



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/795.452	06/07/2010	Toru Yoshida	CANO-1372	1948
37013	7590	11/21/2016	EXAMINER	
Rossi, Kimms & McDowell LLP 20609 Gordon Park Square Suite 150 Ashburn, VA 20147			MERCADO, ARIEL	
			ART UNIT	PAPER NUMBER
			2176	
			NOTIFICATION DATE	DELIVERY MODE
			11/21/2016	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mail@rkmlp.com
EOfficeAction@rkmlp.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TORU YOSHIDA

Appeal 2016-002329¹
Application 12/795,452
Technology Center 2100

Before JEAN R. HOMERE, MICHAEL M. BARRY, and
DAVID J. CUTITTA II, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Appellant identifies the real party in interest as CANON KABUSHIKI KAISHA. App. Br. 1.

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's Non-Final Rejection of claims 1–3, 5, 7, and 9, which constitute all of the claims pending in this appeal. Claims 4, 6, 8, and 10–12 have been canceled. Claims App'x. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellant's Invention

Appellant invented a digital multifunctional peripheral having a console that displays scanned documents only in formats supported by the device for subsequent printing or storage. Spec. ¶¶ 9, 65, Figs. 5–7. In particular, upon detecting that the printing process has been invoked, the display unit displays files in formats (e.g., TIFF and JPEG) that are printable by the device. Likewise, when the storing process has been invoked, the display unit displays files in formats (e.g., TIFF and PDF) that are storable by the device. *Id.* at ¶¶ 74, 79.

Illustrative Claim

Independent claim 1 is illustrative, and reads as follows:

1. A processing apparatus comprising:
a scanner adapted to read an original document and to generate image data;
a determination unit adapted to determine whether processing to be executed with respect to a storage unit that stores a plurality of files is a printing process of printing one of the files stored in the storage unit or a storing process of storing the image data generated by said scanner in the storage unit; and

a display unit adapted to display a file of a format in accordance with the determined processing among the plurality of files stored in the storage unit,

wherein, when the processing determined by said determination unit is the printing process, the display unit displays a file of a first format that is processable by the printing process and processable by the storing process and a file of a second format that is processable by the printing process and not processable by the storing process, without displaying a file of a third format that is processable by the storing process and not processable by the printing process, among the plurality of files stored in the storage unit, and

wherein, when the processing determined by said determination unit is the storing process, the display unit displays the file of the first format and the file of the third format without displaying the file of the second format, among the plurality of files stored in the storage unit.

Prior Art Relied Upon

Uchida	US 2006/0221407 A1	Oct. 5, 2006
Katsuyama	US 2007/0028187 A1	Feb. 1, 2007
Tran	US 2009/0103135 A1	Apr. 23, 2009

Rejection on Appeal

Claims 1–3, 5, 7, and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Katsuyama, Tran, and Uchida.

Non-Final Act. 3–11.

ANALYSIS

We consider Appellant's arguments *seriatim* as they are presented in the Appeal Brief, pages 5–9, and the Reply Brief, pages 2–4.² We have reviewed the Examiner's rejection in light of Appellant's arguments. We are unpersuaded by Appellant's contentions. Except as indicated hereinbelow, we adopt as our own the findings and reasons set forth in the Examiner's Answer in response to Appellant's Appeal Brief, and in the Non-Final Action. *See* Ans. 2–19, Non-Final Act. 2–12. However, we highlight and address specific arguments and findings for emphasis as follows.

Appellant argues the proposed combination of Katsuyama, Tran, and Uchida does not teach or suggest the claimed requirements that the display unit displays files in a first and third format suitable for scanning while excluding files in a second format not suitable therefor. App. Br. 7–9, Reply Br. 2–4. In particular, Appellant argues that, as admitted by the Examiner, Tran does not teach attempting to store a data image generated by a scanning process. Instead, Tran relates to printing, copying, and emailing processes,

² Rather than reiterate the arguments of Appellant and the Examiner, we refer to the Appeal Brief (filed June 15, 2015), the Reply Brief (filed December 21, 2015), and the Answer (mailed October 23, 2015) for the respective details. We have considered in this decision only those arguments Appellant actually raised in the Briefs. Any other arguments Appellant could have made but chose not to make in the Briefs are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

which do not involve selecting certain file types for processing, while excluding others. App. Br. 7 (citing Tran ¶¶ 22–27). Further, Appellant argues although Katsuyama acknowledges the existence of scanning and saving image data, it is silent regarding displaying file formats from the scanned documents that are storable while excluding unstorage image data formats. *Id.* at 8 (citing Katsuyama ¶¶ 117, 125, Figs. 5, 12). Additionally, Appellant argues that because selecting a file to print/copy or attach to an e-mail is different than the process of storing a file generated by scanning, the proposed combination of Tran with Katsuyama would not have been made without the benefit of hindsight. *Id.*, Reply Br. 2. These arguments are not persuasive.

As correctly noted by Appellant, Tran discloses a multifunction copier that accepts at its port a USB device for the purpose of faxing, emailing, and printing. Appeal Br. 7 (citing Tran ¶ 22). In particular, as noted by the Examiner, upon the USB device being inserted at the port, a user selects one of the cited three functions, and then a controller residing on the multifunction device invokes a document conversion utility that scans the USB device to thereby display in the multifunction device console the files in the USB device that are suitable for the selected function. Ans. 13–14 (citing Tran Abstr., ¶¶ 21–23, 26–28). As further correctly noted by the Examiner, Tran discloses that the multifunction device is also capable of copying and scanning documents. *Id.* at 13 (citing Tran ¶ 21). Additionally, the Examiner correctly finds that Katsuyama discloses selecting a SAVE function or a PRINT function to be performed on image data obtained from

scanned documents. *Id.* at 12–13 (citing Fig. 5, ¶¶ 94, 99–100, 117). We agree with the Examiner that because Tran’s multifunction controller selects the suitable files from the USB device inserted therein based on the function invoked by the user, Tran teaches displaying only the selected files while excluding non-selected ones. Accordingly, we agree with the Examiner that the combination of Tran and Katsuyama would predictably result in a multifunction controller, which upon detecting that the printing function has been selected, will display exclusively on the console files associated with the printing function to thereby print the file image data. Likewise, files associated with the save function will be displayed exclusively on the console to thereby save the image data.

The Supreme Court instructs that an obviousness 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.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). As discussed above, we find Tran’s disclosure of incorporating into Katsuyama’s multifunction system a controller that extracts from a USB device those image data files supported by the device in the performance of a selected function (e.g. copying/scanning) is no more than a simple arrangement of old elements with each performing the same function it had been known to perform, yielding no more than one would expect from such an arrangement. *Id.* at 416. The ordinarily-skilled artisan, being “a person of ordinary creativity, not an automaton,” would be able to fit the teachings of Tran and Katsuyama

Appeal 2016-002329
Application 12/795,452

together like pieces of a puzzle. *Id.* at 420–21. Accordingly we do not agree with Appellant that the proposed combination is motivated by impermissible hindsight. Because Appellant has not demonstrated that the Examiner’s proffered combination would have been “uniquely challenging or difficult for one of ordinary skill in the art, we agree with the Examiner that the proposed modification would have been within the purview of the ordinarily skilled artisan. *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418).

Accordingly, we are not persuaded of error in the Examiner’s obviousness rejection of claim 1.

Regarding the rejection of claims 2, 3, 5, 7, and 9, because Appellant has either not presented separate patentability arguments or has reiterated substantially the same arguments as those previously discussed for patentability of claim 1 above, claims 2, 3, 5, 7, and 9 fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(iv).

DECISION

We affirm the Examiner’s obviousness rejection of claims 1–3, 5, 7, and 9.

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