

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN D. BERG,
RANDY MCGEE,
MICHAEL L. SWABB,
and
JEFFERSON ALLAN

Appeal No. 1999-0475
Application No. 08/402,031

ON BRIEF

Before JERRY SMITH, RUGGIERO, and GROSS, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-32. In an amendment filed December 8, 1997 after final rejection, which was entered by the Examiner, claims 1, 4, 5,

Appeal No. 1999-0475
Application No. 08/402,031

6, 8, 14, 16,

and 17 were amended, claims 2, 3, and 15 were canceled, and
claim

Appeal No. 1999-0475
Application No. 08/402,031

33 was newly added. Accordingly, claims 1, 4-14, and 16-33 are before us on appeal.

The claimed invention relates to a printing system for printing documents and forms, as needed, in response to user commands entered through a user interface, such as a touch screen monitor. The documents and forms are electronically stored in memory and arranged in a plurality of libraries. A processor, responsive to the touch screen monitor and memory, is connected to a printer to control printing of the selected forms. Further stored in memory is software to control the display and printing of the documents and forms without the native applications in which the documents and forms were created.

Claim 1 is illustrative of the invention and reads as follows:

1. A printing system for printing documents and forms, as needed, in response to user-entered commands, comprising:

a touch screen monitor for displaying information regarding the documents and forms, and user options, and for entry of commands by the user,

a memory for storing a plurality of documents and forms, said documents and forms being organized into a plurality of libraries, and for storing software to

Appeal No. 1999-0475
Application No. 08/402,031

control the display of options on said monitor and the interpretation and implementation of commands entered on said monitor,

a printer for printing documents and forms, and

a processor, responsive to said monitor and said memory and communicating therewith, said processor being connected to said printer to control printing of a document or form by said printer upon selection thereof by a user and entry of commands via said touch screen monitor, wherein said software causes said monitor initially to display a listing of libraries and, upon user selection of a library, then causes said monitor to display a listing of the documents and forms included in the selected library and of one or more kits of documents and forms included in the selected library.

The Examiner relies on the following prior art:

Montagna et al. (Montagna)	4,899,292	Feb. 06, 1990
Freiman et al. (Freiman)	4,939,670	Jul. 03, 1990
Greulich et al. (Greulich)	5,241,464	Aug. 31, 1993

Claims 1, 4-6, 8-12, 14, 16, and 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Montagna. Claims 7, 13, and 18-33 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner offers Montagna in view of Greulich with respect to claims 7 and 18, Montagna in view of Freiman with respect to claims 19-24, 26-30, and 32, and Montagna in view of Greulich and Freeman with respect to

Appeal No. 1999-0475
Application No. 08/402,031

claims 13, 25, 31, and 33.

Appeal No. 1999-0475
Application No. 08/402,031

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs¹ and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, and the evidence of anticipation and obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the Montagna reference does not fully meet the invention as set forth in claims 1, 4-6, 8-12, 14, 16, and 17. We are also of the view that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the

¹The Appeal Brief was filed December 18, 1997 (Paper No. 15). In response to the Examiner's Answer dated March 31, 1998 (Paper No. 16), a Reply Brief was filed May 26, 1998 (Paper No. 17), which was acknowledged and entered by the Examiner as indicated in the communication dated August 18, 1998 (Paper No. 18).

Appeal No. 1999-0475
Application No. 08/402,031

invention as recited in claims 7, 13, and 18-33. Accordingly, we reverse.

We consider first the Examiner's 35 U.S.C. § 102(b) rejection of claims 1, 4-6, 8-12, 14, 16, and 17 as being anticipated by Montagna. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to independent claims 1 and 14, the Examiner attempts to read the various limitations on the disclosure of Montagna. In particular, the Examiner points (Answer, page 4) to the block diagram illustrations in Figures 1 and 4 of Montagna, as well as to Montagna's description of the organization of stored "hyperpages" of text and graphics in the hierarchical indexing system illustrated in Figure 3.

Appeal No. 1999-0475
Application No. 08/402,031

Appellants' arguments in response assert a failure of Montagna to disclose every limitation in the claims as is required to support a rejection based on anticipation. At pages 7-9 of the Brief, Appellants' arguments focus on the assertion that, contrary to the Examiner's interpretation of Montagna, there is no disclosure of the display of a listing of stored documents and forms " . . . and of one or more kits of documents and forms" as required by each of independent claims 1 and 14.

After reviewing the Montagna reference in light of this assertion of Appellants, we are in agreement with Appellants' position as stated in the Briefs. Our interpretation of the disclosure of Montagna coincides with that of Appellants, i.e., there is no provision for the displaying of both a list of documents and forms and a kit of documents and forms as set forth in the appealed claims. We agree with Appellants that even if the submenus illustrated in Figure 3 of Montagna are interpreted as being kits of forms, there is no disclosure of the display of both the stored kits and a listing of stored documents and forms. In our view, the Examiner's conclusion is based on unwarranted conjecture and speculation that is not

Appeal No. 1999-0475
Application No. 08/402,031

supported by any disclosure in the Montagna reference itself. In order for us to sustain the Examiner's rejection under 35 U.S.C. § 102(b), we would need to resort to speculation or unfounded assumptions to supply deficiencies in the factual basis of the rejection before us. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968), reh'g denied, 390 U.S. 1000 (1968). Accordingly, since all of the claim limitations are not present in the disclosure of Montagna, the Examiner's 35 U.S.C. § 102(b) rejection of independent claims 1 and 14, as well as claims 4-6, 8-12, 16, and 17 dependent thereon, is not sustained.

Turning to a consideration of the obviousness rejection based on the combination of Montagna and Greulich of claims 7 and 18, dependent, respectively, on claims 1 and 14 discussed supra, we do not sustain this rejection as well. It is apparent, from the Examiner's line of reasoning in the Answer, that Greulich is added to Montagna for the sole purpose of providing a teaching of a screen displayed option for selecting the number of copies of a document to be printed. We find nothing, however, in the disclosure of Greulich that

Appeal No. 1999-0475
Application No. 08/402,031

would overcome the innate deficiencies of Montagna discussed previously.

We next consider the Examiner's 35 U.S.C. § 103 rejection of claims 19-24, 26-30, and 32 based on the combination of Montagna and Freiman. We initially note that, unlike independent claims

1 and 14 discussed previously which include the feature of displaying a list of documents and a kit of documents, independent claim 19, rather, includes a recitation directed to the storing in a plurality of formats, documents and forms that were created in a plurality of native applications.

Recognizing that Montagna lacks a disclosure of this feature, the Examiner turns to Freiman which, according to the Examiner, discloses at column 2, lines 17-37, the converting of documents and forms in various formats. In the Examiner's view, the skilled artisan would have recognized the obviousness of incorporating the data conversion features of Freiman into the system of Montagna

" . . . in order to store documents and forms created in different formats and converting these documents and forms

Appeal No. 1999-0475
Application No. 08/402,031

into a format understood by the printer." (Answer, page 7).

After reviewing Appellants' arguments in response, we are in agreement that the Examiner has not established a prima facie case of obviousness. Besides the fact that, as pointed out by Appellants, the claims do not require any format conversion of documents and forms, the express disclosure of Montagna (column 5, lines 17-21) is that, regardless of the origin of the stored data, the data is stored in only one format. Given this disclosure of Montagna, it is not evident to us from the Examiner's line of reasoning in the Answer how and in what manner Montagna would be modified by Freiman to arrive at the claimed invention. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992). Accordingly, since the Examiner has not established a prima facie case of obviousness, the rejection of independent claim 19, and claims 20-24, 26-30, and 32 dependent thereon, over the combination of Montagna and Freiman is not sustained.

Appeal No. 1999-0475
Application No. 08/402,031

Lastly, we also do not sustain the Examiner's 35 U.S.C. § 103 rejection of claims 13, 25, 31, and 33 based on the combination of Greulich and Freiman with Montagna. Dependent claims 13, 31, and independent claim 33 include a feature directed to the limiting of printing of documents and forms until authorization is received for additional printing. Although the Examiner has applied the Freiman reference to address this claimed feature, we find nothing in Freiman that has relevance to the limitations of the appealed claims. In particular, the portion of Freiman specifically cited by the Examiner, i.e., Figure 10 of the drawings, is related to a zoom feature for the EFORM arrangement, not to print authorization. We further agree with Appellants that even assuming, arguendo, that Freiman did disclose a print authorization feature, we fail to see why, absent Appellants' own disclosure, the skilled artisan would have been motivated to print and/or restrict the number of copies of documents in Montagna. As for dependent claim 25 which is directed to the screen display option of selecting a number of document copies to be printed, we find no disclosure in Greulich or Freiman, or any combination thereof, which would overcome the

Appeal No. 1999-0475
Application No. 08/402,031

deficiencies of Montagna with respect to independent claim 19,
upon which claim 25 depends.

In summary, we have not sustained any of the Examiner's
rejections of the claims on appeal. Therefore, the decision
of the Examiner rejecting claims 1, 4-14, and 16-33 is reversed.

Appeal No. 1999-0475
Application No. 08/402,031

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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)	
ANITA PELLMAN GROSS)	
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Appeal No. 1999-0475
Application No. 08/402,031

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