

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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** ELIZABETH B. DADDIS, C. MICHAEL RAY,  
ROBERT G. HAMER, SUSAN B. LAYER,  
REX B. MURPHY, GARY R. KERN,  
EVERETT W. JENKINS, ANNE E. DEWITTE,  
ROBERT W. RASSLER, and DAVID S. MATTHEWS

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Appeal No. 2002-1505  
Application No. 09/004,254

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ON BRIEF

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Before FLEMING, DIXON, and LEVY, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1-17, which are all of the claims pending in this application.

We REVERSE.

## BACKGROUND

The appellants' invention relates to a customer product installation/configuration. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. In an electronic image processing apparatus comprising a plurality of resources including a marking machine, a source of copy sheets, and a controller, a method of determining the configuration of the plurality of resources comprising the steps of:

running turn around tests to determine the interconnection of the resources,

comparing the determined interconnection to a reference interconnection stored in memory,

displaying the difference of interconnections between the reference and the determined interconnections,

confirming the difference and loading the determined interconnection into memory, and

setting up the machine based upon the determined interconnection.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Fukui et al. (Fukui)

5,678,135

Oct. 14, 1997

Claims 1-17 stand rejected under 35 U.S.C. § 102 as being anticipated by Fukui.

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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. 9, mailed Jun. 13, 2001) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 7, filed Feb. 6, 2001) and reply brief (Paper No. 10, filed Aug. 16, 2001) 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 reference, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

### 35 U.S.C. § 102

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. **See Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), **cert. denied**, 465 U.S. 1026 (1984).

It is well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office (PTO). **See In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Appellants argue that the examiner has not set forth a *prima facie* case of anticipation since Fukui does not teach the

claimed confirmation step as recited in each of the independent claims. (See brief at pages 4-5.) In our view, we agree that the examiner has not set forth a ***prima facie*** case of anticipation. The examiner maintains that Fukui discloses that the “differences between the determined and reference interconnections are confirmed and loaded into the RAM . . . (column 18, lines 51-56).” We do not find that this specific portion teaches the confirmation of the configuration as maintained by the examiner and the examiner has not identified any other teaching in Fukui to teach this limitation. Since the examiner has not met the initial burden of establishing a ***prima facie*** case of anticipation, we will not sustain the rejection of independent claims 1 and 11 and their respective dependent claims.

Alternatively, the examiner maintains that with respect to claims 8 and 10 “that confirming the difference step is performed by an operator (column 14, lines 48-52).” Appellants argue that the referenced portion of Fukui simply indicates that when a function is added to a copier, an operator accesses an added function via the display panel. (See brief at page 5.) We agree with appellants, and we do not find that the examiner has shown where Fukui teaches this limitation. Since the examiner has not met the initial burden of establishing a ***prima facie*** case of anticipation, we will not sustain the rejection of independent claims 8 and 10 and their dependent claims.

## CONCLUSION

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To summarize, the decision of the examiner to reject claims 1-17 under  
35 U.S.C. § 102 is reversed.

REVERSED

MICHAEL R. FLEMING	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
JOSEPH L. DIXON	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
STUART S. LEVY	)	
Administrative Patent Judge	)	

JD/rwk

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