UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

_____

Ex parte MARK VELA

_____

Appeal 2017-006285
Application 12/869,204
Technology Center 3600

_____

Before ST. JOHN COURTENAY III, CARL L. SILVERMAN, and
JOHN P. PINKERTON, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant[1] appeals under 35 U.S.C. § 134(a) from a Final Rejection of
claims 1–20. We have jurisdiction over the pending claims under 35 U.S.C.
§ 6(b).

We affirm.

STATEMENT OF THE CASE

Introduction

Embodiments of Appellant's invention are "generally related to
workflow management systems and methods. Embodiments also relate in

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[1] According to Appellant, the real party in interest is Xerox Corporation,
which is the assignee of the present application. App. Br. 2.

general to the field of computers and similar technologies, and in particular
to software utilized in this field. In addition, embodiments relate to the
visual representation of a modified document." Spec. ¶ 1.

Exemplary Claim

1.   A document workflow method, comprising:

[L1] *providing a workflow management application for
receiving and modifying a document for printing;*

integrating a logic that interprets a workflow associated
with said document for printing with a rendering logic;

[L2] *visually displaying said document for printing
incorporating a plurality of changes;*

[L3] *realizing said plurality of changes by a rendering
code associated with said rendering logic;*

*providing a what you see is what you get visual display of
said plurality of changes realized by said rendering code;*

integrating said rendering logic with a workflow logic;

translating said plurality of changes associated with said
document for printing to a workflow process step represented in
an extensible markup language format;

creating a final document by executing said workflow
process step with respect to said document through a workflow
engine:

[L4] *transmitting said final document to an external
production output device over a wireless communication
channel for final production wherein said final document
transmitted to said external production output is substantially*

*identical to the what you see is what you get visual display
provided by said workflow management application*; and
rendering said final document as a hard copy document with
said production output device.

App. Br. 44 (Claims Appendix) (Contested limitation emphasized).

Rejections

A. Claims 1–20 are rejected under 35 U.S.C. § 101, as being directed
to a judicial exception, without significantly more. Final Act. 2.

B. Claims 1–5, 7–12, 14–18, and 20 are rejected under pre-AIA
§ 103(a) as being obvious over the combined teachings and
suggestions of Waldorf (US 8,302,074 B1, issued Oct. 30, 2012),
Perry (US 2004/0261017 A1, published Dec. 23, 2004), and
further in view of Sangroniz et al. (US 2004/0193465 A1,
published Sept. 30, 2004) (hereinafter "Sangroniz"). Final Act. 8.

C. Claims 6, 13, and 19 are rejected under pre-AIA 35 U.S.C.
§ 103(a) as being obvious over the combined teachings and
suggestions of Waldorf, Perry, Sangroniz, and Official Notice.
Final Act. 17.

Issues on Appeal

Did the Examiner err in rejecting claims 1–20 under 35 U.S.C. § 101,
as being directed to a judicial exception, without significantly more?

Did the Examiner err in rejecting claims 1–20 under pre-AIA
35 U.S.C. § 103(a), as being obvious over the cited combinations of
references?

ANALYSIS

We have considered all of Appellant's arguments and any evidence presented. We highlight and address specific findings and arguments for emphasis in our analysis below.

Rejection A under 35 U.S.C. § 101

Mayo/Alice Analysis

Under 35 U.S.C. § 101, a patent may be obtained for "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof." The Supreme Court has "long held that this provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable." *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)). The Supreme Court in *Alice* reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 82–84 (2012), "for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts." *Alice*, 134 S. Ct. at 2355.

The first step in that analysis is to determine whether the claims at issue are directed to one of those patent-ineligible concepts, such as an *abstract idea*. Abstract ideas may include, but are not limited to, fundamental economic practices, methods of organizing human activities, an idea of itself, and mathematical formulas or relationships. *Id.* at 2355–57.

If the "acts" of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are

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not being applied to appropriate subject matter. *See Gottschalk v. Benson*, 409 U.S. 63, 71–72 (1972). "'Phenomena of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work.'" *In re Ferguson*, 558 F.3d 1359, 1363 (Fed. Cir. 2009) (quoting *Gottschalk*, 409 U.S. at 67). Moreover, if a method can be performed by human thought alone, or by a human using pen and paper, it is merely an abstract idea and is not patent-eligible under § 101. *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372–73 (Fed. Cir. 2011).

If the claims are *not directed* to a patent-ineligible concept, *the inquiry ends. See Visual Memory LLC v. NVIDIA Corp.*, 867 F.3d 1253, 1262 (Fed. Cir. 2017).

Otherwise, the inquiry proceeds to the second step in which the elements of the claims are considered "individually and 'as an ordered combination' to determine whether the additional elements 'transform the nature of the claim' into a patent-eligible application." *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 79, 78).

The Examiner's Rejection A under 35 U.S.C. § 101

Regarding the first step of the *Alice/Mayo* analysis, the Examiner concludes that claims 1–20 are directed to a judicial exception, i.e., an abstract idea:

> Claims 1-20 are directed to an abstract idea of creating and outputting a document, specifically, the invention, as recited in independent claim 1 [that] relates to receiving and modifying a document, integrating logic, displaying a document, realizing changes, providing a WYSIWYG display, translating said

> plurality of changes to an XML language, creating a final
> document, transmitting the document, and rendering the final
> document, and independent claims 8 and 15 include similar
> limitations which amounts to merely: (i) *a fundamental
> economic/business practice*, (ii) *a method of organizing human
> activities*, and (iii) *an idea of itself.*

Final Act. 3 (original emphasis omitted and emphasis added).[2]

Regarding the second step of the *Mayo/Alice* analysis, the Examiner

finds the claims do not include additional elements that amount to

significantly more than the judicial exception, because:

> the additional elements or combination of elements in the
> claims other than the abstract idea per se amount[] to no more
> than: (i) mere instructions to implement the idea on a computer,
> and/or (ii) recitation of generic computer structure that serves to
> perform generic computer functions that are *well understood,
> routine, and conventional activities* previously known to the
> industry. The Examiner asserts that the claimed invention
> fails to further improve upon the technology since the claimed
> invention does not improve on the general purpose computer of
> paragraphs [0018], [0021], and [0024] of the published
> specification, which state, for example, in [0024], that the
> "invention may be embodied on a variety of different
> computing platforms, including Macintosh...".

Final Act. 5–6 (original emphasis omitted and emphasis added).[3]

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[2] "Patent eligibility under § 101 presents an issue of law." *Accenture Glob. Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1340–41 (Fed. Cir. 2013).

[3] The patent-eligibility inquiry may contain underlying issues of fact. *Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1325 (Fed. Cir. 2016). In particular, "[t]he question of whether a claim element or combination of elements is well-understood, routine and conventional to a skilled artisan in the relevant field is a question of fact." *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1368 (Fed. Cir. 2018).

For the aforementioned reasons, the Examiner concludes that all claims 1–20 on appeal are not patent-eligible under 35 U.S.C. § 101.

Mayo/Alice Analysis — Step 1

Regarding *Alice* Step 1, Appellant contends:

the claimed method of integrating logic that interprets a workflow associated with rendering logic and displaying that document accordingly is not *a fundamental economic practice*. The claim describes the interconnection of computer code associated with processing a print job and rendering logic to provide a view of a document before it is rendered as a hardcopy.

App. Br. 11 (emphasis added).

Appellant also contends:

While the Examiner does correctly identify a number of cases that establish what ideas constitute *"organizing human activity,"* Appellant's claims *cannot be analogized to any of these examples*. Appellant's claims are directed to method and systems for merging logic that interprets a workflow with rendering logic to provide a more accurate representation of a document (a "what you see is what you get" version) before the document is rendered. *This fundamentally has nothing to do with "interpersonal and intrapersonal activities, such as managing relationships or transactions between people, social activities, and human behavior;* satisfying or avoiding a legal obligation; advertising, marketing, and sales activities or behaviors; and managing human mental activity."

App. Br. 12 (emphasis added).

In the Answer, the Examiner disagrees, and further explains the basis

for the rejection:

> The Examiner respectfully disagrees that the claims are not
> directed to a fundamental economic practice. Reviewing the
> claims reveals several steps that culminate in the creation and
> output of a document. *There are few things more fundamental
> to day-to-day transactions of business than creating and
> outputting documents (whether electronic or paper).* Orders are
> usually conducted via documents, receipts are given, and
> tracking of inventory and other business aspects is performed
> via documents.

Ans. 2 (emphasis added).

Regarding the disputed method of organizing human activity, the

Examiner explains:

> Appellant argues that the claims have "nothing to do" with
> organizing human activity. [The] Examiner respectfully
> disagrees, for all the reasons mentioned in the Final Office
> Action and the After Final, and provides further examples of
> analogous cases. Cases that have been found to be certain
> methods of organizing human activity that have dealt with
> documents include *Ameranth*[4] (generating menus on a
> computer) and *Int. Ventures v. Symantec*[5] (receiving, screening,

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[4] The Examiner is referring to *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229 (Fed. Cir. 2016) (holding that the subject claim directed to "[a]n information management and synchronous communications system for generating and transmitting menus" was patent-ineligible because it "claims no more than the use of existing handwriting and voice capture technologies using a computer system." *Id.* at 1234, 1245.

[5] The Examiner is referring to *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307 (Fed. Cir. 2016) (holding that the subject claim directed to "[a] post office for receiving and redistributing email messages on a computer network" was patent-ineligible because it was not directed to a specific improvement to computer functionality. *Id.* at 1316.

and distributing email). Both of these cases are similar to the
instant case which is directed to generating documents (which
is broader than menus or email) and outputting them.

Ans. 4.

Based upon our review of the record, we find persuasive Appellant's
contentions in the Briefs that claims 1–20 are not directed to a patent-
ineligible judicial exception, i.e., an abstract idea.

At the outset, we find no language in claims 1–20 that pertains to
financial or economic activities. We find the Examiner's broad general
statement that links Appellant's claims with business practices would be
equally applicable to patent-eligible typewriters, printers, and copying
machines: "There are few things more fundamental to day-to-day
transactions of business than creating and outputting documents (whether
electronic or paper)." Ans. 2.

The Examiner's reasoning is flawed and unsupported by applicable
case law. Therefore, we agree with Appellant's contention that "printing a
what you see is what you get [(WYSIWYG)] document is not 'a
fundamental *economic* practice long prevalent in our system of commerce.'"
App. Br. 11.

We find equally unavailing the Examiner's alternative theory that
Appellant's claims are directed to a patent-ineligible *method of organizing
human activity*:

> The claims, which are directed to document workflow, are also
> considered to be certain methods of organizing human activity
> as the claims include concepts relating to managing
> relationships or transactions between people, in that they relate
> to processing document information, similarly to *Dealertrack*,
> which related to processing loan information.

Final Act. 5.[6]

We note loans are fundamental economic practices between individuals and/or businesses. The Examiner's reasoning (*id.*) is misplaced, because that is not the subject matter of Appellant's claims.

Therefore, we find Appellant's rebuttal persuasive:

> While the Examiner does correctly identify a number of cases that establish what ideas constitute "organizing human activity," Appellant's claims cannot he analogized to any of these examples. Appellant's claims are directed to method and systems for merging logic that interprets a workflow with rendering logic to provide a more accurate representation of a document (a "what you see is what you get" version) before the document is rendered. This fundamentally has nothing to do with "interpersonal and intrapersonal activities, such as managing relationships or transactions between people, social activities, and human behavior; satisfying or avoiding a legal obligation; advertising, marketing, and sales activities or behaviors; and managing human mental activity."

App. Br. 12.

Nor do we find the Examiner has shown Appellant's claims are directed to a patent-ineligible *idea of itself* or a *mathematical algorithm*. If Appellant's claims are *not directed* to a patent-ineligible concept, our inquiry ends. *See Visual Memory*, 867 F.3d at 1262. Because Appellant's arguments apply similarly to independent claims 8 and 15, we are

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[6] The Examiner is referring to the pre-*Alice* Federal Circuit opinion: *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1319 (Fed. Cir. 2012) (the subject claim 7 of the '841 patent directed to "[a] computer based method of operating a *credit application* and routing system" that selectively received *credit application data*, obtained *credit report data*, and forwarded the *credit application data*, was held to be patent ineligible by the court) (original emphasis omitted and emphasis added).

constrained on this record to reverse the Examiner's rejection A under 35 U.S.C. § 101 of all claims 1–20 on appeal.

Rejection B of Independent Claim 1 under 35 U.S.C. § 103(a)

<u>Issues</u>: Under pre-AIA 35 U.S.C. § 103(a), did the Examiner err by finding the cited combination of Waldorf, Perry, and Sangroniz would have taught or suggested the contested limitations L1, L2, L3, and L4:

> [L1] *providing a workflow management application for receiving and modifying a document for printing;*
>
> [L2] *visually displaying said document for printing incorporating a plurality of changes;*
>
> [L3] *realizing said plurality of changes by a rendering code associated with said rendering logic;*
> *providing a what you see is what you get visual display of said plurality of changes realized by said rendering code;*
>
> [L4] *transmitting said final document to an external production output device over a wireless communication channel for final production wherein said final document transmitted to said external production output is substantially identical to the what you see is what you get visual display provided by said workflow management application[,]*

within the meaning of representative claim 1?[7] (emphasis added).

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[7] We give the contested claim limitations the broadest reasonable interpretation ("BRI") consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997); *see, e.g.*, Spec. ¶ 34 ("It will be appreciated that variations of the above-disclosed and other features and functions, or alternatives thereof, may be desirably combined into many other different systems or applications. Also that various presently unforeseen or unanticipated alternatives, modifications, variations or

Contested Limitation L1 (Claim 1)

[L1] *providing a workflow management application for
receiving and modifying a document for printing;*

Appellant contends: "Waldorf does not teach or suggest providing a
workflow management application for receiving and modifying a document
. . . while . . . Sangroniz teaches document printing, the present part of the
rejection fails to consider the prior art reference or the claimed features as a
whole." App. Br. 27. In support, Appellant contends:

> More specifically, the cited material fails to teach or
> suggest that an application receives a document in any capacity,
> or that an application modifies a document. Instead, the
> reference describes "a new page layout providing a blank
> canvas" or "an existing page layout within for editing an
> existing webpage" and suggests the process allows for "adding
> a GUI component to a web page." Adding a GUI component to
> a web page does not teach or suggest modifying a document
> before it is printed.

Id.

Regarding the contested "workflow management application for
receiving and modifying a document" (claim 1), we turn to Appellant's
Specification for *context.* We find the Specification broadly describes a
"workflow management application" using exemplary, non-limiting
language: "A workflow management module *can be* configured to provide
support for editing and annotating the document by a user and a result of the
respective operations can be visually represented in a user interface." Spec.
¶ 9.

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improvements therein may be subsequently made by those skilled in the art
which are also intended to be encompassed by the following claims.").

Given the aforementioned lack of a limiting definition, we are not persuaded that the Examiner's reading of the disputed "workflow management application" on the "page layout designer" of Waldorf is in error. *See* Ans. 8, citing Waldorf, col. 6, ll. 26–37. As explained by the Examiner, a web page is a type of document:

> Waldorf discloses this feature in col. 6, lines 26-37. Waldorf provides a "page layout designer" which is an application. Examiner notes that the description of the application as a "workflow management" application is merely descriptive and not a positive claim limitation which further limits the claim. However, the page flow aspect of Waldorf is considered to provide the workflow aspect of applicant's invention. Further, *a web page is a document. A document is a piece of matter, whether printed or electronic, that conveys information. A web page is an electronic conveyor of information and is therefore, a document.* Examiner further notes that, although not disclosed explicitly in Waldorf, *most web documents have the ability to be printed through a browser.*

Ans. 8 (emphasis added).

Based upon our review of the record, we are not persuaded the Examiner's claim interpretation is overly broad, unreasonable, or inconsistent with the Specification, because the Examiner repeatedly refers to descriptions of exemplary, non-limiting embodiments found in the Specification. Ans. 8, *et seq.* Because "applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee." *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (citation omitted).

For a prima facie case of obviousness, the reference need not recognize the same problem solved by the Appellant (*In re Kemps*, 97 F.3d 1427, 1430 (Fed. Cir. 1996)), because "neither the particular motivation nor

the avowed purpose" of the [Appellant] controls" in an obviousness analysis. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 419 (2007). The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by Appellant. *See In re Kahn*, 441 F.3d 977, 987 (Fed. Cir. 2006) (motivation question arises in the context of the general problem confronting the inventor rather than the specific problem solved by the invention); *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1323 (Fed. Cir. 2005) ("One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings.").

To the extent that Appellant argues (App. Br. 11) that Waldorf is non-analogous art, a reference is analogous art to the claimed invention if: (1) the reference is from the same field of endeavor as the claimed invention (even if it addresses a different problem); or (2) the reference is reasonably pertinent to the problem faced by the inventor (even if it is not in the same field of endeavor as the claimed invention). *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). In order for a reference to be "reasonably pertinent" to the problem, it "logically would have commended itself to an inventor's attention in considering his problem." *ICON Health*, 496 F.3d at 1379–80 (quoting *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992)).

Appellant contends that "Appellant's claim[s have] nothing to do with adding a graphical user interface component to a webpage." App. Br. 11.

However, it is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by Appellant, as

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discussed above. *Kahn*, 441 F.3d at 987. Moreover, we find the invention in Waldorf that relates to "[s]ystems and methods for graphical user interfaces and for presenting content to a user of a graphical user interface" (Waldorf, Abstract), would have logically commended itself to modifying a webpage (i.e., a type of electronic document), in which the webpage content can be printed as a hardcopy document (in accordance with the teachings of Sangroniz (¶ 25), with predictable results. (Claim 1). *See ICON Health*, 496 F.3d at 1379–80; *see also KSR*, 550 U.S. at 401 ("[A] combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results."). Therefore, we find Waldorf is reasonably pertinent to the problem faced by the inventor.

Appellant also contends:

> The Final rejection fails to include the words "for printing."
> However, when the claim is read as a whole it is clear that the
> reference does not teach or suggest anything related to the
> claim. Indeed, the whole point of the claim is that
> electronically rendered documents that will be printed often do
> not look the same as the ultimately printed document.

App. Br. 29.

However, we emphasize the Examiner's obviousness rejection B is based on the *combined* teachings and suggestions of Waldorf, Perry, and Sangroniz. Sangroniz (¶ 25) (emphasis omitted) expressly discloses: "Once the complete job ticket 159 is produced, then it is provided to appropriate printing systems 166 or workflow control systems, etc., to effect the printing of the document associated therewith in the respective print environment."

We do not agree that the Examiner's proposed modification of Waldorf/Perry with Sangroniz would change the principle of operation of

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the Waldorf/Perry base combination, as urged by Appellant (App. Br. 30),
because electronic documents can be printed with predictable results.
Accordingly, we find a preponderance of the evidence supports the
Examiner's underlying factual findings and ultimate legal conclusion of
obviousness regarding contested limitation L1 of representative claim 1.

Contested Limitation L2 (Claim 1)

> [L2] *visually displaying said document for printing
> incorporating a plurality of changes*;

Appellant contends:

> Additionally, Waldorf fails to teach or suggest, "visually
> displaying a document for printing" by incorporating a plurality
> of changes. The Final rejection fails to include the words
> "for printing." However, when the claim is read as a whole it is
> clear that the reference does not teach or suggest anything
> related to the claim. Indeed, the whole point of the claim is that
> electronically rendered documents that will be printed often do
> not look the same as the ultimately printed document.

App. Br. 29.

> In response, the Examiner further explains the basis for the rejection:

> [The] Examiner notes that other cited art discloses the "*for
> printing*" portion of the claim. Examiner further notes that "*for
> printing*" is intended use, does not affect the steps of the claims,
> and therefore, receives little patentable weight.

Ans. 10 (emphasis added).

Our reviewing court guides: "An intended use or purpose usually will
not limit the scope of the claim because such statements usually do no more
than define a context in which the invention operates." *Boehringer
Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345

(Fed. Cir. 2003). Although "[s]uch statements often . . . appear in the claim's preamble," *In re Stencel*, 828 F.2d 751, 754 (Fed. Cir. 1987), a statement of intended use or purpose can appear elsewhere in a claim. *Id.*

However, in this case, we conclude a step of printing is positively recited in the last recited step of claim 1: "*rendering* said final document as a hard copy document with said production output device."

Nevertheless, we emphasize again that the Examiner's obviousness rejection B is based on the *combined* teachings and suggestions of Waldorf, Perry, and Sangroniz. The Examiner relies, in pertinent part, on Sangroniz (¶ 25) (emphasis omitted), that we find expressly discloses the "for printing" aspect of the documents modified by Waldorf/Perry base combination: "Once the complete job ticket 159 is produced, then it is provided to appropriate printing systems 166 or workflow control systems, etc., to effect the printing of the document associated therewith in the respective print environment."

Although Appellant contends "[t]he Waldorf reference does not describe any production output device capable of 'rendering said final document as a hard copy document'" (App. Br. 29), we find Appellant is arguing the references separately, because the Examiner finds: "Sangroniz teaches where the final document is rendered *as a hard copy document;* and wherein the document is *for printing* (Sangroniz [0025] [0033] and Fig. 2." (Final Act. 12).[8] Appellant has not persuasively addressed the Examiner's specific findings. *Id.*

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[8] *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references).

Accordingly, on this record, we find a preponderance of the evidence supports the Examiner's underlying factual findings and ultimate legal conclusion of obviousness regarding contested limitation L2 of representative claim 1.

Contested Limitation L3 (Claim 1)

> [L3] *realizing said plurality of changes by a rendering code associated with said rendering logic;*
> *providing a what you see is what you get visual display of said plurality of changes realized by said rendering code;*

Appellant contends:

> The Appellant further disagrees that the cited material teaches or suggests anything related to the claimed rendering code. In particular, the Appellant respectfully asserts that the Final Office Action does not identify any element in the combined prior art, which teaches or suggests the claimed rendering code. This deficiency is the result of the fundamentally different nature of the inventions. The reference does not describe a "rendering code" because it is not ultimately geared toward rending anything. Instead it is, by the Examiner's admission, an invention for developing a web page. By contrast, the present claims are explicitly meant to evaluate rendering code to provide a WYSIWYG view of the document before it is rendered according to the workflow.

App. Br. 32.

In response, the Examiner disagrees, and further explains the basis for the rejection: "Waldorf discloses this in col. 5, lines 14-20. The page flow engine provides the logic that interprets a workflow (see above and Final QA), and an associated code is used when the web page is executed (Waldorf col. 5, lines 14-20)." Ans. 11.

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We find a preponderance of the evidence supports the Examiner's findings. *Id.* Waldorf expressly describes in col. 5, ll. 28–30: "In one implementation, the page layout designer includes a web editor using a 'what you see is what you get' ('WYSIWYG') architecture."

Buttressing the Examiner's underlying factual findings and ultimate legal conclusion of obviousness, we observe Perry similarly describes: "A Web designer will usually use one of the WYSIWYG (What You See Is What You Get) Web designing packages that are on the market, and these do not expose the designer to the underlying code." Perry ¶ 92. At paragraph 93, Perry additionally discloses an XSL "renderForm.xsl" stylesheet that contains XSL instructions for formatting (i.e., transforming to render) the same Web page:

> The code for producing the same Web page 32
> using a preferred embodiment of the present
> invention is now discussed. The Web page 32
> shown in FIG. 10 can be generated by the
> following workflow document which comprises an
> XML instruction 28 to make a call to a database,
> and an associated XSL-T formatting instruction
> 30:
> <workflow>
>   <task>
>   <XML loc="ConfReg::getSeats" resourceType=
>   "DB"/> // XML instruction 28
>   <XSL loc="**renderForm.xsl**"/>
>   // XSL formatting instruction 30
> <task>
> </workflow>

(original emphasis omitted emphasis added).[9]

We emphasize again that the Examiner relies, in pertinent part, on Sangroniz (¶ 25), that expressly discloses the rendering "for printing." Final Act. 12.

Moreover, "'the question under 35 USC 103 is not merely what the references expressly teach but what they would have *suggested* to one of ordinary skill in the art at the time the invention was made.'" *Merck & Co. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807 (Fed. Cir. 1989) (quoting *In re Lamberti*, 545 F.2d 747, 750 (CCPA 1976)) (emphasis added); *see also* MPEP § 2123.

Applying this reasoning here, we find a preponderance of the evidence supports the Examiner's underlying factual findings and ultimate legal conclusion of obviousness regarding contested limitation L3 of representative claim 1.

Contested Limitation L4 (Claim 1)

[L4] *transmitting said final document to an external production output device over a wireless communication channel for final production wherein said final document transmitted to said external production output*

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[9] An obviousness inquiry is not limited to the prior art's preferred embodiment. *See, e.g., Pfizer*, 480 F.3d at 1370. Moreover, "[c]ombining two embodiments disclosed adjacent to each other in a prior art patent does not require a leap of inventiveness." *Boston Scientific Scimed, Inc. v. Cordis Corp.*, 554 F.3d 982, 991 (Fed. Cir. 2009). "[I]n a section 103 inquiry, 'the fact that a specific [embodiment] is taught to be preferred is not controlling, since all disclosures of the prior art, including unpreferred embodiments, must be considered.'" *Merck*, 874 F.2d at 807 (quoting *In re Lamberti*, 545 F.2d at 750).

*is substantially identical to the what you see is what you get visual display
provided by said workflow management application;*

The Examiner finds Waldorf, in combination with Perry and

Sangroniz, teaches contested limitation L4, relying in pertinent part of

Waldorf, at col. 5, ll. 14–30 and col. 11, ll. 1–34, in which the cited portion

of column 5 teaches WYSIWYG technology, and the cited portion of

column 11 teaches wireless communication, as follows:

> [Waldorf teaches] rendering said final document...with said
> production output device (Waldorf col. 4, lines 16-67 Through
> the deployment of web pages that are developed with the page
> layout designer and page flow designer tools, the business
> analyst can provide enterprise-wide, internal and external
> access to web applications across networks such as an intranet,
> or the Internet[col. 4, lines 53-67]).

Final Act. 10–11.

> Appellant contends:

> the cited material in Perry explicitly states that the response
> document is returned to the client for display. By contrast, the
> Appellant's claims explicitly state that the document is sent to
> an external production output device for final production. The
> Appellant respectfully asserts that no skilled artisan would
> equate the cited transmission back to the client device, with the
> claimed method where documents are sent to a rendering device
> (i.e. a printer) for final production. No explanation of why this
> argument has not been found persuasive has been provided.

App. Br. 33.

In response, the Examiner further explains the basis for the rejection,

and discusses the secondary Perry reference:

> Applicant further argues that the claim limitations state that the
> document is sent to "an external production output device for
> final production" and that this is not disclosed by the prior art.
> Examiner respectfully disagrees. This is disclosed by Perry.

> Examiner notes that broadest reasonable interpretation must be used. The claims do not limit the production device to a printer. A display, as is cited in the prior art, also functions as an external production output device for final production as claimed.

Ans. 11.

> Appellant disagrees, and further responds in the Reply Brief, arguing:

> the claimed final production output device represents a device for rendering a hard copy of the document. This is evidenced by the following claim feature, which describes "rendering said final document as a hard copy document with said production output device." Neither the Waldorf nor Perry references describe any production output device capable of "rendering said final document as a hard copy document." Thus, the fact that the Waldorf/Perry combination discloses a display is not sufficient to establish the obviousness of the claimed production output device because the production output device is described and claimed as capable of rendering the final document as a hard copy document.

Reply Br. 14.

We disagree with Appellant that "[n]either the Waldorf nor Perry references describe any production output device capable of 'rendering said final document as a hard copy document.'" *Id.* We emphasize again that the Examiner relies, in pertinent part, on Sangroniz (¶ 25), that expressly discloses the rendering "for printing." Final Act. 12. Moreover, Appellant admits that a printer is a rendering device. *See* App. Br. 33: "documents are sent to a rendering device (i.e. a printer) for final production."

Therefore, on this record, we find a preponderance of the evidence supports the Examiner's underlying factual findings and ultimate legal conclusion of obviousness regarding contested limitation L4 of representative claim 1.

Accordingly, for at least the aforementioned reasons, we sustain the Examiner's rejection B under § 103(a) of representative independent claim 1.

Claims 5, 8–12, 14–18, and 20 rejected under § 103 Rejection B

The remaining claims also rejected under rejection B, and not argued separately below (i.e., grouped claims 5, 8–12, 14–18, and 20), fall with representative claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2015).

Dependent Claim 2 rejected under § 103 Rejection B

Claim 2 recites: "The method of claim 1 further comprising modifying said document for printing upon receiving said document for printing."

Appellant notes the Examiner's reliance on Waldorf (col. 6, ll. 26–37) and Sangroniz (¶¶ 25, 33, and Fig. 2) to support the rejection. App. Br. 34. Appellant contends that Waldorf's "idea that a web designer can change the appearance of a webpage as described in the reference does not teach or suggest modifying an electronic document before that document is printed wherein that document will be printed as described in the claims." *Id.* Appellant also contends "neither Waldorf nor Sangroniz have anything to do with the integration of workflow and rendering logic to provide *a what you see is what you get* version of a document before it is printed, allowing the user to verify the way the document will look before it is converted to a hardcopy document." App. Br. 34–35 (emphasis added).

In response, the Examiner further explains the basis for the rejection: "the broadest reasonable interpretation is used when reading the claims, and that, as above, a webpage qualifies as a document (and may be printed as a hard copy if desired)." Ans. 13.

Waldorf teaches or suggests the claimed WYSIWYG feature: "The page layout designer can provide a collection of pre-built GUI components for use by the user in designing web pages. In one implementation, the page layout designer includes a web editor using a 'what you see is what you get' ('WYSIWYG') architecture." Col. 5, ll. 26–30.

Perry also teaches or suggests the claimed WYSIWYG feature: "A Web designer will usually use one of the WYSIWYG (What You See Is What You Get) Web designing packages that are on the market." ¶ 9.

We find Waldorf teaches modifying an electronic document: "The page layout designer can provide the user with a canvas for laying out or *modifying* web page components." Col. 5, ll. 34–36. As noted above, the Examiner relies, in pertinent part, on Sangroniz (¶ 25), that expressly discloses the rendering "for printing." Final Act. 12.

Moreover, we find the Examiner's proffered combination of familiar elements would have merely produced a predictable result. *KSR*, 550 U.S. at 401 ("[A] combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results."). For at least these reasons, we find a preponderance of the evidence supports the Examiner's underlying factual findings and ultimate legal conclusion of obviousness regarding rejection B of dependent claim 2.

Dependent Claim 3 rejected under § 103 Rejection B

Claim 3 recites: "The method of claim 1 further comprising configuring a workflow management module to provide support for editing and annotating said document for printing by a user providing a what you see is what you get experience."

The Examiner finds Waldorf col. 5, lines 1–30 teaches a WYSIWYG experience, in which the user is a web page designer and the *page layout designer* includes a web editor that provides a WYSIWYG architecture. Final Act. 13.

Appellant contends:

> the Waldorf reference describes means for editing the content of a webpage. Designing a webpage flow process is not equivalent to annotating a document for printing as claimed. Furthermore, the Appellant respectfully asserts that the cited material offers nothing equivalent to the claimed *workflow management module* to provide support for editing and annotating a document in any capacity.

App. Br. 35 (emphasis added).

As previously noted, we find the Specification broadly describes a "workflow management application" using exemplary, non-limiting language: "A workflow management module *can be* configured to provide support for editing and annotating the document by a user and a result of the respective operations can be visually represented in a user interface." Spec. ¶ 9 (emphasis added). As also previously noted, we find Waldorf teaches or suggests the claimed WYSIWYG feature. Col. 5, ll. 26–30. Perry (¶ 92) also teaches or suggests the claimed WYSIWYG feature.

We agree with the Examiner' response (Ans. 13) that Appellant's arguments are grounded on the erroneous premise that the claimed

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"documents" exclude web pages. We conclude a broad but reasonable interpretation of the claim term "document" is appropriate in light of Appellant's description in the Specification:

> WYSIWYG, is an acronym for "What You See Is What You Get", an approach that is utilized in computing and data processing to describe content displayed during editing that appears very similar to a *final output*, which may be, for example, *a rendered document, a web page*, a slide presentation or even a lighting for a theatrical event, etc. WYSIWYG implies a user interface that permits a user to view something very similar to the end result while the *document* is being created. A typical WYSIWYG application can provide a high-quality rendered output and/or a high-quality *onscreen output* and allow the user to visualize what the *document* may look like when rendered.

Spec. ¶ 26 (emphasis added).

Buttressing the Examiner's findings, we note Perry teaches creating workflow documents, albeit for a different purpose than that claimed by Appellant[10]:

> The present invention also extends to a method of designing a dynamic response document such as a Web page, the method comprising creating a workflow document including a plurality of workflow tasks, wherein the creating step comprises specifying a plurality of first type of workflow instructions for retrieving data and a plurality of second type of corresponding workflow instructions for converting the retrieved data into a corresponding plurality of commonly understood format language fragments.

Perry ¶ 59.

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[10] [N]either the particular motivation nor the avowed purpose" of the [Appellant] controls" in an obviousness analysis. *KSR*, 550 U.S. at 419.

For at least these reasons, we find a preponderance of the evidence supports the Examiner's underlying factual findings and ultimate legal conclusion of obviousness regarding rejection B of dependent claim 3.

Dependent Claim 4 rejected under § 103 Rejection B

Claim 4 recites: "The method of claim 1 further comprising modifying said workflow via said rendering code associated with said rendering logic."

The Examiner finds: "Waldorf, as modified by Perry, discloses modifying said workflow via said rendering code associated with said rendering logic (Perry [0015]-[0020][0054] A pre-written workflow document calls an XML instruction that dynamically generates a new workflow document which contains an XSL formatting instruction for the user's particular browser[0054])." (Final Act. 14) (emphasis omitted).

However, Appellant contends:

> the claim describes modifying a workflow via rendering code associated with a rendering logic. The cited material makes no mention of a rendering logic in any capacity; much less that the rendering logic is related to a rending code. Thus, the Appellant respectfully asserts that the reference fails to make obvious a rendering code and rendering logic as claimed.

App. Br. 36.

In response, the Examiner further explains the basis for the rejection: "it is inherent when generating a web page that it is rendered. This requires rendering code." Ans. 14.

We additionally note Perry (¶ 18) teaches "[t]he construction of a document written in a markup language (such as a Web page, for example) can thus be reduced to the assembly, execution and then conversion

rendering of multiple *workflow* tasks." (Emphasis added). As discussed above regarding limitation L3 of claim 1, Perry (¶ 93) also discloses rendering code for producing (i.e., rendering) a Web page.

We find the evidence cited by the Examiner (Final Act. 14) is sufficient to show that "*the natural result flowing* from the operation as taught would result in the performance of the questioned function." *PAR Pharm., Inc. v. TWI Pharms., Inc.*, 773 F.3d 1186, 1194–95 (Fed. Cir. 2014) (internal citation omitted).

For at least these reasons, we find a preponderance of the evidence supports the Examiner's underlying factual findings and ultimate legal conclusion of obviousness regarding rejection B of dependent claim 4.

Dependent Claim 7 rejected under § 103 Rejection B

Claim 7 recites: "The method of claim 3 further comprising configuring said workflow management module to provide at least one tool for transmitting said document for printing and an associated ticket to said production output device for final production."

Appellant admits that Sangroniz teaches a job ticket:

> The Appellant respectfully acknowledges that the Sangroniz reference includes reference to a "job ticket" or "complete job ticket".

App. Br. 39.

However, Appellant argues:

> claim 7 describes a workflow management module that provides a tool for transmitting a document and associated ticket. The Appellant respectfully asserts that the combined prior art does not teach or suggest, and no citation has been

provided to support, a teaching or suggestion of a tool for transmitting a document and a ticket as claimed.

Id.

We note the Examiner relies on Waldorf for teaching or suggesting the transmitting feature, citing "Waldorf col. 4, lines 49-67 and col. 5, lines 1-30":

> Through the deployment of web pages that are developed with the page layout designer and page flow designer tools, the business analyst can provide enterprise-wide, internal and external access to web applications across networks such as an intranet, or the Internet[col. 4, lines 49-67] where the at least one tool for *transmitting* the document to the client computer 10 is the [I]nternet 14 as used in the deployment of the web pages by Waldorf's system and where Examiner notes that the [I]nternet is capable of transmitting an associated ticket as well[.]

Final Act. 14–15 (original emphasis omitted and emphasis added).

An obviousness inquiry is not limited to the prior art's preferred embodiment. *See, e.g., Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1370 (Fed. Cir. 2007).

Here, we again find the Examiner's proffered combination of familiar elements would have merely produced a predictable result. *KSR*, 550 U.S. at 401 ("[A] combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.").

For at least these reasons, we find a preponderance of the evidence supports the Examiner's underlying factual findings and ultimate legal conclusion of obviousness regarding rejection B of dependent claim 7.

Remaining Claims 6, 13, and 19 rejected under § 103 Rejection C

Dependent claim 6 is representative of this group of claims: "The method of claim 5 further comprising configuring said user interface to display a visual control for inputting control values comprising a starting number of a *Bates range*, for editing said document for printing." (Emphasis added).

The Examiner took Official Notice in the Final Action regarding the claimed *Bates range*:

> [The] Examiner takes Official Notice that providing a visual control for inputting a starting number was well known at the time of invention to persons of ordinary skill in the art. For example, Microsoft Office Word, one of the most widely used word processing applications, has provided the ability to select a starting number for numbering pages of a document since at least Word 2003.

Final Act. 18.

Appellant notes the Examiner's reliance on Official Notice:

> The Examiner took Official Notice that providing a visual control for inputting a starting number was well known at the time of invention to persons of ordinary skill in the art. The Final Office Action argued for example, Microsoft Office Word, one of the most widely used word processing applications, has provided the ability to select a starting number for numbering pages of a document since at least Word 2003.

App. Br. 41.

Appellant contends:

> The Appellant respectfully asserts that the specific claim language describes "a starting number of a Bates range." The "Bates range" is not an intended use of the starting number. Instead, the Bates range is its own stand-alone feature of the claim, which describes the character of the starting number. The Examiner "interpretation" of a Bates number as "providing page numbers for a document" is incorrect. Bates numbering is

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> more accurately described as a method of indexing documents wherein a number and or identifier are provided for a series of independent documents where the index continues through the separate documents.
>
> The Examiner has admittedly failed to make reference to anything which teaches or suggests the use of Bates numbering in any capacity, relying instead on the assertion that the Bates range is an intended use.

App. Br. 42.

To traverse the Examiner's taking of Official Notice, Appellant "must specifically point out the supposed errors in the examiner's action, *which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art.*" *See* MPEP § 2144.03 (emphasis added). An adequate traverse of the Examiner's taking of Official Notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the Examiner's notice of what is well known to one of ordinary skill in the art. *In re Boon*, 439 F.2d 724, 728 (CCPA 1971).

Here, Appellant has not *stated why the noticed fact is not considered to be common knowledge or well-known in the art.* Nor do we find a definition in Appellant's Specification for the claim language: "a starting number of a *Bates range.*" The Specification (¶ 29) merely mentions: "Further, the interface 380 may provide for a dialog box or other visual control for inputting control values for the edit or annotation such as the *starting number of a Bates range.*"

Buttressing the Examiner's taking of Official Notice (Final Act. 18), we note US Patent 484,389 ("CONSECUTIVE NUMBERING MACHINE"), Serial No. 349,452, to inventor Edwin G. Bates of New York, NY, issued on October 18, 1892, describes subject matter that lapsed into the

public domain well over a century ago: "machines for *printing consecutive numbers*, designed particularly to be set up with type in a printer's form and to advance the number printed by it at each impression." Page 1 of US patent 484,389 description, column 1, lines 9–13. (Emphasis added).[11]

Therefore, on this record, we find a preponderance of the evidence supports the Examiner's underlying factual findings and ultimate legal conclusion of obviousness regarding the contested "Bates range" numbering limitation of representative claim 6. Grouped claims 13 and 19 (not argued separately and also rejected under rejection C) fall with claim 6. *See* 37 C.F.R. § 41.37(c)(1)(iv). Accordingly, we sustain rejection C of claims 6, 13, and 19.

Reply Brief

To the extent Appellant *may* advance new arguments in the Reply Brief not in response to a shift in the Examiner's position in the Answer, we note arguments raised in a Reply Brief that were not raised in the Appeal Brief or are not responsive to arguments raised in the Examiner's Answer will not be considered except for good cause. *See* 37 C.F.R. § 41.41(b)(2).

CONCLUSIONS

The Examiner erred in rejecting claims 1–20 under 35 U.S.C. § 101, as being directed to a judicial exception, without significantly more.

The Examiner did not err in rejecting claims 1–20 under 35 U.S.C. § 103(a), as being obvious over the cited combinations of references.

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[11] A downloadable PDF copy of US Patent 484,389, to inventor Edwin G. Bates of New York, NY, issued on October 18, 1892, is available on Google Patents.

DECISION

We reverse the Examiner's decision rejecting claims 1–20 under 35 U.S.C. § 101.

We affirm the Examiner's decision rejecting claims 1–20 under pre-AIA 35 U.S.C. § 103(a).

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner's decision is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

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). *See* 37 C.F.R. § 41.50(f).

<u>AFFIRMED</u>