

DECISION OF THE COMMISSIONER

UNOBEVIOUS: New Claims under R. 46(3)

Only the two new claims were considered. The applicant held entitled to claims of the scope of new claim 2 in that the concept of the specific test document in combination is not taught by the prior art. Consequently the rejection of the original claims is supported; and new claim 1 is held inadmissible.

FINAL ACTION: Amendment permissible in-part.

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This decision deals with a request for review by the Commissioner of Patents of the Examiner's Final Action dated May 1, 1972 on application 053,265. This application was filed in the name of Armand M. Johnston et al and refers to "Self Test Apparatus For Facsimile Graphic Communication System". The Patent Appeal Board conducted a hearing on July 25, 1972. Mr. R.F. Delbridge represented the applicant.

In the prosecution terminated by the Final Action the examiner refused the claims of the application in that they are not patentably different from the cited reference to CARY - United States patent 3,064,077. Also, the application was refused in view of the patent to CARY and common general knowledge.

In the Final Action the examiner applied the CARY reference and maintained that: the subject matter of the claims is basically taught by the reference, and the only basic difference is that the detected pattern and the printed pattern are on a single document and in his view this did not add patentable subject matter to the claims. He also stated that an acoustic coupling is well known in the art.

The applicant in his response of July 11, 1972 cancelled all the claims and submitted new claims 1 and 2 for consideration. The applicant objected to the grounds used by the examiner in refusing to grant a patent and stated in part:

Besides requiring the special test document, proposed Claim 1 also specifies (as does present claim 3) a dummy telephone handset for coupling the audio signals from the first converting means to the second converting means, the handset including a hollow tube for allowing a close physical and audio relationship with the acoustic coupler. There is no suggestion in Cary of such a dummy telephone handset for providing audio communication between the audio output of a scan acoustic coupler and the audio input of a print acoustic coupler. Cary suggests only direct electric coupling between the scan and print circuitry. The examiner rejected present Claim 3 as defining acoustic coupling which is well known in the art. However, there is clearly no justification that the dummy telephone handset defined in present Claim 3 and proposed Claim 1 is well known in the art. It is therefore believed that proposed Claim 1 is clearly allowable.

In view of the fact that the applicant has, by requesting cancellation, declared no interest in the claims presently on file, the Board will not consider these claims; however, new claims 1 and 2 will be considered. The nature of the invention is fairly indicated by new claim 1 which reads:

In a facsimile transceiver including a scanner, a printer, and scan and print circuitry operating in conjunction with said scanner and printer in the respective modes thereof, apparatus for testing the effectiveness of operation of said transceiver comprising:
means for simultaneously energizing said scan circuitry and said print circuitry to enable simultaneous scanning and printing;
an acoustic coupler for coupling the output of said scan circuitry to the input of said print circuitry, said acoustic coupler including first means for converting the output of said scan circuitry into audio signals representative thereof, and second means for converting audio signals into electrical signals for application to said print circuitry;

a dummy telephone handset for coupling the audio signals from said first converting means to said second converting means, said handset including a hollow tube for allowing a close physical and audio relationship with said acoustic coupler; and

a special test document that is simultaneously scanned by said scanner and printed upon by said printer, the print quality on said document being an indication of the effectiveness of the operation of said transceiver.

The reference to CARY basically teaches a facsimile transceiver with transmitting and receiving capabilities, and which includes:

- a) a means for scanning and detecting a pattern on a document;
- b) a means for receiving and printing a pattern on a record sheet;
- c) a means for simultaneously enabling the transmit and receive capabilities;
- d) a means for coupling the output of the scan circuitry (transmit) to the input of the print circuitry (receive) and
- e) the coupling means being an electric coupler (switch).

It is noted that the CARY reference teaches the concept and the means by which a transceiver is connected to a copier and by applying the principles taught by CARY to the telecopier, i.e. connecting the transceiver output to its input circuitry and operating the detector and printer simultaneously, the expected and only result is that the telecopier will detect any pattern on the record medium and will print it on the same record medium, but normally in the form of an overlap print.

With respect to the type of coupling used for connecting the transceiver output to the input circuitry, page 14 line 11 of the disclosure reads: "While the embodiment shown in Figure 2 is described in conjunction with an acoustic coupler, any facsimile transceiver utilizing electric, inductive or other coupling would work as well" Therefore, the type of coupling used becomes a matter of choice.

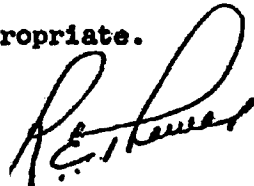
The fact that applicant substitutes a particular acoustic type coupler, such as that shown in Figure 1 of this application as prior art, combined with a "dummy telephone handset for coupling the audio signals" which is nothing more than a form of a commonly used air tube; as opposed to an electrical coupler as shown by switch 164 of figure 4 of the CARY patent; does not, per se, amount to invention over the art of record, and as noted before the expected and only result of the telecopier so connected is that it will detect and print on the same record medium.

The Board, therefore, is satisfied that new claim 1, which is substantially the same as original claim 3, does not set out any patentable subject matter over the reference to CARY and the prior art disclosed in figure 1 of this application.

New claim 2 which is dependent on claim 1 adds a previously unclaimed feature "test document includes first and second minor portions thereof, wherein preselected test indicia is defined on said minor portion, said apparatus simultaneously scanning said first minor portion with said scanner and printing said test indicia on said second minor portion with said printer," which feature and the concept of

doing it, as a total combination with the subject matter of claim 1, is not taught by the prior art cited and, in the opinion of the Board, the applicant is entitled to a claim of this scope. It is suggested that when claim 2 is written in independent form the fourth paragraph of present new claim 1 be amended to read: "acoustic means; such as, a dummy telephone handset"

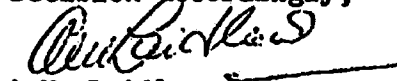
The Board recommends that the decision of the examiner, to refuse the claimson file, be upheld. Also that new claim 1 be refused as not setting forth patentable subject matter over the prior art of record; however, it is held that the subject matter of new claim 2, which includes claim 1, is not taught by the prior art of record. In the opinion of the Board, a claim of similar scope in terms of a method of testing would be more appropriate.



R. E. Thomas,
Chairman,
Patent Appeal Board.

I concur with the findings of the Patent Appeal Board and refuse to grant a patent on the claims presently on file in this application. New claim 1 is also rejected on the grounds set forth herein, and new claim 2 is found to be allowable or a method claim of similar scope would be allowable. Applicant has six months in which to cancel the original claims and resubmit new claim 2 in independent form as claim 1 or to appeal this decision in accordance with Section 44 of the Patent Act.

Decision accordingly,


A.M. Laidlaw,
Commissioner of Patents.

Dated at Ottawa,
Ontario, this 11th day
of August, 1972.

Messrs. Gowling & Henderson