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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte THOMAS J. GILG

Appeal 2015-003162
Application 13/192,079
Technology Center 2600

Before CAROLYN D. THOMAS, JON M. JURGOVAN, and
SHARON FENICK, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant seeks our review under 35 U.S.C. § 134(a) of the Examiner's Final Rejection of claims 1–7 and 14–22, all the pending claims in the present application. Claims 8–13 are canceled. *See* Claims Appendix. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

The present invention relates generally to printing encrypted print content. *See* Abstract.

Claim 1 is illustrative:

1. A method comprising:
 - receiving, by a print order manager including a processor, unencrypted metadata associated with encrypted print content, wherein the unencrypted metadata is extracted from a print document, and the encrypted print content is produced by encrypting the print document;
 - identifying, by the print order manager, a printer system from among plural printer systems to which the encrypted print content is to be routed, wherein the identifying is based on the unencrypted metadata extracted from the print document; and
 - causing, by the print order manager, the encrypted print content to be sent to the identified printer system for decryption of the encrypted print content and printing of the decrypted print content.

Appellant appeals the following rejections:

R1. Claims 1, 2, 5, 14, 15, 17, and 19–22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Barnett (US 2009/0063860 A1, Mar. 5, 2009) and Oh (US 2006/0290981 A1, Dec. 28, 2006);

R2. Claims 3, 4, 7, and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Barnett, Oh, and Yacoub (US 6,452,692 B1, Sept. 17, 2002); and

R3. Claims 6 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Barnett, Oh, and Nuggehalli (US 2011/0188063 A1, Aug. 4, 2011).

ANALYSIS

Claims 1–7, 14–19, and 21

Issue 1: Did the Examiner err in finding that Barnett and Oh collectively teach or suggest identifying a printer system to which the

encrypted print content is to be routed, wherein the identifying is based on the unencrypted metadata extracted from the print document, as set forth in claim 1?

Appellant contends “there is no teaching or hint in Barnett that unencrypted metadata associated with encrypted print content is **extracted from a print document**” (App. Br. 5). Appellant further contends that “Oh provides no teaching that any of the foregoing metadata can be used for ‘identifying . . . a printer system from among plural printer systems to which the encrypted print content is to be routed’” (*id.* at 6) and “the ‘locality information’ of Oh also cannot be the metadata of claim 1” (*id.*).

The Examiner finds Barnett “discloses metadata (e.g. either encrypted or unencrypted) that contains plurality of attribute information relating to the print job(s) including wherein print jobs to be printed [sic] (e.g. destinations, par. 38 . . .)” (Ans. 5) and that Oh “also discloses metadata (encrypted or unencrypted) . . . including . . . where the print will be printed” (*id.*). We agree with the Examiner.

We refer to, rely on, and adopt the Examiner's findings and conclusions set forth in the Answer. Our discussions here will be limited to the following points of emphasis.

Specifically, Barnett discloses “[u]nencrypted or encrypted metadata corresponding to the encrypted print data may be generated prior to the encrypted of the print job. . . . Such metadata may include . . . destinations” (¶ 38). Similarly, Oh discloses that “[t]he metadata extractor **1010** extracts metadata contained in a received printing data file from the printing data file” (¶ 123). In other words, the Examiner finds, and we agree, that the *combined* teachings of Barnett and Oh teach and/or suggest metadata

identifying a printer system to which the encrypted print content is to be routed, i.e., destination, and the unencrypted metadata being extracted from the print document.

Even if we assume *arguendo* (without deciding) that there is no hint in Barnett that unencrypted metadata is **extracted from a print document**, or that Oh provides no teaching that any of the foregoing metadata can be used for identifying a printer system to which the encrypted print content is to be routed (as proffered by Appellant, *see* App. Br. 5–6), the Examiner has found that Oh teaches extracting metadata from a print document (*see* Oh ¶ 123) and that Barnett teaches metadata identifying routing information, i.e., a destination (*see* Barnett ¶ 38). Appellant fails to rebut these specific findings.

As such, Appellant’s arguments do not take into account what the Examiner has found the collective teachings of the prior art would have suggested to one of ordinary skill in the art and is therefore ineffective to rebut the Examiner’s *prima facie* case of obviousness. As our reviewing Court states:

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

See In re Keller, 642 F.2d 413, 425 (CCPA 1981) (citations omitted). This reasoning is applicable here.

Accordingly, we sustain the Examiner’s rejection of claim 1. Appellant’s arguments regarding the Examiner’s rejection of independent

claim 14 rely on the same arguments as for claim 1, and Appellant does not argue separate patentability for the dependent claims (with the exception of claims 20 and 22). We, therefore, also sustain the Examiner's rejection of claims 2–7, 14–19, and 21.

Claims 20 and 22

Issue 2: Did the Examiner err in finding that the cited art, particularly Barnett, teaches/suggests an encrypted print document that also includes an encrypted version of the unencrypted metadata, as set forth in claim 20?

Appellant contends that “Barnett contemplates **either** providing the encrypted metadata **or** unencrypted metadata” rather than providing both the unencrypted and the encrypted metadata (App. Br. 8) (*see also* Reply Br. 4–6).

In response, the Examiner finds that “[b]oth Barnett and Oh teach methods/steps that allow the metadata to be encrypted and/or unencrypted” (Ans. 6), and that “it would have been obvious to anyone ordinary to decide which version is appropriate” (*id.*). However, even if Barnett and Oh teaches having encrypted and/or unencrypted metadata and the Examiner is correct in interpreting this as “anyone ordinary [can] decide which version is appropriate” (*id.*), we find that the aforementioned teachings do not teach or suggest including *both* an encrypted and unencrypted version of the unencrypted metadata in the print document, as required by claim 20.

For example, Barnett merely discloses “[u]nencrypted **or** encrypted metadata corresponding to the encrypted print data may be generated The metadata may be appended or prepended to the encrypted print job” (*see* ¶ 38) (emphasis added). However, we find that Barnett, which the Examiner

relies upon, falls short of suggesting that the metadata appended to the print job includes both an unencrypted and encrypted version of the unencrypted metadata.

In view of the above discussion, we are of the opinion that the proposed combination of references, particularly Barnett, does not support the obviousness rejection. We, accordingly, do not sustain the rejection of dependent claim 20, or the rejection of claim 22 for similar reasons.

DECISION

We affirm the Examiner's § 103(a) rejections of claims 1–7, 14–19, and 21.

We reverse the Examiner's § 103(a) rejection of claims 20 and 22.

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-IN-PART