

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** HOWARD A. MILLER

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Appeal No. 2002-0886  
Application No. 08/674,937

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ON BRIEF

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Before HAIRSTON, KRASS, and FLEMING, ***Administrative Patent Judges.***

FLEMING, ***Administrative Patent Judge.***

***DECISION ON APPEAL***

This is a decision on appeal from the final rejection of claims 12-24, all the claims pending in the instant application. Claims 1-11 and 25-30 have been canceled.

***Invention***

The invention relates to a method and apparatus for providing additional fonts for a printer. See page 2 of Appellant's specification. If a user of prior art printers wants to access a greater number of fonts, the user has two options.

First, the user can purchase a printer having a larger amount of ROM with more fonts stored in the ROM. Second, the user can purchase a printer with a reduced number of fonts, and then purchase additional RAM plus additional fonts. See page 2 of Appellant's specification. From a user's perspective, both options are undesirable because they require the user to pay more to own and operate a printer. See page 3 of Appellant's specification.

Typically, ROM is assembled in a manner that results in the total amount of ROM being a factor of two, i.e., two megabytes, four megabytes, eight megabytes, or more. But assembling ROM in this manner can result in a portion of the ROM not being used. Appellant's invention utilizes this unused memory for storing additional fonts. See page 6 of Appellant's specification.

Figure 3 is a pictorial representation of a ROM that may be used to implement the method and apparatus for additional font availability. ROM 300 is a single ROM in which operating software 302, fonts 304, and additional fonts 306 are stored thereon. Additional fonts 306 are stored in what would have been unused space within ROM 300. Fonts 304 and additional fonts 306 are stored in the ROM in a manner that eliminates or minimizes the amount of unused ROM space. Thus, the total number of fonts

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in the printer is increased without any additional hardware. See page 7 of Appellant's specification.

Referring to Figure 4, a flowchart depicts a preferred method for additional font availability. The method begins at block 400, with all the fonts stored in ROM within the printer. A user turns on the printer, and a portion of the fonts stored in the ROM are then made available using techniques known in the art. These two steps are illustrated in blocks 402 and 404, respectively. A determination is then made as to whether or not a key is present or has been added to the printer. This step is depicted in block 406. The key can be one of several items, examples being software code, a hardware jumper or a card with a hardware identification or jumper. See page 7 of Appellant's specification. If the key is not present, the process ends, as shown in block 408. In this case, only a portion of the fonts stored in ROM is made available to the user. If the key is present, the process passes to block 410 where the additional fonts are made available from the ROM. Now the user can use all the fonts stored in the printer. The process then ends, as shown in block 408. See page 8 of Appellant's specification.

Independent claim 12 present in the application is as follows:

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12. A method for making at least one additional font available to a system, wherein data is stored in a storage medium and is available to the system, the method comprising the steps of:

storing the at least one additional font in the storage medium in a manner that minimizes or eliminates an amount of unused space in the storage medium;

determining whether or not a key is associated with the system;

making at least one of the at least one additional font stored in the storage medium available to the system when the key is associated with the system; and

having only the data stored in the storage medium be available to the system when the key is not associated with the system.

#### **Reference**

The reference relied on by the Examiner is as follows:

Sone et al. (Sone)	5,175,811	Dec. 29, 1992
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#### **Rejection at Issue**

Claims 12-24 stand rejected under 35 U.S.C. § 102 as being anticipated by Sone.

Throughout the opinion, we will make reference to the briefs<sup>1</sup> and answer for the respective details thereof.

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<sup>1</sup> Appellant filed an appeal brief on August 10, 1998. Appellant filed a reply brief on November 5, 1998. The Examiner mailed an Office communication on July 5, 2002, stating that the reply brief has been entered and considered.

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**OPINION**

With full consideration being given the subject matter on appeal, the Examiner's rejection and the arguments of the Appellant and the Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claims 12-24 under 35 U.S.C. § 102.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. **See *In re King***, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and ***Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.***, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

Appellant argues that Sone does not teach or suggest additional fonts in a plurality of fonts and storing the additional fonts in a way that minimize or eliminate unused space. Appellant further argues that Sone does not teach or suggest making the additional fonts available to the apparatus when the key is associated with the apparatus, and making only the data available to the apparatus when the key is not associated with the apparatus. See pages 6-8 of the brief and pages 2 and 3 of the reply brief.

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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).

We note that independent claim 12 recites

storing the at least one additional font in the storage medium in a manner that minimizes or eliminates an amount of unused space in the storage medium; determining whether or not a key is associated with the system; making at least one of the at least one additional font stored in the storage medium available to the system when the key is associated with the system; and having only the data stored in the storage medium be available to the system when the key is not associated with the system.

We note that the other independent claims 17 and 21 recite similar language.

Upon our review of Sone, we agree with the Examiner that Figure 1 shows additional memory, external memory, stored thereon additional fonts. However, we fail to find that Sone teaches storing the additional fonts and unused memory space or providing a key which is determinative of whether the user has available the additional fonts.

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In view of the foregoing, we have not sustained the  
Examiner's rejection of claims 12-24 under 35 U.S.C. § 102.

**REVERSED**

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
ERROL A. KRASS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
MICHAEL R. FLEMING	)	
Administrative Patent Judge	)	

MRF/lbg

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