

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT D. CHRISTIANSEN and PATRICK O. SANDFORT

Appeal 2007-3243
Application 10/104,924¹
Technology Center 2600

Decided: March 25, 2008

Before KENNETH W. HAIRSTON, JOSEPH F. RUGGIERO, and
SCOTT R. BOALICK, *Administrative Patent Judges*.

BOALICK, *Administrative Patent Judge*.

¹ Application filed March 21, 2002. The real party in interest is Hewlett-Packard Development Company, LP.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-19, all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellants' invention relates to a method for assuring that a selected imaging device is the desired one. (Spec. paragraph [0001].)

Claim 1 is exemplary:

1. A method of assuring proper imaging device selection, comprising the steps of:

determining a location of a desired imaging device;

interacting between a user's mobile device and an actual imaging device to determine if said actual imaging device is said desired imaging device;

downloading information to be printed from said mobile device to said desired imaging device; and

printing the information on said desired imaging device.

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

Plasson	US 6,795,688 B1	Sep. 21, 2004
Aquilon	WO 00/51293	Aug. 31, 2000

Claims 1-19 stand rejected under 35 U.S.C. § 103(a) as being obvious over Plasson and Aquilon.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Brief and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants did not make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).²

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). That is, given the teachings of the prior art, have Appellants shown that the differences between the claims and the prior art are sufficient to render the claimed subject matter unobvious to a person skilled in the art at the time the invention was made?

² Except as will be noted in this opinion, Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See* 37 C.F.R. § 41.37(c)(1)(vii).

PRINCIPLES OF LAW

All timely filed evidence and properly presented arguments are considered by the Board in resolving an obviousness issue on appeal. *See In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984).

In the examination of a patent application, the Examiner bears the initial burden of showing a *prima facie* case of unpatentability. *Id.* at 1472. When that burden is met, the burden then shifts to the applicant to rebut. *Id.*; *see also In re Harris*, 409 F.3d 1339, 1343-44 (Fed. Cir. 2005) (finding rebuttal evidence unpersuasive). If the applicant produces rebuttal evidence of adequate weight, the *prima facie* case of unpatentability is dissipated. *In re Piasecki*, 745 F.2d at 1472. Thereafter, patentability is determined in view of the entire record. *Id.* However, on appeal to the Board it is an appellant's burden to establish that the Examiner did not sustain the necessary burden and to show that the Examiner erred.

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). In *KSR*, the Supreme Court reaffirmed that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 1739.

"[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). "To

facilitate review, this analysis should be made explicit." *KSR*, 127 S. Ct. at 1741. However, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.*

During examination of a patent application, a claim is given its broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969). "[T]he words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). The "ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id.* at 1313.

ANALYSIS

Appellants contend that the Examiner erred in rejecting claims 1-19 as being obvious over Plasson and Aquilon. Reviewing the record before us, we do not agree. In particular, we find that the Appellants have not shown that the Examiner failed to make a *prima facie* showing of obviousness with respect to claims 1-19. Appellants failed to meet the burden of overcoming that *prima facie* showing.

Regarding claim 1, the Examiner correctly found that the combination of Plasson and Aquilon teaches each limitation recited. (Ans. 3-4; Plasson col. 7, ll. 48-53, col. 8, ll. 1-38; Aquilon p. 8, ll. 12-18, p. 12, l. 1 to p. 13,

1. 27 and Fig. 1.) The Examiner also articulated a rationale for combining Plasson and Aquilon. (Ans. 4, 11.)

Appellants argue that the applied references do not teach or suggest each and every claim limitation. (Br. 5-6.) In particular, Appellants contend that neither Plasson nor Aquilon addresses selecting from one of two identical printers located in front of the user. (Br. 6.) The limitation of selecting one of two identical printers in front of the user is not found in any of the claims.³ However, in support of their argument that the claim must be interpreted to include this limitation, Appellants assert that:

[o]ne of the main keys to the present invention is that if the user comes upon two identical printers, . . . the present invention allows the user to solve the problem of selecting from the two identical printers by interacting between the user's mobile device and the actual imaging device to determine if the actual imaging device is the desired imaging device and downloading information to be printed from the mobile device to the desired imaging device.

(Br. 5 (emphasis deleted).) Appellants also assert that:

the interaction required to uniquely identify and select an imaging device of the present invention requires the mobile device, the imaging device, and the user. In other words, it is not just an interaction between the two devices but also requires the user to see a unique message on the imaging device's control panel or a printed output. This is one of the key differences between the present invention and the prior art.

³ Nor do we find in the Specification an explicit teaching of selecting from one of two identical printers located in front of a user.

(Br. 5.) We do not agree.

Appellants' arguments are not commensurate with the scope of the claims, as the Examiner has pointed out (Ans. 11-12). Independent claim 1 does not recite selecting one of two identical printers in front of a user. Nor is there anything in the Specification that requires claim 1 to be interpreted as including such a limitation. In addition, claim 1 does not recite a user or any particular action to be taken by a user. Therefore, we decline Appellants' invitation to read additional limitations into the claim.

Accordingly, we conclude that Appellants have not shown that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a). Claims 2-11, which depend from claim 1, were not argued separately and fall with claim 1.

With respect to independent claim 12, Appellants repeat the same arguments discussed with respect to claim 1. (Br. 6-8.) Therefore, we will sustain the rejection of independent claim 12 for the reasons discussed with respect to claim 1. Claims 13-19, which depend from claim 12, were not argued separately and fall with claim 12.

CONCLUSION OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1-19.

DECISION

The rejection of claims 1-19 for obviousness under 35 U.S.C. § 103 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)(1)(iv).

AFFIRMED

tdl/gw

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