

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL E. REILLY

Appeal No. 1999-0006
Application No. 08/470,970

ON BRIEF

Before BARRETT, RUGGIERO, and LEVY, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-9 and 11-40, which are all of the claims pending in the present application. Claim 10 has been canceled. An amendment filed September 23, 1997 after final rejection was approved for entry by the Examiner.

The claimed invention relates to a centralized print queue for a network printer system. Print job requests,

without a transmission of print job data which remains at a host computer, are submitted by the host computer and stored as print job information in the centralized print queue. When the printer becomes available, the print job information in the print queue permits the host computer with the actual print job data to be accessed for transmission of the print data to the printer, thereby reducing the amount of network traffic.

Claim 1 is illustrative of the invention and reads as follows:

1. A network printing system comprising:

(a) a plurality of host computers connected to a network; and

(b) a printer connected to the network for receiving and printing print jobs in response to print requests from said host computers, wherein said printer includes a localized print queue for storing print job information for each of said host computers attempting to gain print access to said printer, and wherein each of said host computers communicates with said printer using an application-layer uniform interface protocol.

The Examiner relies on the following prior art:

DeHart et al. (DeHart)	5,517,636	May 14, 1996 (filed Oct. 13, 1994)
Davidson, Jr. et al. (Davidson)	5,550,957	Aug. 27, 1996 (filed Dec. 07,

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1994)
Patel et al. (Patel) 5,566,278 Oct. 15, 1996
(filed Aug. 24,

1993)

Claims 1-9 and 11-40 stand rejected under 35 U.S.C.

§ 103. As evidence of obviousness, the Examiner offers Davidson in view of DeHart with respect to claims 1-5, 7-9, 11-14, 16-19, 21-28, 30-37, 39, and 40, and adds Patel to the basic combination with respect to claims 6, 15, 20, 29, and 38.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs¹ and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, and the evidence of obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision,

¹ The Appeal Brief was filed January 23, 1998 (Paper No. 14). In response to the Examiner's Answer dated March 3, 1998 (Paper No. 15), a Reply Brief was filed May 4, 1998 (Paper No. 16) which was acknowledged and entered by the Examiner as indicated in the communication dated May 8, 1998 (Paper No. 17).

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Appellant's arguments set forth in the Briefs along with the Examiner's rationale in support of the rejections 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

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particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as recited in claims 1-9 and 11-40. Accordingly, we reverse.

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, 1073-74, 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

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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, 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).

With respect to the appealed independent claims 1, 7, 9,
25, and 32, the Examiner proposes to modify the network
printing system disclosure of Davidson. According to the
Examiner (Answer, page 3, which refers to the final Office
action mailed June 23, 1997, Paper No. 7), Davidson discloses

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the claimed invention except for the use of an application-layer uniform interface protocol to provide communication between a host computer and a network printer. To address this deficiency, the Examiner turns to DeHart which, as interpreted by the Examiner, discloses ". . . computer programming to allow application-layer communications in a computer environment independent of the system on which the program is running . . ." (final Office action, page 3). In the Examiner's view, the skilled artisan would have been motivated and found it obvious to include a uniform interface protocol as taught by DeHart in the system of Davidson ". . . in order to provide a uniform protocol for interfacing between computers using network service protocols/ports and a printer." (Id.)

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In response, Appellant's arguments, aside from a general assertion at page 12 of the Brief, do not attack the combinability of Davidson and DeHart but, rather, focus on the alleged lack of disclosure in Davidson of key features of the appealed claims. Appellant initially contends (Brief, page 11) that the Examiner has misinterpreted the disclosure of Davidson as providing a description of the claimed feature of storing "print job information" in a localized print queue, a feature which is present in all of the independent claims. In making this assertion, Appellant refers to a specific definition of the terminology "printer job information" appearing at page 4, lines 11-23 of the specification, which draws a distinction with actual print job data.

After careful review of the Davidson reference in light of the arguments of record, we are in agreement with Appellant's position as stated in the Briefs. While the Examiner is correct that claims are to be given their broadest possible interpretation, any such interpretation must be consistent with the specification. In the present factual situation, Appellant's specification (page 4, lines 11-23; page 16, lines

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3-6) provides a clear disclosure of the meaning of the terminology "printer job information," i.e., descriptive properties related to the print job such as job name, estimated print time, number of pages, etc., as opposed to the actual print job data itself. An inventor's definition and explanation of the meaning of a term, as evidenced by the specification, controls the interpretation of that claim term, as opposed, for example, to dictionary definitions. Serrano v. Telular Corp., 111 F.3d 1578, 1581, 42 USPQ2d 1538, 1541 (Fed. Cir. 1997).

In contrast to the language of the appealed claims, our interpretation of the disclosure of Davidson coincides with that of Appellant, i.e., only the transmittal of printer status information from a printer to a host computer is described. We find no basis for the Examiner's conclusion that "print job information," as opposed to actual print job data, is stored in a printer queue in Davidson, at least not according to the definition provided by Appellant in the specification.

We are further in agreement with Appellant that no basis exists for the Examiner's conclusion that Davidson provides

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for a printer-initiated connection or job-execution connection on printer availability, as required by independent claims 7, 25, and 32. In our view, as also asserted by Appellants (Reply Brief, pages 5 and 6), the mere existence of two-way

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communication capability, relied on by the Examiner, between a host computer and printer in Davidson is not sufficient to establish a teaching of a printer-initiated connection under the specific conditions set forth in the appealed claims.

With respect to the DeHart and Patel references relied on by the Examiner as providing a teaching of the use of an application layer interface and print job characteristic data, respectively, we find nothing in either of these disclosures that would overcome the innate deficiencies of Davidson discussed supra.

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In view of the above discussion, it is our view that, since all of the limitations of the appealed claims are not taught or suggested by the prior art, the Examiner has not established a prima facie case of obviousness. Accordingly, the 35 U.S.C.

§ 103 rejection of independent claims 1, 7, 9, 25, and 32, as well as claims 2-6, 8, 11-24, 26-31, and 33-40 dependent thereon, cannot be sustained. Therefore, the decision of the Examiner rejecting claims 1-9 and 11-40 is reversed.

REVERSED

LEE E. BARRETT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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)	
STUART S. LEVY)	
Administrative Patent Judge)	

JFR:hh

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