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EXAMINER

CHEN, HUO LONG

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SHINICHI OHNO

Appeal 2013-001585
Application 11/006,620
Technology Center 2600

Before BRUCE R. WINSOR, TERRENCE W. McMILLIN,
and KAMRAN JIVANI, *Administrative Patent Judges*.

WINSOR, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from the final rejection of claims 1–24, which constitute all the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse and institute a new ground of rejection within the provisions of 37 C.F.R. § 41.50(b).

¹ The real party in interest identified by Appellant is Canon Kabushiki Kaisha. (App. Br. 5.)

STATEMENT OF THE CASE

Appellant's disclosed invention relates to "releasing a power-saving mode in a printer connected to a network." (Spec. 1:7-8.) Claim 1, which is illustrative, reads as follows:

1. An information processing apparatus for performing a communication via a network with a print control apparatus which activates a second interface unit in response to reception of a first activation instruction through a first interface unit, said information processing apparatus comprising:

a first instruction control unit configured to transmit, via the network, upon input of a print instruction via a printer driver by a user, the first activation instruction to the print control apparatus for shifting the print control apparatus from a first power status in which no print job can be received to a second power status in which a print job can be received but cannot be processed;

a reception unit configured to receive, from the print control apparatus via the network, information indicating that the print control apparatus has activated a communication function of the second interface in response to the first activation instruction transmitted by said first instruction control unit; and

an output control unit configured to output, via the network without an instruction by the user, a print job to the print control apparatus for shifting the print control apparatus from the second power status to a third power status in which the print job can be processed and for controlling the print control apparatus to process the print job, after the reception unit receives the information from the print control apparatus,

wherein power consumed in the second power status is larger than power in the first power status and power consumed in the third power status is larger than power in the second power status.

The Examiner relies on the following prior art in rejecting the claims:

Hashimoto et al. ("Hashimoto")	US 2002/0054318 A1	May 9, 2002
Parry	US 2002/0120659 A1	Aug. 29, 2002
Yamada '268	US 2002/0134268 A1	Sept. 26, 2002
Agasaveeran et al. ("Agasaveeran")	US 6,594,709 B1	July 15, 2003
Sandfort et al. ("Sandfort")	US 2003/0179402 A1	Sept. 25, 2003
Kim	US 2004/0156074 A1	Aug. 12, 2004
Yamada '907 ²	US 6,807,907 B2	Oct. 26, 2004
Collard	US 6,813,037 B1	Nov. 2, 2004
Nakazawa	US 2005/0086332 A1	Apr. 21, 2005

Claims 1, 3, 9, 11, 17, and 19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Yamada '268, Agasaveeran, Collard, and Hashimoto. (*See* Final Act. 7–13.)

Claims 2, 10, and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Yamada '268, Agasaveeran, Collard, Hashimoto, and Parry. (*See* Final Act. 13–15.)

Claims 4, 8, 12, 16, 20, and 24 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Yamada '268, Agasaveeran, Collard, Hashimoto, and Nakazawa. (*See* Final Act. 15–18.)

² Yamada '907 is *not* relied upon by the Examiner. Appellant cites to Yamada '268 by column and line numbers. (*See, e.g.,* App. Br. 29.) However, the copy of Yamada '268 in the record has page and paragraph numbers, but has neither column nor line numbers, making Appellant's citations unclear and difficult to follow. Although Appellant offers no explanation, we believe Appellant is citing to Yamada '907, the issued patent corresponding to Yamada '268, rather than the reference relied upon by the Examiner, and we have considered the Appellant's arguments accordingly.

Claims 5, 7, 13, 15, 21, and 23 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Yamada '268, Agasaveeran, Collard, Hashimoto, and Kim. (*See* Final Act. 18–20.)

Claims 6, 14, and 22 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Yamada '268, Agasaveeran, Collard, Hashimoto, and Sandfort. (*See* Final Act. 20–22.)

Rather than repeat the arguments here, we refer to the Briefs (“App. Br.” filed Aug. 6, 2012; “Reply Br.” filed Nov. 7, 2012) for the positions of Appellant and the Final Office Action (“Final Act.” mailed Oct. 12, 2011) and Answer (“Ans.” mailed Sept. 7, 2012) for the findings and conclusions of the Examiner.

ISSUE

The dispositive issue³ presented by Appellant’s arguments is: Does the combination of Yamada '268, Agasaveeran, Collard, and Hashimoto, and, in particular, does Hashimoto, teach or suggest

information processing apparatus comprising:

a first instruction control unit configured to transmit, via the network, upon input of a print instruction via a printer driver by a user, the first activation instruction to the print control apparatus for shifting the print control apparatus from a first power status . . . to a second power status . . .[,]

a reception unit configured to receive, from the print control apparatus via the network, information indicating that the print control apparatus has activated a communication function of the second interface in response to the first activation instruction transmitted by said first instruction control unit[,] and

³ Appellant’s arguments present additional issues. Because the identified issue is dispositive of the appeal, we do not reach the additional issues.

an output control unit configured to output, via the network without an instruction by the user, a print job to the print control apparatus for shifting the print control apparatus from the second power status to a third power status in which the print job can be processed . . . ,

as recited in claim 1? In other words, does Hashimoto teach or suggest a printer driver including a printer wake-up procedure in which, upon input of a print instruction, the printer is first transitioned from a first power status to a second power status and, upon receipt of confirmation that the transition has been effected, the printer is then transitioned from the second power status to a third power status in which the print job can be executed?

ANALYSIS

The Examiner relies on Hashimoto to teach “that a recording apparatus (printer system) has multiple sleep modes (paragraph 11). The recording apparatus (printer system) is able to shift from the one sleep mode [(i.e., “first power status)] to another [(i.e., “second power status)] and then shift to a standby mode [(i.e., “third power status”)] (Fig.11).” (Final. Act. 10; *accord* Ans. 4, 6–7; *see also* Hashimoto ¶¶ 54, 89, 110–111.) Appellant contends “simply having the ability to shift from sleep level 0 [(i.e., “first power status)] to sleep level 1 [(i.e., “second power status)] and then to a stand-by mode [(i.e., “third power status”)] is not what is being claimed, but rather, a specific process for effecting the shift is what is being claimed.” (Reply Br. 4.)

Appellant’s arguments persuade us of error. We agree with the Examiner that Hashimoto teaches a printer that could respond to a printer driver that is adapted to perform a printer wake-up procedure in which, upon input of a print instruction, the printer is first transitioned from a first power

status to a second power status and upon receipt of confirmation that the transition has been effected, the printer is then transitioned from the second power status to a third power status in which the print job can be executed, (*See* Final Act. 10; Hashimoto ¶¶ 110–111, Fig. 11.) However, the Examiner points to no teaching or suggestion in Hashimoto, or in Yamada '268, Agasaveeran, or Collard, that would lead one of ordinary skill in the art to actually adapt a print driver to cause a printer to perform the recited wake-up procedure upon input of a print instruction.

Accordingly, we do not sustain the rejections of claim 1, independent claims 9 and 17, which recite similar limitations and were rejected on substantially the same bases as claim 1 (Final Act. 13), and claims 2–8, 10–16, and 18–24, which depend from claims 1, 9, and 17 respectively,

NEW GROUND OF REJECTION WITHIN 37 C.F.R. § 41.50(b)

Claims 17–24 are rejected on a new ground of rejection under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Our reviewing court has found transitory, propagating signals are not within any of the four statutory categories set forth in 35 U.S.C. § 101. Therefore, a claim directed to a transitory propagating signal is not statutory under § 101. *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007). “A transitory propagating signal . . . is not a ‘process, machine, manufacture, or composition of matter.’ [These] four categories define the explicit scope and reach of subject matter patentable under 35 U.S.C § 101; thus, such a signal cannot be patentable subject matter.” *Id.* According to U.S. Patent & Trademark Office (USPTO) guidance:

The broadest reasonable interpretation of a claim drawn to a computer readable [sic] medium . . . typically covers forms of non-transitory tangible media and transitory propagating signals per se in view of the ordinary and customary meaning of computer readable media When the broadest reasonable interpretation of a claim covers a signal per se, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter.

David J. Kappos, *Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010) (citation omitted).

Moreover, “[a] claim that covers *both* statutory and non-statutory embodiments . . . embraces subject matter that is not eligible for patent protection and therefore is directed to non-statutory subject matter,” *Manual of Patent Examining Procedure* (MPEP) § 2106(I) (9th Ed., 2014) (emphasis added) (citation omitted); *cf. In re Lintner*, 458 F.2d 1013, 1015 (CCPA 1972) (“Claims which are broad enough to read on obvious subject matter are unpatentable even though they also read on nonobvious subject matter.”).

Claim 17 recites, in pertinent part, “[a] *computer-readable medium* storing a computer-executable program used to direct an information processing apparatus” (App. Br. 50 (Claims Appendix.)) (Emphasis added.) Appellant’s Specification is silent as to the meaning of “computer-readable medium” and, therefore, does not exclude transitory media from the broadest reasonable interpretation of a “computer-readable medium.” Nor does the recitation of the medium “storing a . . . program” preclude transitory media. “[A] signal with embedded data [stores the data] . . . for data can be copied and held by a transitory recording medium, albeit temporarily, for future recovery of the embedded data.” *Ex parte Mewherter*, 107 USPQ2d 1857, 1862 (PTAB 2013) (precedential).

Therefore, we conclude the broadest reasonable interpretation of claim 17, in light of Appellant's Specification, encompasses a propagating transitory signal, which is non-statutory subject matter.

We recognize that the Examiner relies on a different claim construction. (Final Act. 13 (citing US 2005/0128515 A1, ¶ 95⁴.) However, claim construction is an issue of law that we review *de novo*. *Cordis Corp. v. Boston Scientific Corp.*, 561 F.3d 1319, 1331 (Fed. Cir. 2009). Further, the hard disk 1503 disclosed in the passage relied on by the Examiner is at most an example of a medium, and does not preclude other media, including transitory signals. Additionally, the hard disk 1503 stores an initialization program for an image processing unit 1501 (Spec. 30:21–23); we see no disclosure that it stores a “program used to direct an information processing apparatus,” as recited in claim 17.

Claims 18–24 depend from claim 17 and recite no limitation that would exclude a transitory signal; therefore claims 18–24 also encompass a non-statutory propagating transitory signal.

DECISION

The decision of the Examiner to reject claims 1–24 is reversed.

We enter a new ground of rejection for claims 17–24 under 35 U.S.C. § 101.

Section 41.50(b) provides that “[a] new ground of rejection . . . shall not be considered final for judicial review.”

⁴ Publication US 2005/0128515 A1 is the printed publication corresponding to the instant application. Paragraph 95 corresponds to the Specification at page 30, line 21 through page 31, line 2.

Section 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record.

37 C.F.R. § 41.50(b).

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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED
37 C.F.R. § 41.50(b)

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