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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/959,668	08/05/2013	Masafumi OKIGAMI	1560-0685PUS3	1072

127226 7590 11/15/2016
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EXAMINER
RILEY, MARCUS T

ART UNIT	PAPER NUMBER
2677	

NOTIFICATION DATE	DELIVERY MODE
11/15/2016	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MASAFUMI OKIGAMI and MASANORI MATSUMOTO

Appeal 2015-007199
Application 13/959,668
Technology Center 2600

Before MAHSHID D. SAADAT, JOHN A. EVANS, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

AMUNDSON, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants[1] seek our review under 35 U.S.C. § 134(a) from a final rejection of claims 1–7, i.e., all pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

The Invention

According to the Specification, the invention relates to various aspects of an information-processing or communications system in which an image-

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[1] According to Appellants, the real party in interest is Sharp Kabushiki Kaisha. Br. 1.

forming apparatus (e.g., a printer or multifunction peripheral) prints an image based on image data received from an external device (e.g., a mobile phone with a camera). Spec. 1:15–17, 2:24–3:18; Abstract.[2]

Representative Claim

Claim 1 exemplifies the subject matter of the claims under consideration and reads as follows, with italics identifying the limitation at issue in claim 1:

> 1. A communication system having a mobile terminal and an image forming apparatus that comprises a receiving section for receiving an image data from the mobile terminal and prints an image based on the received image data, wherein
>
> the image forming apparatus comprises a sending section that sends a communication address of the image forming apparatus to the mobile terminal,
>
> the image forming apparatus makes the receiving section receive an image data sent with the communication address of the image forming apparatus by the mobile terminal,
>
> a communication between the mobile terminal and the image forming apparatus is performed wirelessly with an IEEE 802.11 standard,
>
> the communication address of the image forming apparatus is uniquely associated with and identifies the image forming apparatus,
>
> the communication address of the image forming apparatus is used for printing the image based on the image data from the mobile terminal,

[2] This decision employs the following abbreviations: "Spec." for the Specification, filed August 5, 2013; "Final Act." for the Final Office Action, mailed September 4, 2014; "Br." for the Appeal Brief, filed February 4, 2015; and "Ans." for the Examiner's Answer, mailed May 22, 2015.

the mobile terminal comprises:

a data selection receiving section that receives a selection of an image data among plural thumbnails displayed on a display section; and

an image data sending section that wirelessly sends the selected image data with the communication address of the image forming apparatus to the image forming apparatus,

the image forming apparatus makes the receiving section receive the selected image data, when the selected image data is sent with the communication address of the image forming apparatus from the mobile terminal,

the image forming apparatus comprises a deleting section that deletes an address of the mobile terminal after the communication with the mobile terminal through the receiving section is finished,

the image forming apparatus determines whether or not the mobile terminal has approached within a given range,

when determining that the mobile terminal has not approached within the given range, the image forming apparatus waits until the mobile terminal approaches within the given range, and

when determining that the mobile terminal has approached within the given range, the image forming apparatus transmits the communication address or identification information identifying the image forming apparatus to the mobile terminal.

Br. 13–14 (Claims App.).

The Prior Art Supporting the Rejections on Appeal

Oba et al. ("Oba")	US 2004/0078169 A1	Apr. 22, 2004
Porat	US 2006/0223394 A1	Oct. 5, 2006
Heinonen et al. ("Heinonen")	US 7,218,644 B1	May 15, 2007

Minatogawa	US 2008/0297607 A1	Dec. 4, 2008
Kato	US 2009/0066998 A1	Mar. 12, 2009

The Rejections on Appeal

Claims 1–7 stand provisionally rejected on the ground of obviousness-type double patenting as unpatentable over one or more claims in one or more copending applications. Final Act. 3.

Claims 1–7 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Kato, Oba, Minatogawa, Heinonen, and Porat. Final Act. 4–14; Br. 6.

ANALYSIS

We have reviewed the rejections of claims 1–7 in light of Appellants' arguments that the Examiner erred. For the reasons explained below, we are unpersuaded by Appellants' assertions regarding error by the Examiner.

The Rejection for Obviousness-Type Double Patenting

In the Final Office Action, the Examiner rejected all pending claims on the ground of obviousness-type double patenting. Final Act. 3. In the Appeal Brief, Appellants do not present any arguments addressing the double-patenting rejection. App. Br. 7–11. In the Answer, the Examiner does not withdraw the double-patenting rejection. Ans. 2–4.

Because Appellants do not contest the double-patenting rejection, we summarily sustain that rejection. *See Hyatt v. Dudas*, 551 F.3d 1307, 1314 (Fed. Cir. 2008) (explaining that "[w]hen the appellant fails to contest a ground of rejection to the Board, . . . the Board may treat any argument with respect to that ground of rejection as waived"); *see also* 37 C.F.R. § 41.37(c)(1)(iv).

The Rejection of Claims 1, 4, and 5 Under 35 U.S.C. § 103(a)

Claim 1 recites "an image forming apparatus" comprising a "deleting section that deletes an address of the mobile terminal after the communication with the mobile terminal through the receiving section is finished." Br. 14 (Claims App.). Claims 4 and 5 include similar limitations concerning deleting an address of the mobile terminal. *Id.* at 15, 16; *see id.* at 8.

The Examiner finds that Porat teaches "a finite space for storing pairing information" and "deleting pairing information to make room for new pairing information." Final Act. 7, 10, 13. The Examiner also finds that "[s]uch an arrangement advantageously allows for the removal of undesired pairing information." *Id.* at 7, 10, 13.

Appellants argue that no cited reference teaches or suggests the claimed "deleting section that deletes an address of the mobile terminal after the communication with the mobile terminal through the receiving section is finished." Br. 8–9 (emphasis omitted). In particular, Appellants contend that Porat merely discloses deleting address information should a need arise to pair an additional phone. *Id.* at 10. Appellants contrast those occasional deletions to the claimed deletions "after the communication with the mobile terminal through the receiving section is finished." *Id.* (emphasis omitted). Appellants also contend that Porat "merely discloses the concept of making room for new phones" by deleting address information for other phones instead of "the concept of preventing a third party with malicious intent from ill-using the communication history and stealing the address of the mobile terminal." *Id.*

In response, the Examiner explains that the "claim language only requires that the deletion occur *after* the communication is finished" and "does not specify particularly *when* it must occur after the communication is finished." Ans. 2. The Examiner also explains that the claims effectively recite "an infinite window in which deletion can occur after communication" finishes and do not require deletion immediately after communication finishes. *Id.* at 2–3. The Examiner finds that deletion according to Porat "necessarily happens" after communication finishes but not "necessarily *immediately* afterwards." *Id.* at 3.

In addition, the Examiner notes that the claim language says nothing about preventing a third party from stealing address information and that "limitations from the specification are not read into the claims." Ans. 2–3 (citing *In re Van Geuns*, 988 F.2d 1181 (Fed. Cir. 1993)).

Appellants submitted no reply and did not contest the Examiner's claim interpretation.

We agree with the Examiner's findings and reasoning. "[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000). An appellant cannot rely on an unclaimed feature to establish patentability. *See In re Self*, 671 F.2d 1344, 1348, 1350 (CCPA 1982). Appellants' arguments are not commensurate in scope with the claims. Br. 10–11. Based on the broadest reasonable claim interpretation, we discern no error in the Examiner's determination that Porat teaches the claimed "deleting section that deletes an address of the mobile terminal after the communication with the mobile terminal through the receiving section is finished."

Accordingly, Appellants' arguments have not persuaded us that the Examiner erred in rejecting claims 1, 4, and 5 for obviousness based on Kato, Oba, Minatogawa, Heinonen, and Porat. Hence, we sustain the rejection.

The Rejection of Claims 2 and 6 Under 35 U.S.C. § 103(a)

Claims 2 and 6 depend from claims 1 and 5 respectively and require that the "image forming apparatus" include "a notification section that wirelessly notifies an error information to the mobile terminal when an error occurs." Br. 14, 17 (Claims App.). The Examiner finds that "it is well known in the art to inform the originator of a print job of its results" and that "doing so would have predictably and advantageously let the originator know how the job turned out and when another job could be issued." Final Act. 7, 14.

Appellants argue that "the Examiner has failed to provide reference(s)" disclosing the "notification section" required by claims 2 and 6 and that "none of the prior art of record discloses or suggests the feature recited in claims 2 and 6." Br. 11.

Appellants do not identify errors in the finding that "it is well known in the art to inform the originator of a print job of its results" or expressly challenge the basis for the finding. Br. 11. Instead, Appellants quote the claim language and simply assert that the "prior art of record" lacks the recited feature. *Id.* The applicable rules require that the arguments in an appeal brief "explain why the examiner erred as to each ground of rejection contested by appellant." 37 C.F.R. § 41.37(c)(1)(iv). The rules also provide that "[a] statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim." *Id.*

Consequently, Appellants have not submitted an argument for separate patentability of claims 2 and 6.

Accordingly, Appellants' arguments have not persuaded us that the Examiner erred in rejecting claims 2 and 6 for obviousness. Hence, we sustain the obviousness rejection of these dependent claims.

The Rejection of Claims 3 and 7 under 35 U.S.C. § 103(a)

Claims 3 and 7 depend from claims 1 and 5 respectively. Br. 14, 17 (Claims App.). Appellants do not present any patentability arguments for these dependent claims beyond the arguments regarding the independent claims except for relying on their dependency from claims 1 and 5. *Id.* at 11. Thus, we sustain the obviousness rejection of these dependent claims.

DECISION

We affirm the Examiner's decision to reject claims 1–7.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED