

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex Parte KENDRA L. DUNLAP and MARK M. JOSEPHSEN

Appeal No. 2006-3067
Application No. 09/952,953

ON BRIEF

Before KRASS, JERRY SMITH and BARRY, 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 21-36, which constitute all the claims pending in this application.

The disclosed invention pertains to a method and apparatus for displaying on a multi-function printing device overlapping first and second menus. The first menu could include send and copy options. The second menu could include email, fax and/or save options if the send option is selected from the first menu or number of copies, scale and/or contrast options if the copy option is selected from the first menu.

Representative claim 21 is reproduced as follows:

21. A multi-function printing device, comprising:
- a scanner;
 - a printer;
 - an interface enabling communication with other devices;
 - a control panel enabling user input to the device and including a display;
 - a processor and associated memory, the processor operatively coupled to the scanner, printer, interface and control panel and the memory having programming thereon that when executed by the processor causes the control panel to display a first menu that includes one or more of user selectable send and copy options,
 - in response to a selection of a send option from the first menu, display a second menu that includes one or more of user selectable email, fax and save options, the second menu overlapping the first menu such that all of the second menu and only a portion of the first menu are visible, and
 - in response to a selection of a copy option from the first menu, display a second menu that includes one or more of user selectable number of copies, scale and contrast options, the second menu overlapping the first menu such that all of the second menu and only a portion of the first menu are visible.

The examiner relies on the following references:

Inoue et al. (Inoue)	5,159,546	Oct. 27, 1992
Barrett et al. (Barrett)	5,880,727	Mar. 09, 1999
Nomura et al. (Nomura)	6,421,509	July 16, 2002 (filed Nov. 22, 2002)

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The admitted prior art described in appellants' specification.

Claims 21-36 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers the admitted prior art in view of Nomura and Inoue with respect to claims 21-23,

25-28, 30-33, 35, and 36, and Barrett is added to this combination with respect to claims 24, 29, and 34.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the 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 the claims on appeal. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343, 61 USPQ2d at 1433-34. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in

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the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000)). See also In re Thrift, 298 F.3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See id.; 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). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

We consider first the rejection of claims 21-23, 25-28, 30-33, 35, and 36 based on the admitted prior art, Nomura, and Inoue. The examiner has explained how the invention of these claims is deemed to be rendered obvious by the collective teachings of the applied prior art [answer, pages 3-5]. Since appellants have argued all of these claims as a single group, we will consider this rejection with respect to independent

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claim 21 as representative of all the claims subject to this rejection. Appellants argue that although they have acknowledged that multifunction printing devices were known in the art, that send and copy options have been displayed on such devices through scrolling menus, and that overlapping menus in general are old, the examiner has failed to make specific factual findings with respect to the motivation to combine the applied references. Appellants argue that neither Nomura nor Inoue say anything about the use of overlapping menus for the diverging menu trees needed in a multifunction device. They assert that neither reference teaches the claimed second menus being displayed in response to a send or copy option. Appellants argue that although Inoue teaches the benefits of overlapping menus in general, this is insufficient to support the rejection because Inoue does not contemplate the circumstance in which overlapping menus could or should be used for diverging menu trees such as recited in the claimed invention [brief, pages 5-7].

The examiner responds that appellants are attacking references for teachings that they are not being relied on. The examiner notes that Inoue was cited only for its teaching of displaying menus in an overlapping manner. The examiner also asserts that this overlapping display would replace the display of the menu trees of the admitted prior art. The examiner notes that navigation through the menu trees of the admitted prior art would be improved through the use of Inoue's overlapping menus for reasons taught by Inoue [answer, pages 6-8].

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Appellants respond that the examiner has merely attempted to show that each of the differences between the claimed invention and the prior art would have been individually obvious rather than considering the claimed invention as a whole. Appellants essentially argue that it was error by the examiner to conclude, after arriving at the first combination of references based on a first advantage, that it would have been obvious to add a third reference based on a second advantage, and then add a fourth reference to gain a third advantage. Appellants assert that there must be a motivation for the overall combination, not just for each succeeding combination [reply brief, pages 1-4].

We will sustain the examiner's rejection of claims 21-23, 25-28, 30-33, 35 and 36. We are not persuaded by appellants' argument that the rejection fails to consider the claimed invention as a whole. We are also of the view that the applied references teach more than the examiner has relied on. For example, Nomura appears to teach everything for which the admitted prior art is relied on. Specifically, Nomura teaches a combination scanner and printer with an interface and control panel. Nomura displays a first menu between the display portions 701 and 801 that includes the user selectable options "send" (print or fax) and "copy." Selection of the "copy" function results in a second menu display 801 having at least a scale function (copy ratio), while selection of the "print" or "fax" functions results in a second display menu 802 having at least email and fax functions. Although second menus 801 and 802 partially overlap each other [see Figures 5, 7, and 9-12], they do not partially overlap the copy and print buttons of

the first menu. Inoue specifically teaches that overlapping displays can be advantageous for displaying a larger amount of information in the same display area. Thus, as noted by the examiner, the artisan would have been motivated to use overlapping menu areas in Nomura so that the size of the control panel could be reduced. Appellants' argument that Inoue's teaching of the general advantages of overlapping menus does not recognize the problem of diverging menu trees is not persuasive. The test for obviousness is whether the references would have suggested doing what appellants have done. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Thus, the absence of express suggestion or motivation in the applied prior art is not alone determinative. The prior art need not suggest solving the same problem set forth by appellants. In re Dillon, 919 F.2d 688, 692-693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (in banc) (overruling in part In re Wright, 848 F.2d 1216, 1220, 6 USPQ2d 1959, 1962 (Fed. Cir. 1988)). Thus, the advantage of overlapping menus as taught by Inoue is enough to support the combination of this teaching with the plural menus displayed in Nomura. Appellants have indicated in the specification that the overlapping of displays was an improvement on the display of the diverging menu trees of the admitted prior art. Even if Inoue teaches the use of overlapping displays for a different reason, it still renders the claimed invention obvious as long as the advantages taught by Inoue apply to the display of Nomura as well. As noted above, we find that it does.

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We now consider the rejection of claims 24, 29, and 34 based on the admitted prior art, Nomura, Inoue, and Barrett. The examiner has explained how the invention of these claims is deemed to be rendered obvious by the collective teachings of the applied prior art [answer, pages 5-6]. We have considered the examiner's explanation of this rejection, and we find that the examiner has at least established a prima facie case of obviousness. Appellants have made no separate arguments with respect to this rejection. Since the examiner has established a prima facie case of obviousness with respect to these claims, and since appellants have made no persuasive arguments in rebuttal, we will sustain the examiner's rejection of claims 24, 29, and 34.

In summary, we have sustained each of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 21-36 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)(1)(iv).

AFFIRMED

ERROL A. KRASS)
Administrative Patent Judge)
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JERRY SMITH) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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LANCE LEONARD BARRY)
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