

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MANABU HIRATA

Appeal No. 2001-1624
Application 09/164,583¹

ON BRIEF

Before THOMAS, BARRETT, and BARRY, Administrative Patent Judges.
BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1-18.

We reverse.

¹ Application for patent filed October 1, 1998, entitled "Image Forming Apparatus That Permits Easy Job Registration."

BACKGROUND

The invention relates to an apparatus and method for registering a new job in a printer in a simple fashion by selecting a job that is already registered, editing or revising the copy modes if desired, and registering the job as a new job. This is similar to the well-known technique of creating a new document in a word processing system by retrieving an old document, editing it (or not), and giving it a new name.

Claim 18 is reproduced below.

18. A job registration method of an image forming apparatus, comprising:

inputting image data;

registering said image data with operating modes as a job by a first registering means;

selecting a job from among the jobs registered by said first registering means; and

registering said selected job as a new job by a second registering means.

The examiner relies on the following reference:

Gauronski et al. (Gauronski) 5,206,735 April 27, 1993

Claims 1-18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Gauronski.

We refer to the final rejection (Paper No. 9) (pages referred to as "FR__") and the examiner's answer (Paper No. 16) (pages referred to as "EA__") for a statement of the examiner's

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rejection, and to the brief (Paper No. 15) (pages referred to as "Br__") and reply brief (Paper No. 17) (pages referred to as "RBr__") for a statement of appellant's arguments thereagainst.

OPINION

Comments regarding Summary of the Invention

We have considered the examiner's disagreements with the Summary of the Invention (EA3) and appellant's response (RBr1-3). Normally we would not say anything about this matter because it is a matter of procedure, not substance, and the panel evaluates the rejection based on the claim language, not the Summary of the Invention. However, in view of the effort appellant took in responding, we present a short discussion.

We find nothing wrong with the Summary of the Invention and, in fact, find it to be succinct, complete, and accurate. While the examiner objects to the summary of conventional copying machines as improper in a description of the invention, we find such a description helpful as background in understanding the invention without having to refer to the specification. The Summary of the Invention accurately describes the claimed invention. As to the examiner's objection to the analysis of certain claims in the Summary, the Summary of the Invention points out (at Br3) that this is recommended practice in the Manual of Patent Examining Procedure § 1206.

Anticipation

Appellant notes that each of the independent claims has language which recites selecting a job from among registered jobs and registering the job as "a new job," with or without revision (Br5). It is argued that Gauronski selects a job, edits the job, and then returns the edited job to memory so that the original, unedited job no longer exists, so Gauronski does not disclose registering the edited job as a "a new job" (Br5-6). It is argued that "new job" clearly refers to a job that is added to a job list as another job to be processed in addition to the (old) job that was used to "create" the "new job" (Br6; RBr4), whereas Gauronski is merely an edited job that replaces the job on the job list that was used to create the "edited job" (Br6).

The examiner states that the specification does not support the view that a "new job" is a job in addition to the "old job" that was revised (EA10). The examiner refers to page 3, lines 24-26, page 4, lines 3-5, and page 21, lines 18-20, as support for the interpretation that a revised job is a new job and that there is no reference to keeping the old job (the job that was revised) (EA10). The examiner maintains that "[i]f a job is edited then it is referred to as [sic] a **new job**" (FR6). The examiner states that there is no requirement in the specification that the old job, which is revised or edited, is

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kept (EA10), or that "the new job must be or [sic, of] a nature to include the old job plus the revised one" (EA11).

Appellant refers to the description of the new registration key F503 registering a selected job as a new job with or without revision and the revise key F505 revising the copy modes of a registered, but not yet processed job, but registration of a new job does not take place (RBr4). It is argued that one of ordinary skill in the art would clearly understand from the disclosure the difference between a revised (edited) job and the registration of a "new job" (RBr4).

We conclude that the examiner erred in interpreting the revised job in Gauronski to be a "new job." There is clearly a semantic distinction between a "revised job," the same job but changed, modified, or edited in some way, and a "new job," a job which has just been created. Contrary to the examiner's findings, the specification clearly distinguishes between a "new job," created by revising an existing job, and a "revised job." As shown in Fig. 8, there are separate paths for "New" and "Revise." As shown in Fig. 11, there is a separate new registration key F503, a delete key F504, a revise key F505, and an end key F506 for use in connection with selection of a job that is already registered (spec. at 23, lines 23-26). The new registration key F503 is pressed when the selected job is registered as a new job with or without revision (spec. at 23,

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line 26, to page 24, line 2). However, "[w]hen the revise key F505 is operated, the copy modes of a registered job are revised but registration of a new job does not take place." (Emphasis added.) (Spec. at 24, lines 5-7.) To take a word processing example, if a user retrieves an existing document, revises it, and saves it under the same name, this becomes a "revised document," whereas if the user retrieves an existing document and saves it under a new name, with or without revision, this becomes a "new document" using the common meaning of words. The examiner has not said how else appellant could claim the invention if there is no difference between a "revised job" and a "new job." Because Gauronski does not disclose saving (registering) the revised job as a "new job," it fails to anticipate the claims on appeal. Accordingly, the rejection of claims 1-18 is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
LANCE LEONARD BARRY)	

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Administrative Patent Judge)
McDERMOTT WILL & EMERY
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096