

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HENDRICUS M.J.C. VAN KURINGEN

Appeal No. 2002-1885
Application No. 08/966,453

HEARD: MARCH 20, 2003

Before BARRETT, GROSS, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-9¹, which are all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to a controller for a printing unit. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced as follows:

¹ The rejection of claims 1-9 under 35 U.S.C. § 112, first paragraph, has been withdrawn by the examiner (answer, page 2).

1. A controller for a printing unit, the controller comprising:

a mother board having

a central processing unit (CPU),

a first bus system to which said CPU is directly connected and to which at least one of a user input device, a first memory and an interface to a host computer is directly connected, and

a non-processing connector arrangement to make a direct connection to said first bus system for devices that are off said mother board without said connector arrangement processing data passing therethrough,

a memory board having

a second memory, different than said first memory, including at least one integrated circuit (I/C) memory chip, directly connected to said first bus system via said connector arrangement, for storing at least one of bitmap data and compressed bitmap data of a page to be printed, and

a second bus system to which said second memory including said at least one IC memory chip also is directly connected; and

a reader, connected to said second bus system, for reading at least one of said bitmap data and said compressed bitmap data of said page and for providing the read-data to said printing unit.

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, appellant's arguments set forth in the brief 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 invention as set forth in claims 1-9.

Accordingly, we reverse, for the reasons set forth by appellant.

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. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore 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. 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).

The examiner's position (answer, pages 3-9) with respect to claims 1, 2, 4, 5, 7, and 9 is that Suzuki does not teach a non-processing connector arrangement to make a direct connection to the first bus system for devices that are off the mother board without the connector arrangement processing data passing therethrough. To make up for this deficiency in Suzuki, the

examiner turns to the admitted prior art of figure 2 for a teaching of a non-processing connector arrangement 16 which makes a direct connection with the first bus system 14 for devices that are off of the mother board without the connector arrangement processing data passing therethrough. The examiner asserts (id.) that it would have been obvious to replace the connector arrangement 25, 30 of Suzuki with the non-processing connector 16 of the admitted prior art. The examiner's rationale (answer, page 5) is that:

(1) a non-processing connector arrangement is cheaper in cost than an image processor connector arrangement; and, (2) a non-processing connector arrangement would provide a faster or quicker data transmission since no data processing or processing is performed.

With regard to claims 3, 6, and 8 the examiner takes Official Notice that single in-line memory modules (SIMMs) are old and well known, and asserts that it would have been obvious to use a SIMM as the IC memory chip (claims 3 and 6) or board (claim 8) of Suzuki.

Appellant agrees with the examiner (brief, page 14) that connector 16 is a non-processing connector, but traverses the examiner's rationale for combining the references. Appellant asserts (brief, page 15) that replacing image processor 25 and second bus 30 of figure 16 of Suzuki with the non-processing

connector 16 of the admitted prior art would render the system of figure 16 of Suzuki inoperative. Figure 11 of Suzuki presents a representation of the element to raster conversion that takes place within image processor 25. If the conversion was performed by CPU 22, the CPU 22 and bus 20 would be busy for long periods of time. It is argued that if the image processor 25 and the bus 30 of figure 16 of Suzuki were removed and replaced with the non-processing connector 16 of the admitted prior art, then element information 60 would be provided directly to raster memory 31, and printer 50 would fail to operate because it would be provided with element information, not raster data. The examiner responds (answer, page 14) that the modification would not render Suzuki inoperative, and that the modification would have been obvious because

the CPU 22 in the Suzuki patent (see figure 16) can perform the conversion process into raster data, as admitted by the Appellant on page 15 of the Appeal Brief filed June 19, 2001 and as disclosed by Suzuki (U.S. Patent 4,722,064) at column 5, lines 43-56 and column 7, lines 48-55.

At the outset, we note that we do not agree with the examiner that 25 and 30 of Suzuki represent connectors. Suzuki discloses (col. 5, line 32) image processor 25. Image processor 25 reads element information from element memory 23 and converts

the information into raster information (col. 5, lines 62-67). As shown in figure 5, second bus 30 is connected to output terminal 25h of image processor 25 (col.6, lines 8 and 9). Figure 11 (col. 7, line 42, et seq.) explains the operations by which image processor 25 converts element information from memory 23 into raster information. Raster information is outputted to second bus 30 through an interface 25g. This information is stored in raster memory 31 (col. 8, lines 44-46).

From this disclosure of Suzuki, we find that 25 and 30 of Suzuki are not connectors as advanced by the examiner. In addition, as to the portions of Suzuki relied upon by the examiner as a teaching that the image processor 25 and bus 30 are not needed because CPU 22 can process the element information into raster data, the examiner relies upon col. 5, lines 43-56, which recites that:

The CPU 22 is composed of a well known micro-processor, memory elements required for the operation therefor, and the peripheral circuits thereof. The CPU controls operations of the respective devices in accordance with a predetermined program. This program has been stored in a memory element (not shown) incorporated therein. Targets of the control are, for example, processing for fetching element information from an external system through the interface 21, processing for converting element information into raster information by means of the processor 25, processing for operating the printer 50 by means of the

printer controller 24 and the like processing, thus the CPU generalizes and controls the whole system.

The examiner additionally relies upon col. 7, lines 48-55, which recites that:

First, the CPU 22 (FIG. 5) feeds a command having such meaning that converts a prescribed number of element information beginning with a specified address in the element memory 23 into raster information to an instruction register 25b of the image processor 25 whereby the image processor 25 starts conversion processing of a series of element information into raster information.

From this disclosure of Suzuki, we find that CPU 22 controls operations of the respective devices in accordance with a predetermined program. Targets of the control include "processing for converting element information into raster information by means of the image processor 25" (col. 5, lines 51-53). We further find that CPU 22 feeds commands for converting a prescribed number of element information beginning with a specified address in the element memory 23 "into raster information to an instruction register 25b of the image processor 25, whereby the image processor 25 starts conversion processing of a series of element information into raster information" (col.7, lines 51-55).

From these disclosures of Suzuki, we find that although CPU 22 controls the whole system, and feeds commands for the

conversion of element information into raster information, it is the image processor 25 that converts the series of element information into raster information. Thus, we find no teaching or suggestion in Suzuki that the CPU can perform the operations of the image processor 25. Nor do we find any admission by appellant on page 15 of the brief, as advanced by the examiner, that CPU 22 can perform the conversion process. What appellant states (on page 15 of the brief) is that if the conversion was performed by CPU 22, the CPU 22 and bus 20 would be busy for long periods of time, and that Suzuki provides the image processor 25 in order to free the CPU 22 and the bus 20 from being paralyzed by the element-to-raster conversion. Appellant goes on to state (brief, page 16) that if the modification were made, the embodiment of figure 16 of Suzuki would be rendered inoperative. In sum, because Suzuki relies upon the image processor 25 to convert the element information into raster information, and does not teach or suggest that the CPU 22 can be used instead to convert the element information into raster information, we agree with appellant (brief, page 16) that:

If when combined, the references "would produce a seemingly inoperative device," then they teach away from their combination. In re Sponnoble, 56 C.C.P.A. 823, 405 F.2d 578, 587, 160 U.S.P.Q. 237, 244 (CCPA 1969); see also In re Gordon, 733 F.2d 900, 902, 221

U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) [**14] (finding no suggestion to modify a prior art device where the modification would render the device inoperable for its intended purpose).

Accordingly, from all of the above, we find that the examiner has failed to establish a prima facie case of obviousness of claims 1-9. The rejection of claims 1-9 under 35 U.S.C. § 103(a) is therefore reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-9 under 35 U.S.C. § 103(a) is reversed.

REVERSED

LEE E. BARRETT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ANITA PELLMAN GROSS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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