

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHANG-SUB LEE

Appeal No. 2001-0596
Application 08/824,344

HEARD: JUNE 13, 2002

Before JERRY SMITH, DIXON and LEVY, Administrative Patent Judges.
JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-17, which constitute all the claims in the application.

The disclosed invention pertains to a method and apparatus for changing printer drivers in a computer-printer system.

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Representative claim 1 is reproduced as follows:

1. A method for changing printer drivers in a computer-printer system, comprising the steps of:

 sending a print command to a printer to begin a print operation;

 periodically transmitting a response request signal to said printer;

 determining that an error has occurred when said printer fails to respond to said response request signal;

 checking whether said error corresponds to any one of a plurality of specific error types stored in a memory of a computer of said computer-printer system;

 stopping said print operation when said step of checking determines that said error does not correspond to any of said specific error types stored in said memory;

 changing from a printer driver initially set to control said printer to a second printer driver stored in said memory when said error corresponds to one of said specific error types corresponding to an abnormal operation state of said initially set printer driver; and

 setting up said second printer driver to control said printer and returning to said step of periodically transmitting said response request signal to said printer.

The examiner relies on the following references:

Gase et al. (Gase)	5,580,177	Dec. 03, 1996
Kageyama et al. (Kageyama)	5,625,757	Apr. 29, 1997
		(filed Dec. 21, 1994)

Claims 1-17 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Kageyama in view of Gase.

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Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-17. Accordingly, we reverse.

Appellant has indicated that for purposes of this appeal the claims will all stand or fall together as a single group [brief, page 4]. Consistent with this indication appellant has made no separate arguments with respect to any of the claims on appeal. Accordingly, all the claims before us will stand or fall

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together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will consider the rejection against independent claim 1 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore

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Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness.

Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444

(Fed. Cir. 1992). If that burden is met, the burden then shifts

to the applicant to overcome the prima facie case with argument

and/or evidence. Obviousness is then determined on the basis of

the evidence as a whole and the relative persuasiveness of the

arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ

685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472,

223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d

1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments

actually made by appellant have been considered in this decision.

Arguments which appellant could have made but chose not to make

in the brief have not been considered and are deemed to be waived

by appellant [see 37 CFR § 1.192(a)].

With respect to representative claim 1, the examiner's rejection is set forth on pages 3-5 of the examiner's answer.

Appellant argues that there is no teaching in Kageyama or Gase of stopping said print operation when said step of checking

determines that said error does not correspond to any of said

specific error types stored in said memory. Specifically,

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appellant argues that there are no unknown specific error types in Kageyama. Appellant also argues that there is no error determined in Gase because Gase simply replaces a working printer driver with a newer version of the driver [brief, pages 5-14]. The examiner responds that the apparatus of Kageyama stops the printing operation when the printer fails to respond to the response request signal. The examiner also notes that Gase teaches the replacement of an initial printer driver with a second printer driver due to an abnormal operational state of the initial driver [answer, pages 9-13]. Appellant responds that there is no provision in Kageyama corresponding to an abnormal operational state of an initially set printer driver, and Gase does not replace an initially set printer driver in response to an abnormal condition. Appellant also responds that the commands generated in Kageyama do not correspond to the errors detected in the claimed invention [reply brief].

We agree with the position argued by appellant. In our view, the examiner has not properly interpreted an error in view of the language of the claim. More particularly, representative claim 1 specifically defines an error "as occurring when said

printer fails to respond to said response request signal." Thus, when the term "said error" is used later in claim 1, it must be an error that occurred when the printer failed to respond to a response request signal. We agree with the examiner that Kageyama does teach that his printer will shut down when the printer fails to respond to a response request signal or receives the wrong command when the communication preparation completion command is expected [column 63, step (i)]. At all other times, however, Kageyama only shuts down when a command is received which cannot be classified. Thus, Kageyama also teaches that the host computer will classify a command received from the printer in response to a response request signal [id., step (l)]. Although this command forces shutdown if it cannot be classified, such a command is not an error as defined in claim 1 because the printer has, in fact, responded with a command and not with a failure to respond as claimed. The same holds true for step (r) in the apparatus of Kageyama.

Thus, every "error" in Kageyama, except for the communication regarding preparation completion, results from a command which cannot be classified rather than from a failure to respond as claimed. There is no suggestion that an error corresponding to an abnormal operational state of the initially

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set printer driver would lead to a failure to respond to a response request signal. Although the examiner relies on Gase as teaching replacing the initially set printer driver, the replacement in Gase is not based on an abnormal operational state of the initially set driver, but instead, is based on a desire to update an operational initial driver with a newer version of the driver. This basis for replacing the initially set printer driver could never appear in Kageyama as a failure to respond to the response request signal. Since an error is specifically defined in claim 1 as noted above, the command to replace the driver in Gase could never meet the definition of an error as defined in claim 1. Therefore, an "error" corresponding to an abnormal operational state of the initially set printer driver would not be an "error" as defined in claim 1.

Since we find that the examiner has not properly interpreted an error as defined in claim 1, we also find that the examiner has failed to establish a prima facie case of obviousness. Therefore, we do not sustain the examiner's

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rejection of claims 1-17. Accordingly, the decision of the
examiner rejecting claims 1-17 is reversed.

REVERSED

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JERRY SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH L. DIXON)	
Administrative Patent Judge)	APPEALS AND
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