

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 45

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROYUKI ASAI and YOICHI KAWABUCHI

Appeal No. 2002-2155
Application No. 09/003,276

HEARD: February 19, 2003

Before COHEN, FRANKFORT, and MCQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3 and 5 through 17, all of the claims remaining in this application. Claims 2, 4 and 18 have been canceled.

Appellants' invention relates to an image forming system having means for selecting a confidential mode wherein the system automatically finishes copies as confidential documents or as a

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personal letter for protection of privacy. More particularly, as indicated on page 2 of the specification, the invention includes selecting means for selecting a confidential mode and control means which, when the confidential mode is selected, controls the folding means and stapling means of the system to fold a sheet in two with the formed image inside and staple the folded sheet along a side opposite the fold. Independent claims 1, 10, 14 and 16 are representative of the subject matter on appeal and a copy of those claims can be found in the Appendix to appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Higashio et al. (Higashio)	5,060,921	Oct. 29, 1991
Kanou et al. (Kanou)	5,769,404	Jun. 23, 1998

Claims 1, 3, 5 through 7 and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kanou.

Claims 8 and 10 through 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kanou in view of Higashio.

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Rather than reiterate the examiner's full commentary concerning the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we make reference to the examiner's answer (Paper No. 35, mailed April 25, 2002) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 34, filed March 26, 2002) and reply brief (Paper No. 37, filed June 24, 2002) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

Looking first to the examiner's rejection of claims 1, 3, 5 through 7 and 9 under 35 U.S.C. § 102(b), we observe that, in pertinent part, the examiner has made the determination that Kanou discloses

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selecting means 220 and control means 202 which can be programmed to designate whether the image to be formed is confidential by directing the apparatus to operate in a "confidential mode" (i.e., with an image folded in two, the image folded inside, stapled over, and with a reverse side image). The control means 220 is an interface with selection keys; see figure 109.

With reference to claims 7 [sic, claim], Kanou discloses reverse side image forming means which may include means to denote the sheet is confidential, so this limitation is inherent in the system disclosed by Kanou (answer, pages 3-4).

On page 5 of the answer, the examiner makes the further assertion that Kanou teaches a plurality of control keys (231-236) in order to select a confidential mode, and on page 6, that each key of the plurality of keys is individually considered to be "a means for selecting a confidential mode i.e., control key 236 (figure 109) for selecting a confidential two folding mode."

Having reviewed and evaluated the teachings of the applied Kanou reference, we are of the opinion that the examiner's position regarding the purported anticipation of independent claim 1 on appeal has improperly disregarded the full details of the "means for selecting a confidential mode" set forth in appellants' claim 1. More particularly, we share appellants' view that the examiner has failed to properly interpret the

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"means for selecting a confidential mode" in accordance with 35 U.S.C. § 112, sixth paragraph. As was made clear in In re Donaldson Co. Inc., 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994), the sixth paragraph of 35 U.S.C. § 112 permits an applicant to express an element in a claim for a combination as a means or step for performing a specified function without the recital of structure, materials or acts in support thereof, and mandates that such a claim limitation

shall be construed to cover the corresponding structure, materials, or acts described in the specification or equivalents thereof.

In this case, it is clear to us, as has been argued by appellants in their brief (pages 4-8) and reply brief, that the purported "means for selecting a confidential mode" pointed to by the examiner in Kanou are not the same (structurally or functionally) as those described in appellants' specification, and also clear that the examiner has not meaningfully attempted to articulate any reasoning as to why the structure of the applied Kanou patent should be considered to be an equivalent of the means which is set forth in appellants' specification and claims.

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Appellants' system includes a single control key (120) for selecting a confidential mode to designate the image as confidential and for automatically setting in motion associated hardware and software of the image forming system for copying in a confidential mode whereby when a sheet bearing a copied confidential image reaches the finisher (9) it is automatically folded to hide the confidential image inside and then stapled to prevent access thereto. By contrast, Kanou makes no mention whatsoever of copying in a confidential mode and neither carries out the function of selecting a confidential mode nor includes structure that is either identical to, or insubstantially different from, appellants' claimed confidential mode selection key (120) and its associated hardware and software.

The examiner's theory that folding mode selector key (242) and related indicator (236) of Kanou correspond to appellants' claimed "means for selecting a confidential mode" and inherently define a confidential procedure or mode of operation, is, for the reasons set forth in appellants' brief and reply brief, entirely without foundation. In appellants' invention, an operator need only press one key, the confidential mode selection key (120), to set the imaging forming system into the confidential mode that

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automatically preforms inversion, folding and stapling of a print sheet to conceal the printed confidential image. The folding mode selection key (242) of Kanou does not perform that same function, and is not an equivalent of appellants' confidential mode selection key (120).

Since we have determined that the teachings which would have been fairly derived from Kanou would not have anticipated the subject matter of claim 1 on appeal, we must refuse to sustain the examiner's rejection of that claim under 35 U.S.C. § 102(b). It follows that the examiner's rejection of claims 3, 5 through 7 and 9, which depend from claim 1, will also not be sustained.

With regard to the examiner's rejection of claims 8 and 10 through 17 under 35 U.S.C. § 103(a) based on the collective teachings of Kanou and Higashio, we observe that the examiner has relied upon Higashio for a teaching of a stamping unit (200A) and urged that it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to use the stamping unit disclosed by Higashio as a reverse side image forming means on the image forming system disclosed by Kanou in order to stamp

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the word "Confidential" on the reverse side of sheets to indicate confidentiality. However, even if this were so, we note that the teachings of Higashio do nothing to make up for or otherwise supply that which we have indicated above to be lacking in the teachings of Kanou. Neither Kanou nor Higashio disclose a "means for selecting a confidential mode" as set forth in claims 1 and 10 on appeal, a "means for designating the image as confidential when a confidential mode has been selected" as in claim 14, or "a designating device designating the image as a confidential image when a confidential mode has been selected" as in claim 16. Thus, Higashio fails to bridge the gap between Kanou and the subject matter of the rejected claims and would not have taught or suggested the claimed invention as a whole in combination with Kanou. Accordingly, the examiner's rejection of claims 8 and 10 through 17 under 35 U.S.C. § 103(a) will also not be sustained.

To summarize, neither the examiner's rejection of claims 1, 3, 5 through 7 and 9 under 35 U.S.C. § 102(b) as being anticipated by Kanou, nor the rejection of claims 8 and 10 through 17 under 35 U.S.C. § 103(a) based on Kanou and Higashio has been sustained.

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The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
JOHN P. MCQUADE)	
Administrative Patent Judge)	

CEF/lbg

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BARRY E BRETSCHNEIDER
MORRISON & FOERSTER
1650 TYSONS BOULEVARD
SUITE 300
MCLEAN, VA 22102