

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 BARNABY JAMES and SU CHEN

Appeal No. 2003-1112
Application No. 09/520,892

ON BRIEF

Before KRASS, DIXON, and SAADAT, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-65, which are all of the claims pending in this application.

We REVERSE.

Appellants' invention relates to a distributed computing document recognition and processing. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A distributed computing system for processing document data at a processing location remote from users, comprising:

a network server which receives documents transmitted to said processing location from at least one user terminal; and

an application server connected to said network server to receive documents transmitted thereto, and which distributes a portion of said documents responsive to one or more document processing applications at said processing location which convert the received documents into one or more electronic document formats.

The prior art of record relied upon by the examiner in rejecting the appealed claims are as follows:

Chong	5,175,684	Dec. 29, 1992
Yamauchi et al. (Yamauchi)	5,701,497	Dec. 23, 1997
Mitchell et al. (Mitchell)	5,963,966	Oct. 05, 1999

Claims 1-4, 9, 10, 12, 13, 17, 22, 29, 31, 32, 36, 37, 39, 40, 42, 52, 55, 60, 64, and 65 stand rejected under 35 U.S.C. § 102 as being anticipated by Yamauchi.

Claims 5-8, 11, 16, 18, 23-28, 30, 35¹, 38, 41, 43, 44, 53, 54, and 56-59 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yamauchi in view of Mitchell.

¹ We note that the examiner has not indicated a grounds of rejection for dependent claims 33 and 34. Since claim 35 depends from claim 34 which depends from claim 33, we will assume that the examiner intended to reject these claims under 35 USC § 103 with claim 35.

Appeal No. 2003-1112
Application No. 09/520,892

Claims 14, 15, 19-21, 45-51 and 61-63 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yamauchi in view of Mitchell further in view of Chong.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 16, mailed Sep. 30, 2002) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 15, filed Jul. 12, 2002) and reply brief (Paper No. 18, filed Nov. 29, 2002) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

35 USC § 102

As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations set forth in independent claim 1.

Appellants argue that the examiner has not established a *prima facie* case of anticipation since not all of the claimed elements are taught by Yamauchi. (See brief at pages 5-8.) Appellants argue that the examiner maintains that Yamauchi teaches an

application server, but the examiner does not indicate what specific element of Yamauchi corresponds to this element. (See brief at page 8.) The examiner repeats the same content of the rejection in the answer at pages 4-5. In the response to arguments portion of the answer, the examiner maintains that the facsimile machine of Yamauchi is really a telecommunication and processing system that contains language translation processor. (See answer at page 7.) Additionally, the examiner indicates that “Yamauchi teaches a network server (see items 4 and 5) and that application server and applications (e.g., items 6, 7, 9, and 10) since the software for the translation must be included in the application server hardware to perform the processing. Furthermore, since an ‘application server’ is a processor that executes an application, Yamauchi teaches the application server . . . The application server then distributes the document to the processing location which converts the received documents into one or more electronic document formats.” (See answer at pages 7-8.) We disagree with the examiner’s interpretation of the teachings of Yamauchi. From our review of the teachings of Yamauchi, we find at most that Yamauchi teaches the use of either a network or an application server, but not both. Furthermore, we find the correlation of items 6, 7, 9, and 10 in Figure 1 to be unreasonable since there does not appear to be any server type function carried out by these elements as recited in the language of independent claim 1. Claim 1 requires that “an application server connected to said network server to receive documents transmitted thereto, and which

distributes a portion of said documents responsive to one or more document processing applications at said processing location which convert the received documents into one or more electronic document formats.” (See also brief at page 8.) Appellants argue that the mere presence of applications in Yamauchi does not mean that Yamauchi teaches the use of an application server as recited in the language of independent claim 1. (See brief at page 8.) We agree with appellants. Therefore, we find that the examiner has not established a *prima facie* case of anticipation, and we cannot sustain the rejection of independent claims 1, 36, and 64 which all have similar limitations and the rejection of their dependent claims.

With respect to independent claim 65, appellants argue that independent claim 65 includes a “means for distributing said one or more documents to said one or more remote terminals.” Here, we find no response to this argument by the examiner in the answer. Therefore, we cannot sustain the rejection of independent claim 65.

35 USC § 103

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d

Appeal No. 2003-1112
Application No. 09/520,892

1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See **In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination only by showing some objective teaching in the prior art or individual to combine the relevant teachings of the references." **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**,

Appeal No. 2003-1112
Application No. 09/520,892

972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) .

The examiner relies upon the teachings of Mitchell with respect to the use of web browsers and document conversion and that it would have been obvious to one of ordinary skill in the art to combine the teachings of Yamauchi and Mitchell to utilize the well-known commercial networks and display browsers. (See answer at pages 5-6.) Appellants argue that the examiner has not provided a *prima facie* case of obviousness. (See brief at page 14.) We agree with appellants and find the examiner's rationale for the combination to be merely conclusory. Furthermore, we do not find that the teachings of Mitchell remedy the noted deficiency in the teachings of Yamauchi with respect to the lack of the teaching of an application server as discussed above. Furthermore, we generally agree with appellants' three arguments at pages 14-17 of the brief, and we will not sustain the rejection based upon the combination of Yamauchi and Mitchell.

Appeal No. 2003-1112
Application No. 09/520,892

With respect to the examiner's reliance upon the teachings of Chong, appellants argue that the examiner has not provided a *prima facie* case of obviousness. (See brief at pages 18-19.) We agree with appellants and find the examiner's rationale for the combination to be merely conclusory. Furthermore, we do not find that the teachings of Mitchell and Chong remedy the noted deficiency in the teachings of Yamauchi with respect to the lack of the teaching of an application server as discussed above. Furthermore, we generally agree with appellants' three arguments at pages 17-21 of the brief, and we will not sustain the rejection based upon the combination of Yamauchi, Mitchell, and Chong.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-65 under 35 U.S.C. § 103 is reversed.

Appeal No. 2003-1112
Application No. 09/520,892

REVERSED

ERROL A. KRASS
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

MAHSHID D. SAADAT
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)
)

JD/RWK

Appeal No. 2003-1112
Application No. 09/520,892

BROMBERG & SUNSTEIN LLP
125 SUMMER STREET
BOSTON, MA 02110-1618