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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte HARUO NISHIYAMA and MASANORI MATSUMOTO

Appeal 2019-005478
Reissue Application 14/606,686
Patent 8,451,479 B2
Technology Center 3900

Before ALLEN R. MacDONALD, JOHN A. JEFFERY, and
JENNIFER L. McKEOWN, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Under 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–6 and 11–16. Claims 7–10 were allowed. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM and enter a new ground of rejection.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Sharp Kabushiki Kaisha. Appeal Br. 2.

STATEMENT OF THE CASE

Appellant seeks to reissue U.S. Patent 8,451,479 B2 (“’479 patent”) directed to an image forming apparatus that, before printing, (1) enables previewing content, and (2) warns users when they exceed a page limit. *See generally* ’479 patent, Abstract; col. 26, l. 59 – col. 28, l. 30; Figs. 1–3, 15. Claims 1 and 11 are illustrative:

1. An image forming apparatus comprising:
 - a processor and a memory including a program stored therein, the program
 - being readable by the processor,
 - a display device[portion],
 - a preview image generating circuit[portion that generates] controlled by the processor to generate a preview image of image data to be output,
 - a display control portion [that displays] controlled by the processor to perform a control to display the preview image generated by the preview image generating circuit[portion] on the display device [portion], and
 - a setting storage portion that stores, for each user, setting information related to a preview display of the preview image displayed on the display device by control performed by the display control portion, wherein the setting information includes forcible execution information showing whether or not the preview image is forcibly displayed on the control device control performed by the display control portion.
 - wherein and in which the display control portion is controlled by the processor to [performs]perform display control to display the preview image on the display device based on the setting information stored in the setting storage portion,
 - wherein the image forming apparatus is capable of printing on sheets and [comprises] the processor and the memory are configured to [: an upper-limit-number storage portion that stores]store, for each user, an upper limit number of printed sheets or number of printing every fixed period, and [a count portion that counts[to count the number of printed sheets or the number of printing for each user every fixed period, and

wherein the display control portion is controlled by the processor to perform display control based on the forcible execution information stored in the setting storage portion [sets the forcible execution information so] such that the preview image is forcibly shown to a user that causes the total number of printed sheets or the number of printing counted [by the count portion] to exceed the upper-limit-number of printed sheets [stored in the upper-limit-number storage portion].

11. An image forming apparatus which is capable of printing on sheets comprising:
an upper-limit-number storage portion that stores, for each user, an upper-limit number of printed sheets or printing every fixed period: and
a count portion that counts the number of printed sheets or printing for each user every fixed period, and
the image forming apparatus configured to display whether to execute printing as it is or to cancel when the number of printed sheets or printing counted by the count portion exceeds the upper-limit number stored in the upper-limit-number storage portion.

THE REJECTIONS

The Examiner rejected claims 1–6 and 11–15² under 35 U.S.C. § 112, second paragraph as indefinite. Final Act. 25–26.³

² Although the Examiner’s indefiniteness rejection omits claims 11–15, the Examiner’s Answer nonetheless indicates that these claims are so rejected. *Compare* Final Act. 25 *with* Ans. 3–4. Accordingly, notwithstanding Appellant’s omitting claim 11 when characterizing the Examiner’s indefiniteness rejection on page 13 of the Appeal Brief, we nonetheless include claims 11–15 here to clarify the record, and treat the Examiner’s and Appellant’s errors in this regard as harmless.

³ Throughout this opinion, we refer to (1) the Final Rejection mailed May 1, 2018 (“Final Act.”); (2) the Appeal Brief filed February 1, 2019 (“Appeal Br.”); and (3) the Examiner’s Answer mailed April 5, 2019 (“Ans.”).

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The Examiner rejected claims 11 and 16 under 35 U.S.C. § 103 as unpatentable over Nakagawa (US 2007/0229887 A1; published Oct. 4, 2007) and Asai (US 2006/0023243 A1; published Feb. 2, 2006). Final Act. 27–28.

The Examiner rejected claims 12–14 under 35 U.S.C. § 103 as unpatentable over Nakagawa, Asai, and Koga (US 6,473,539 B1; issued Oct. 29, 2002). Final Act. 28–32.

The Examiner rejected claim 15 under 35 U.S.C. § 103 as unpatentable over Nakagawa, Asai, and Murakami (US 2008/0246993 A1; published Oct. 9, 2008). Final Act. 32–33.

THE INDEFINITENESS REJECTION

The Examiner determines that independent claim 1 is indefinite because it is unclear what structure the phrase “wherein the image forming apparatus is configured to print . . .” refers to given the image forming apparatus’s “many components.” Final Act. 25; Ans. 4–6. The Examiner adds that independent claim 11 is also indefinite because the recited “image forming apparatus configured to display whether to execute . . .” recites a method step that results in a hybrid “product claim” or, alternatively, ordinarily skilled artisans cannot determine the structure associated with this “configured to” clause. Final Act. 25–26; Ans. 6–7.

Appellant argues that claim 1 is definite because ordinarily skilled artisans would understand what is meant by an imaging apparatus that is capable of printing or configured to print on sheets. Appeal Br. 13–14. Appellant adds that claim 11 is likewise definite because ordinarily skilled

artisans would understand what is meant by an imaging apparatus that is configured for display as specified in claim 11. Appeal Br. 15–16.

ISSUE

Has the Examiner erred in rejecting claims 1 and 11 under § 112, second paragraph as indefinite? This issue turns on whether (1) ordinarily skilled artisans would understand what is meant by the recited image forming apparatus and their respective capabilities in claims 1 and 11, and (2) claim 11 is a hybrid claim.

ANALYSIS

Claims 1–6

We begin by noting that the Examiner’s quoted phrase “wherein the image forming apparatus is configured to print . . .” (Final Act. 25) that is said to be unclear does not match the language of claim 1 that recites, in pertinent part, “wherein the image forming apparatus is capable of printing on sheets” (“the printing capability limitation”). Nevertheless, given these phrases’ similarity, we presume that the Examiner intended to refer to the printing capability limitation, and treat the Examiner’s error in this regard as harmless.

Turning to the rejection, claim 1 recites, in pertinent part, “[a]n *image forming apparatus* comprising . . . wherein the *image forming apparatus* is capable of printing on sheets” Our emphasis underscores that, apart from the printing capability limitation, the image forming apparatus is recited only in the preamble and at a high level of generality. Although the

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image forming apparatus comprises various structural elements, namely a processor, memory, display device, preview image generating circuit, display control portion, and setting control portion, there are no structural elements recited that are capable of *printing*, let alone printing on sheets as claimed.

Given this omission, the Examiner’s finding that it is unclear what particular component of the image forming apparatus the printing capability limitation refers to (Final Act. 25; Ans. 5–6) has merit. To the extent that Appellant contends that the image forming apparatus comprises an element, such as a printing portion, or other means that is capable of printing on sheets (*see* Appeal Br. 13–14), there is no such element or means recited, nor will we import such limitations into the claim.

To be sure, the ’479 patent indicates that digital multi-functional peripheral 1 “is assumed to be capable of printing on sheets”—the very capability indicated for the image forming apparatus—and that image forming apparatus are conventionally copying machines and multi-function peripherals. *See* ’479 patent, col. 1, ll 19–22, 30–33; col. 2, ll. 44–46, col. 27, ll. 15–16. Still, claim 1 recites no particular structure or means that are capable of printing on sheets apart from the overall “image forming apparatus” in the preamble.

We recognize that a patent’s disclosure is written for those skilled in the art who come to the patent with knowledge of what has come before. *LizardTech, Inc. v. Earth Resource Mapping, Inc.*, 424 F.3d 1336, 1345 (Fed. Cir. 2005). Therefore, it is unnecessary to spell out every detail of the invention; only enough must be included in the disclosure to ensure the

claims are clear, and convince a person of ordinary skill in the art that the inventor possessed the invention, and to enable such a person to make and use the invention without undue experimentation. *See id.* Nor is the fact that a claim is broad in scope mean that it is indefinite. *See In re Gardner*, 427 F.2d 786, 788 (CCPA 1970) (“Breadth is not indefiniteness.”); Manual of Patent Examining Procedure (MPEP) § 2173.04 (9th ed. Rev. 08.2017, Jan. 2018) (citing *Gardner*). *Accord* Appeal Br. 14 (noting this point).

But where, as here, the claim does not specify *any* structure that is capable of performing the recited function, namely printing on sheets, and the recited element with such capability, namely the image forming apparatus, is otherwise recited only in the preamble with no further elaboration, it is unclear what particular structure in the claim is so capable, even when read in light of the Specification.

Therefore, we are not persuaded that the Examiner erred in rejecting claim 1, and claims 2–6 not argued separately with particularity.

Claims 11–15

We also sustain the Examiner’s rejection of claim 11 reciting, in pertinent part, an image forming apparatus *configured to display* whether to execute printing as is or cancel when the number of counted printed sheets or printing exceeds a stored upper-limit number.

Here again, the image forming apparatus is only otherwise recited in the preamble with no structural elaboration regarding its display capability, let alone the ability to display the particular recited options noted above. Although the image forming apparatus comprises various structural

elements, namely upper-limit number storage and count portions, there are no structural elements recited that are capable of displaying, much less displaying the particular recited options noted above. Given this omission, it is unclear what particular structure in the claim is so capable, even when read in light of the Specification.

To the extent that Appellant contends that the image forming apparatus comprises an element, such as a display portion, or other means that is capable of displaying the recited options as in column 27 and Figure 15 (*see* Appeal Br. 16), there is no such element or means recited, nor will we import such limitations into the claim.

To be sure, the fact that a claim is broad in scope does not mean that it is indefinite. *See Gardner*, 427 F.2d at 788. But where, as here, the claim does not specify *any* structure that is capable of performing the recited function, namely displaying the recited options, and the recited element with such capability, namely the image forming apparatus, is otherwise recited only in the preamble with no structural elaboration to achieve its display capabilities, it is unclear what particular structure in the claim is so capable, even when read in light of the Specification.

Regarding the Examiner's alternative basis for the indefiniteness rejection, namely that claim 11 a hybrid claim (*see* Final Act. 25–26), we agree, but for reasons different from those articulated by the Examiner. Apparatus claims reciting active method steps have been held indefinite under § 112, second paragraph, for such claims raise the question of whether they are infringed by devices that are merely capable of performing the recited function, or that they must actually perform that function. *See IPXL*

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Holdings, L.L.C. v. Amazon.com, Inc., 430 F.3d 1377, 1384 (Fed. Cir. 2005); *see also Rembrandt Data Technologies, LP v. AOL, LLC*, 641 F.3d 1331, 1339 (Fed. Cir. 2011) (data transmitting device held indefinite for reciting transmitting method step).

But that is not the case regarding the Examiner’s identified “configured to” limitation of apparatus claim 11 that merely specifies what the image forming apparatus is *configured to* do—not that it actually performs that function. *Accord* Appeal Br. 16 (noting this point).

Claim 11, however, recites other limitations with active steps, namely that the display control portion *performs* a control, and the count portion *counts* the number of printed sheets or printing. Our emphasis underscores that these limitations recite active method steps in apparatus claim 11, thus rendering it indefinite as a hybrid claim. The Examiner, however, did not identify these particular limitations as rendering the claim indefinite: only the “configured to” clause was so identified. *See* Final Act. 25–26; Ans. 5–6.

So although we agree with Appellant that the Examiner’s articulated basis for the indefiniteness rejection of claim 11 is problematic, the claim nonetheless is an indefinite hybrid claim that was properly rejected—but for different reasons.

In addition, other active terminology in dependent claims 12–14, such as (1) “performs a control” in claims 12 and 14; (2) “displaying” in claim

13; (3) “storages” [sic],⁴ “counts,” and “causes” in claim 14 renders those claims indefinite as hybrid claims in addition to the reasons noted previously regarding independent claim 11. That the latter term is recited in terms of what *a user must do*, namely *cause* the recited sheet (or printing) number to exceed the upper-limit number, only underscores the active method step associated with this user-based causation. *Cf. IPXL*, 430 F.3d at 1384 (holding a claim indefinite because it was unclear whether infringement occurred when (1) a system was created *allowing the user* to change predicted transaction information or accept the displayed transaction, or (2) *the user actually uses* an input means to perform those functions).

We, therefore, agree with the Examiner to the extent that claims 11–15 are indefinite, albeit for different reasons. Given our rationale that was not articulated by the Examiner, we designate our affirmance of the Examiner’s indefiniteness rejection of claims 11–15 as a new ground of rejection.

THE OBVIOUSNESS REJECTION OVER NAKAGAWA AND ASAI

Regarding claim 11, the Examiner finds that Nakagawa discloses an image forming apparatus with the recited upper-limit-number storage and count portions, but is not configured to display whether to (1) execute printing as it is, or (2) cancel when the number of printed sheets or printing counted exceeds the stored upper-limit number. Final Act. 27. The

⁴ Although the term “storage” is a noun, it is nonetheless used as a verb in the context of claim 14 in the form of the unorthodox term “storages” that is apparently synonymous with the term “stores.”

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Examiner, however, cites Asai for teaching this feature in concluding that the claim would have been obvious. Final Act. 27–28.

Appellant argues that Asai’s comparing a document’s total number of pages to the currently-printed page number does not pertain to, and is independent of, monthly printing limits and print usage. Appeal Br. 19–20. Appellant adds that the Examiner fails to identify why ordinarily skilled artisans would be led to modify Nakagawa’s device in the manner proposed. Appeal Br. 20–21.

ISSUE

Under § 103, has the Examiner erred by finding that Nakagawa and Asai collectively would have taught or suggested the limitations recited in claim 11? This issue turns on whether the Examiner’s proposed combination of the cited references is supported by articulated reasoning with some rational underpinning to justify the Examiner’s obviousness conclusion.

ANALYSIS

As noted above, the Examiner acknowledges that Nakagawa’s image forming apparatus is not configured to display whether to (1) execute printing as it is, or (2) cancel when the number of printed sheets or printing counted exceeds the stored upper-limit number as claimed, but cites Asai to cure those deficiencies. Final Act. 27–28.

We see no error in the Examiner’s reliance on Asai in this regard. As the Examiner explains (Ans. 9–11), Asai at least suggests displaying

whether to (1) execute printing as it is, namely using the “CONTINUE” key 7-13-2 in Figure 14B, or (2) cancel, using the “STOP” key 7-13-1, when the number of printed sheets or printing counted exceeds the stored upper-limit number, particularly given the warning displayed in Figure 14B. *See* Asai Figs. 13B (step S826), Fig. 13C (steps S842–S843); ¶¶ 175, 179. On this record, we see no reason why this display functionality could not be provided in connection with Nakagawa’s image forming apparatus that includes, among other things, the recited upper-limit-number storage and count portions as the Examiner proposes. Such an enhancement not only would provide the user more control over the printing or copying process as the Examiner indicates (Final Act. 28), but it also uses prior art elements predictably according to their established functions—an obvious improvement. *See KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417 (2007).

To the extent that Appellant contends that the proposed enhancement to Nakagawa would have been uniquely challenging or otherwise beyond the level of ordinarily skilled artisans, there is no persuasive evidence on this record to substantiate such a contention. *See id.*; *see also Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007). That Asai may not disclose monthly printing limits and print usage as Appellant contends (Appeal Br. 19) is of no consequence here, for Appellant’s arguments regarding Asai’s individual shortcomings in this regard do not show nonobviousness where, as here, the rejection is based on the cited references’ collective teachings. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Therefore, we are not persuaded that the Examiner erred in rejecting claim 11, and claim 16 not argued separately with particularity.

THE REJECTION OVER NAKAGAWA, ASAI, AND KOGA

Claim 12

We also sustain the Examiner's rejection of claim 12 reciting, in pertinent part, a display control portion that performs a control to display on a display device a preview image forcibly as *the* warning.⁵ Despite Appellant's arguments to the contrary (Appeal Br. 22–25), we see no error in the Examiner's reliance on Koga for at least suggesting the recited limitations.

As noted in the Abstract, Koga's system prevents overlap between regions of an original's image and staple positions. As shown in Koga's Figure 6, after setting the preview mode in step S7, the system determines, among other things, whether parallel movement is possible in step S14. If not, a preview image is displayed while producing an alarm sound *and* an image is displayed indicating the staples' positions *with a conspicuous color*, such as red, or by *flashing* the image in steps S17 and S18. Koga col. 1, 4 – col. 1, 1; col. 5, ll. 39–46; Fig. 6.

Our emphasis on the term “and” above underscores that not only is a preview image displayed under this particular alarm condition, but an image

⁵ Our emphasis on the word “the” underscores the lack of antecedent basis for “the warning” in claim 12 or claim 11 from which claim 12 depends. We, therefore, leave the question of whether this inconsistency renders the claim indefinite under § 112, second paragraph to the Examiner to consider after this opinion.

is *also* displayed essentially warning the user visually with conspicuous colors or flashing visual indicators. *See* Koga col. 5, ll. 39–46. This functionality at least suggests displaying a preview image forcibly as a warning, particularly since the preview and warning images are displayed simultaneously under this alarm condition. *Accord* Ans. 13–14 (noting that Koga displays a preview image as a warning by using a conspicuous color *with* the preview image). We reach this conclusion even assuming, without deciding, that Koga’s preview and warning images are separate images, for providing visual elements commensurate with those in the warning image, such as conspicuous colors, in the accompanying preview image would have been at least an obvious variation to, among other things, highlight the alarm condition via conspicuous visual elements in both images. Such a creative step would have been well within the level of ordinarily skilled artisans, and a predictable use of prior art elements according to their established functions. *See KSR*, 550 U.S. at 417, 421 (“A person of ordinary skill is also a person of ordinary creativity, not an automaton.”).

We reach this conclusion despite Koga’s displaying a preview image regardless of whether parallel movement is possible in step S14 of Figure 6 as shown in steps S15 and S16 as Appellant indicates. *See* Appeal Br. 22–25. Not only does the claim not preclude displaying preview images in these situations as the Examiner indicates (Ans. 13), the Examiner does not rely solely on Koga’s preview image as the warning, but rather the preview image *with the conspicuous color*. *See* Ans. 13–14. This added visual alert is provided only in connection with Koga’s preview image displayed in the alarm condition in step S16—not the preview image displayed when parallel

movement is possible in step S15. *See* Koga col. 5, ll. 39–55. So to the extent that Appellant relies on the preview image displayed in step S15, this particular preview image is irrelevant to the Examiner’s finding that relies on the preview image displayed in step S16. *See* Ans. 13–14.

Therefore, we are not persuaded that the Examiner erred in rejecting claim 11.

Claim 13

We also sustain the Examiner’s rejection of claim 13. Claim 13 depends from claim 12 and adds that when the preview image is displayed, the display control portion also performs control to display on the display device a warning message showing that the number of printed sheets or printing exceeds the upper-limit number at the same time.

Despite Appellant’s arguments to the contrary (Appeal Br. 26–27), we see no error in the Examiner’s reliance on the cited prior art for at least suggesting the recited limitations. *See* Final Act. 30; Ans. 14–16. On this record, we see no reason why an excess page warning message, such as that shown in Asai’s Figure 14B (“NUMBER OF PAGES GREATER THAN TOTAL NUMBER OF PAGES”), could not be displayed simultaneously with the preview image under the Examiner’s proposed combination to, among other things, warn the user of the identified condition along with the preview image. Such an enhancement uses prior art elements predictably according to their established functions—an obvious improvement. *See KSR*, 550 U.S. at 417. That Asai’s Figure 14B shows various images that

are displayed simultaneously with the excess page warning message only bolsters the Examiner's findings and conclusions in this regard.

Also, despite Appellant's arguments to the contrary (Appeal Br. 26–27), we find the Examiner's reason to combine the teachings of the cited references is supported by articulated reasoning with some rational underpinning to justify the Examiner's obviousness conclusion for the reasons noted previously and those indicated by the Examiner. We reach this conclusion even assuming, without deciding, that neither Asai nor Koga articulates a reason to modify Nakagawa as proposed as Appellant contends in the heading on page 27 of the Appeal Brief. It is well settled that “[t]he motivation [to combine references] need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself.” *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1361 (Fed. Cir. 2006) (citation omitted). So to the extent that Appellant contends that the Examiner's rationale to combine the cited references must be articulated in the cited references themselves (*see* Appeal Br. 27), we disagree.

Accordingly, we are not persuaded that the Examiner erred in rejecting claim 13.

Claim 14

We also sustain the Examiner's rejection of claim 14 reciting, in pertinent part, the upper-limit-number storage portion storages [sic], for each user, an upper-limit number of color printed sheets or color printing every

fixed period and an upper-limit number of monochrome printed sheets or monochrome printing every fixed period as the upper-limit number of printed sheets or printing every fixed period. The claim adds that the count portion counts the number of color and monochrome printed sheets separately, and the display control portion performs a control to forcibly display the preview image to the user that causes the counted number of color or monochrome printed sheets or printing to exceed the stored upper-limit number.

Despite Appellant's arguments to the contrary (Appeal Br. 28–31), we see no error in the Examiner's reliance on the cited prior art's collective teachings for at least suggesting the recited limitations. First, Appellant's arguments pertaining to Koga's alleged shortcomings regarding displaying a preview image regardless of the outcome of step S14 in Figure 6 (Appeal Br. 29–30) are unpersuasive for the reasons previously discussed. Second, Appellant's contention that Koga does not teach or suggest displaying a preview image to *a user that causes* the number of color or monochrome printed sheets (or printing) to exceed an upper-limit number (Appeal Br. 29–31) is likewise unpersuasive. Leaving aside the fact that this user-based causation is an active method step in an apparatus claim—an inconsistency that renders the claim indefinite as noted previously⁶—it is nevertheless at least suggested by the cited prior art, particularly given the functionality of Asai's Figures 13C and 14B that enables the user to continue printing despite a displayed excess page warning. *Accord* Final Act. 31; Ans. 18

⁶ See *IPXL*, 430 F.3d at 1384; see also *Rembrandt*, 641 F.3d at 1339.

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(noting this warning). Such an enhancement uses prior art elements predictably according to their established functions—an obvious improvement. *See KSR*, 550 U.S. at 417. Appellants’ arguments regarding Koga’s individual shortcomings in this regard do not show nonobviousness where, as here, the rejection is based on the cited references’ collective teachings. *See Merck*, 800 F.2d at 1097.

On this record, then, we find that the cited prior art collectively at least suggests claim 14’s recited limitations, and the Examiner’s reason to combine the teachings of the cited references is supported by articulated reasoning with some rational underpinning to justify the Examiner’s obviousness conclusion.

Therefore, we are not persuaded that the Examiner erred in rejecting claim 14.

THE OTHER OBVIOUSNESS REJECTION

We also sustain the Examiner’s obviousness rejection of claim 15. Final Act. 32–33. Because this rejection is not argued separately with particularity, we are not persuaded of error in this rejection for the reasons previously discussed.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/ Basis	Affirmed	Reversed	New Ground
1-6, 11-15	112, second paragraph	Indefiniteness	1-6, 11-15		11-15
11, 16	103	Nakagawa, Asai	11, 16		
12-14	103	Nakagawa, Asai, Koga	12-14		
15	103	Nakagawa, Asai, Murakami	15		
Overall Outcome			1-6, 11-15		11-15

TIME PERIOD FOR RESPONSE

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).

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, the 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

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both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

AFFIRMED; 37 C.F.R. § 41.50(b)