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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte REINHARD HOHENSEE, HARRY LEWIS,
and MICHAEL LOTZ

Appeal 2019-000939
Application 14/174,512
Technology Center 2600

Before HUNG H. BUI, MICHAEL M. BARRY, and MICHAEL J. ENGLE,
Administrative Patent Judges.

BARRY, *Administrative Patent Judge.*

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner’s decision to reject claims 1–20, which constitute all pending claims. *See* Appeal Br. 6–17 *and* Final Act. 1–16.² 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 the real party in interest as Ricoh Company Ltd. Appeal Br. 3.

² We refer to the Specification, filed Feb. 6, 2014 (“Spec.”); Final Office Action, mailed Feb. 22, 2018 (“Final Act.”); Appeal Brief, filed May 22, 2018 (“Appeal Br.”); Answer, mailed Sept. 10, 2018 (“Ans.”); and the Reply Brief, filed Nov. 9, 2018 (“Reply Br.”).

Introduction

Appellant describes the invention as “relat[ing] to the field of printing, and in particular, to stored print data.” Spec. ¶ 1; *see also id.* ¶¶ 2–9 (discussing features of the Advanced Function Presentation (AFP) standard architecture for printing and summarizing the disclosed embodiments of the invention as including features from the AFP standard). Claim 1 is illustrative, shown here with a disputed limitation *in italics*:

1. A system comprising:

a controller operable to load Advanced Function Presentation (AFP) print data, to identify AFP objects within the print data, to correlate the AFP objects with contextual information describing the AFP objects, and to insert the contextual information for the AFP objects into AFP Object Container Data (OCD) structures within AFP Index Elements (IELs) of an AFP index; and

a memory operable to store the index,

wherein the contextual information for each AFP object is organized as a multilevel hierarchy of data, and the controller is further operable to insert contextual information for each AFP object into an OCD within the IEL, while preserving the organization of the contextual information.

Appeal Br. 12 (Claims App’x).

Rejections & References

Claim 18 stands rejected under 35 U.S.C. § 112(a) as failing to comply with the written description requirement. Final Act. 4.

Claims 1–4, 7–11, and 14–17 stand rejected under 35 U.S.C. § 103 as unpatentable over Eiler et al. (US 8,397,162 B2; Mar. 12, 2013) and the Advanced Function Presentation Consortium, “*Mixed Object Document Content Architecture (MO:DCA) Reference*” (9th ed. 2011) (hereafter, the “AFP Standard Reference”). Final Act. 5–14.

Claims 5, 6, 12, 13, 19, and 20 stand rejected under § 103 over Eiler, the AFP Standard Reference, and DeRoller et al. (US 2012/0246559 A1; Sept. 27, 2012). Final Act. 14–16.

ANALYSIS

The § 103 Obviousness Rejections

In rejecting claim 1, the Examiner finds the combined teachings of Eiler and the AFP Standard Reference teach the disputed limitation. Final Act. 6–8 (citing Eiler 1:6–3:31 (Background), 5:19–56, 6:21–33, 7:36–49, Fig. 3; AFP Standard Reference 1–5 (i.e., Chapter 1), 12 (Data Objects), 15 (Object Containers), 27 (Data Object), 67 (Fig. 15)).

Appellant contends the Examiner errs because “[t]he cited references do not discuss *contextual information being organized in a multi-level hierarchy*, and a controller that *inserts contextual information into an OCD within an IEL*,” as required by the disputed limitation. Appeal Br. 9.³ In particular, Appellant argues that the AFP Standard Reference fails to teach or suggest the Examiner’s proposed modification because the disputed limitation results in a system that violates the requirements of the AFP Standard Reference, and therefore it would not have been obvious to an artisan of ordinary skill to make the proposed combination of teachings from

³ Appellant also states “[t]his combination of features was never rejected by the PTAB.” Appeal Br. 9. This refers to our decision in Appeal No. 2016-006707 (PTAB May 4, 2017), in which we reversed a 35 U.S.C. § 102 anticipation rejection of then-pending claim 1 (which did not include the disputed limitation of now-pending claim 1). As part of that Prior Decision, we issued a new ground of rejection under 35 U.S.C. § 103 for then-pending claim 1, which we note differs from now-pending claim *only* by the addition of the disputed limitation. To the extent there is any inconsistency between this decision and our Prior Decision, this decision controls.

Eiler and the AFP Standard Reference to achieve claim 1. *Id.* at 9–10; *see also* Reply Br. 6.

Appellant’s argument is persuasive. The importance of “identify[ing] a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does” is a well-established principle, because “inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417–18 (2007); *see also, e.g., B.G. Corp. v. Walter Kidde & Co.*, 79 F.2d 20, 21–22 (2d Cir. 1935) (explaining that selection of known elements “serviceable to a given need may require a high degree of originality”).

Here, the AFP Standard Reference defines IELs as containing only specifically identified types of components. *See* AFP Standard Reference 66–70. AFP OCD structures that contain a multilevel hierarchy of data are not identified as an allowed type of component within an IEL. *Id.* The AFP Standard Reference provides that unidentified structured fields within an IEL will generate an exception condition. *Id.* at 79. Thus, Appellant persuades us that embedding an AFP OCD structure containing a multi-level hierarchical AFP object into an AFP Index Element within an AFP index, as recited, would have violated the AFP standard, such that it would have generated an exception condition under the AFP standard architecture. Appeal Br. 9–10; Reply Br. 6.

“[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Here, the Examiner,

relying on the new ground in our original decision, met that *prima facie* burden. At that point, “the burden of coming forward with evidence or argument shifts to the applicant.” *Id.* “After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument.” *Id.* Here, Appellant has provided persuasive rebuttal evidence that a person of ordinary skill in the art would not have been motivated to modify the references as proposed because that would violate the AFP standard and cause an exception condition. The Examiner has not sufficiently rebutted Appellant’s evidence, such as by explaining why Eiler or other circumstances would have provided a person of ordinary skill with reason to accept or overcome such an exception condition. Thus, given the totality of the record as it currently stands in this case, there is an insufficient explanation why a person of ordinary skill would have modified the AFP Standard Reference in the way proposed despite it causing an exception condition.

Accordingly, on the record before us, we do not sustain the § 103 rejection of claim 1. We also, therefore, do not sustain the § 103 rejection of independent claims 8 and 15, which recite the same disputed limitation as claim 1 and for which their rejection relies on the same findings. Because the rejections of dependent claims 2–7, 9–14, 16, 17, 19, and 20 do not cure the deficiency in the rejection of the independent claims, we also, therefore, do not sustain their rejections.

The § 112(a) Written Description Rejection of Claim 18

Claim 18 depends from independent claim 15⁴ and recites “wherein: the AFP IELs do not include Tag Logical Elements (TLEs) and do not include Link Logical Elements (LLEs).”⁵ Appeal Br. 17 (Claims App’x). The Examiner rejected claim 18 as lacking written description support because the Specification nowhere discusses LLEs and, therefore, does not show the inventors were in possession of a claim limitation for excluding LLEs from IELs. Final Act. 4.

Appellant contends the Examiner errs, because Figure 5 provides a detailed illustration of IELs that do not include LLEs, arguing “[a]ny LLEs would necessarily be included in FIG. 5 if they did indeed exist within the IELs.” Appeal Br. 6 (“Just like the plans for a house may be reviewed to determine whether the house includes a kitchen, the specifically listed IELs can be reviewed to determine whether they each include an LLE.”); *see also* Reply Br. 4–6.

Appellant’s argument is unpersuasive. Compliance with the written description requirement is a question of fact that is context-sensitive. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) (“[T]he level of detail required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology.”). To fulfill the written description requirement, the application as filed “must clearly allow

⁴ Claim 15 recites “[a] non-transitory computer readable medium embodying programmed instructions” and includes a wherein clause identical to the wherein clause of claim 1. Appeal Br. 16 (Claims App’x).

⁵ The original claims in the Specification did not include the limitation recited in claim 18. *See* Spec. 11–14.

persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.” *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1479 (Fed. Cir. 1998) (internal citation and quotation omitted). A description that merely renders the invention obvious does not satisfy the written description requirement. *Ariad*, 598 F.3d at 1352. When an applicant amends a claim “in such a way as to justify an assertion that it is directed to a *different invention* than was the original claim, it is proper to inquire whether the newly claimed subject matter was *described* in the patent application when filed as the invention of the applicant.” *In re Wright*, 866 F.2d 422, 424 (Fed. Cir. 1989).

The Specification is silent with respect to TLEs and with respect to excluding them from IELs. Merely because the embodiments of IELs illustrated in the Figures do not include TLEs is insufficient to show, with the requisite clarity, the inventors were in possession of the positive step of excluding TLEs from IELs. *Gentry Gallery*, 134 F.3d at 1479.

Accordingly, we sustain the written description rejection of claim 18.

CONCLUSION

We affirm the 35 U.S.C. § 112(a) rejection of claim 18.

We reverse the 35 U.S.C. § 103 rejections of claims 1–17, 19, and 20.

In summary:

Claims Rejected	35 U.S.C. §	References/Basis	Affirmed	Reversed
18	112(a)	Written Description	18	
1-4, 7-11, 14-17	103	Eiler, AFP Standard Reference		1-4, 7-11, 14-17
5, 6, 12, 13, 19, 20	103	Eiler, AFP Standard Reference, DeRoller		5, 6, 12, 13, 19, 20
Overall Outcome			18	1-17, 19, 20

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