is provided which shows different

prices that exist if different quantities are ordered (col. 7, lines 5-9).

In figures 5A and 5B, Greulich discloses that upon selection of the variable "form type," such as multipart form 32, a graphic display 44 is provided that overlays screen 40, but does not completely obscure the first set of options 43 (col. 7, lines 22-35). On graphic display 44 are a second set of options 45; a third set of options 46, and a fourth set of options 47. As seen in figures 5A and 5B, upon selection of a variable, any necessary changes in other variables associated with the selected variable are automatically depicted; see page width 57 and the depiction of three optional page lengths 57' (figure 5B; col. 8, lines 13-26, and col. 10, lines 45-47), so that the customer will know which additional options are available in view of the option selected. (col. 7, line 38 - col. 8, line 25).

From these portions of the disclosure of Greulich, we find that a price quote is initially provided after the parameters have been selected. However, as noted by the examiner, Greulich additionally discloses that orders can be saved and opened. In addition, a previously changed file (figure 6) can be saved. We find that as shown in figures 9W and 9X, the customer can select "SAVE" or "SAVE AS" files and overwrite existing files. In

addition, under the selection "OPEN ORDER" of figure 6, the user can select and open a file, which brings the user to the "FILL IN ORDER SCREEN" as shown in figure 9V.

From these teachings of Greulich, we agree with the examiner (answer, page 4), that upon opening a saved order, (or a completed screen 40 without an order having been placed), that the customer will have a default quote without having to add any additional information; i.e., without any interaction by the user. We consider an opened file where screen 40 was completely filled out before the file was saved to be a default quote since the customer does not have to input any parameters.

As stated by the court in In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) "[t]he name of the game is the claim." Claims will be given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims. In re Etter, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. cir. 1985). Claim 1 recites "displaying a default quote depicting a default value for each of a plurality of variables." Claim 1, as broadly drafted, does not recite how the default quote is obtained. As drafted, the above quoted language of claim 1 reads on opening a completely filled out screen 40 in

Greulich that has been previously saved by the customer. Because the quote 41 and additional quotes 42, based upon different quantities, are provided without input from the user, we consider the quotes 41 and 42 to be default quotes. We are not persuaded by appellants' assertion (reply brief, pages 2 and 3) that:

However, Fig. 9V requires the user to "FILL IN ORDER SCREEN" when "opening" a selected file name i.e., a stored order. This is contrary to a default quote wherein the user is not required to "fill in" anything. That is the point of displaying a default quote: the user is not forced to enter information before seeing a typical quote with quantity and price information. If a user of Greulich opens a saved order, even if it were completed after filling it in, the user doesn't know whether it's a typical quote or not because it is not a default.

We find that upon opening a saved file, where screen 40 was completely filled in and a quote obtained, that unless the user makes changes to the variables requiring the price to be recalculated (col. 8, lines 66-68) the price provided in the opened quote is a default quote because the quote is obtained by the customer without having to change any variables. In addition, we find that the customer does not have to fill in all of the fields with default values because the values with the quote are already present in the fill order screen. If the order screen referred to in figure 9V was blank and had to be filled in, this would defeat the purpose of being able to save files and

then open them at a later time. We find that in similar fashion, in appellants' invention, a customer can change a variable in a default quote and obtain a new default quote which may be saved as "Save As New Quote" so that, upon subsequent use of the system, the modified quote that was saved is then considered to be the default quote (specification, page 9, line 15 - page 10, line 6). Assuming arguendo, that in Greulich, the opening and use of a saved file having a quote is not considered as having a default quote, we find that it would have been obvious to a skilled artisan to use a quote in a saved file as a default quote in view of the teaching in Greulich (col. 2, lines 3-11) that:

A number of advantages associated with the invention are: the ability to allow the customer to lay out its own forms on personal computers; eliminates or reduces labor intensive portions of business form order preparation, such as design and composition; manages and automates the entire order entry process; decreases the time required to produce and deliver short run orders of business forms; and reduces the manufacturer's overhead costs in producing short run orders.

In view of these advantages associated with the automated form creation system of Greulich, and Greulich's disclosure of saving files, overwriting files, and opening files, we find that a skilled artisan would have considered it obvious to open saved

files as default quotes, in order to save time in placing a new order. From all of the above, the rejection of claim 1 under 35 U.S.C. § 103(a) is affirmed.

Turning next to dependent claim 2, appellants assert (brief, page 7) that Greulich does not disclose that the default quote includes a default value for quantity, but rather that Greulich teaches the opposite, i.e., that quantity must be entered by the user. We find this limitation to be met by Greulich for two reasons. The first is that upon reopening a saved file where screen 40 was completely filled in, a default quote is displayed. The second reason is that Greulich discloses (col. 7, lines 5-9) that "[i]n order to provide the customer with information that can assist him/her in optimizing the order, a display 42 is also preferably provided showing the different prices that exist if different quantities are ordered." From this disclosure of Greulich, we find that as shown in figure 4, to help in optimizing an order, the different standard quantities that can be ordered are displayed to the user at 42. Accordingly, the rejection of claim 2 under 35 U.S.C. § 103(a) is affirmed.

Turning next to dependent claim 3, appellants have not presented arguments with respect to the specific limitations of this claim. We agree with the examiner (final rejection, page 5)

that Greulich discloses in figure 4, there is a simultaneous display of the variables 30 and 32-39, quantity 31, and the associated price 41, when the price is calculated. Accordingly, the rejection of claim 3 under 35 U.S.C. § 103(a) is affirmed.

We turn next to the rejection of dependent claim 4 and independent claim 11. We note at the outset that with respect to claim 11, we make reference to our findings, supra, regarding the teachings in the prior art.

Appellants assert (brief, page 9) that claims 4 and 11 further specify adjusting the displayed price in response to each user change in a variable affecting the price in order to allow the user to see how each change in the variable affects the price. Appellants argue (id.) that Greulich requires the selection of parameters in a particular sequence, and that only after all of the parameters are entered along with an order quantity is the price calculated, such that the user of Greulich cannot see how the selection of each parameter affects the price. Appellants rely upon the disclosure of col. 8, lines 62-66 of Greulich that "[a]s illustrated in FIG. 9b in the quantity routine, updated pricing information is sent -- see box 64 -- to a subroutine to be stored and to be ultimately used to calculate

a price when enough information has been received to calculate a price." Appellants conclude that because Greulich does not adjust the price displayed in response to each change of a variable that affects the price, that the rejection of claims 4 and 11 is based upon improper hindsight.

We make reference to the final rejection (page 5) and the examiner's answer (page 7) for the examiner's position. Of note is the passage in Greulich (col. 8, lines 66-68) that follows the portion of Greulich relied upon by appellants. This passage recites "[a]s illustrated in the other parts of FIG. 9, this price is recalculated and updated as more options (e.g. perforations) are added." We construe these portions of Greulich to refer to two situations. The first, as argued by appellants, is that when a customer is filling in variables 31 through 38 (figure 4), along with any allowable options (figures 5A and 5B), pricing information is stored and ultimately used to calculate a price when enough information has been received to calculate a price. The second situation, as argued by the examiner, is when a saved order has been opened to start a new price quote. In this instance, upon changing a variable, once the information for the variable has been supplied, the price is recalculated. For

example, as shown in figure 4, a price quote 41 is shown. In addition, alternate quantities and prices are shown at 42. Upon selection of the variable of a different quantity, the price will be recalculated, as no further information is needed to recalculate the price. As another example, as shown in figure 5B, upon changing a variable such as changing a page length from 7 to 10, the price will be recalculated as no further information is needed. In addition, as a third example, if a customer wants to change the variables of ink used and paper size, upon changing the type of ink used (figure 9P), a new price would be calculated before the change in paper size was input, as no further information was needed. In addition, if changing of the variable paper size requires additionally changing other variables associated with the paper size, such as changing from portrait to landscape, which additionally requires a change in stub location (from e.g., 50 to 52 in figure 5A) a change would therefore be made to two variables, i.e., orientation and stub location, before a new price is calculated. Claim 4 recites "including the step of adjusting the price displayed in response to each user input change to the value of a variable affecting the price to allow a user to see how each change in the variable affects the price" [underlining added]. We note that claim 1, from which

claim 4 depends, does not require that a change to a variable input by a user will always produce changes to other variables, but rather that any necessary changes are depicted, which Greulich discloses in figure 5B. In addition, we note that the language of adjusting the price displayed in response to each user input change to the value of a variable does not require that the user change a variable that necessarily requires the change in an additional variable before the price is adjusted. We therefore find that the limitation of claim 4 is met by the user changing variables, each of which does not require the changing of other variables before the price quote is changed. With respect to claim 11, we find that the limitation:

"automatically adjusting the price displayed to a new value in response to each change of a displayed variable value affecting the price to display each new price value resulting from a change in one of said displayed variable values as each of said displayed variable values is changed to allow a user to see how a change in a variable affects said price"

is met by the customer changing variables that do not require a change in another variable before the price quote is changed. In addition, we observe that as broadly drafted, the limitations in claim 11 regarding variables are also met by interpreting Greulich's variables or first set of options to be the variables

30-38 (figure 4), and considering the second, third, and fourth sets of options (figures 5A and 5B) to be sub-options. From all of the above, the rejection of claims 4 and 11 under 35 U.S.C. § 103(a) is affirmed.

We turn next to the rejection of claims 9, 17, and 18.

Appellants assert (brief, page 10) that:

Claims 9, 17 and 18 specify a method of storing a first default quote; displaying the first default, changing the displayed default quote in response to a user input change of one or more of the default values contained in the quote; and storing the changed quote as a second default quote which the system automatically displays upon starting a new quote. This feature allows a user to change a default quote so that one user of the system may use one default quote and a different user of the same system may use a different default quote.

We make reference to the final rejection (pages 5 and 6) and the examiner's answer (pages 7 and 8) for the examiner's position.

With respect to independent claim 17, we make reference to our findings, supra, with respect to the teachings and suggestions of Greulich.

With regard to the limitation in claim 17 that the system automatically displays the second default quote upon starting a new quote, we find that this limitation is met by the customer starting a new quote by opening a saved file that is a second default quote; i.e., a quote that has been saved,

changed, and resaved in the past. Upon selection, the file is "automatically displayed." Accordingly, the rejection of claim 17 under 35 U.S.C. § 103(a) is affirmed.

Turning next to the rejection of claim 9, the claim requires that the new default quote is automatically displayable in response to a reset input to start a new quote. We find that in figures 6 and 9U of Greulich, a customer can select "clear" to reset an order screen, and can also open a saved file. However, Greulich does not disclose automatically opening a saved file in response to a "clear" order resetting the order screen. We agree with the examiner that Greulich teaches or suggests that a saved file can be opened and used by the customer as a default quote. We additionally agree with the examiner (answer, page 6) that "it is old and well-known in the art to open a saved file as a default [file]." However, we do not agree with the examiner's assertion (final rejection, page 5) that opening a saved file in Greulich is a reset input. We find that in Greulich, selecting "clear" (figure 6) is a reset input as it resets the order screen (figure 9U). In addition, we find that a skilled artisan would not have been motivated to use a saved file as the reset order screen, because a reset (empty) order screen is needed in the event the user wishes to create a form that is completely

different from forms that have been previously created by the user. We find no suggestion, apart from appellants' disclosure, and no convincing line of reasoning has been provided by the examiner, for the reset (empty) order screen to be a saved file (default quote), so as to automatically display a changed default quote as a new default quote in response to a reset input to start a new quote, as required by claim 9. Claim 18 contains similar language. Accordingly, the rejection of claims 9 and 18 under 35 U.S.C. § 103(a) is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-4, 11, and 17 under 35 U.S.C. § 103(a) is affirmed. The decision of the examiner to reject claims 9 and 18 under 35 U.S.C. § 103(a) is reversed.

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

AFFIRMED-IN-PART

PARSHOTAM S. LALL)	
Administrative Patent Judge)	
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Appeal No. 1999-0828
Application No. 08/526,743

Page 22

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