

Ex parte Miller et al.
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AND INTERFERENCES

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

This opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM G. MILLER
and DAVID J. SWEET

Appeal No. 96-1847
Application No. 07/980,934¹

ON BRIEF

Before KRASS, JERRY SMITH and FLEMING, 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 9-11, 16 and 17. Claims 1-5, 12 and 13 have been canceled. Claims 6-8, 14, 15 and 18 have

¹ Application for patent filed November 20, 1992, which is, according to appellants, a continuation of Application No. 07/589,828 filed September 24, 1990, now U.S. Patent No. 5,221,973.

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been indicated as being allowable and form no part of this appeal.

The claimed invention pertains to a reprographic system. More particularly, the invention relates to the determination of the status of components within a peripheral device which is attached to the reprographic system.

Representative claim 9 is reproduced as follows:

9. A reprographic system, comprising:

a peripheral device, attached to the reprographic system so as to receive print media output therefrom, the function of said peripheral device being integrated with the reprographic system;

means for communicating with said peripheral device;

means for receiving configuration information from said peripheral device, thereby characterizing components contained therein; and

means for determining the status of the components.

The examiner relies on the following reference:

Yano et al. (Yano) 4,167,322 Sep. 11, 1979

Claims 9-11, 16 and 17 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Yano taken alone. A rejection of these claims under the second paragraph of 35 U.S.C. § 112 was not repeated in the examiner's answer, and we are treating this rejection as having been withdrawn by the examiner.

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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 collective 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 9-11, 16 and 17. Accordingly, we affirm.

As a general proposition in an appeal involving a rejection under 35 U.S.C. § 103, an examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden then shifts to the applicant to overcome the prima facie

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case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); 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).

The examiner has pointed out the teachings of Yano, has pointed out the perceived differences between Yano and the claimed invention, and has reasonably indicated how and why Yano would have been modified to arrive at the claimed invention. The examiner has, therefore, at least satisfied his burden of presenting a prima facie case of obviousness. The burden is, therefore, upon appellants to come forward with evidence or arguments which persuasively rebut the examiner's prima facie case of obviousness. Appellants have presented several arguments in response to the examiner's rejection. Therefore, we consider obviousness based upon the totality of the evidence and the persuasiveness of the arguments.

We consider first the rejection of claim 9 which is the only independent claim on appeal before us. The manner in which the examiner reads claim 9 on Yano is a little confusing because the

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incorporated rejection (Paper No. 19) seems to view the "main" copier 12 as the peripheral device whereas the response portion of the answer seems to view copier 12 as the reprographic system and any of copiers 13, 14 or 16 to be the claimed peripheral device. Notwithstanding this apparent inconsistency, it is clear that Yano discloses machines which are peripheral with respect to each other. The examiner focuses the rejection on the obviousness of receiving "configuration information" from the peripheral device.

Appellants' position with respect to the patentability of claim 9 is premised on two major arguments regarding the allegedly patentably distinguishing features of claim 9. The first argument by appellants is that the peripheral device of Yano as interpreted by the examiner does not receive print media output from the reprographic system of Yano as recited in claim 9. The specification uses the term "print media" to refer to hard copies of reproduced material. It is clear that the various copiers 12-16 of Yano are not described as exchanging hard copies between them. Electronic data is exchanged which may be printed out by a copier. To the extent that the examiner's interpretation of Yano finds a teaching of one copier receiving print media from another copier in accordance with the recitation

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of claim 9, we do not agree. Nevertheless, in our view, the breadth of scope of the invention of claim 9 is still suggested by Yano for reasons which follow.

Claims are to be given their broadest reasonable interpretation during prosecution. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969). It is improper to narrow the scope of the claim by implicitly reading in disclosed limitations from the specification which have no express basis in the claims. See Id. Similarly, claims are not interpreted in a manner which limits them to the preferred embodiments of the specification. Note Amhil Enterp. v. Wawa, Inc., 81 F.3d 1554, 1559, 38 USPQ2d 1471, 1474 (Fed. Cir. 1996). In our view, the peripheral device as recited in claim 9 is met by any attachment to a copier which handles the hard copies or print media after the copies have been made.

Yano suggests that it is conventional for a plurality of copiers such as copiers 12-16 to be located at different locations in a building and for each copier to have different functional capabilities [column 1, lines 21-26]. The copiers 12-16 are drawn differently in Fig. 1 of Yano to suggest that each copier has different functional capabilities. It was well known

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in the reprographic system art to include "peripheral" attachments to the system for handling the hard copies produced by the system. For example, reprographic systems which had attachments to staple, sort and/or collate hard copies were commonly used in business environments. Such attachments would satisfy the peripheral device recitation of claim 9. More specifically, each of the copiers 12-16 is a reprographic system as claimed, and a copier which has an attachment for sorting, stapling or collating has a peripheral device attached thereto for receiving print media output from the reprographic system. Thus, a single copier of Yano, such as copier 16, meets the claim 9 recitation if the copier 16 has a device attached to the copier to sort, staple, collate, etc. There is no other requirement in claim 9 which precludes the conventional print media handling subsystem of any copier from meeting the "peripheral device" recitation of claim 9.

Appellants' second major argument with respect to the patentability of claim 9 concerns the recited "means for receiving configuration information from said peripheral device." According to appellants, Yano does not meet this recitation because Yano is forced to reprogram his computer to provide for additional functional capability. We agree with the examiner

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that this argument goes beyond the scope of claim 9. Claim 9 does not preclude reprogramming of a computer, and the term "configuration information" is an overly broad term. In our view, when the computer in copier 12 of Yano communicates with one of the other copiers to receive the status of various parameters of the other copier, this suggests the reception of "configuration information" from any peripheral device attached to that copier as well. Appellants have also failed to respond to the examiner's rationale as to why it would have been obvious to communicate configuration information as that term is defined by appellants. Thus, we find the term "configuration information" to be sufficiently broad so as to be met by the information transmitted in Yano. We also find the examiner's reasoning as to the obviousness of sending configuration information to be essentially un rebutted by appellants with respect to the specific reasons offered by the examiner.

In summary, in view of the breadth of claim 9, the teachings of Yano, and the relative persuasiveness of the arguments presented by appellants and the examiner, we conclude that the invention as broadly recited in claim 9 would have been obvious to the artisan in view of the evidence before us. Even though we sustain the examiner's rejection of claim 9 for slightly

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different reasons than those advanced by the examiner, our position is still based upon the complete teachings of the reference and does not constitute a new ground of rejection. Note In re Bush, 296 F.2d 491, 496, 131 USPQ 263, 267 (CCPA 1961); In re Boyer, 363 F.2d 455, 458 n.2, 150 USPQ 441, 442 n.2 (CCPA 1966). Since claim 10 has not been separately argued by appellants, we also sustain the rejection of claim 10 for all the reasons discussed above.

With respect to claim 11, appellants argue that the claimed invention is not obvious over the user display of Yano, and that the selection and exercise of the components located within a peripheral device is not suggested by Yano [brief, pages 11-12]. However, Yano discloses that the single computer 31 is "connected to monitor the parameters of and control all of the copying machines 12, 13, 14 and 16 through the bus lines 19, 21 and 22" [column 4, lines 47-49]. The artisan would have recognized that Yano suggests monitoring any component within any of the copiers including any peripheral devices attached to the copiers. The artisan also would have appreciated that controlling all of the copying machines as disclosed by Yano suggests the selection and exercise of such components as claimed. Therefore, we conclude

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that the invention as set forth in claim 11 would have been obvious to one having ordinary skill in the art in view of Yano.

With respect to claim 16, appellants note that the claim recites data records representative of components and that the specification describes such records as including the name and type of components within the subsystem. As we noted above with respect to claim 9, an example in the specification of a data record or the preferred embodiment of a data record will not be read into the claim. A data record is a very broad term which can include almost any information exchanged between two devices. The information exchanged between computer 31 of Yano and any of the copying machines meets the recitation of communicating data records representative of components contained within the peripheral device. Therefore, we sustain the rejection of claim 16 as unpatentable over the teachings of Yano.

With respect to claim 17, appellants argue that Yano discloses distributed copiers which does not meet the claimed recitation that the components are located within peripheral devices integrally associated with the reprographic system for receiving printed output therefrom [brief, page 12]. For reasons we discussed above relative to claim 9, the Yano teachings are considered to meet the peripheral device and reprographic system

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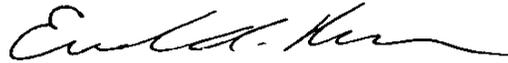
recitations as required by these claims. Appellants also argue that Yano does not disclose sensory component status data. In our view, the Yano teaching of allowing a user at any of the copying machines to determine the status of any of the other copying machines meets the claim 17 recitation of transmitting data representative of the status of a sensory component. Therefore, we also sustain the rejection of claim 17 as unpatentable over the teachings of Yano.

In summary, we have sustained all of the examiner's rejections so that the decision of the examiner rejecting claims 9-11, 16 and 17 is affirmed.

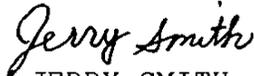
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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED



ERROL A. KRASS)
Administrative Patent Judge)



JERRY SMITH)
Administrative Patent Judge)

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MICHAEL R. FLEMING)
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