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for publication and is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte KENNETH A. PARULSKI

Appeal No. 2003-1459
Application No. 09/534,469

ON BRIEF

Before McQUADE, NASE, and DIXON, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 62, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to configuring imaging devices and purchasing such configured imaging devices (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Camaisa et al. (Camaisa)	5,845,263	Dec. 1, 1998
Dockes et al. (Dockes)	5,974,004	Oct. 26, 1999

Claims 1 to 62 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dockes.

Claims 1 to 62 stand rejected under 35 U.S.C. § 103 as being unpatentable over Camaisa.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 5, mailed June 21, 2002) and the answer (Paper No. 8, mailed January 24, 2003) for the examiner's complete reasoning in support of the rejections,

and to the brief (Paper No. 7, filed December 16, 2002) and reply brief (Paper No. 9, filed March 31, 2003) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us (i.e., Dockes and Camaisa), it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejections of claims 1 to 62 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence[1] that would have led one of ordinary skill in the art

[1] Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although
(continued...)

to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). When obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

The applied prior art

Dockes' invention relates generally to production of compact discs (also known as "CDS"), and more particularly to a system and method for production of customized compact discs on demand. Dockes' system and method for production of customized compact discs on demand includes acquisition means for acquiring audio data from a plurality of commercial-quality CDS and converting the audio data to digital format; mass storage means, coupled to the acquisition means, for storing the audio data in digital format; indexing means for associating identification data uniquely attributable to the plurality of commercial-quality CDS with their respective audio data in digital format;

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[1](...continued)
"the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." Thus, when an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002). See also In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

order processing means for compiling customer data including particularized selection data and shipping data; writing means for recording the customer data to a blank CD; packaging means for labeling the blank CD recorded by the writing means and inserting same in a box for shipment; and production management means, coupled to the mass storage means, indexing means, order processing means, writing means, and packaging means, for controlling production of the customized CDS.

Camaisa's invention relates to visual transaction systems, and more particularly to a system and method for interactively ordering restaurant menu items. The system may be used by a restaurant to facilitate ordering menu items by a customer. The customer can request the system to display full-color images of a menu item as a help to decide what to order. The customer can also obtain a list of ingredients, method of preparation and nutritional information for a selected menu item. When the customer decides to order a particular menu item, the system captures the ordered item and tabulates a running bill. In another embodiment of the system, multiple visual ordering devices are networked together at the restaurant. An option in the networked system is to allow the customer to pay the bill by a credit card or debit means at his/her table. The system enables businesses to reduce labor costs in running the business and provides the customer with more information at the point of sale to make a more informed decision.

Claims 1 to 25

We will not sustain the rejection of claims 1 to 25 under 35 U.S.C. § 103 as being unpatentable over Dockes or the rejection of claims 1 to 25 under 35 U.S.C. § 103 as being unpatentable over Camaisa.

Independent claim 1 specifies that the imaging device includes a processor controlled by firmware stored in a firmware memory, and further includes the step of "configuring the imaging device by storing in the firmware memory, customized firmware which provides the selected features." Both Dockes and Camaisa fail to teach or suggest these limitations of claim 1. The examiner has not presented any evidence establishing the obviousness of modifying either Dockes or Camaisa to arrive at the subject of claim 1. Thus, a proper prima facie case of obviousness of claim 1 has not been established and the rejections of claim 1, and claims 2 to 25 dependent thereon, are reversed.

Claims 26 to 34

We will not sustain the rejection of claims 26 to 34 under 35 U.S.C. § 103 as being unpatentable over Dockes or the rejection of claims 26 to 34 under 35 U.S.C. § 103 as being unpatentable over Camaisa.

Independent claim 26 includes the step of "configuring the imaging device by adding at least one program which provides one feature selected by the purchaser, the at least one program controlling an operation of a processor in the imaging device." Both Dockes and Camaisa fail to teach or suggest this limitation of claim 26. The examiner has not presented any evidence establishing the obviousness of modifying either Dockes or Camaisa to arrive at the subject of claim 26. Thus, a proper prima facie case of obviousness of claim 26 has not been established and the rejections of claim 26, and claims 27 to 34 dependent thereon, are reversed.

Claims 35 to 42

We will not sustain the rejection of claims 35 to 42 under 35 U.S.C. § 103 as being unpatentable over Dockes or the rejection of claims 35 to 42 under 35 U.S.C. § 103 as being unpatentable over Camaisa.

Independent claim 35 includes the step of "applying a digital image to a selected program for changing such digital image to demonstrate the effect of the selected feature, and displaying such changed digital image at the purchaser's location to aid in the selection process." Both Dockes and Camaisa fail to teach or suggest this limitation of claim 35. The examiner has not presented any evidence establishing the obviousness of modifying either Dockes or Camaisa to arrive at the subject of claim 35.

Thus, a proper prima facie case of obviousness of claim 35 has not been established and the rejections of claim 35, and claims 36 to 42 dependent thereon, are reversed.

Claims 43 to 48

We will not sustain the rejection of claims 43 to 48 under 35 U.S.C. § 103 as being unpatentable over Dockes or the rejection of claims 43 to 48 under 35 U.S.C. § 103 as being unpatentable over Camaisa.

Independent claim 43 includes the step of "storing the designee identifying information [provided by the purchaser] in the selected digital imaging device." Both Dockes and Camaisa fail to teach or suggest this limitation of claim 43. The examiner has not presented any evidence establishing the obviousness of modifying either Dockes or Camaisa to arrive at the subject of claim 43. Thus, a proper prima facie case of obviousness of claim 43 has not been established and the rejections of claim 43, and claims 44 to 48 dependent thereon, are reversed.

Claims 49 and 50

We will not sustain the rejection of claims 49 and 50 under 35 U.S.C. § 103 as being unpatentable over Dockes or the rejection of claims 49 and 50 under 35 U.S.C. § 103 as being unpatentable over Camaisa.

Independent claim 49 specifies that the configured camera has a nonvolatile memory, and further includes the step of "configuring the camera by storing the purchaser provided information in the nonvolatile memory." Both Dockes and Camaisa fail to teach or suggest these limitations of claim 49. The examiner has not presented any evidence establishing the obviousness of modifying either Dockes or Camaisa to arrive at the subject of claim 49. Thus, a proper prima facie case of obviousness of claim 49 has not been established and the rejections of claim 49, and claim 50 dependent thereon, are reversed.

Claims 51 to 57

We will not sustain the rejection of claims 51 to 57 under 35 U.S.C. § 103 as being unpatentable over Dockes or the rejection of claims 51 to 57 under 35 U.S.C. § 103 as being unpatentable over Camaisa.

Independent claim 51 specifies that the configured digital camera has a nonvolatile memory, and further includes the step of "the purchaser providing information to be stored in the nonvolatile memory of the digital camera." Both Dockes and Camaisa fail to teach or suggest these limitations of claim 51. The examiner has not presented any evidence establishing the obviousness of modifying either Dockes or Camaisa to arrive at the subject of claim 51. Thus, a proper prima facie case of

obviousness of claim 51 has not been established and the rejections of claim 51, and claims 52 to 57 dependent thereon, are reversed.

Claims 58 to 62

We will not sustain the rejection of claims 58 to 62 under 35 U.S.C. § 103 as being unpatentable over Dockes or the rejection of claims 58 to 62 under 35 U.S.C. § 103 as being unpatentable over Camaisa.

Independent claim 58 includes the step of "configuring a camera to contain at least one program which provides the features selected by the customer, the at least one program controlling an operation of a processor in the camera." Both Dockes and Camaisa fail to teach or suggest this limitation of claim 58. The examiner has not presented any evidence establishing the obviousness of modifying either Dockes or Camaisa to arrive at the subject of claim 58. Thus, a proper prima facie case of obviousness of claim 58 has not been established and the rejections of claim 58, and claims 59 to 62 dependent thereon, are reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 62 under 35 U.S.C. § 103 as being unpatentable over Dockes is reversed and the decision of the

examiner to reject claims 1 to 62 under 35 U.S.C. § 103 as being unpatentable over Camaisa is reversed.

REVERSED

JOHN P. McQUADE Administrative Patent Judge	)	
JEFFREY V. NASE Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JOSEPH L. DIXON Administrative Patent Judge	)	

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