

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YOON-SEOP EOM, CHANG-SUB LEE and DONG-HO LEE

Appeal No. 1998-0938
Application 08/377,532

ON BRIEF

Before, BARRETT, FLEMING and DIXON, **Administrative Patent Judges.**

FLEMING, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 22, all of the claims pending in the present application.

The present invention relates to a device for controlling data transmission/reception between electrophotographic printers from local and remote areas and a method

thereof. On page 15 of the specification, appellants disclose that Figure 1 illustrates a communication system of the present invention. In Figure 1, a data transmission/reception device is attached to an existing printer (100) for adapting the printer (100) to function as a facsimile machine, and for enabling the printer (100) not only to print both image signals from a host computer (400) and facsimile messages from a remote facility, such as either a remote fax machine (300) or a remote computer (200) via a private service telephone network, but also transmits the facsimile messages received from either the remote fax machine (300) or the remote computer (200) to the host computer (400) for a visual display on a computer screen and in accordance with the user's selection. On pages 15 and 16 of the specification, appellants disclose that Figure 2 shows the preferred embodiment of the data transmission/reception device according to the present invention. Appellants disclose that the fax/modem transmission/reception unit which is newly added to a well-known electrophotographic printer according to the present invention, comprises a ring heard detector (28) for detecting a ring signal indicative of a facsimile reception; a modular/demodular (26) for demodulating the data transferred from the remote facsimile (300) and modulating the data supplied from a host computer (400) connected to a printer; a control part (22) and (29) for controlling the modulator/demodulator (26) to start the facsimile reception if the

ring signal has been detected, and transmitting the data demodulated by the modulator/demodulator (26) to either an engine control part (20) for enabling direct printing or to a host computer (400) depending upon whether the printer (100) is set in one of a print mode or a facsimile mode, and transmitting the data supplied from the local computer (400) to the modulator/demodulators (26) for modulation and transmission of either remote facsimile machine (300) or the remote computer (200) in dependence upon whether the printer (100) is set in one of the print modes or facsimile modes.

Independent claim 7 is reproduced as follows:

7. A method for transferring facsimile data in a printer between a host computer and one of a remote computer and a remote facsimile machine, said method comprising the steps of:

detecting a ring signal indicative of facsimile data being transmitted from one of said remote computer and said remote facsimile machine;

receiving said facsimile data transmitted from one of said remote computer and said remote facsimile machine;

determining whether said printer is set in one of a print mode and a facsimile mode;

printing the received facsimile data, when said printer is set in said print mode; and

transferring the received facsimile data to said host computer for a visual display on a computer screen, when said printer is set in said facsimile mode.

The examiner relies on the following references:

Koshiishi	4,652,933	Mar. 24, 1987
Seo	5,383,030	Jan. 17, 1995

Claims 1, 3, 4 and 7 through 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Seo in view of Koshiishi. Claims 2, 5, 6 and 20 through 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Seo in view of Koshiishi and the examiner's notice of well-known prior art.

Rather than reiterate the arguments of appellants and the examiner, reference is made to the briefs¹ and answers² for the respective details thereof.

OPINION

We will not sustain the rejection of claims 1 through 22 under 35 U.S.C. § 103.

The Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d

¹Appellants filed an appeal brief on January 24, 1997. Appellants filed a reply brief on July 7, 1997. The examiner responded to the reply brief with a supplemental examiner's answer dated October 28, 1997, thereby considering and entering the reply brief. Appellants filed a supplemental reply brief on January 2, 1998. The examiner responded to the supplemental reply brief with a letter on January 14, 1998 stating that the reply brief has been entered and considered.

² The examiner mailed an examiner's answer on May 7, 1997.

Appeal No. 1998-0938
Application 08/377,532

989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." ***Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.***, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), ***cert. denied***, 519 U.S. 822 (1996), citing ***W. L. Gore & Assocs., Inc. v. Garlock, Inc.***, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), ***cert. denied***, 469 U.S. 851 (1984).

On pages 7 through 20 of the brief, appellants point out that all the independent claims recite either an apparatus or method in which the printer is set in one of a print mode or a facsimile mode. The claims further recite that if the printer is set in the print mode, the facsimile data received from either a remote computer or a remote facsimile machine is directly printed on printable medium. If the printer is set in a facsimile mode, the received facsimile data is transferred to the host computer for a visual display on a computer screen. Appellants argue that neither Seo nor Koshiishi teaches the print mode or the facsimile mode as recited in these claims.

Upon our review of Seo and Koshiishi, we fail to find that the examiner has provided evidence of a printer that is capable of being set in a print mode or a facsimile mode and operate as set forth in appellants' claims. We note that there is no teaching in Seo to transfer image data received from a host computer for either direct printing or

for transmission to a remote facility such as a remote facsimile machine or remote computer or to transfer image data received from either a remote computer or a remote facsimile machine to a host computer in dependence upon whether the printer is set in one of a print mode or a facsimile mode as defined by appellants' claims. Furthermore, we agree with the examiner that Koshiishi teaches four separate modes of operation of a working PC in conjunction with a facsimile machine. However, there is no suggestion or teaching in Koshiishi that would provide a printer system that is operable in either a print mode or a facsimile mode as defined by appellants' claims.

We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a *prima facie* case. *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984); *In re Knapp-Monarch Co.*, 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); *In re Cofer*, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966). Furthermore, our reviewing court states in *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788 the following:

The Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) focused on the procedural and evidentiary processes in reaching a conclusion under section 103. As adapted to *ex parte* procedure, *Graham* is interpreted as continuing to place the "burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103". *In re Warner*, 379 F.2d 1011,

Appeal No. 1998-0938
Application 08/377,532

1016, 154 USPQ 173, 177 (CCPA 1967).

We have not sustained the rejection of claims 1 through 22 under 35 U.S.C.

§ 103. Accordingly, the examiner's decision is reversed.

REVERSED

LEE E. BARRETT)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
JOSEPH L. DIXON)	
Administrative Patent Judge)	

vsh

Appeal No. 1998-0938
Application 08/377,532

ROBERT E. BUSHNELL ATTORNEY-AT-LAW
1522 K STREET, NW
SUITE 300
WASHINGTON , DC 20005-1202