

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DAVID A. KUMPF, GLENN R. GARCIA, and DAVID L. SMITH

Appeal No. 2003-0048
Application No. 09/163,787

ON BRIEF

Before THOMAS, HAIRSTON, and BARRY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claims 1-12. The appellants appeal therefrom under 35 U.S.C. § 134(a). We reverse.

BACKGROUND

The invention at issue on appeal enables a client to discover servers on a computer network. In a computer network servers initiate connections with peripherals, which perform functions such as scanning. According to the appellants, multifunction peripherals combine scanning with other functions such as printing, exchanging

facsimiles, and copying. A user needing to scan must learn which servers, if any, can establish a connection with a peripheral that can scan. (Spec. at 1.)

Accordingly, the appellants' invention enables servers on a network to advertise a basic function of printing. Clients seeking peripherals offering the additional function of scanning retrieve ID strings of peripherals having the basic function to learn if the additional function is available. (Paper No. 7 at 5.)

A further understanding of the invention can be achieved by reading the following claim.

1. A network client peripheral server discovery method for a client to discover peripheral servers having peripherals with an additional function in addition to peripherals with a basic function, the method comprising steps of:

announcing, by servers on the network, that they have peripherals having the basic function;

searching, by a client on the network, for announcements by servers having the basic function;

forming, by the client, a list of servers having peripherals having the basic function based upon announcements discovered in said step of searching;

retrieving, by the client, data including that which specifies whether the peripheral has the additional function from servers on the list of servers having peripherals; and

identifying, by the client, peripherals having the additional function by examining data retrieved in said step of retrieving from the list of servers.

Claims 1-12 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,101,528 ("Butt") and U.S. Patent No. 5,933,580 ("Uda").

OPINION

Rather than reiterate the positions of the examiner or the appellants *in toto*, we address the main point of contention therebetween. The examiner asserts, "Butt discloses the client checks (ie. [sic] retrieves) from the registration lists (ie. [sic] data including that which specifies whether the servers have additional functions from servers on the list of servers having peripherals) [Butt, col. 4, lines 30-55], a second registration function list and identifying, by the client, peripherals having the functions by examining data retrieved in the step of retrieving from the list of servers [Butt, col. 5, lines 11-42 and col. 5, line 64 - col. 6, line 4]." (Examiner's Answer at 7.) He admits, however, that "Butt does not specifically disclose an additional function in addition to peripherals with a basic function." (*Id.*) The appellants argue, "Butt totally fails to teach or suggest the retrieving and identifying steps . . . , and Uda et al. fails to supply the deficiency." (Appeal Br. at 9.)

In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the independent claims at issue to determine their scope. Second, we determine whether the construed claims would have been obvious.

1. CLAIM CONSTRUCTION

"Analysis begins with a key legal question -- *what is the invention claimed?*" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "the Board must give claims their broadest reasonable construction. . . ." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000).

Here, claim 1 recites in pertinent part the following limitations: "forming, by the client, a list of servers having peripherals having the basic function based upon announcements discovered in said step of searching; retrieving, by the client, data including that which specifies whether the peripheral has the additional function from servers on the list of servers having peripherals; and identifying, by the client, peripherals having the additional function by examining data retrieved in said step of retrieving from the list of servers." Claim 6 includes similar limitations. Giving the independent claims their broadest, reasonable construction, the limitations require that a client form a list of servers connected to peripherals performing a basic function,

retrieve from the list data specifying whether a peripheral performs an additional function, and examine the retrieved data to identify peripherals performing the additional function.

2. OBVIOUSNESS DETERMINATION

Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious. "In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would . . . have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, the examiner has not shown that the combination of Butts and Uda would have suggested that a client retrieve, from a list of servers connected to peripherals performing a basic function, data specifying whether a peripheral performs an additional function or that the client examine the retrieved data to identify peripherals performing

the additional function. As aforementioned, the examiner relies on three passages of Butts. He asserts that the first passage "discloses the client checks (ie. [sic] retrieves) from the registration lists. . . ." (Examiner's Answer at 7.) The passage, however, merely mentions that a "client discovery service 20 includes a first registration function 52 for registering the discovery callback procedures of client applications 18. . . ." Col. 4, ll. 32-24. The examiner asserts that the second and third passages teach "identifying, by the client, peripherals having the functions by examining data retrieved in the step of retrieving from the list of servers. . . ." (Examiner's Answer at 7.) The second passage, however, merely describes the components of a "discovery response packet 100. . . ." Col. 5, ll. 11-12. For its part, the third passage merely discloses that a "server application 24a/24b calls second registration function 58 to register itself with server discovery services 26a/ 26b. . . ." Col. 5, ll. 65-67. "As part of the registration process, server application 24a/ 24b provides at least its identifier, the socket or port through which a client application should conduct subsequent communication, and the maximum datagram size." Col. 5, l. 67 - col. 6, l. 4.

Agreeing with the appellants that "*Uda et al. has nothing at all to do with the discovery of peripheral servers,*" (Appeal Br. at 9), we are not persuaded that the addition of the reference cures the aforementioned deficiency of Butts. Absent a teaching or suggestion that a client form a list of servers connected to peripherals

performing a basic function, retrieve from the list data specifying whether a peripheral performs an additional function, and examine the retrieved data to identify peripherals performing the additional function, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the obviousness rejection of claim 1; of claims 2-5, 11, and 12, which depend therefrom; of claim 6; and of claims 7-10, which depend therefrom.

CONCLUSION

In summary, the rejection of claims 1-12 under § 103(a) is reversed.

REVERSED

JAMES D. THOMAS
Administrative Patent Judge

KENNETH W. HAIRSTON
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)

Appeal No. 2003-0048
Application No. 09/163,787

Page 9

HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400