

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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALAN BECK

Appeal No. 1999-0482
Application 08/632,331

ON BRIEF

Before FLEMING, RUGGIERO, and LEVY, ***Administrative Patent Judges***.

FLEMING, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1, 4, 5 and 8 through 20. On December 23, 1997, Appellant filed an amendment after final. On January 14, 1998, the Examiner mailed an advisory action stating that the

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proposed amendment will be entered and the status of the claims are as follows: Claims 1, 4, 5, 8, 13 through 16 and 20 are allowed. Claims 9 through 12 and 17 through 19 stand rejected. We note that the file shows that claims 2, 3, 6, 7 and 12 have been canceled. Therefore, claims 9 through 11 and 17 through 19 are the only claims that are before us on this appeal.

The invention relates to the control of multiple print jobs that are respectively directed to different printers.

Independent claim 9 is reproduced as follows:

9. A method for managing the printing of documents in a system having multiple printers, comprising the steps of:

establishing separate folders that are respectively associated with said printers;

providing data which relates a document to be printed to a print manager;

creating a data file which describes the document and storing the data file in memory;

passing a reference to the data file from the print manager to the folder that pertains to a designated one of said printers on which the document is to be printed;

launching a spooler program stored in the folder that is associated with the designated printer;

transmitting the data from the file to a printer driver

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associated with the designated printer; and

printing the document on the designated printer.

The reference relied on by the Examiner is as follows:

Hower, Jr. et al. (Hower)	5,467,434	Nov. 14,
1995		

Claims 9 through 11 and 17 through 19 stand rejected under 35 U.S.C. § 102 as being anticipated by Hower.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the briefs¹ and answer for the details thereof.

OPINION

After a careful review of the evidence before us, we do not agree with the Examiner that claims 9 through 11 and 17 through 19 are anticipated by Hower.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every

¹Appellant filed an appeal brief on March 26, 1998. Appellant filed a reply brief on June 29, 1998. The Examiner mailed an office communication on September 1, 1998 stating that the reply brief has been entered and considered but no further response by the Examiner is deemed necessary.

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element of the claim. **See In re King**, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and **Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.**, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). "Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention." **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), **citing Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), **cert. denied**, 465 U.S. 1026 (1984).

The Examiner maintains in the final rejection that the queue shown in Hower's figure 1 as element 42 reads on Appellant's claimed "spooler program stored in the folder that is associated with the designated printer." Appellant argues on pages 6 through 8 that Hower's queue is not an executable program. Appellant argues that the spooler program as claimed is a program which prepares a file for printing and in contrast the queue for Hower merely comprises area for storing

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job tickets. Appellant points to column 7, lines 30 through 32, of Hower.

In response to this argument, the Examiner withdraws from the position that the Hower queue reads on the Appellant's claimed spooler program but then maintains that a spooler program is inherent in the Hower teaching. On pages 2 and 3 of the reply brief, Appellant argues that the spooler program is not inherent to the Hower teaching because it is not a necessary result from the teaching of the Hower reference. Appellant points out that the Hower reference teaches that a job ticket is formed and is transmitted to one of the printer queues. Appellant argues that it is not apparent that there is a spooler program launched in each queue nor is it inherent. Appellant argues that the system of the Hower patent is the conventional arrangement depicted in appellant's figure 1 in which all the printer services are carried out with a centralized printer manager. As such, appellant submits that the inherency rationale employed in the rejection is not supported by reference and cannot be applied just to assert that each queue maintains a spooler program.

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Furthermore, "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) *citing Continental Can Co. v. Monsanto Co.*, 948 F.3d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result for a given set of circumstances is not sufficient." *Id. citing Continental Can Co v. Monsanto Co.*, 948 F.3d 1264, 1269, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

Upon our review of the Hower reference, we note that Hower teaches in column 5, lines 2 through 10, that a server processor is capable of combining a set of electronic documents and a corresponding combination of print job selections, such as a job ticket, into a job file for

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printing. In column 7, lines 30 through 32, Hower further teaches that the corresponding job ticket 35 is transmitted to one of the print queues 42. We note that the reference is silent as to the queue being capable of providing a spooler program function. In fact, reading Hower as a whole we note that Hower leads a reader to the conclusion that the server processor 50 performs the preparation of the electronic document 39 for printing. Therefore, we fail to find that the Examiner's inherency rationale is supported by the evidence before us.

In view of the foregoing, the decision of the Examiner

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rejecting claims 9 through 11 and 17 through 19 is reversed.

REVERSED

MICHAEL R. FLEMING)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
STUART S. LEVY)	
Administrative Patent Judge)	

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MRF:pgg
Burns, Doane, Swecker & Mathis
P.O. Box 1404
Alexandria, VA 22313-1404