

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD L. HARTMAN, MARY M. HARTMAN,
and ROY P. MASSENA

Appeal No. 2002-0362
Application 09/054,339

ON BRIEF

Before JERRY SMITH, LEVY, and SAADAT, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 64-79, which constitute all the claims remaining in the application.

The disclosed invention pertains to a method and apparatus for storing and retrieving resumé files of job applicants.

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Claims 64-79 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Nebel in view of Taylor.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 64-79. Accordingly, we affirm.

Appellants have indicated that for purposes of this appeal the claims will all stand or fall together as a single group

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[brief, page 4]. Consistent with this indication appellants have made no separate arguments with respect to any of the claims on appeal. Accordingly, all the claims before us will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will consider the rejection against independent claim 64 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil,

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Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellants [see 37 CFR § 1.192(a)].

With respect to representative, independent claim 64, the examiner cites Nebel as teaching a method and apparatus for sending and receiving graphics files which maintain the

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appearance, format and font information of original documents. The examiner essentially finds that Nebel teaches the claimed invention except for the transferred files representing resumé files of job applicants. The examiner cites Taylor as teaching that it was known in the art to transmit resumé files over the internet. The examiner finds that it would have been obvious to the artisan to transmit resumé files as taught by Taylor in the file transmission system taught by Nebel [final rejection, pages 2-5, incorporated into answer at page 3]. We find that the examiner's rejection is sufficiently complete and reasonable as to establish a prima facie case of obviousness. Therefore, as noted above, the burden shifts to appellants to present arguments and/or evidence that persuasively rebut the examiner's prima facie case of obviousness.

Appellants argue that it would not have been obvious to combine Taylor with Nebel because there is no teaching or suggestion within this prior art to make the combination. Appellants also argue that even if the references were combined, there is still no teaching of a resumé graphics file or a non-bitmap graphics file as claimed. Specifically, appellants note that Taylor lacks any teaching toward resumé graphics files. Appellants argue that Nebel only teaches a generic file transfer

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method and lacks any teachings directed to transmission of resumé graphics files. Appellants' arguments essentially note that the combination of references fail to teach the transfer of resumé files as graphics files or non-bitmap files which maintain the appearance, format information and font information of the original resumé documents [brief, pages 5-12].

The examiner responds that Taylor is cited only to teach that it was known to send resumé files over the internet. The examiner asserts that Nebel teaches that it was known to send graphics files which files maintain their appearance using HTML and MIME protocols along with forms for the input of information. In other words, the examiner notes that the graphics file portion of the claimed invention is taught by Nebel, while the resumé file portion of the claimed invention is taught by Taylor [answer, pages 3-5].

We will sustain the examiner's rejection of claims 64-79 because we are not persuaded by appellants' arguments in the brief that the rejection is in error. Most of appellants' arguments point to teachings missing from each of the applied references even though the alleged missing teachings are not relied on by the examiner in making the rejection. For example, appellants continually argue that Taylor does not teach a resumé

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graphics file even though Taylor was not relied on to teach a graphics file. Taylor was only cited to demonstrate that it was well known to send resumé files over the internet. Nebel was cited by the examiner to teach the transmission of non-bitmap graphics files over the internet. Appellants also point out the advantages of the resumé graphics file of their invention. The examiner's rejection also explains that the graphics files transmitted in Nebel maintain appearance, format and font information of original documents in accordance with the HTML format and the MIME protocols. Appellants' brief does not challenge this finding of the examiner. Appellants' arguments with respect to Nebel only assert broad generalizations about the reference and do not address the specific portions of Nebel relied on by the examiner.

In summary, Nebel is cited as teaching the transmission of text or graphics files using the HTML format and MIME protocols. The examiner finds that these disclosures of Nebel teach the transmission of graphics files which maintain the appearance, format information and font information of original documents. This finding of the examiner is not challenged in the arguments made by appellants in the brief. We agree with the examiner that the files in Nebel can be any type of text and/or graphics files.

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Since the transmission of resumé files over the internet was well known as taught by Taylor, we agree with the examiner that it would have been obvious to the artisan to send resumé files over the internet as graphics file in the HTML format and using MIME protocols as taught by Nebel.

In conclusion, we have sustained the examiner's rejection of the claims on appeal. Therefore, the decision of the examiner rejecting claims 64-79 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

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| JERRY SMITH |) | |
| Administrative Patent Judge |) | |
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| STUART S. LEVY |) | BOARD OF PATENT |
| Administrative Patent Judge |) | APPEALS AND |
| |) | INTERFERENCES |
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| MAHSHID D. SAADAT |) | |
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