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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL K. RODGERS, BRENT L. HADLEY,
and PATRICK J. EAMES

Appeal 2016-001406
Application 13/673,281¹
Technology Center 2100

Before JAMES R. HUGHES, SCOTT B. HOWARD, and
MATTHEW J. McNEILL, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Final Rejection of claims 1–18, which constitute all of the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

¹ Appellants identify The Boeing Company as the real party in interest. App. Br. 1.

THE INVENTION

The disclosed and claimed invention is directed “to panoptic visualization of documents or their document components in a manner that reflects logical relationships between the documents / components.” Spec. p. 1, ll. 21–23.

Claims 1 and 6, reproduced below, are illustrative of the claimed subject matter:

1. An apparatus for implementation of a panoptic visualization document support system, the apparatus comprising a processor and a memory storing executable instructions that, in response to execution by the processor, cause the apparatus to implement at least:

a request interface configured to receive a request for one or more printouts of one or more document components selected from a layout of document components presented in a graphical user interface (GUI), the document components of the layout being of a panoptic visualization document collection having a plurality of document components, each document component including respective media content and having associated metadata providing structured information about the document component, the layout including a panoptic arrangement of images of the document components of the layout according to the associated metadata of the respective document components, the images of the document components of the layout including the media content thereof; and

a support engine coupled to the request interface and configured to retrieve and prepare the selected one or more document components for printing according to at least a selected print layout style, the preparation including generation of one or more printable document components for respective ones of the one or more printouts,

wherein the support engine is configured to communicate the one or more printable document components.

6. The apparatus of Claim 1, wherein a selected document component of the selected one or more document components is in the layout with a size smaller than its native size, and

wherein the support engine being configured to retrieve the selected one or more document components includes being configured to retrieve the respective selected document component in its native size.

REFERENCES

The prior art relied upon by the Examiner as evidence in rejecting the claims on appeal is:

Kim	US 2007/0273767 A1	Nov. 29, 2007
Berkner	US 2009/0044106 A1	Feb. 12, 2009

REJECTIONS

Claims 1–18 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Berkner in view of Kim. Final Act. 5–17.

ANALYSIS

We have reviewed the Examiner’s rejection in light of Appellants’ arguments that the Examiner erred. In reaching this decision, we have considered all evidence presented and all arguments made by Appellants. We are not persuaded by Appellants’ arguments regarding claims 1–5, 7–11, and 13–17. However, based on the current record, we are persuaded by Appellants’ argument that the Examiner erred in rejecting claim 6, 12, and 18.

Claims 1–5, 7–11, and 13–17

Appellants present four separate arguments asserting that the Examiner erred in rejecting claim 1. We are not persuaded by any of the arguments that the Examiner erred in finding the subject matter of the claim obvious.

First, Appellants argue “neither Berkner nor Kim teaches or suggests a layout of panoptically-arranged document components presented in a GUI, from which one or more document components are selected, retrieved and prepared for printing according to a selected print layout style,” as recited in claim 1. App. Br. 7; *see also* Reply Br. 3–4. For example, Appellants argue “Berkner does not disclose that its paginated document and metadata (alleged selected document component(s)) are selected *from a layout of panoptically-arranged document components presented in a GUI*, similar to the selected document component(s) of independent Claim 1.” App. Br. 7–8 (emphasis added). Similarly, Appellants argue “nowhere does Kim disclose selection of images *from the panoramic image* for printing, similar to independent Claim 1.” App. Br. 8 (emphasis added).

The Examiner finds that the combination of Berkner (limitations relating to panoptic visualization of documents) and Kim (limitations relating to the graphical user interface) teach the disputed limitation recited in claim 1. Final Act. 5–7. The Examiner further finds “Berkner discloses printing parts of a wiki document collection. Multiple options are available for selecting different parts of the document collection based on metadata. Kim discloses displaying images in a graphical user interface for a user to select.” Ans. 14. Thus, the Examiner finds “[t]he combination of Berkner

and Kim disclose displaying the document content in an overview for selection and printing.” *Id.*

Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). The test for obviousness is not whether the claimed invention is expressly suggested in any one or all of the references, but whether the claimed subject matter would have been obvious to those of ordinary skill in the art in light of the *combined teachings* of those references. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). Accordingly, we are not persuaded the Examiner erred based on Appellants’ arguments directed to the references individually and not addressing the combined teachings as found by the Examiner.

Second, Appellants argue “the wiki content of Berkner is not to a layout of panoptically-arranged document components, similar to independent Claim 1.” App. Br. 8. More particularly, “Appellants disagree that the broadest reasonable interpretation of panoptcially-arranged [sic] document components includes an overview of document components.” Reply Br. 4.

The Examiner concludes that the broadest reasonable interpretation of “panoptically-arranged” is broad enough to encompass the “wiki content or document” taught by Berkner. Ans. 15.

During prosecution, claims must be given their broadest reasonable interpretation while reading claim language in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Absent an express intent to impart a novel meaning to a claim term, the words take on the

ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 (Fed. Cir. 2003).

The ordinary meaning of panoptic is “including in one view everything within sight.” *Panoptic*, Webster’s New World College Dictionary (2010), <http://www.yourdictionary.com/panoptic> (last visited Aug. 10, 2016); *see also Ex parte Hadley*, Appeal 2015-00330, 2016 WL 4579907 *3 (PTAB. Aug. 26, 2016) (using the same definition in related appeal). There is nothing in the ordinary meaning of panoptic that would exclude a wiki-type format so long as the entire wiki is within one view. Because Appellants’ argument is not commensurate with the scope of the claims, it is unpersuasive. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982). Instead, we agree with and adopt the Examiner’s finding that Berkner teaches the disputed limitation.

Third, Appellants argue the Examiner did not provide a reason to modify Berkner or Kim to “yield the layout of panoptically-arranged document components of the claimed apparatus.” App. Br. 8–9. Because we find above Berkner teaches a panoptically-arranged displayed, we are not persuaded by Appellants’ argument that the Examiner erred. There is no requirement for the Examiner to find a reason to modify a reference when the specific limitation is taught by the prior art.

Fourth, Appellants argue “it would not have been obvious to modify Berkner per Kim to provide ‘a method for easy ‘panoramic image’ creation,’ as alleged by the Examiner.” App. Br. 9. According to Appellants, “Berkner is clearly and specifically directed to formatting wiki content into a paginated document, which is completely different from and bears no

relation to a panoramic image. [E]ven if one could argue that Kim discloses a method for easy panoramic image creation, its use in Berkner is completely misplaced.” App. Br. 9; *see also* Reply Br. 6.

“The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.” *Keller*, 642 F.2d at 425. Instead, the relevant issue is “what the combined teachings of the references would have suggested to those of ordinary skill in the art.” *Id.* “Combining the *teachings* of references does not involve an ability to combine their specific structures.” *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973). Because Appellants’ argument focuses on the bodily incorporation of the references and not what the combined teachings would suggest to a person of ordinary skill in the art, the argument is not persuasive.

Moreover, to the extent Appellants argue that the Berkner and Kim are not analogous art, we are similarly not persuaded by the argument that the Examiner erred. Art is analogous when it is: (1) from the same field of endeavor as the claimed invention; or (2) reasonably pertinent to the particular problem faced by the inventor, if the art is not from the same field of endeavor. *In re Bigio*, 381 F.3d 1320, 1325–26 (Fed. Cir. 2004). In other words, the focus is on comparing the prior art references to the claimed invention, not to each other. Because Appellants’ argument focuses exclusively on references and not comparing the references to the field of the claimed invention or the problem faced by the inventor, it is not persuasive in demonstrating the Examiner erred in relying on a combination of Berkner and Kim.

Accordingly, we sustain the Examiner’s rejection of claim 1, along with the rejections of claims 7 and 13, which are argued on the same grounds, and dependent claims 2–5, 8–11, and 14–17, which are not separately argued.

Claims 6, 12, and 18

Claim 6 recites selecting a document component “with a size smaller than its native size” and retrieving “the respective selected document component in its native size.” App. Br. 12 (Claims App’x). Appellants argue Berkner “simply discloses the rendering of a paginated document into a printable or displayable format,” and, therefore, does not teach the selection of a document in a small size and the retrieval of it in its native size as recited in claim 6. App. Br. 10; *see also* Reply Br. 8.

The Examiner finds Berkner “discloses creating thumbnails for graphics.” Final Act. 13 (citing Berkner ¶ 71). The Examiner further finds—without identifying the basis for the finding—“Berkner discloses generating a ‘graphic representation of the output’ and “it would be obvious that the graphic would be generated in native size.” Ans. 17.

Rejections based on obviousness must be supported by “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), *cited with approval in KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). A rejection cannot be based on “speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.” *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967).

We have reviewed Berkner at paragraph 71, the paragraph cited by the Examiner. Berkner paragraph 71 does not teach displaying in a small size and retrieving in a native, larger size. Instead, Berkner merely teaches “receiv[ing] the paginated document and metadata and render[ing] the document into a printable or displayable format.” Berkner ¶ 71. Accordingly, we conclude that the Examiner’s finding is not supported by the cited record.

We, therefore, are constrained on this record to reverse the Examiner’s rejection of claim 6, along with the rejections of claims 12 and 18, which recite limitations commensurate in scope to the disputed limitations discussed above.

DECISION

For the above reasons, we affirm the Examiner’s decisions rejecting claims 1–5, 7–11, and 13–17.

For the above reasons, we reverse the Examiner’s decisions rejecting claims 6, 12, and 18.

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