



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.
14/175,277	02/07/2014	Atsuhiko Fukushima	70404.2303/dk	2285
54072	7590	02/25/2020	EXAMINER	
SHARP KABUSHIKI KAISHA C/O KEATING & BENNETT, LLP 1800 Alexander Bell Drive SUITE 200 Reston, VA 20191			HUNTSINGER, PETER K	
			ART UNIT	PAPER NUMBER
			2615	
			NOTIFICATION DATE	DELIVERY MODE
			02/25/2020	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):

JKEATING@KBIPLAW.COM
epreston@kbiplaw.com
uspto@kbiplaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ATSUHIKO FUKUSHIMA, YUJI OKAMOTO,
TOSHIHIRO YAMANAKA, TOSHIHIKO FUKUHARA, SHUHI FUJII,
TATSUO NOMURA, SYOUICHIROU YOSHIURA, and
TSUTOMU YOSHIMOTO

Appeal 2019-000457
Application 14/175,277
Technology Center 2600

Before JEAN R. HOMERE, DEBRA K. STEPHENS, and
JOHN A. EVANS, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE¹

Pursuant to 35 U.S.C. § 134(a), Appellant appeals from the
Examiner’s decision to reject claims 23–26, 29, and 31.² Appeal Br. 1.

¹ We refer to the Specification in US 2014/0153036 A1, filed Feb. 7, 2014, and published June 5, 2014 (“Spec.”); the Final Office Action, mailed October 25, 2017 (“Final Act.”); the Appeal Brief, filed July 20, 2018 (“Appeal Br.”); the Examiner’s Answer, mailed August 30, 2018 (“Ans.”); and the Reply Brief (“Reply Br.”) filed October 24, 2018. This appeal relates to Appeal 2016-004942 (previously decided on April 3, 2017) in which we affirmed the Examiner’s obviousness rejection of claims 18, 20–26, 28, and 29. Dec. 7.

² We use the word “Appellant” to refer to “applicant” as defined in

Claims 1–22, 27, 28, 30, and 32 have been cancelled. *Id.* at 15–16. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

II. CLAIMED SUBJECT MATTER

According to Appellant, the claimed subject matter relates to digital multifunctional device (1) including image reading unit (2), operation unit (4), image forming unit (6), and device control unit (8). Spec. ¶¶ 40, 41, Fig. 1. Operation unit (4) includes input unit (4a) and display unit (4b) for implementing various functions including erasing processed image data stored in hard disk (12). *Id.* ¶ 43, Fig. 1.

Independent claim 23, reproduced below with disputed limitation emphasized in *italics*, is illustrative of the claimed subject matter:

23. An image processing device comprising:
an image data reader which inputs image data;
an image data storage which stores the image data inputted through the image data reader;
an image data printer which outputs the image data stored in the image data storage;
a display including a region which displays a print setup; and
a device controller which controls the display and erases the image data stored in the image data storage; wherein
the device controller repeatedly executes an erase process to the image data stored in the image data storage for a plurality of times, and displays an icon, in a periphery of the display and outside the region which displays the print setup, which indicates that an image data erase process function is in an operable state and has been validated, and during execution of the erase process, displays the icon in a different display than a normal display.

37 C.F.R. § 1.42(a). Appellant identifies Sharp Kabushiki Kaisha as the real party-in-interest. Appeal Br. 2.

Appeal Br. 15 (Claims Appendix).

Figure 1, discussed above and reproduced below, are useful for understanding the claimed invention:

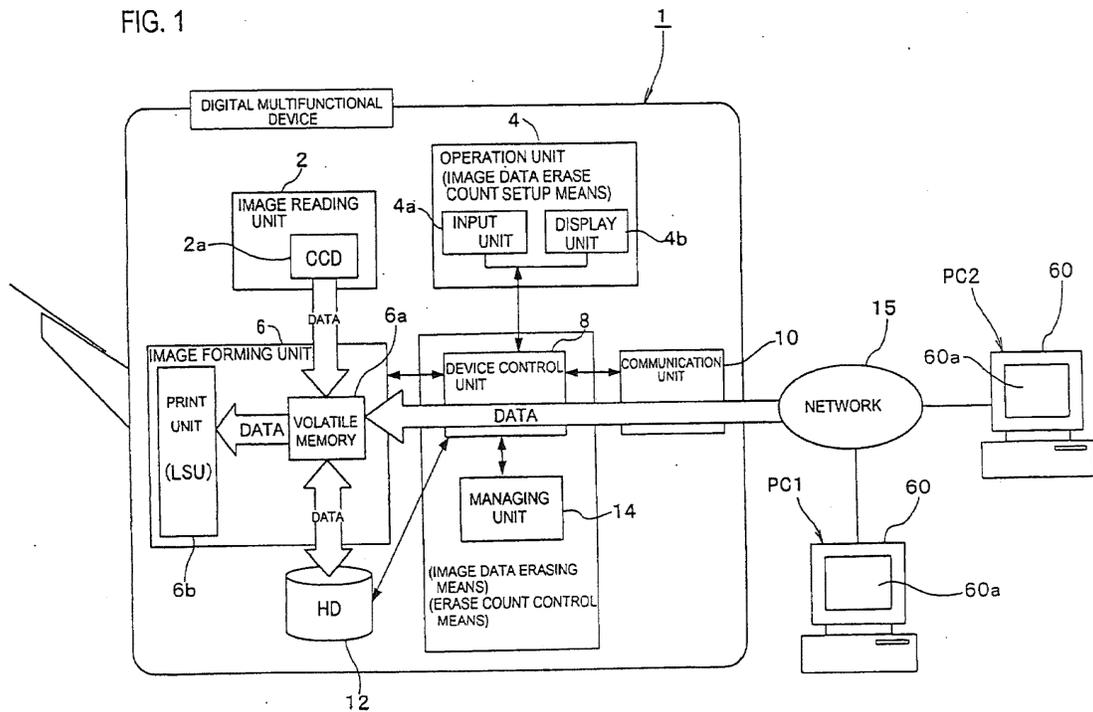


Figure 1 illustrates a schematic configuration of a digital multifunctional device including an image processing device. Spec. ¶ 41.

III. REFERENCES

The Examiner relies upon the following references.³

Name	Number	Filed	Publ'd/Issued
Nomura (Nomura '045)	US 5,950,045	June 10, 1998	Sept. 7, 1999
Battles	US 6,437,811 B1	Jan. 26, 2000	Aug. 20, 2002

³ All reference citations are to the first named inventor only.

Bunker	US 2002/0181134 A1	June 4, 2001	Dec. 5, 2002
Nomura (Nomura '099)	JP 2001-309099A		Nov. 2, 2001

IV. REJECTION⁴

The Examiner rejects claims 23–26, 29, and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Bunker, Battles, Nomura '099, Nomura '045, and Applicant's Admitted Prior Art (AAPA)/Official Notice. Final Act. 11–16; Ans. 2–7.

V. ANALYSIS

We consider Appellant's arguments *seriatim*, as they are presented in the Appeal Brief, pages 3–14, and the Reply Brief, pages 2–4.⁵ We are unpersuaded by Appellant's contentions. Except, as otherwise indicated herein below, we adopt as our own the findings and reasons set forth in the Final Action, and the Examiner's Answer in response to Appellant's Appeal Brief. Final Act. 6–19; Ans. 2–10. However, we highlight and address specific arguments and findings for emphasis as follows.

Appellant argues the Examiner erred in finding that the combination of Bunker, Battles, Nomura '099, Nomura '045, and AAPA/Official Notice teaches or suggests an icon showing an erase process function, as recited in independent claim 1. Appeal Br. 4–5. In particular, Appellant argues

⁴ The Examiner withdraws the indefiniteness and obviousness rejections previously entered against claims the pending claims. Final Act. 2; Ans. 2.

⁵ 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) (2014).

Bunker discloses a graphical user interface of a driver on a remote computer, as opposed to an image processing device. *Id.* (citing Bunker ¶ 27, Fig. 4.) This argument is misplaced because the Examiner relies on Bunker’s graphical interface in an image processing device, as depicted in Figures 3A, 3b, and as later acknowledged in Appellant. Ans. 7.

Further, Appellant argues that “[o]ne of ordinary skill in the art would not be motivated to modify Bunker to include an icon in view of Battles.” Appeal Br. 5 (boldface omitted). According to Appellant, Bunker discloses an erase device in an image processing device (e.g., scanner, copier) including an erase trigger that allows a user to perform an erase process via the SEC. ERASE tab requiring the user to input various parameters to execute the underlining erase function. *Id.* at 5–6 (citing Bunker Figs. 3A, 3B); whereas Battles discloses a matrix of icons related to sorting various photographs by providing the user with the capability of performing multiple sorting functions for each photograph on a common screen. *Id.* at 6 (citing Battles 1:9–34, 5:14–30). Appellant contends that the Examiner failed to explain how Battles’s simple icon for performing a single sorting task could have been used to replace Bunker’s icon for performing the more complex erase trigger functions requiring multiple inputs or parameters. *Id.* at 7 (citing Bunker ¶¶ 5, 6).

Furthermore, Appellant argues that the proposed substitution of Battles’s simpler function for Bunker more complex functions would have rendered Bunker unsuitable for its intended purpose of performing the desired erase functions thereby eliminating Bunker’s customization (i.e., allowing a user to customize and select the number of overwrites, pattern and cycle) of the erase function. Appeal Br. 8–9. Appellant also contends

that because Battles is directed to sorting (deleting, locking, grouping, printing, rotating) a plurality of photographs one at a time on a common screen, its mere checking of a box to indicate files to be deleted cannot replace Bunker's customizing of various screens to perform the more complex erase function. *Id.* at 9–10.

Additionally, Appellant argues that, given the disparate teachings of the cited references, the Examiner has not explained how one of ordinary skill in the art would have modified the Bunker-Battles's icon, which must be located in the print setup location, with Nomura's small icon displayed in the upper left corner of the screen. Appeal Br. 10–11 (citing Nomura 22:37–50). According to Appellant, the proposed modification would have been counterintuitive for the placement of Bunker's erase function icon. *Id.* at 11.

Finally, Appellant argues that there would not have been any logical reason or motivation to modify Bunker's erase trigger with (1) Battles's simple icon, (2) Nomura's peripheral icon displayed on the side of the screen or (3) in light of the Examiner's taking of official notice, as evidenced by Conti,⁶ to provide blinking or spinning icon during operation of the erase process. Appeal Br. 12. According to Appellant, Conti's disclosure of a camera including spinning memory icons indicating an available amount of memory in the camera would not properly be combinable with Bunker's multi-screen process for customizing the erase trigger function. *Id.* at 12–13 (citing Conti ¶¶ 25, 28).

Appellant's arguments are not persuasive of reversible Examiner error. As an initial matter, we note there are no material disputes between

⁶ Conti, US 2003/0048714 A1, published Mar. 13, 2003.

Appellant and the Examiner regarding the teachings of the cited references. The principal dispute before us is whether the cited references are properly combined, as proposed by the Examiner, to teach the disputed claim limitations. We answer this inquiry in the affirmative.

We agree with the Examiner that the proposed combination of Bunker's multi-screen erase process for allowing a user to customize the erase trigger function with Battles' single screen icon for deleting previously selected photographs is proper. Ans. 7–8. In particular, Battles's teaching would have simplified Bunker's interface by replacing Bunker's multi-screen approach with a single screen wherein inputs or parameters are arranged in a matrix of rows and columns from which the user can select desired ones for subsequent deletion during the customizing of the erase function. Because the customization of the interface would be preserved in the aftermath of the substitution, we find unavailing Appellant's argument that the proposed combination of Bunker's teaching with Battles would have rendered Bunker's unsuitable for its intended purpose of customizing the erase function.⁷

⁷ The argument that the proposed combination of references would render one of the references unsuitable for its intended purpose, or would change its principle of operation, is a teaching away argument. *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984) (The court concluded that in effect, “French teaches away from the board’s proposed modification” because “if the French apparatus were turned upside down, it would be rendered inoperable for its intended purpose”). “If references taken in combination would produce a ‘seemingly inoperative device,’ . . . such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness.” *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1354 (Fed. Cir. 2001) (citation omitted); *see also In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1382 (Fed. Cir. 2007) (“[A] reference teaches

Further, we agree with the Examiner that the proposed combination of Bunker with Battles and Nomura is likewise proper because Nomura's teaching of simply relocating the icon on the upper left screen would set the icon apart from the various input parameters the user has to select in the main screen during the customization of the erase function icon. Ans. 9. Additionally, we agree with the Examiner that the Official Notice, as evidenced by Conti's teaching an icon spinning icon during operation of the erase process to indicate availability of space in memory, would enhance the functionality of the Bunker-Battles-Nomura system by indicating that the erase trigger process live and ongoing. Ans. 9–10. We find the Examiner's proposed combination of the cited teachings of Bunker, Battles, Nomura, Official Notice, and Conti 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. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007). Therefore, the ordinarily skilled artisan, being "a person of ordinary creativity, not an automaton," would be able to fit the teachings of the cited references together like pieces of a puzzle to predictably result in a multifunction system displaying in a single screen of a graphical user interface including a plurality of input parameters from which a user may designate selected ones to customize an erase process, and wherein a spinning erase icon associated therewith indicates a live and ongoing process. *Id.* at 420–21. Because

away from a combination when using it in that combination would produce an inoperative result," but the obviousness analysis must account for "modifications that one skilled in the art would make to a device borrowed from the prior art").

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). Consequently, we are satisfied that, on the record before us, the Examiner has established by a preponderance of the evidence that the combination of Bunker, Battles, Nomura '099, Nomura '045, and Applicant's Admitted Prior Art (AAPA)/Official Notice renders claim 23 unpatentable. Accordingly, we are not persuaded of error in the Examiner's obviousness rejection of claim 23.

Regarding the rejection of claims 24–26, 29, and 31, Appellant has not presented separate patentability arguments or reiterated substantially the same arguments as those previously discussed for patentability of claim 23. As such, claims 24–26, 29, and 31 fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(iv).

VI. CONCLUSION

We likewise affirm the Examiner's obviousness rejection of claims 23–26, 29, and 31 under 35 U.S.C. § 103(a).

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
23–26, 29, 31	103(a)	Bunker, Battles, Nomura '099, Nomura '045, AAPA/Official Notice	23–26, 29, 31	

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).

AFFIRMED