

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASAHIRO KUBO

Appeal No. 2004-0316
Application 09/136,619

ON BRIEF

Before THOMAS, DIXON and GROSS, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 1, 3, 10-12, 16-18 and 22-28.

Representative claim 1 is reproduced below:

1. A recording medium with an index print wherein, in a recording medium in the form of a disk having a digital data recording surface on which a plurality of digital image data can be recorded, thumbnail images, forming the index print,

Appeal No. 2004-0316
Application 09/136,619

claims on appeal. Appellant groups all independent claims 1, 10, 16, and 22 together with independent claim 1 as representative thereof. Appellant also presents dependent claims 25-28 as falling together in a separate grouping. Note the top of page 4 of the brief.

At page 4 of the brief, appellant urges that Wen fails to disclose markings which specify images that correspond to the print images, where the markings are displayed in printing together with the print images on the CD. The ensuing discussion recognizes that column 1, lines 48-61 of Wen teaches the thumbnail images recited in the body of independent claim 1 on appeal which is stated there to form the so-called index print of the preamble of that claim. Page 5 of the brief urges that the only text contemplated by Wen regards the descriptive contents of the CD and that there is no teaching or suggestion of specific information that would map out the location of thumbnail images on a CD. Finally, appellant recognizes in the paragraph bridging pages 5 and 6 of the brief that Wen mentions the desire to print thumbnail images "as" an index on a CD surface. This is correct in that column 1, lines 50 and 51 indicate that "thumbnail images can be printed on the label as an index of the images stored in

Appeal No. 2004-0316
Application 09/136,619

the CD." Appellant continues to argue that this teaching does not contemplate the additional provision of a marking for specifying images on the CD that corresponds to the print images. Appellant's arguments at page 6 of the brief regarding this teaching of an index in Wen takes the position that the use of the word "index" does not necessarily include specific markings and that the index "is constituted by thumbnail images only and there is no teaching that specific markings should accompany each thumbnail image."

We disagree with these arguments and appellant's view with respect to the teaching in the identified portion of the bottom of column 1 of Wen, and we are persuaded by the examiner's reasoning set forth on substantially all of page 4 of the answer which we reproduce here:

The Examiner contends that Wen's disclosure of using thumbnails as an index for the photos necessitates having markings associated therewith to direct the user of the disc as to which track has the photo, whether it be a number [sic ,] a letter, etc. Wen explicitly states that the thumbnails are for index use, which implies that a user is to utilize the thumbnails to locate the pictures of the disk. This is the identical purpose of that found in Appellant's invention. Furthermore, Wen explicitly discloses the usage of print with images and graphics in order to provide more information to the user in the disc. The Examiner disagrees with the implication of Appellant's argument.

Appeal No. 2004-0316
Application 09/136,619

Appellant's argument would suggest that even though Wen discloses thumbnail images of photos to be used as an index (which is exactly what Appellant's invention does), and further discusses the usage of text with images to provide information to the user, this disclosure somehow fails to encompass the addition of a mark (e.g., track listing next to the thumbnail image) on the CD. The Examiner contends that Appellant is reading the term "index" in Wen as narrowly as possible, and that even with this narrow interpretation still does not overcome the rejection. Appellant's interpretation of index contradicts not only what one of ordinary skill in the art would perceive as being an index on a CD (see any list of tracks on music CD, note the numbers that identify the tracks on the disc), it also contradicts a simple common sense interpretation of what an "index" is. The Examiner maintain [sic, maintains] that when Wen states that an index is provided that consists of thumbnails, that this implicitly means that markings accompany the thumbnail index.

The examiner's persuasiveness is aided by earlier teachings at column 1, lines 20-23 of Wen. There it is stated that a label is "usually printed with, say, a description of the information stored on the CD. The printed information may be logos, text, graphics, and/or bar codes." Not only does this descriptive information correspond to the just-reproduced portion of the answer, it essentially refutes the appellant's arguments at pages 4-6 of the brief as to the first stated rejection of each of the independent claims on appeal. Consistent with this teaching of

Appeal No. 2004-0316
Application 09/136,619

conventional CD descriptive material on their labels, the artisan would readily interpret the teaching at the bottom of column 1 relating to thumbnail images that are printed for photo CD would also include index information that is characteristic of descriptive information of the actual images stored in the photo array on the disk itself. Moreover, an ordinary dictionary definition of the term "index" indicates the term commonly includes a list of items and a numeric identifier or "marking" indicating where the item may be found. Thus, there are clear teachings consistent with the examiner's position that "markings for specifying images corresponding to the print images are displayed in printing together with the print images" as set forth at the end of representative independent claim 1 on appeal.

In view of these conclusions, we sustain the rejection of each independent claim 1, 10, 16, and 22 on appeal and their corresponding dependent claims 3, 12, 18, and 24 within this first stated rejection of the claims under 35 U.S.C. § 102. Appellant's position with respect to dependent claims 11, 17 and 23 at the bottom of page 6 of the brief, which claims are rejected under 35 U.S.C. § 103 and not 35 U.S.C. § 102, notes that these claims fall with their respective parent independent claims 10, 16, and 22.

Appeal No. 2004-0316
Application 09/136,619

Lastly, we consider the subject matter of dependent claims 25-28 that are rejected under 35 U.S.C. § 103 over Wen alone. According to the reasons set forth by the examiner at page 6 of the final rejection, we sustain this rejection in addition to the examiner's responsive arguments at page 5 of the answer. Each of these claims 25-28 recite the same feature, namely, that the markings of the independent claims comprise "frame numbers." Although we agree with appellant's view at page 7 of the brief that Wen's teaching of an index formed by thumbnail images does not indicate frame numbers per se, we agree with the examiner's positions. The examiner's reliance upon "Official notice" is noted at the bottom of page 7 of the brief but is not challenged per se. The appellant merely argues that the examiner's rationale is based upon hindsight.

In addressing this criticism at page 5 of the answer the examiner, within 35 U.S.C. § 103, argues that the "usage of track numbers is probably implied with the usage of the term "index" in Wen. We also agree with the examiner's further views stated here:

Appeal No. 2004-0316
Application 09/136,619

Having an index implies that this index must guide a user of it to where the information exists. Simply placing thumbnails on the disk provides the user with no direction. One of ordinary skill in the art would want to provide the user with means for finding the picture on the disc (much in the same way a user can find tracks on a CD by referencing the song index on the CD).

This rationale is consistent with the examiner's views expressed at page 6 of the final rejection. There the examiner appears to analogously argue that the track numbers of a song on the label of an audio CD would advantageously lead the artisan to use and identify the frame number of an image on a photo CD as in Wen. To print the name of a song plus its track number "corresponding to" the digital audio information on the other or opposite side of conventional audio disc obviously would have lead the artisan to print the index of the image "corresponding to" the frame with the frame number of the digital video on the opposite side of the CD/DVD, on a photo CD as in Wen.

All of this rationale is consistent with appellant's disclosed invention which recognizes at pages 1 and 2 of the specification as filed that the prior art provides a conventional index print (claimed as a feature in the preamble of each claim on appeal) which is separately provided together with a recording

Appeal No. 2004-0316
Application 09/136,619

medium of the photo image of video images as well. Consistent with the examiner's rationale and the teachings identified earlier at the initial portion of column 1 of Wen, prior art/conventional index prints contain a numeric identifier corresponding to each image and therefore its location on the opposite or image data surface of the CDS. These conventional index prints map the location of each of the respective individual index prints to the respective images in their corresponding, relative location among the digital data on the disk itself.

Finally, we note that dependent claims 25-28 recite a specific detail (a frame number) of what the generic "marking" is in their parent independent claims. By implication therefore, our affirmance of the rejection of claims 25-28 under 35 U.S.C. § 103 applies equally well to their parent independent claims even though no express rejection of them has been made under 35 U.S.C. § 103.

In view of the foregoing, the decision of the examiner rejecting various claims under 35 U.S.C. § 102 and 35 U.S.C. § 103 is affirmed.

Appeal No. 2004-0316
Application 09/136,619

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

AFFIRMED

James D. Thomas)	
Administrative Patent Judge)	
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Joseph L. Dixon)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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)	
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Appeal No. 2004-0316
Application 09/136,619

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