

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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* FRANCIS A. FERREIRO

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Appeal No. 2002-2034  
Application No. 09/175,080

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ON BRIEF

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Before SCHAFER, LEE, and MOORE, *Administrative Patent Judges*.  
MOORE, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1-2, 4-9, 11-16, and 18-25. Claims 3, 10, and 17 are said to be allowable if rewritten in independent form.<sup>1</sup> Thus, only claims 1-2, 4-9, 11-16, and 18-25 are before us on this appeal.

REPRESENTATIVE CLAIM

The appellant has indicated (Brief, page 4) that, for the purposes of this appeal, claims 1-7 will stand or fall together,

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<sup>1</sup> Although a rejection appears to be repeated and applied to these claims, the examiner has stated them to be allowable (Examiner's Answer, page 2). We shall therefore direct no analysis towards these claims other than to observe that the rejection should have been updated to reflect the allowable claims.

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claims 8-14 will stand or fall together, and claims 15-25 will stand or fall together. Consistent with this indication, the appellant has made no separate arguments with respect to the remaining claims.

Accordingly, the dependent claims will stand or fall together with their independent claims, and we will select claims 1, 8, and 15, the independent claims as representative of all of the claims on appeal. See 37 CFR 1.192(c)(7). Note also In re Dance, 160 F.3d 1339, 1340 n.2, 48 USPQ2d 1635, 1636 n.2 (Fed. Cir. 1998); In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

Claim 1, 8, and 15 read as follows:

1. An image information transmitting method in a facsimile machine, comprising the steps of:  
pre-programming a dialing group of predetermined destinations in said facsimile machine;  
storing said pre-programmed dialing group of predetermined destinations in said facsimile machine;  
detecting the presence of a document in said facsimile machine;  
automatically selecting switches for accessing said pre-programmed dialing group of predetermined destinations;  
automatically selecting a switch for manually entering an additional destination desired by said user;  
automatically releasing said switches for accessing said pre-programmed dialing group of predetermined destinations;  
entering said additional destination desired by said user;  
following said step of entering said additional destination, automatically transmitting image information from said document to each of said predetermined destinations of said pre-programmed dialing group; and  
transmitting said image information from said document to said additional destination desired by said user.

8. A system for transmitting image information, comprising:  
a user interface for manually entering a dialing group of predetermined destinations in said facsimile machine;

a memory operable to store said dialing group of predetermined destinations;

a circuit operable to detect said document, automatically select switches to access said pre-programmed dialing group of predetermined destinations, and automatically select a switch that allows a user to manually enter an additional destination;

a user interface to manually enter said additional destination desired by said user; and

a transmitting device for automatically transmitting said image information to each said predetermined destination in said pre-programmed dialing group; said transmitting device also used to transmit said image information to the manually entered destination desired by said user whereby the transmitting device transmits said image information to each predetermined destination in said pre-programmed dialing group and to the manually entered destination in a single operation.

15. A dialing group selection circuit operable to detect a document placed in a facsimile machine, automatically start a pre-programmed dialing group of predetermined destinations, and automatically select a switch that allows a user to manually enter an additional destination comprising:

a detecting circuit operable to detect a document placed in a receiving aperture of said facsimile machine;

a sequential switching circuit operable to receive an electrical reset signal from said detecting circuit, said sequential switching circuit further operable to automatically activate a single-button dialer associated with a pre-programmed dialing group of predetermined destinations; and

an oscillator circuit operable to receive a reset signal from said detecting circuit causing the timer<sup>2</sup> to begin running, said oscillator circuit further operable to electrically drive said sequential switching circuit;

whereby, after said single-button dialer is activated, a user is prompted to manually enter an additional desired destination, and the transmitting device transmits said image information to each predetermined destination in said pre-programmed dialing group and to the manually entered destination in a single

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<sup>2</sup> This term appears to lack antecedent basis. In the event of further prosecution on the merits, the examiner and the appellant should address this issue.



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of entering the additional destination, automatically transmitting image information from the document to each of the preprogrammed destinations, and transmitting the image information from the document to the additional destination. (Examiner's Answer, page 3, line 14, page 4, line 11) (citations omitted).

The examiner has additionally found that, for claim 8, Fukushima describes a system for transmitting image information including a user interface for manually entering a dialing group of predetermined destinations, a memory operable to store the dialing group, a circuit operable to detect a document and to automatically select switches to access the preprogrammed dialing group of predetermined destinations and a switch that allows a user to manually enter an additional destination, whereby the image information is transmitted in a single operation.

(Examiner's Answer, page 6, lines 1-17) (citations omitted).

Finally, for claim 15, the examiner has found that Fukushima describes a dialing group selection circuit operable to detect a document placed in a facsimile machine, start a pre-programmed group of predetermined destinations, and automatically select a switch that allows a user to manually enter an additional destination. Fukushima is further said to describe a detecting circuit to detect a document, a switching circuit to receive a reset signal and automatically activate a single button dialer

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associated with a group of destinations, and an oscillator circuit operable to receive a reset signal from the detecting circuit to cause a timer to begin running. The oscillator circuit drives the sequential switching circuit whereby after the single button group dialer is activated a user is prompted to manually enter an additional desired destination and the facsimile machine transmits the image in a single operation. (Examiner's Answer, page 8, line 5 - page 9, line 3) (citations omitted).

The appellant does not directly challenge these factual findings of the examiner. Rather, the appellant asserts that the rejection is defective in that the claimed invention requires all of the destinations (including automatic dialing groups and additional destinations) are entered before any of the facsimile messages are sent. (Appeal Brief, page 4, last 3 lines for claim 1; page 5, lines 1-7 for claim 8; page 5, lines 8-11 for claim 15) (emphasis added).

Fukushima, it is argued, discloses a different order of steps, wherein the fax machine sends the fax to the predetermined dialing group, then the user enters additional destinations, and the machine then sends the fax to the additional destinations. (Id., page 6, line 5 - page 7, line 3). Consequently, it is urged, Fukushima cannot anticipate the instant claims.

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The examiner, in reply, states that by pressing the interrupt key 43, a user may enter additional destinations and then send the facsimile to the preprogrammed destinations as well as any additional destinations in a single operation (Examiner's Answer, page 11, line 3 - page 12, line 11).

In the counter position, the appellant notes that it is not pertinent as to whether the facsimile messages are all sent at the same time, but whether the recited sequence of entering addresses and sending the messages is taught by Fukushima (Appeal Brief, page 8, lines 5-9).

It is by now well-understood that it is applicants' claims which define the subject matter for which they seek protection. United Carbon Co. v. Binney & Smith Co., 317 U.S. 228, 232, 55 USPQ 381, 383-384 (1942) (citing General Electric Co. v. Wabash Appliance Corp., 304 U.S. 364, 369, 37 USPQ 466, 468-469 (1938); In re Zletz, 893 F.2d 319, 321, 322, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); SRI Int'l. v. Matsushita Elec. Corp., 775 F.2d 1107, 1121, 227 USPQ 577, 586 (Fed. Cir. 1985). Thus, we begin our review by determining what is the scope and content of appellant's claims here on appeal.

The appellant argues that the claims recite a particular order of steps. We note that this is only true when such order is expressly recited or required, for example by the use of the word

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"following" or where the context of the claim makes it a necessity.

For claim 1, it is required that "image information" be "automatically transmitted" to "each of said predetermined destinations" and "said additional destination" "following said step of entering said additional destination." We therefore agree with the appellant that the image information transfer must occur to all of the destinations "each" after the entry of the pre-programmed dialing group and an additional destination, at least for claim 1.

The question raised for review, presented squarely, is whether the following passage (column 3, line 65 - column 4, line 10) anticipates the transmission order parameters of the claim:

FIG. 2 is a plan view of the operation panel 35 in FIG. 1. In the diagram, the operation panel comprises a ten-key group 40 for entering [the] telephone number or the like of a destination, a display portion 41 for displaying instructions of operation procedure, destination telephone number or the like, a transmission key 42 for giving an instruction of transmission start after an original is set or destinations are specified, an interruption key 43 for giving an instruction of additional destinations for the broadcast transmission, a broadcast transmission key 44 for effecting a broadcast transmission, and a non-transmission key 45 for giving an instruction not to transmit image data of a predetermined area.

While the Fukushima reference clearly teaches all of the pertinent steps of the claimed invention, and we agree with the examiner that the "prescribed sequence of actions in Fukushima is

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fundamentally the same and consistent with the [claimed] invention" (Examiner's Answer, page 12, lines 12-13), we disagree with the examiner's conclusion of anticipation by the above quoted passage.

As set forth in Gechter v. Davidson, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997), "[u]nder 35 U.S.C. § 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim." "Every element of the claimed invention must be literally present, arranged as in the claim." Richardson v. Suzuki Motor Co., Ltd., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Although Fukushima describes an interrupt key 43 to enter additional destinations and a user may then send out the transmission to the recipients, this description does not clearly describe the claimed sequence of steps. Depending on when the interrupt button is pushed, and whether transmission has commenced, one may or may not end up with the invention of claim 1. We therefore conclude that this disclosure is insufficient to anticipate the claimed invention. Consequently, we are constrained to reverse this rejection.

However, we remand this application to the jurisdiction of the examiner to consider whether an additional rejection founded on 35 U.S.C. § 103 should be applied to claim 1 and the claims

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which depend therefrom. We decline to exercise our authority under 37 CFR § 1.196(b) as, on this record. The issue of whether this disclosure may render the claimed invention, as interpreted above, obvious within the meaning of 35 U.S.C. § 103 has not been fully developed and would benefit from further prosecution on the merits.

Turning now to claim 8, we note that the term "following" is absent from the claim. Rather, the claim requires that the send operation be completed as a "single operation." The appellant interprets this as requiring that all of the destinations are entered before any of the facsimile messages are sent. We disagree with the appellant's narrow interpretation of claim 8. In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. In re Yamamoto, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984).

Here, unlike claim 1, there is no requirement that all the transmissions to each individual destination occur after the entry of the additional destinations. Thus, we agree with the examiner that the provision of the interrupt button by Fukushima anticipates the subject matter of claim 8 and we shall affirm this portion of the rejection.

Claim 15 is similar to claim 8, in that the transmission

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operation and additional destination entry must occur after the single button dialer is activated, but as between the two, no particular order is specified. Consequently, the operation of the interrupt button 43 in Fukushima, regardless of when it is pushed during the transmission operation, acts to anticipate claim 15. Accordingly, we shall affirm this portion of the rejection.

Summary of Decision

The rejection of claims 1-6 under 35 U.S.C. § 102(e) over Fukushima is reversed.

The rejection of claims 8-9, 11-16, and 18-25 under 35 U.S.C. § 102(e) over Fukushima is sustained.

APPROPRIATE ACTION

Accordingly, the subject application is being returned to the jurisdiction of the examiner, via the office of a Director of the Technology Center involved, for consideration of whether claims 1-6 (and any additional claims) are rendered obvious within the meaning of 35 U.S.C. § 103 by the disclosure of Fukushima.

This application, by virtue of its "special" status, requires an immediate action. Manual of Patent Examining Procedure § 708.01 (7th ed., rev. 1, February 2000). It is important that the Board be informed promptly of any action affecting the appeal in this case.

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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-IN-PART**

**REMANDED**

JAMESON LEE	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
SALLY G. LANE	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JAMES T. MOORE	)	
Administrative Patent Judge	)	

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