

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT D. CHRISTIANSEN and PATRICK O. SANDFORT

Appeal 2007-3116
Application 10/104,922
Technology Center 2600

Decided: December 12, 2007

Before JOSEPH F. RUGGIERO, ROBERT E. NAPPI, and
KEVIN F. TURNER, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1-3, 5-13 and 15-17. We have jurisdiction under 35 U.S.C. § 6(b).

Appellants disclose methods and programs implementing those methods for determining a unique identifier of an imaging device. The methods include changing an operating condition of the imaging device and determining, from a presented list, which nearby device changed that operating condition. Subsequently, a document is printed on the selected imaging device. (Specification 1: [0001]).

The independent claim 1, which is deemed to be representative, reads as follows:

1. A method for detecting an imaging device proximity, comprising the steps of:
 - using a mobile device to interact with a network list of imaging devices;
 - changing a variable operating condition of a desired imaging device by activating an on/off button on said desired imaging device;
 - using said mobile device to determine which imaging device on said list changed said variable operating condition;
 - uploading, by said imaging device, of a unique identifier of said imaging device to said mobile device; and
 - printing a document on said imaging device.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Haartsen	US 6,519,460 B1	Feb. 11, 2003
Plasson	US 6,795,688 B1	Sep. 21, 2004

The Examiner rejected claims 1-3, 5-13, and 15-17 under 35 U.S.C. § 103(a) as being unpatentable over Plasson and Haartsen. Appellants have argued that identical limitations in independent claims 1 and 11 are not taught or suggested by the cited prior art references, (Br. 7-9), and we take independent claim 1 as representative of all of the pending claims.

Appellants contend that the Examiner erred in indicating that the claimed subject matter would have been obvious. More specifically, Appellants have argued that Plasson and Haartsen, together or separately,

fail to teach or suggest “changing a variable operating condition of a desired imaging device by activating an on/off button on said desired imaging device,” as recited in claim 1. (Br. 8-9). The Examiner finds that Plasson teaches that devices in proximity of the network are detected, including their power conditions, where a user can change the power state of the devices and that inherently includes a user pressing an on/off button on the device. (Answer 7-12).

We affirm.

ISSUE

Have Appellants shown that the Examiner erred in establishing that the combination of the cited references teaches or suggests all of the disputed elements of independent claim 1?

FINDINGS OF FACT

1. The application provides the steps of using a mobile device to interact a network list of imaging devices and having the user operate a key on a desired imaging device in order to change a variable of the desired imaging device. The mobile device is then used to interact with the network list to determine which imaging device has changed that variable and having the user select the desired imaging device listed on the mobile device. Thereafter, a unique identifier is downloaded from the desired imaging device to the mobile device and the mobile device downloads to the desired imaging device the information to be printed. (Specification 4: [0011]; Figs. 1A and 1B, elements 4, 6, 8, 12, 14 and 16).

2. Claim 1 recites, in part, “changing a variable operating condition of a desired imaging device by activating an on/off button on said desired

imaging device.” The Specification makes clear that “[t]his activation may cause the imaging device to go from the on-state to the off-state or vice versa.” (Specification 4: [0013]).

3. Plasson discloses a system that dynamically configures a device coupled in a wireless personal area network, with an attribute corresponding to a characteristic of the device. The device can be a personal data assistant that supports point-to-point and point-to-multipoint connections, where those connections can be with printers. When a printer is detected, the device uses the address for the printer to determine the nature of the location and selects the appropriate mode of operation. The process for identifying the printer, and for selecting and implementing the appropriate configuration, can occur automatically, or the user selects the mode of operation to be activated and initiates the change in configuration manually. (Abstract; col. 1, l. 21; col. 8, ll. 6-7; col. 10, l. 45; col. 13, ll. 10-28).

4. The configuration, in Plasson, can include modes of operation including discoverable, connectable and paired and can also include security settings, power levels and settings for applications. The power modes include standby, page, inquiry, sniff, hold and park. Additionally, the personal area network may be moving, or have moved to another location within proximity of a printer, or one of these printers may have moved to within proximity of the personal area network. The device operates in a mode where it can monitor for other devices that move within its range, and/or for loss of communications with other devices. (Col. 15, ll. 1-4; col. 17, ll. 53-67; TABLE 5).

5. Haartsen is directed to a method and apparatus for applying a narrow band link for low-rate and medium-rate communications, and a stationary wide band channel for high-speed communications. Haartsen discloses that a laptop can download a print job to a printer on the same piconet. (Abstract; col. 6, ll. 8-13; Figs. 4a and 4b, elements 440 and 450).

PRINCIPLES OF LAW

The Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). If that burden is met, then the burden shifts to the Appellants to overcome the *prima facie* case with argument and/or evidence. *In re Mayne*, 104 F.3d 1339, 1342 (Fed. Cir. 1997).

The analysis need not seek out precise teachings directed to the specific subject matter of the claim but can take into account the inferences and the creative steps that a person of ordinary skill in the art would employ. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). “[F]amiliar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *Id.* at 1742.

Although claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369 (Fed. Cir. 2004).

ANALYSIS

Turning first to claim 1, the limitation of claim 1 that Appellants allege is not taught by Plasson and Haartsen, namely “changing a variable operating condition of a desired imaging device by activating an on/off button on said desired imaging device,” is interpreted in light of the specification. We find that the limitation may be satisfied by turning an imaging device on by a user. (Finding of Fact 2). Plasson discloses that devices are detected when they enter into the range of personal area network. (Finding of Fact 4). Thus, if a user enters into an area where a printer is turned off, interacts with a listing of devices within the personal area network and then turns the printer on, the new printer would then appear within a network list of devices, i.e. through the monitoring of communications with other devices. (Finding of Fact 4). The mobile device would then be used to determine which listed item corresponds to the printer that was just turned on and the user could then print a document on that printer. Given this discussion of the scope of claim 1, we do not find any elements of claim 1 that could not be rendered obvious over the teachings of Plasson alone. However, the Examiner’s rejection of claim 1 is that it is obvious over Plasson and Haartsen, and we examine that rejection to determine if it was made in error.

Appellants argue that Plasson does not disclose “changing a variable operating condition of a desired imaging device by activating an on/off button on said desired imaging device,” as recited in claim 1, and particularly does not disclose the activation of the on/off button. It is clear that Plasson teaches the changing of a power mode of a printer by the user,

(Findings of Fact 3 and 4), and that is not exactly the same as activating an on/off button. While we disagree with the Examiner that the activation of an on/off button would be inherent to the disclosure of Plasson, we do find that such an activation of an on/off button would have been obvious. While some printers might not have an on/off button, it would have been generally understood that by one of ordinary skill in the art at the time the application was conceived that printers have on/off buttons. It would have been within the inferences and the creative steps of a person of ordinary skill in the art to change the power state of an imaging device through an on/off button on the device, instead of merely changing its power state manually. We find no reversible error in the rejection of claim 1.

Since we find that the activation of an on/off button of an imaging device would be obvious in view of the disclosure of Plasson, we find the Appellants' argument that Haartsen fails to disclose changing a variable operating condition of a desired imaging device by activating an on/off button on said desired imaging device to be immaterial.

CONCLUSION OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1-3, 5-13 and 15-17 and we affirm the Examiner's rejections under 35 U.S.C. § 103(a) as unpatentable over Plasson and Haartsen.

DECISION

The decision of the Examiner is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

Tdl/gw

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