

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NORIHISA HANEDA
and
ATSUSHI ITO

Appeal No. 2003-1866
Application 08/839,361

HEARD: February 3, 2004

Before HAIRSTON, RUGGIERO, and BLANKENSHIP, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 9-27, 32-37 and 40-43, which are all of the claims pending in the present application. Claims 1-8, 28-31, 38, and 39 have

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been canceled. An amendment filed July 8, 2002 after final rejection was approved for entry by the Examiner.

The disclosed invention relates to a system for printing an image appearing on a visual image medium as well as recording, on a digital medium, image data representing the image appearing on the visual image medium. A billing feature in the form of a fee charging apparatus which prints charging information on a slip is incorporated into the system. The charging information is also transmitted to a charging information confirming apparatus including a display where a sales clerk can visually compare the displayed charging information with the charging information on the printed slip.

Claims 9 and 13 are illustrative of the invention and read as follows:

9. An image filing apparatus comprising:

a visible image medium reading device reading a visible image appearing on a visible image medium and outputting digital image data representing the visible image;

a display device displaying a digital output medium selection screen for guiding selection of a digital output medium from a plurality of digital output media;

an input device used to select an output media displayed on said display device;

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a digital medium recording device recording on the digital output medium selected by said input device, the digital image data representing the visible image and outputted from said visible image medium reading device; and

a charging information printer printing information necessary for a recording service charge, said information relating to the recording executed in said digital medium recording device.

13. An image printing system comprising:

an image printing apparatus and a charging information confirming apparatus, said image printing apparatus and said charging information confirming apparatus being connected so as to communicate with each other,

said image printing apparatus including,

a digital medium reading device reading digital image data recorded on a digital medium;

an image printer printing an image represented by the digital image data read by said digital medium reading device;

a charging information printer printing charging information necessary for a print service charge, said charging information relating to image print processing executed in said image printer; and

a charging information transmitting device sending the charging information to said charging information confirming apparatus,

said charging information confirming apparatus including,

a charging information receiving device receiving the charging information sent from said charging information transmitting device; and

a display device displaying the charging information received by said charging information receiving device,

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wherein the displayed charging information is visually compared to the printed charging information in order to confirm the charging information.

The Examiner relies on the following prior art:

Kristy	5,218,455	Jun. 08, 1993
Parulski et al. (Parulski)	5,270,831	Dec. 14, 1993
Fredlund et al. (Fredlund)	5,666,215	Sep. 09, 1997 (filed Aug. 03, 1995)
Yamamoto	5,715,034	Feb. 03, 1998 (filed Dec. 20, 1995)
Truc et al.	5,872,591	Feb. 16, 1999 (filed Feb. 21, 1996)

Claims 9-27, 32-37 and 40-43, all of the appealed claims, stand finally rejected under 35 U.S.C. § 103(a).¹ As evidence of obviousness, the Examiner offers Kristy in view of Yamamoto with respect to claims 13-27, adds Fredlund to the basic combination with respect to claims 9-12, 32, 33, 41, and 43, adds Truc to the basic combination with respect to claim 37, and adds Parulski to the basic combination with respect to claim 40. In a separate rejection under 35 U.S.C. § 103(a), claims 34-36 and 42 stand finally rejected as being unpatentable over Kristy in view of Truc.

¹ As indicated in the Advisory Office action mailed July 19, 2002, Paper No. 28, the Examiner has withdrawn the 35 U.S.C. § 112, first paragraph, rejection of claims 34 and 42.

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Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs² and the Answer for the respective details.

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 rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' 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 have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in

² The Appeal Brief was filed July 8, 2002 (Paper No. 27). In response to the Examiner's Answer mailed August 1, 2002 (Paper No. 29), a Reply Brief was filed October 1, 2002 (Paper No. 30), which was acknowledged and entered by the Examiner in the communication dated October 16, 2002 (Paper No. 32).

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claims 9-12, 32-37, and 40-43. We reach the opposite conclusion with respect to claims 13-27. Accordingly, we affirm-in-part.

Appellants' arguments in response to the Examiner's rejections of the appealed claims are organized according to a suggested grouping of claims indicated at page 5 of the Brief. We will consider the appealed claims separately only to the extent separate arguments for patentability are presented. Any dependent claim not separately argued will stand or fall with its base claim. 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). Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Brief have not been considered [see 37 CFR § 1.192(a)].

As a general proposition in an appeal involving a rejection under 35 U.S.C. § 103, an Examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to Appellant 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

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relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); 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).

With respect to independent claim 9, the representative claim for Appellants' first suggested grouping (including claims 9-12, 32, 41, and 43), Appellants assert that the Examiner has not established a prima facie case of obviousness based on the proposed combination of Kristy, Fredlund, and Yamamoto. In particular, Appellants contend (Brief, pages 11-16; Reply Brief, pages 4-6) that none of the applied prior art teaches or suggests the claimed feature of ". . . displaying a digital output medium selection screen for guiding selection of a digital output medium from a plurality of digital output media." Initially, Appellants assert (Brief, page 23) that Kristy does not provide for the selection of output media since, in their characterization of the disclosure of Kristy, there is no suggestion of a user selection of output media since the skilled minilab operator is disclosed

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as using the photofinishing lab for producing a permanent record of images while the unskilled consumer uses the lab for producing image prints.

After reviewing the disclosure of Kristy in light of the arguments of record, we do not agree with Appellants' interpretation of such disclosure. Our review of Kristy reveals that, while there is indeed a discussion (column 4, lines 6-27) of the use of the photofinishing lab by a skilled lab operator for producing a permanent record of images on, for example, an optical compact disc, Kristy also discloses (column 4, lines 58-62) that the lab operator can alternatively utilize a thermal printer for supplying image prints to a customer.

Given the clear teaching in Kristy to provide the user with a choice of digital output media, i.e., optical disc permanent record or thermal printer produced prints, it is our view that the skilled artisan would have recognized and appreciated the obviousness of enabling such selection of output media through a display screen, especially in view of the fact that an interactive video display terminal 16 is provided as an integral part

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of the system of Kristy.³ Although the Examiner has applied the Fredlund reference to address the digital output medium selection feature of representative claim 9, it is our opinion, given our interpretation of the teaching nature of the disclosure of Kristy, that Fredlund is not necessary for a proper rejection under 35 U.S.C. § 103(a). Further, while Appellants attack (Brief, page 14) the addition of the charging system disclosure of Yamamoto to the Examiner's proposed combination since, in Appellants' view, Yamamoto has no disclosure of recording digital data, we find this argument unpersuasive since, as pointed out by the Examiner (Answer, page 9), Kristy clearly provides this feature. Accordingly, we sustain the Examiner's obviousness rejection of representative claim 9, and claims 10-12, 32, and 43 which fall with claim 9 in accordance with Appellants' claim grouping, based solely on the combination of Kristy and Yamamoto.⁴

³ In considering the language of appealed claim 9, we have given the broadest reasonable interpretation to the recitation "digital output medium." In doing so, we see no reason why the thermal printer 24 in Kristy, which processes the digital image files from computer 14, would not be considered to be a digital output medium.

⁴ The Board may rely on less than all of the references applied by the Examiner in an obviousness rationale without designating it as a new ground of rejection. In re Bush, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961); In re Boyer, 363 F.2d 455, 458, n.2, 150 USPQ 441, 444, n.2 (CCPA 1966).

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We also sustain the Examiner's obviousness rejection of independent claim 41, which includes the feature of a digital input medium selection screen, based on the combination of Kristy, Fredlund, and Yamamoto. Although Appellants have grouped claim 41 in the grouping including claims 9-12, 32, 41, and 43, separate arguments for claim 41 have been presented by Appellants in the Briefs which have been discussed by the Examiner in the Answer. After reviewing the arguments of record in the Briefs and Answer, we find no error in the Examiner's position that Fredlund provides a teaching to the skilled artisan of utilizing plural digital input media in a photofinishing operation such as in Kristy, the selection of which digital input media, in our view, would be obviously recognized and appreciated by the skilled artisan as being implemented by Kristy's interactive video display terminal.

Turning to a consideration of the Examiner's 35 U.S.C. § 103(a) rejection of dependent claim 33, grouped and argued separately by Appellants, based on the combination of Kristy, Fredlund, and Yamamoto, we sustain this rejection as well. The limitations in claim 33, which is dependent on claim 9 discussed

supra, are directed to the feature of selecting among displayed thumbnail images the images to be recorded on a recording device. In addressing this feature, the Examiner (Answer, page 6) points to the discussion at column 4, lines 42-57 of Kristy which discusses the display of low resolution miniature (thumbnail) images which are indexed to a corresponding higher resolution image file.

Appellants' argument in response (Brief, page 19; Reply Brief, page 8) suggests that, while Kristy clearly discloses the display of thumbnail images, the purpose of the display is solely to easily locate the stored higher resolution images, not to use the displayed thumbnail images for selection of images to be recorded. We do not find this argument to be persuasive. It is apparent to us that the disclosed purpose of the thumbnail images in Kristy is to rapidly access the selected corresponding high resolution image that is desired for "a requested photofinishing operation." (Kristy, column 4, line 57). It is equally apparent, alluded to by the Examiner (Answer, page 21) that from the entirety of the disclosure in Kristy, the "photofinishing operation" would clearly encompass an image recording operation

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as claimed. Since, as previously discussed with regard to claim 9, Fredlund is not needed for a proper rejection under 35 U.S.C. § 103(a), we sustain the Examiner's obviousness rejection of claim 33 based solely on the combination of Kristy and Yamamoto.

We also sustain the Examiner's 35 U.S.C. § 103(a) rejection, in which Truc is added to Kristy, of independent claims 34 and 42, which also are directed to the thumbnail image selection feature discussed above with regard to claim 33. Although the Examiner has added Truc to the Kristy reference as the basis for the rejection, it is our view, for all of the reasons discussed above with regard to claim 33, that Truc is not needed for a proper rejection under 35 U.S.C. § 103(a). Accordingly, we sustain the Examiner's obviousness rejection of claims 34 and 42 based on Kristy alone.

Turning to a consideration of claims 35 and 36, we sustain the Examiner's obviousness rejection of these claims as well based on Kristy alone. Although Appellants have grouped these claims along with claims 34 and 42 which include limitations directed to selection of thumbnail images, claims 35 and 36

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contain no such limitations. In fact, the language of claims 35 and 36 is directed to a selection screen for selecting among an image printing service and an image filing service, features which we found to be clearly taught at column 4, lines 58-62 of Kristy as previously discussed with regard to claim 9.

Similarly, with respect to dependent claim 37, which adds a charging information limitation to claim 35, in which the Examiner's stated rejection has combined Kristy with Truc and Yamamoto, we sustain the obviousness rejection of this claim solely on the combination of Kristy and Yamamoto. As previously discussed, Yamamoto provides a clear teaching of the use of a charging information printer in an image printing device, while Truc is not necessary for this rejection since Kristy suggests the obviousness to the skilled artisan of the service selection screen set forth in parent claim 35.

With respect to independent claim 40, grouped and argued separately by Appellant, we also find no persuasive arguments from Appellants that would convince us of any error in the Examiner's position which offers the combination of Kristy, Yamamoto, and Parulski. As asserted by the Examiner (Answer,

pages 16, 17, and 23), we find a clear suggestion in Parulski of providing a user with a choice of visible medium input devices, i.e., photo or film readers, as claimed, while the Parulski reference incorporation of Kristy (column 1, lines 35-41) into its disclosure suggests its combination. We also reiterate our previous view that Kristy's clear teaching of an interactive display terminal would suggest the obviousness to the skilled artisan of enabling the input medium selection by a screen selection display, and that Yamamoto's charging information disclosure has clear applicability to the system of Kristy. Accordingly, since the Examiner's prima facie case of obviousness has not been overcome by any convincing arguments from Appellants, we sustain the Examiner's 35 U.S.C. § 103(a) rejection of independent claim 40 based on the combination of Kristy, Yamamoto, and Parulski.

Turning to a consideration of the Examiner's obviousness rejection of independent claims 13, 18, and 23 based on the proposed combination of Kristy and Yamamoto, we note that these claims are directed to details of the fee charging printing, displaying, and confirming features of Appellants' invention.

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To address the claimed fee charging features, the Examiner relies on Yamamoto and, in particular, directs attention (Answer, page 9) to the illustration in Figure 21 of Yamamoto along with the accompanying description beginning at column 23, line 49. According to the Examiner, Yamamoto's bar code reader 231 corresponds to the claimed charging information transmitting device, while the display 232 corresponds to the claimed charging information receiving device where the displayed price is visually compared to printed charging information on the information card J.

In response, Appellants assert (Brief, pages 8 and 9) that the Examiner has not established a prima facie case of obviousness since the features relied on in Yamamoto do not correspond to those as claimed. After reviewing the Yamamoto reference, we are in agreement with Appellants' position as stated in the Brief. In particular, we agree that Yamamoto's bar code reader and register do not satisfy the claimed limitations since these devices are separate from and are not included within the image printing device as specifically set forth in each of the independent claims 13, 18, and 23.

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We are aware that the Examiner (Answer, page 19) suggests a possible alternative interpretation of Yamamoto in which the information card preparation apparatus (Fig. 17) is considered the charging information transmitting device, and the bar code reader the charging information receiving device. We are in agreement with Appellants (Reply Brief, page 3), however, that this interpretation does not satisfy the claim language since Yamamoto's information card preparation apparatus can not reasonably be interpreted as sending information to the charging information receiving device as claimed.

In view of the above discussion, because the Examiner has not established a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art references, the 35 U.S.C. § 103(a) rejection of independent claims 13, 18, and 23, as well as claims 14-17, 19-22, and 24-27 dependent thereon, based on the combination of Kristy and Yamamoto is not sustained.

In summary, with respect to the Examiner's 35 U.S.C. § 103(a) rejection of the appealed claims, we have sustained the rejection of claims 9-12, 32-37, and 40-43, but have not

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sustained the rejection of claims 13-27. Therefore, the Examiner's decision rejecting claims 9-27, 32-37 and 40-43 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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Administrative Patent Judge)	
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