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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERT THOMAS REES, JOHN WILLIAM LUMLEY, and
ROGER BRIAN GIMSON

Appeal 2012-007506
Application 11/927,036¹
Technology Center 2100

Before JEFFREY N. FREDMAN, ULRIKE W. JENKS, and
KENNETH G. SCHOPFER, *Administrative Patent Judges*.

SCHOPFER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) involving claims to a method and apparatus for constructing a machine-readable document. The Examiner rejected the claims as obvious. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

¹ According to Appellants, the real party in interest is Hewlett-Packard Development Company, L.P. App. Br. 2.

STATEMENT OF THE CASE

Background

Appellants' invention relates to a method of constructing a machine-readable document. Spec. ¶ 2.

The Claims

Claims 1–16 are on appeal. Claim 1 is representative and reads as follows.

1. A method of constructing a machine-readable document from first and second input machine-readable documents, wherein the first input machine-readable document is a template document and the second input machine-readable document is a variable data document, wherein each input document is of a respective type having a type identifier, the method comprising the steps of:

determining, by means of a processor, the types of the input documents;

declaring, by means of a processor, the determined types;

determining, by means of a processor, if the declared types meet a type match criterion;

allowing other types of variable data documents to be used when the declared types do not meet the type match criterion; and

if the declared types meet the type match criterion, applying a machine-readable document construction process to the first and second input machine-readable documents to produce an output document binding the variable data to the template.

*The Rejections*²

1. The Examiner maintains that claims 1–9 and 14–15 are unpatentable under 35 U.S.C. § 103(a) over Titemore.³
2. The Examiner maintains that claims 10–13 and 16 are unpatentable under 35 U.S.C. § 103(a) over Titemore in view of Conroy.⁴

DISCUSSION

1. Obviousness: Titemore

With respect to this rejection, Appellants present separate arguments only for claims 1 and 5. *See* App. Br. 9–12. We address each of these claims separately below.

Claim 1

The Examiner finds that Titemore discloses a method of constructing a document according to the steps recited in claim 1, except for the claim requirement “allowing other types of variable data documents to be used when the declared types do not meet the type match criterion.” Ans. 6–7. The Examiner finds that Titemore considers selecting portions from more than one document in accordance with defined business rules, and the Examiner concludes that it would have been obvious to one of ordinary skill in the art “to allow selection [of] portions from a plurality of document[s] (other variable data types) if the first document [does] not meet the business rules (type match criteria).” *Id.* at 7. According to the Examiner, “[t]he modification would be obvious because one of the ordinary skills in the art

² The Examiner’s previous rejection of claims 1–9 and 14–15 under 35 U.S.C. § 112 has been withdrawn. Ans. 4.

³ Titemore et al., US 2007/0011608 A1, published on Jan. 11, 2007.

⁴ Conroy et al., US 7,047,236 B2, issued on May 16, 2006.

would want to efficiently create documents . . . by reusing or inserting portions of documents previously stored (Titemore, para. [0023]).” *Id.*

The dispositive issue with respect to claim 1 is whether Titemore discloses or suggests allowing other types of variable data documents to be used when the declared types do not meet the type match criterion.

Principles of Law

In order to establish a prima facie case of obviousness, the Examiner must show that each and every limitation of the claim is described or suggested by the combination of prior art references or would have been obvious based on the knowledge of those of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Further, during examination of a patent application, pending claims are given their broadest reasonable construction consistent with the Specification. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004); *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969).

Analysis

Appellants argue that while Titemore states that text may be selected from more than one document, “Titemore does not teach using other types of variable data documents to be used based on the condition set forth in claim 1 . . . [and] Titemore does not even mention or suggest or provide any teaching whatsoever of what happens if there is not a match.” App. Br. 10–11. We find Appellants’ arguments unpersuasive.

Titemore discloses the following:

The method of the present invention generally encompasses the steps of creating a document based on a predetermined document type, determining a rule set for the document type, retrieving data from at least one data source based on at least one rule in the rule set, and populating the document with the retrieved data.

The pre-existing business rules, which are defined by the user, may be based on the document type. For instance, the rules may determine which type of data should be retrieved for a specific document type. Additionally, the user may define the business rules for the system by example. Further, the business rules may be executed by the user upon voice activation, such as with specific speech commands uttered during the dictation process.

Titemore ¶¶ 29, 33

Based on these portions of Titemore, we agree with the Examiner that Titemore discloses a method of constructing a document as claimed other than the aforementioned requirement of “allowing other types of variable data documents to be used” Ans. 7. We also agree with the Examiner that although Titemore may not expressly disclose this step, Titemore suggests that it would have been obvious. We find that Titemore teaches searching a set of documents for documents that meet specific criteria, and we agree with the Examiner that parsing a set of documents, i.e. assessing each document’s type to determine if it matches the business rule before moving on to and assessing the next document, suggests or makes obvious the claim limitation at issue. *See* Ans. 15–16. Further, we note that while Appellants have indicated they do not agree with this conclusion, they have not provided any reason beyond stating that Titemore does not “mention . . . what happens if there is not a match.” *See* App. Br. 10–11; Reply Br. 3.

Finally, we agree with the Examiner that one of ordinary skill in the art would recognize that allowing other types of documents to be used would further the goal of Titemore to allow “for the efficient creation of new documents.” Titemore ¶ 23. Accordingly, we conclude that the Examiner has established a prima facie showing of obviousness as to claim 1, which Appellants have failed to rebut. Thus, we affirm the rejection of claims 1–4, 6–9, 14, and 15.

Claim 5

The Examiner finds that Titemore teaches the use of a substitute match because Titemore allows a user to select a specific result when multiple results are returned for a specific rule during a document search. App. Br. 17 (citing Titemore ¶¶ 73–74). Appellants assert that the cited portions of Titemore describe that there may be multiple returns for a rule but Titemore “does not teach the very specific claim recitation of an **acceptable substitute match.**” Reply Br. 4. We agree with the Examiner that the requirement of claim 5 is broad enough to encompass allowing a user to select a suitable document from a list of multiple returns, i.e. we find that each document returned may be considered an acceptable substitute match. For this reason and the reasons expressed above with respect to claim 1, we find that the Examiner has established a prima facie showing of obviousness with respect to claim 5, which Appellants have failed to rebut. Thus, we affirm the rejection of claim 5.

2. Obviousness: Titemore in view of Conroy

With respect to this rejection, Appellants rely on the same arguments relied upon with respect to claims 1 and 5, discussed above. *See* App. Br. 12–13. Thus, for the reasons discussed above, we find that the Examiner has

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established a prima facie showing of obviousness with respect to claims 10–13 and 16, which Appellants have failed to rebut. Accordingly, we affirm the rejection of these claims.

DECISION

For the reasons set forth above, we affirm the rejection of claims 1–16 as obvious.

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

kme