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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/175.080	07/17/2008	Nobuhiko SUZUKI	006760.00222	9908
30755	7590	11/30/2016	EXAMINER	
BANNER & WITCOFF, LTD. ATTORNEYS FOR CLIENT NO. 016689 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			ZHANG, FAN	
			ART UNIT	PAPER NUMBER
			2674	
			NOTIFICATION DATE	DELIVERY MODE
			11/30/2016	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte NOBUHIKO SUZUKI and HIROKO ISHIKAWA

Appeal 2015-007882
Application 12/175,080
Technology Center 2600

Before ALLEN R. MACDONALD, IRVIN E. BRANCH, and
JOSEPH P. LENTIVECH, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1, 4, 12–15, and 17–20. Claims 2 and 5–11 are withdrawn, and claims 3 and 16 are cancelled. App. Br. ii–x. We have jurisdiction under 35 U.S.C. § 6(b).

Exemplary Claim

Exemplary claim 1 under appeal reads *in-part* as follows (emphasis and formatting added):

1. An image scanning apparatus, comprising:

a generally enclosed body; . . . and
a switching unit configured to

switch the scanner light source on in response to[:]

the judging unit judging that the transition, from the state in which the removable writable memory is not attached to the image scanning apparatus to the state in which ***the removable writable memory is attached*** to the image scanning apparatus, occurred in the image scanning apparatus and

the writable condition judging unit judging that the removable writable memory ***is*** in the predetermined writable condition, and

maintain the scanner light source off in response to[:]

the judging unit judging that the transition, from the state in which the removable writable memory is not attached to the image scanning apparatus to the state in which ***the removable writable memory is attached*** to the image scanning apparatus, occurred in the image scanning apparatus and

the writable condition judging unit judging that the removable writable memory ***is not*** in the predetermined writable condition.

Rejections

The Examiner rejected claims 1, 4, 12, 14, 15, 17, 18, and 20 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Okamoto (JP 10-20952; published January 23, 1998), Ono (US 7,936,474 B2; issued May 3, 2011), Wakai (US 2007/0019020 A1; published January 25, 2007), Choi (US 2004/0101325 A1; published May 27, 2004), and Sugita (JP 401007761 A; published January 11, 1989).¹

The Examiner rejected claims 13 and 19 under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Okamoto, Ono, Wakai, Choi, Sugita, and Cheung (US 2002/0171819 A1; published November 21, 2002).²

Appellants' Contentions

1. Appellants contend that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a) because:

None of Okamoto, Ono, Wakai, and Sugita discloses or suggests a switching unit for the scanner light source as recited in independent claims 1 and 15, namely one which switches on or off the scanner light source in response to attachment of a removable writable memory. Choi merely discloses a light source lamp that is warmed up when a key input signals are entered. However, the warming-up behavior as described in

¹ Separate patentability is not argued for claims 4, 12, 14, 15, 17, 18, and 20. Except for our ultimate decision, the rejection of these claims is not discussed further herein.

² Separate patentability is not argued for claims 13 and 19. Claim 13 is argued by virtue of its dependence from claim 1. App. Br. 14. Thus, the rejection of claim 13 turns on our decision as to claim 1. Except for our ultimate decision, the rejection of claims 13 and 19 is not discussed further herein.

Choi is completely unrelated to attachment of a removable memory. The Final Office Action characterizes Choi as disclosing the light lamp source switch is “programmable based on various conditions” (Final Office Action, p. 6). However, it is apparent each of the “various” conditions pertains only to actuation of the operation panel or a preset time delay. See Choi, ¶¶ [0037]-[0039]. Nothing in Choi would have led the skilled worker to switch the light lamp on or off depending on attachment of a removable writable memory.

App. Br. 11–12.

2. Further, Appellants also contend that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a) because:

[E]ven if the five references of Okamoto, Ono, Wakai, Sugita, and Choi were combined, the resulting apparatus simply would have a light source lamp which is warmed up when a key input is entered through the operation unit.

App. Br. 12.

3. Additionally, Appellants also contend that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a) because:

The Final Office Action’s contention that it would have been obvious to provide a switching unit configured to switch a scanner light source on or off depending on the detection of a writable memory comes not from anything taught in the five references relied on in the § 103 rejection, but instead only from the *hindsight* gleaned from reading the present disclosure. Put another way, the Final Office Action’s ultimate finding of obviousness entirely lacks the needed evidentiary underpinnings and instead is premised on precisely the sort of “mere conclusory statements” that the U.S. Supreme Court said are insufficient to sustain obviousness rejections. *KSR [Int’l Co. v. Teleflex Inc., 550 U.S. 398 (2007)]*.

App. Br. 13, emphasis added.

[T]he Answer does little more than piece together five references and assert that the skilled worker somehow would

have known how to combine them and arrive at something taught by none of them. This is not *prima facie* obviousness. It is *hindsight*.

Reply Br. 5, emphasis added.

Issues on Appeal

Did the Examiner err in rejecting claim 1 as being obvious?

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants' arguments (Appeal Brief and Reply Brief) that the Examiner has erred. We disagree with Appellants' conclusions. Except as noted below, we adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in the Examiner's Answer in response to Appellants' Appeal Brief. We concur with the conclusions reached by the Examiner. We highlight the following points.

As to Appellants' above contention 1, we disagree. Appellants argue that Okamoto, Ono, Wakai, and Sugita do not disclose or suggest "a switching unit for the scanner light source." App. Br. 11. However, Examiner did not cite Okamoto, Ono, Wakai, and Sugita for this limitation. Rather, the Examiner relied on Choi to teach "turning on/off the light source lamp of a scanner is programmable based on various conditions." Final Act. 5-6. Further, Appellants argue that Choi does not disclose or suggest warming-up behavior related to detection of attachment of a removable memory. App. Br. 11. However, Examiner did not cite Choi for this limitation. Rather, the Examiner relied on Okamoto to teach "detect attachment of the removable writable memory." Final Act. 3.

We conclude that Appellants' argument does not address the actual reasoning of the Examiner's rejections. Instead, Appellants attack the references singly for lacking teachings that the Examiner relied on a combination of references to show. It is well established that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *See In re Keller*, 642 F.2d 425–26 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091 (Fed. Cir. 1986). The effect of Appellants' argument is to raise and then knock down a straw man rejection of claim 1 that was never made by the Examiner in that the Examiner did not rely solely on Choi as argued. In other words, Appellants argue findings the Examiner never made. This form of argument is inherently unpersuasive to show Examiner error. Our reviewing court requires that references must be read, not in isolation, but for what they fairly teach in combination with the prior art as a whole. *Merck*, 800 F.2d at 1097 (Fed. Cir. 1986).

As to Appellants' above contention 2, we disagree. Appellants speculate that the combination of Okamoto, Ono, Wakai, Sugita, and Choi render obvious “a light source lamp which is warmed up when a key input is entered through the operation unit.” App. Br. 12. Even if we were to agree that the cited combination also renders obvious an invention other than the invention of Appellants claim 1, this is simply not a relevant argument as to whether the Examiner has provided a proper final conclusion that the combination of references renders obvious the claimed invention. A combination of references is not precluded from rendering obvious any number of distinct inventions.

As to Appellants' above contention 3, we disagree. Appellants cite to *KSR*, yet fail to fully quote the Court's "hindsight" discussion. The full point the Court made was:

The Court of Appeals, finally, drew the wrong conclusion from the risk of courts and patent examiners falling prey to hindsight bias. A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. See *Graham*, 383 U.S., at 36, 86 S.Ct. 684 (warning against a "temptation to read into the prior art the teachings of the invention in issue" and instructing courts to "guard against slipping into the use of hindsight" (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F.2d 406, 412 (C.A.6 1964))). Rigid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it.

KSR, 550 U.S. at 421. Beyond alleging improper hindsight Appellants' argument fails to explain the basis for their allegation. For example, Appellants do not provide objective evidence of nonobviousness (secondary considerations) to show the combination is less obvious than concluded by the Examiner (*see Power Integrations, Inc. v. Fairchild Semiconductor Int'l Inc.*, 711 F.3d 1348, 1368 (Fed. Cir. 2013)), or explain why elements of the Examiner's combination are superfluous (*see In re NTP, Inc.*, 654 F.3d 1279, 1299 (Fed. Cir. 2011)).³ Nonetheless, we have reviewed the rejection for improper hindsight and find none. We conclude the Examiner's rejection takes into account only knowledge which was within the level of

³ Although Appellants separately argue that the references fail to achieve the result of the claims (Contentions 1 and 2, discussed *supra*) (*See NTP* 654 F.3d at 1299), we have found those arguments unpersuasive.

ordinary skill in the art at the time the invention was made. *See In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971).

More particularly as to Appellants' allegation in above contention 3 that the Examiner has engaged in impermissible hindsight, we find no impermissible hindsight as Choi shows the turning light source lamp on/off can be based on various conditions of the scanner and as the Examiner points out Okamoto shows a known condition of a scanner is "the transition, from the state in which the removable writable memory is not attached to the image scanning apparatus to the state in which the removable memory is attached to the image scanning apparatus, occurred in the image scanning apparatus." Final Act. 4. The Examiner correctly points out the rejection is based "on factual evidence and logical analysis within the knowledge and capability of an ordinary skilled in the art." Ans. 9.

We conclude the Examiner's rejection takes into account only knowledge which was within the level of ordinary skill in the art at the time the invention was made, and does not include knowledge gleaned only from the Appellants' disclosure. *See McLaughlin*, 443 F.2d at 1395. We deem it reasonable for the Examiner to conclude

it would have been obvious for an ordinary skilled in the art to combine the teaching of all to turn on the copier/scanner light source lamp during preheating process when a writable storage memory is detected in order to ensure that the copier/scanner is ready for operation for improving processing efficiency; and to keep the light source lamp off when a writable storage memory is not detected to avoid unnecessary operation for saving energy.

Final Act. 6.

CONCLUSIONS

(1) Examiner has not erred in rejecting claims 1, 4, 12–15, and 17–20 as being unpatentable under 35 U.S.C. § 103(a).

(2) Claims 1, 4, 12–15, and 17–20 are not patentable.

DECISION

The Examiner's rejections of claims 1, 4, 12–15, and 17–20 as being unpatentable under 35 U.S.C. § 103(a) are affirmed.

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