

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD L. ALFVIN AND WILLIAM C. ARCHIE

Appeal No. 2006-1491
Application No. 09/607,140
Technology Center 3600

ON BRIEF

Before BAHR, NAPPI and FETTING, **Administrative Patent Judges.**

NAPPI, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 1 through 16. For the reasons stated *infra* we will not sustain the examiner's rejection of claims 1 through 16.

THE INVENTION

The invention relates to a method of managing digital images captured by a customer using a combined telecommunications and image capture device. The telecommunications provider provides a database for receiving and storing images from the customer. The telecommunications provider provides a periodic statement for

services which also contains visual representation of the images. See page 2 of appellants' specification. Claims 1 and 15 are representative of the invention and are reproduced below:

1. A method of managing digital images captured by a customer using a combined portable telecommunications and digital image capture device, said method comprising:
a telecommunication service provider providing a telecommunication service to a customer, said telecommunications service provider forwarding a periodic statement for telecommunication services provided to said customer for a predetermined time period;
providing a data base for receiving and storing said digital images from said customer using said combined telecommunications device to transmit said digital images to said service provider; and
said telecommunication service provider providing to said customer a visual representation of said captured images taken during said predetermined time period along with said periodic statement.

15. A multi-section statement form for use by a combined telecommunications and imaging services service provider, comprising:
a first portion of said form comprising a billing invoice for telecommunications and imaging services charges accumulated for a predetermined time period;
a second portion of said form comprising a hard copy index print containing images taken during a predetermined time period;
a third portion of said form comprising an order form for ordering photographic goods and/or services based upon said images contained in said index print.

THE REFERENCES

The references relied upon by the examiner are:

Kolling	6,385,595	May 7, 2002
Loeb	6,014,641	Jan. 11, 2000
Enomoto	5,974,401	Oct. 26, 1999
Reele	5,893,037	Apr. 6, 1999

THE REJECTIONS AT ISSUE

Claims 1, 2 and 8 through 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Reelee and Kolling. Claims 3 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Reelee, Kolling and Enomoto. Claims 4 through 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Reelee, Kolling and Enomoto and Loeb. Claims 15 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kolling and Loeb. The examiner's rejections are set forth on pages 2 through 8 of the Office action mailed December 18, 2002. Throughout the opinion 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, 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.

With full consideration being given to the subject matter on appeal, the examiner's rejection and the arguments of the appellants and the examiner, for the reasons stated *infra* we will not sustain the examiner's rejections of claims 1 through 16.

On page 2 of the brief, appellants group the claims into four groups. On pages 3 through 8 of the brief, appellants present arguments directed to each of these groups. Accordingly, we will consider the claims as grouped by appellants.

Rejection of claims 1, 2 and 8 through 14.

Appellants assert, on page 3 of the brief, that Reelee teaches a combined camera and cellular phone. However, appellants argue, on page 4 of the brief:

Reelee et al. does not teach the sending of the images to a service provider. Quite the contrary, what is set forth at column 5, lines 25-43 is that the operator (i.e. the owner of the camera) can have images sent to a remote location.

There is no indication or suggestion in the reference that the images would be sent to a image service provider for storage. Further, neither Reelee et al. or Kolling et al. disclosed the claimed feature of providing a "visual representation of said captured images" along with a periodic statement for telecommunication services. The Examiner cites Kolling et al. to provide this feature. However, Kolling et al. merely discloses the supplying of a logo or other graphic on a periodic statement, or the including of enclosures with the statement. A corporate logo or advertising enclosure however is not a visual representation of the images captured by the customer that is received by an image provider and stored on a database as claimed by applicants. The images in Kolling et al. are instead supplied by the service provider not by the owner of the combined image captured telecommunication device. The Examiner acknowledges that Reelee et al. does not provide a periodic statement. Accordingly, it is respectfully submitted that Reelee et al. could not teach or suggest the providing of visual representation of captured images taken during a predetermined time period along with a periodic statement as taught and claimed by applicants. (underlining original)

In response, the examiner states, on pages 3 and 4 of the answer: "the features upon which applicant relies (i.e. sending of images to a service provider, a image service provider and images captured by the customer) are not recited in the rejected claim(s). Also the limitation of 'images supplied by the owner of the combined image captured telecommunication device' is not recited in the claim." In the paragraph bridging pages 4 and 5 of the answer, the examiner states that Reelee teaches that a telecommunications provider provides services and a database for storing digital images. Further, the examiner states that Kolling discloses the step of providing statements for telecommunication services along with custom enclosure and that in combination one skilled would provide a statement which included the images.

We disagree with the examiner's rationale and findings concerning Reelee. Claim 1 recites "providing a data base for receiving and storing said digital images from said customer using said combined telecommunications device to transmit said digital images to said service provider; and said telecommunication service provider providing to said customer a visual representation of said captured images taken during said predetermined time period along with said periodic statement." Independent claim 9 contains a similar limitation of a "database for receiving and storing said captured images transmitted from said customer" and "a computer used by said service provider for managing and associating said telecommunications and image storage services for said customer and for providing a visual representation of said captured images captured during said predetermined time period along with said periodic statement." Thus, contrary to the examiner's findings, claim 1 does recite transmitting the digital images to the service provider. We find that Reelee teaches that the images captured by the camera are transmitted to remote locations, see column 5, line 25 through 49. This transmission of an image is discussed as being sent to another person for review and approval (see column 1, lines 36 through 45). Implicit in this transmission of the image is that it is transmitted to the telecommunications provider, as the telecommunications provider is the intermediary to such a transmission. However, we do not find that Reelee teaches that the images are stored in a database or that the telecommunications provider provides a visual representation of the images along with the periodic statement of services provided to the customer. We concur with the examiner that Kolling teaches generating periodic statements for services provided including telecommunications services. See column 18 lines 64 through column 19 line 7 and column 19, lines 34 through 41. While we also concur with the examiner that Kolling teaches custom enclosures on column 19 lines 43 through 66, we find that these custom enclosures are for advertisements (see items 850, 851 in figure 10 and figure 15) and thus do not find that Kolling's teaching of custom enclosures in the statements teaches or suggests that a representation of images captured and transmitted by the telecommunication device should be provided along with the

periodic statement. Thus, we do not find that the combination of Reelee and Kolling would have suggested the limitations of independent claims 1 and 9. Accordingly we will not sustain the examiner's rejection of claims 1, 2, and 8 through 14.

Rejection of claims 3 and 7.

Claim 3 is dependent upon claim 1, and claim 7 depends on claim 3. The examiner applies Reelee, Kolling and Enomoto in rejecting these claims. As discussed *supra* the combination of Reelee and Kolling do not teach or suggest the limitations of claim 1. The examiner has not asserted nor do we find that Enomoto teach or suggests modifying Reelee or Kolling such that the telecommunications provider provides a visual representation of the images along with the periodic statement of services provided to the customer. As such we will not sustain the examiner's rejection of claim 3 and 7 for the reasons stated *supra* with respect to claim 1.

Rejection of claims 4 through 6.

Claims 4 through 6 are dependent upon claim 3. The examiner applies Reelee, Kolling, Enomoto and Loeb in rejecting these claims. As discussed *supra* the combination of Reelee, Kolling and Enomoto do not teach or suggest the limitations of claim 3. The examiner has not asserted nor do we find that Loeb teaches or suggests modifying Reelee or Kolling or Enomoto such that the telecommunications provider provides a visual representation of the images along with the periodic statement of services provided to the customer. As such we will not sustain the examiner's rejection of claims 4 through 6 for the reasons stated *supra* with respect to claim 3.

Rejection of claims 15 and 16.

Appellants argue on page 8 of the brief that the rejection based upon Kolling in view of Loeb is improper as:

Loeb et al. is not directed to storing images on behalf of a customer nor is it directed to a billing invoice for a telecommunication and image services for a predetermined period of time. Nor is there any teaching or suggestion for providing an order form for obtaining photographic goods and/or services. As previously discussed, the Kolling et al. reference is directed to an electronic billing system. It does

not teach or suggest the providing of a combined telecommunication and image service provider nor does it teach the providing of statement [sic] with the three portions as claimed by applicant. Thus, it is respectfully submitted that it could not teach the claimed invention as there are essential elements missing from the combined cited references.

The examiner responds, on page 7 of the answer, stating that the feature argued, storing images on behalf of the customer is not recited in claims 15 and 16. Further, on pages 7 and 8 of the answer, the examiner states the Kolling teaches providing a periodic statement for services provided and providing to said customer a visual representation of captured images. Additionally the examiner finds that Loeb teaches the use of paper forms.

We are not persuaded by the examiner rationale. As stated *supra* we do not find that Kolling teaches or suggests providing a statement to a user for telecommunications services, which includes a representation of images captured and transmitted by the telecommunications device.

We note claim 15 is directed to a form and recites limitations directed to information contained in three sections of the form. The first section being a billing invoice, the second an index print of images taken during a period of time and the third being an order form for ordering photographic goods based upon images in the index print. We consider the information on the first portion, the billing invoice for telecommunications and imaging services, to be non-functional descriptive material, and as such does not patentably distinguish the claim over the prior art. See *In re Gulack* 703 F.2d 1381, 217 USPQ 401 (Fed Cir. 1983). However, we consider the information in the second portion, the index print containing images, and the third portion “an order form for ordering photographic goods and/or services based upon said images contained in said index print” to be functionally related to each other and the substrate on which they are printed, i.e. the order form on the third section is for the images contained in the second section. The examiner has not shown that either Kolling or Loeb teaches or

Appeal No. 2006-1491
Application No. 09/607,140

suggests such information presented on an order form. Accordingly we will not sustain the examiner's rejection of claims 15 and 16.

Conclusion

In summary, we will not sustain the examiners rejection of claims 1 through 16. The decision of the examiner is reversed.

REVERSED

JENNIFER D. BAHR)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
ROBERT E. NAPPI)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
ANTON W. FETTING)	
Administrative Patent Judge)	

Appeal No. 2006-1491
Application No. 09/607,140

PATENT LEGAL STAFF
EASTMAN KODAK COMPANY
343 STATE STREET
ROCHESTER, NY 14650-2201

REN/jrg