

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. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

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BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** JUNICHI IIZUKA and TASUKU HAYAKAWA

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Appeal No. 2004-1680  
Application No. 09/122,741

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Heard: February 8, 2005

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Before DIXON, BLANKENSHIP, and SAADAT, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1-26, which are all of the claims pending in this application.

We REVERSE.

## BACKGROUND

Appellants' invention relates to an information processing apparatus, mode control method and storage medium. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. An information processing apparatus adapted to be coupled to a printer, said information processing apparatus having a power save mode in which a power of the information processing apparatus is ON but a power consumption thereof is reduced, and comprising:

a spool which stores print data to be transferred to the printer; and

a controller which monitors a state of said spool and when the state becomes a state where a transition of said information processing apparatus to the power save mode is to be made, the transition of said information processing apparatus to the power save mode is prohibited if the print data is stored in said spool.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Pearce et al. (Pearce)	5,617,572	Apr. 1, 1997
Maeda (Japanese patent)	JP-09044324	Feb. 14, 1997

Claims 1-26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Maeda in view of Pearce.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's

Appeal No. 2004-1680  
Application No. 09/122,741

answer (Paper No. 28, mailed Feb. 10, 2004) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 26, filed Nov. 25, 2003) and reply brief (Paper No. 30, filed Apr. 7, 2004) 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 references, 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. § 103

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as

Appeal No. 2004-1680  
Application No. 09/122,741

shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the examiner can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.'" **In re Lee**,

Appeal No. 2004-1680  
Application No. 09/122,741

277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, 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). Therefore, we look to the language of independent claim 1. Appellants argued at oral hearing that Maeda teaches that the printer is placed in a power saving mode (Maeda at page 21) and that the claimed invention "monitors a state of said spool and when the state becomes a state where a transition of said information processing apparatus to the power save mode is to be made, the transition of said information processing apparatus to the power save mode is prohibited if the print data is stored in said spool." Therefore, Maeda does not teach or suggest the control of the power saving mode of the information processing system, but only the power saving of the printer. The examiner

acknowledges this difference at page 3 of the answer, but maintains that Pearce teaches and suggests the use of a controller that prohibits a transition of the information processing apparatus to the power save mode if the activity of the memory is occurring. (See answer at page 3, Pearce at Column 5.) We disagree with the examiner and find that Pearce teaches:

Responsive to detection by the PMU **18** of an I/O activity interrupt from the generator **15**, the ASV is set to BUSY, to indicate the occurrence of I/O activity during the period, the PSV is set to 0 and the device is caused to operate in FULL POWER mode, corresponding to PSV=0. Upon the expiration of the current period, as indicated by the timer's **19** generating a periodic timer interrupt to the PMU **18**, the state of the ASV is checked. If the ASV is set to BUSY, indicating that I/O activity occurred during the previous period, the value of PSV and the power consumption mode of the device **16** remain unchanged and the ASV is set to IDLE. Alternatively, if the ASV is set to IDLE, indicating that there has been no I/O activity during the previous period, the PSV is checked to determine the power consumption mode of the device and, if the device is not already in its lowest reduced power consumption mode, (i.e., if the PSV is not set to its maximum value), the PSV is incremented and the device is caused to operate in its next lowest reduced power consumption mode, that is, the mode corresponding to the incremented value of the PSV. (Emphasis added.) (Pearce at column 5, lines 34-53.)

Pearce similarly teaches at column 3, lines 3-17 that:

Upon the expiration of the associated timer, as indicated by the generation of a periodic timer interrupt to the microcontroller, the state of the ASV is checked. If the ASV is set to BUSY, indicating that I/O activity occurred during the previous period, the device remains in FULL POWER mode, as it is apparently active. Alternatively, if the ASV is set to IDLE, indicating that there was no I/O activity during the period, the PSV is checked to determine the mode of operation of the device and, if the device is not already in its lowest reduced power mode, the PSV is incremented and the device is caused to operate in its next lowest

Appeal No. 2004-1680  
Application No. 09/122,741

reduced power consumption mode, as indicated by the incremented value of the PSV. In addition, regardless of the states of the ASV and PSV, the internal flag of the interrupt generator associated with the I/O device is reset. (Emphasis added.)

Based on these teachings, we cannot find that Pearce teaches or fairly suggests “controller which monitors a state of said spool and when the state becomes a state where a transition of said information processing apparatus to the power save mode is to be made, the transition of said information processing apparatus to the power save mode is prohibited if the print data is stored in said spool.” Pearce only teaches that during the period there was activity and not that there is print data stored in the spool at that time the information processing system is to transition to power save mode. Therefore, we find that the examiner has not established a *prima facie* case of obviousness. Therefore, we will not sustain the rejection of independent claim 1 and dependent claims 2-4 and 8 which depend therefrom. We find similar limitations in each of independent claims 5, 9, 13, 17, 21 and 25 which the examiner has not shown are taught or fairly suggested by the combination of Maeda and Pearce. Therefore, we cannot sustain the rejection of these claims and those that depend therefrom.

Appeal No. 2004-1680  
Application No. 09/122,741

**CONCLUSION**

To summarize, the decision of the examiner to reject claims 1-26 under 35 U.S.C. § 103 is reversed.

**REVERSED**

JOSEPH L. DIXON	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
HOWARD B. BLANKENSHIP	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
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MAHSHID D. SAADAT	)	
Administrative Patent Judge	)	

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Appeal No. 2004-1680  
Application No. 09/122,741

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