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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID C. ROBINSON, and KATHERINE LOJ

Appeal 2018-009245
Application 13/892,693
Technology Center 2600

Before KALYAN K. DESHPANDE, CATHERINE SHIANG, and
MATTHEW J. McNEILL, *Administrative Patent Judges*.

SHIANG, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1–7, 9, and 11–16, which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm in part.

¹ We use “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies Xerox Corporation as the real party in interest. Appeal Br. 1.

STATEMENT OF THE CASE

Introduction

The present invention relates to “a splitter operation performed on a PDF/VT [portable document format/variable data and transactional] file at the client device for rendering output at a printer device. More specifically, the splitter operation divides a catalog tree into multiple branches. The printer device uses relevant tree portions when processing corresponding chunks.” Spec. ¶ 1. In particular,

[o]ne embodiment of the present disclosure relates to a method for outputting a print job. The method includes accessing a file representing a previously created document at a client computer. The method includes accessing a catalog tree residing in the document and including metadata corresponding with a job ticket embedded in the file for rendering the document. The method includes splitting pages in the document into multiple chunks using a splitter located in the client computer. The method includes splitting by the splitter the catalog tree into a set of branches each corresponding with one of the chunks of the finished document. The method includes embedding corresponding branch information into the each chunk. The method includes streaming the chunks as a package to a digital front end (DFE) of an output device.

Spec. ¶ 10. Claim 1 is exemplary:

1. A method for outputting a print job, the method comprising:
 - accessing at a client computer a first file representing a previously created document;
 - accessing a catalog tree residing in the document and including metadata attached to each page of the document, the metadata corresponding with a job ticket embedded in the first file for advising a printer device how to apply the metadata for rendering the document;

dividing pages in the document into multiple chunks by splitting the pages in alternating fashion at a fixed distance, wherein the dividing is performed according to a predetermined chunk size parameter using a splitter located in the client computer;

trimming the catalog tree into portions each including only information that is required for a resident page within a chunk;

generating a branch for each chunk, the branch containing the trimmed portions of the catalog tree corresponding to resident pages within the chunks;

adding set boundary information at nodes of the branches, wherein each node defines a finishing level and the set boundary information is operative to be used by an associated raster image processor to generate commands for the chunk, and

embedding the corresponding branch information into the each chunk;

generating a second file including the chunks; and,
streaming the second file as a package to a digital front end (DFE) of an output device.

References and Rejections²

Claims Rejected	35 U.S.C. §	References
1-6	103	Mori (US 2011/0170132 A1; July 14, 2011), Boeck (US 2012/0186475 A1; July 26, 2012)
7, 9, 13-16	103	Mori, Boeck, AAPA (Background section of the Specification), Smith (US 2008/0309962 A1; Dec. 18, 2008)
11-12	103	Mori, Boeck, AAPA, Smith, Klassen (US 2011/0122433 A1; May 26, 2011)

² Throughout this opinion, we refer to the (1) Final Office Action dated Feb. 07, 2018 (“Final Act.”); (2) Appeal Brief dated July 6, 2018 (“Appeal Br.”); (3) Examiner’s Answer dated Aug. 29, 2018 (“Ans.”); and (4) Reply Brief dated Sept. 27, 2018 (“Reply Br.”).

ANALYSIS

Obviousness

On this record, the Examiner did not err in rejecting claim 1. We disagree with Appellant's arguments, and adopt the Examiner's findings and conclusions in (i) the action from which this appeal is taken and (ii) the Answer that are consistent with our analysis below.³

I

Appellant contends Mori does not teach "adding set boundary information at nodes of the branches," as recited in claim 1. *See* Appeal Br. 7–11; Reply Br. 3–4. In particular, Appellant contends paragraph 21 of the Specification defines "boundary information," but the Examiner fails to "interpret the claim limitation . . . in view of the definition assigned to it in the specification." Appeal Br. 10; *see also* Reply Br. 3. Appellant argues "Mori does not teach or suggest the claimed 'set boundary information' because it does not divide a PDF in interleave fashion." Appeal Br. 10. Appellant contends the Examiner erred in finding Mori's metadata teach both the claimed "boundary information" and "branch." Appeal Br. 10.

Appellant has not persuaded us of error.

First, it is well established that during examination, claims are given their broadest reasonable interpretation consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art, but without importing limitations from the

³ To the extent Appellant advances new arguments in the Reply Brief without showing good cause, Appellant has waived such arguments. *See* 37 C.F.R. § 41.41(b)(2).

specification. *See In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (citations omitted); *SuperGuide Corp. v. DirectTV Enters., Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004). The Specification states:

The set-boundary indicators indicate a boundary for each set of pages that are grouped together for a finishing operation. A set-boundary indicator can include the beginning page of a partitioned set and/or document (hereinafter referred to as “begin-set indicator”). The set boundary indicator can additionally include a last page of the partitioned set (“end-set indicator”).

Spec. ¶ 21.

Contrary to Appellant’s arguments, the above paragraph does not define the term “boundary information.” In fact, that term does not even appear in the above paragraph. As a result, we agree with the Examiner that Appellant has not shown the Specification specifically defines the term “boundary information.” *See* Ans. 2–3.

Second, Appellant’s argument that “Mori does not teach or suggest the claimed ‘set boundary information’ because it does not divide a PDF in interleave fashion” (Appeal Br. 10) is unsubstantiated and speculative, as Appellant has not persuasively explained why Mori must “divide a PDF in interleave fashion” (Appeal Br. 10) in order to teach the claimed “set boundary information.”

Third, in response to Appellant’s arguments, the Examiner further explains why Mori teaches both the claimed “branch” and “boundary information,” and why Mori teaches “adding set boundary information at nodes of the branches,” as recited in claim 1:

Mori ‘132 discloses that the metadata shown in FIGS. 9B, 9C and 9D has pages associated with the attributes of the “Record” (page 6, paragraph 61). The listing of pages can be

considered as boundary information because they indicate the bounds of the attributes.

.....

Mori '132 discloses that the metadata shown in FIG. 9A is divided as the print job is divided into groups (page 7, paragraph 66). The entire collection of metadata in the divided print job is saved with the new print job and can be considered a branch. The metadata shown in FIGS. 9B, 9C and 9D has pages associated with the attributes of the "Record" (page 6, paragraph 61). Generation of data involves creation of data, and because the original print job is split into multiple new print jobs, data that is carried over to the new pages can be considered as being added to the new job. Therefore, the generated metadata in the new print job can be considered as added.

Ans. 3–4.

Appellant fails to persuasively respond to such findings and, therefore, fails to show Examiner error. *See In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991) ("It is not the function of this court [or this Board] to examine the claims in greater detail than argued by an appellant, looking for [patentable] distinctions over the prior art."). In particular, Appellant's conclusory assertion that "the Examiner is drawing a broad conclusion" (Reply Br. 4) does not explain why and how the Examiner erred. Appellant also argues:

The claimed invention would not work on Mori. In other words, boundary information would not work on Mori. Take Mori FIG. 7, for example, a complete document having 9 pages includes metadata that instructs on some pages to be printed on plain paper and other pages to be printed on heavy paper. The pages that share the same finishing operation are grouped together to form a print job in FIG. 7B. FIG. 7B shows that pages 1, 2, 3, 7, 8, and 9 are all printed on plain paper. This is a noncontiguous group, so boundary information (page 1 and page 9) would not instruct on or guarantee any conformity on

pages 2-8. As evidenced in the illustrated example of Mori, there is gap in the group because pages 4-6 are assigned to a different finishing operation. In the claimed invention, the boundary information would designate pages 1 and 9 for the group, and this information would further instruct on a group of contiguous pages (for example 1, 3, 5, 7, and 9; or 1, 5, 9) that starts at page 1 and page 9. Therefore, Mori does not provide the outcome that is claimed.

Reply Br. 4.

The above arguments are unpersuasive, because they are not directed to the Examiner's specific findings: the Examiner finds in Mori, the claimed boundary information is "[t]he listing of pages" (Ans. 3)—not merely the beginning and ending page numbers, as Appellant argues (Reply Br. 4).

II

Appellant contends "Mori does not disclose the elements of (1) trimming the catalog tree; (2) generating a branch for each chunk . . . ; and (4) embedding the branch information into the chunk." Appeal Br. 7.⁴ In particular, Appellant argues:

During prosecution, Appellant pointed out that the Examiner cited to the same broad paragraph for limitations (2) [and] (4), above (See, Response dated April 17, 2018). it is clear that the exact text of the cited section(s) do not expressly disclose any one of the limitations [(1), (2), and (4)]. Appellant also submits that one of ordinary skill in the art would not conclude that the cited sections inherently suggest that any specific operations are being performed—on a catalog tree—when dividing a print job. Appellant submits that the Examiner has failed to provide *pin point citations* to Mori. Because the

⁴ Appellant refers to the limitation "adding set boundary information at nodes of the branches" as element (3). Appeal Br. 7. We have already discussed that limitation in Section I above.

Examiner has failed to provide a pin point citation for *each* limitation, Appellant submits that the Examiner is not able to fill the missing limitations using Mori.

Appeal Br. 8.

Appellant has not persuaded us of error. It is well settled that: [The USPTO] satisfies its initial burden of production by adequately explain[ing] the shortcomings it perceives so that the applicant is properly notified and able to respond. In other words, the PTO carries its procedural burden of establishing a prima facie case when its rejection satisfies 35 U.S.C. § 132, in notify[ing] the applicant . . . [by] stating the reasons for [its] rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.

In re Jung, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (internal citations and quotation marks omitted). Specifically, the Jung Court finds:

the examiner's discussion of the theory of invalidity (anticipation), the prior art basis for the rejection (Kalnitsky), and *the identification of where each limitation of the rejected claims is shown in the prior art reference by specific column and line number was more than sufficient to meet this burden.*

Jung, 637 F.3d at 1363 (emphasis added).

Here, the Examiner's rejection clearly satisfies the requirement of 35 U.S.C. § 132 to establish a *prima facie* case of unpatentability. The rejection identifies: the theory of unpatentability (obviousness); the prior art basis for the rejection (Mori and Boeck); where each limitation of claim 1 is shown in the references by page and paragraph numbers, plus additional explanation on how the prior art features teach the disputed claim limitations. *See* Final Act. 4–7; Ans. 2–4. In short, similar to the Examiner

in Jung, the Examiner has done “more than sufficient to meet this burden [of establishing the *prima facie* case].” The burden then shifts to Appellant to rebut the Examiner’s case.

In order to rebut a *prima facie* case of unpatentability, Appellant must distinctly and specifically point out the supposed Examiner errors, and the specific distinctions believed to render the claims patentable over the applied reference. *See* 37 C.F.R. § 1.111(b).

Appellant has not carried the burden. Appellant’s general arguments that “exact text of the cited section(s) do not expressly disclose any one of the limitations” and “one of ordinary skill in the art would not conclude that the cited sections inherently suggest that any specific operations are being performed--on a catalog tree--when dividing a print job” (Appeal Br. 8) are insufficient to show Examiner error. *See* 37 C.F.R. § 1.111(b); 37 C.F.R. § 41.37(c)(1)(iv) (“A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.”); *see also In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (holding that “the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art”); *see also In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990) (whether a reference teaches a claim limitation “is not an ‘ipsissimis verbis’ test”).

Because Appellant has not persuaded us the Examiner erred, we sustain the Examiner’s rejection of independent claim 1.

Regarding independent claim 7, Appellant advance similar arguments discussed above. *See* Appeal Br. 12–14. Such arguments are unpersuasive for the reasons discussed above. Appellant also contends “the claimed ‘set-

boundary indicator’ is an additional piece of information that is not inherent in the applied reference.” Appeal Br. 14. Appellant’s argument is not commensurate with the scope of the claim, as claim 7 does not recite a “set-boundary indicator.” In any event, such a general argument is unpersuasive of error. *See* 37 C.F.R. § 41.37(c)(1)(iv); *Lovin*, 652 F.3d at 1357.

Therefore, we sustain the Examiner’s rejection of independent claim 7.

We also sustain the Examiner’s rejection of corresponding dependent claims 2, 3, 5, 6, 9, and 11–13, 15, and 16, as Appellant does not advance separate substantive arguments about those claims. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Separately Argued Dependent Claims

Regarding dependent claim 4, we have reviewed the Examiner’s rejection in light of Appellant’s contentions and the evidence of record. We concur with Appellant’s contentions that the Examiner has not adequately explained why Mori and Boeck collectively teach “the second file includes . . . at least one set-boundary indicator indicating a boundary for each set of pages that are grouped together for a finishing operation,” as recited in claim 4. *See* Appeal Br. 11.

The Examiner cites Mori’s paragraph 61, and finds “[t]he metadata has pages associated with the attributes of the ‘Record’” (Final Act. 8) (original emphasis omitted), but does not adequately explain why the cited paragraph teaches the disputed limitation.⁵ In response to Appellant’s arguments, the Examiner further finds “[b]y the metadata listing each page

⁵ We have reviewed the cited Mori’s paragraph 61 and absent further Examiner explanation, that paragraph does not teaches the disputed limitation.

number of the record, one page number will inherently indicate the beginning and/or last page of the partitioned set” (Ans. 4–5), but still does not adequately explained why the cited paragraph teaches “the second file includes . . . at least one set-boundary indicator indicating a boundary for each set of pages that are grouped together for a finishing operation,” as required by claim 4.

Because the Examiner fails to provide sufficient evidence or explanation to support the rejection, we are constrained by the record to reverse the Examiner’s rejection of dependent claim 4.

For similar reasons, we are constrained by the record to reverse the Examiner’s rejection of dependent claim 14.

CONCLUSION

We affirm the Examiner’s decision rejecting claims 1–3, 5–7, 9, and 11–13, 15, and 16 under 35 U.S.C. § 103.

We reverse the Examiner’s decision rejecting claims 4 and 14 under 35 U.S.C. § 103.

In summary:

Claims Rejected	35 U.S.C. §	References	Affirmed	Reversed
1–6	103	Mori, Boeck	1–3, 5, 6	4
7, 9, 13–16	103	Mori, Boeck, AAPA, Smith	7, 9, 13, 15, 16	14
11–12	103	Mori, Boeck, AAPA, Smith, Klassen	11–12	
Overall Outcome			1–3, 5–7, 9, 11–13, 15, 16	4, 14

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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).

AFFIRMED IN PART