The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRUCE P. CLEMENS

Appeal No. 2003-0408
Application 09/019,965

ON BRIEF

Before JERRY SMITH, RUGGIERO, and DIXON, 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 final rejection of claims 1-27 and 29, which constituted all the claims in the application. An amendment after final rejection was filed on May 19, 2000 and was entered

by the examiner. This amendment cancelled claims 6, 7, 13, 14, 16 and 20-26. Accordingly, this appeal is directed to the rejection of claims 1-5, 8-12, 15, 17-19, 27 and 29.

The disclosed invention pertains to a method and apparatus of operating an imaging system in a dual mode of operation by capturing a still image concurrently with performing digital video streaming operations of a digital camera tethered to a computer system.

Representative claim 1 is reproduced as follows:

1. A method of operating an imaging system in a dual mode of operation by capturing a still image concurrently with performance of digital video streaming operations of a digital camera tethered to a computer system comprising:

pausing digital video streaming operations of the digital camera;

capturing a still image by the digital camera;

storing the still image as digital still image data in a memory within the digital camera;

transferring the digital image data from the digital camera to the computer system;

storing the digital still image data in a first memory in the computer system and storing digital video streams in a second memory in the computer system; and

resuming digital video streaming operations of the digital camera;

wherein the above steps are performed as an atomic operation which is non-interruptible.

The examiner relies on the following references:

Nagasawa et al. (Nagasawa)	5,659,654	Aug. 19, 1997
Endsley et al. (Endsley)	5,841,471	Nov. 24, 1998 (filed Sep. 12, 1996)
Tung et al. (Tung)	5,859,979	Jan. 12, 1999 (filed Oct. 21, 1997)

Claims 1-5, 8-12, 15, 17-19, 27 and 29 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Tung and Nagasawa with respect to claims 1-5, 8-12, 27 and 29, and the examiner adds Endsley to this combination with respect to claims 15 and 17-19.

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 rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. 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 rejections 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 the claims on appeal. Accordingly, we reverse.

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

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 [see 37 CFR § 1.192(a)].

We consider first the rejection of claims 1-5, 8-12, 27 and 29 based on the teachings of Tung and Nagasawa. The examiner essentially finds that Tung teaches the claimed invention except that Tung fails to teach the camera being a digital camera. The examiner cites Nagasawa as teaching a digital camera which can capture both still and moving images. The examiner finds that it

would have been obvious to the artisan to include the digital camera of Nagasawa in the system of Tung. The examiner also finds that it would have been obvious to the artisan to store still images and digital video streams in first and second memories of a computer system. Finally, the examiner finds that there is no evidence that the combined system would suffer from interruptions or information being lost or destroyed. The examiner, therefore, concludes that the combined system would operate in a non-interruptible manner [answer, pages 4-5].

With respect to independent claims 1 and 8, appellant argues that there is no teaching or suggestion in Tung or Nagasawa to combine the features disclosed in the two references to arrive at the claimed invention. Appellant also argues that neither Tung nor Nagasawa, alone or in combination, teaches or suggests that the entire capture and image retrieval command sequence of claims 1 and 8 is an atomic operation and non-interruptible. Appellant notes that the lack of a discussion of interrupting video streaming in Tung or Nagasawa is not evidence that the combined system would operate in an atomic and non-interruptible manner as claimed [brief, pages 5-7].

The examiner responds that Tung teaches pausing the video streaming action, capturing a still image, transferring the still image to the remote site, and resuming video streaming all performed as an atomic operation which is non-interruptible [answer, pages 11-14].

Appellant responds that the images in Tung are sent between computers over a computer network. Appellant argues that there is an indeterminate amount of time required to send two SNAPSHOT messages in the Tung computer network, and during this time the computers will continue processing which could cause interrupts within the computers to occur. Appellant asserts that the processing in Tung is anything but atomic and non-interruptible as claimed [reply brief].

We will not sustain the examiner’s rejection of independent claims 1 and 8 for essentially the reasons argued by appellant in the briefs. Most importantly, we agree with appellant that there is no teaching within the combination of Tung and Nagasawa that the steps and operation of these claims are performed as an atomic operation which is non-interruptible. Appellant’s specification describes the atomic operation as follows:

> The camera device driver performs the entire image capture and image retrieval command sequence as an atomic operation, thereby causing the captured image to be stored on the host computer system before it can be overwritten by the next video frame in the video streaming sequence generated by the camera. This atomic operation cannot be interrupted by events relating to the video streaming processing, thus ensuring that the captured image will be retained on the host [specification, page 20].

Since the images in Tung are sent from the camera to a remote location over a computer network and must receive two commands from the remote location, we agree with appellant that there is no way that such a network can perform the claimed steps and operations as an atomic operation which is non-interruptible as claimed. The examiner erred in finding that the failure of the applied prior art to discuss interruptions was evidence that the combined system was atomic and non-interruptible. Limitations in a claimed invention must be specifically suggested by the applied prior art or must be clearly inherently present in the prior art. Neither situation is present in this case.

Since we have not sustained the examiner’s rejection of independent claims 1 and 8, we also do not sustain the examiner’s rejection of dependent claims 2-5 and 9-12.

With respect to independent claim 27, the examiner relied on the rejection as set forth with respect to claim 1. Appellant argues that claim 27 has limitations not present in claim 1, and the examiner's vague reference to the rejection of claim 1 fails to establish a case of obviousness [brief, pages 9-10]. The examiner responds that the limitations of claim 27 are sufficiently similar to the limitations of claim 1 that the rejection of claim 1 was sufficient to support the rejection of claim 27 [answer, page 15].

Although we agree with the examiner that claim 27 is sufficiently similar to claim 1 to allow the rejection of claim 1 to be used as the rejection of claim 27, the similarity of these claims also requires that we not sustain the examiner's rejection of claim 27 for the same reasons discussed above with respect to claim 1. We also do not sustain the examiner's rejection of claim 29 because it depends from claim 27.

We now consider the examiner's rejection of claims 15 and 17-19 based on the teachings of Tung, Nagasawa and Endsley. Independent claim 15 has limitations similar to claim 1. Endsley was only cited to teach a camera device driver as recited in claim 15, but Endsley does not overcome the deficiencies in the basic combination of Tung and Nagasawa discussed above.

Therefore, we do not sustain the examiner's rejection of claims 15 and 17-19 for the same reasons discussed above with respect to claim 1.

In summary, we have not sustained either of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-5, 8-12, 15, 17-19, 27 and 29 is reversed.

REVERSED

JERRY SMITH Administrative Patent Judge	)	
JOESPH F. RUGGIERO Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOSEPH L. DIXON Administrative Patent Judge	)	

JS:dym

Aloysius T C Auyeung
Blakely Sokoloff Taylor & Zafman
12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-2026