

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROBERT D. BUSHEY  
AND GARY DON CARLTON

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Appeal No. 2006-1876  
Application No. 09/877,522<sup>1</sup>

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ON BRIEF

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Before HAIRSTON, SAADAT, and MACDONALD, Administrative Patent Judges.

SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-20, which are all of the claims pending in this application.

We affirm.

BACKGROUND

Appellants' invention relates to peripheral devices configured for connection to a network and communication with a

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<sup>1</sup> Application for patent filed June 8, 2001.

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device connected to the network such that software can be downloaded and uploaded without inconvenience to the user. According to Appellants, a peripheral device automatically receives the software that facilitates communication with a separate device and stores the software in the memory. An understanding of the invention can be derived from a reading of exemplary independent claim 1, which is reproduced as follows:

1. An image capture appliance configured for connection to a network and communication with a device connected to the network, the appliance comprising:

a processing device configured to control operation of the image capture appliance;

memory including logic configured to receive software via the network that facilitates communication between the image capture appliance and the device from a software source; and

a network interface device with which the image capture appliance communicates with the software source.

The Examiner relies on the following prior art references:

Anderson (Anderson '538)	6,222,538	Apr. 24, 2001
Anderson et al. (Anderson '122)	6,567,122	May 20, 2003 (filed Mar. 18, 1998)
Anderson et al. (Anderson '259)	6,636,259	Oct. 21, 2003 (filed Jul. 26, 2000)
Anderson et al. (Anderson '749)	6,680,749	Jan. 20, 2004 (effectively May 6, 1997)

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Claims 1-20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Anderson '749 or, in the alternative, as being anticipated by Anderson '538.

Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson '749 or Anderson '538 in combination with Anderson '122 or Anderson '259.

Rather than reiterate the opposing arguments, reference is made to the brief (filed October 11, 2005), the reply brief (filed February 2, 2006) and the answer (mailed December 28, 2005) for the respective positions of Appellants and the Examiner. 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 briefs have not been considered (37 CFR § 41.37(c)(1)(vii)).

#### OPINION

##### 35 U.S.C. § 102 rejection of the claims

Regarding claim 1, the Examiner's position is that Anderson '749 provides for an image capture device as the appliance configured to communicate with a device connected to a network having a processing device and a memory (answer, page 4). The Examiner also finds that Anderson '538 similarly discloses a

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Network programmable digital camera that may be programmed from a remote location over a network (id.).

In response, while acknowledging that an "application program 760" is downloaded from a network in Anderson '749, Appellants argue that the reference does not teach that the "application program 760" facilitates communication between Anderson's digital device and another device (brief, page 9). Appellants further argue that the communication software in the reference actually is not replaced by any user interface software (brief, page 10).

The Examiner responds by stating that the camera of Anderson '749 includes control program 760 which receives software programs and facilitates communication with the outside world (answer, page 7). The Examiner then asserts that the digital camera receives the software without specific requests and thus reads on automatically receiving software with the appliance that facilitates communication between the appliance and the separate device (id.).

A rejection for anticipation requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention

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without undue experimentation. See Atlas Powder Co. v. IRECO Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), it is only necessary for the claims to “read on’ something disclosed in the prior art reference, i.e., all limitations of the claim are found in the reference, or ‘fully met’ by it.” See also Atlas Powder Co. v. IRECO Inc., 190 F.3d at 1346, 51 USPQ2d at 1945 (Fed. Cir. 1999) (quoting Titanium Metals Corp. of Am. v. Banner, 778 F.2d 775, 781, 227 USPQ 773, 778 (Fed. Cir. 1985)).

In determining the subject matter encompassed by claim 1, we agree with the Examiner that the claim merely requires “receiving software” that facilitates communication between the camera and a device. However, Anderson ‘749 does show the received software in Figure 12 in a way that functions such as interfacing with functions in the tool box may become available (col. 12, lines 5-8). We also remain unconvinced by Appellants’ argument that the references say nothing about receiving software to facilitate

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communication between the image capture appliance that receives the software and another device on the network (replay brief, page 2). As pointed out by the Examiner (answer, page 7), Anderson '749 also teaches that application program 760 may be downloaded from a host computer or from a network to run in place of the control application (col. 12, lines 14-18).

Therefore, while Anderson '749 does not explicitly describe the downloaded application program as the software to facilitate communication between the camera and the device, as held in In re Graves, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995), we find that a person of ordinary skill in the art would understand that the application program affects the tool box and the drivers, which in turn, would facilitate the camera interface for external communication (col. 12, lines 5-13). See also Helifix Ltd. v. Blok-Lok, Ltd., 208 F.3d 1339, 1347, 54 USPQ2d 1299, 1304 (Fed. Cir. 2000) (even if a piece of prior art does not expressly disclose a limitation, it anticipates if a person of ordinary skill in the art would understand the prior art to disclose the limitation and could combine the prior art description with his own knowledge to make the claimed invention). Thus, a skilled artisan could take Anderson's teachings in combination with his own knowledge and be in

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possession of the memory including logic to receive software that facilitates communication between the image capture appliance and the device from a software source of Appellants' claim 1.

Accordingly, the 35 U.S.C. § 102(e) rejection of claims 1-20 over Anderson '749 or Anderson '538 is sustained.

35 U.S.C. § 103 rejection of the claims

Appellants argue that if Anderson '749 does not disclose an appliance that receives software that facilitates communication between the appliance and another device, and a different reference is needed to reject the claims, how can it anticipate the claims (brief, page 19). Appellants further point out that neither of the Anderson references discloses that the received software facilitates communication between the appliance and another device (id.). The Examiner refers to the teachings of Anderson '749 (col. 12, lines 14-18) and asserts that the application program is directly downloaded from a network to replace the current application that did communicate (answer, page 9).

A review of Anderson '749 reveals that the downloaded application program is from a host computer or from a network and indeed is used for interfacing with functions in the tool box and to control the I/O port 348 for external communication (col. 12,

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lines 5-13). Although Anderson '749 already describes all the recited features, its combination with Anderson '122 or Anderson '259 is proper as they both describe making a direct connection to the network for obtaining the software ('122 col. 9, lines 4-8). Obviousness from [prior art reference] would follow, ipso facto, if [prior art reference] anticipates. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1446, 221 USPQ 385, 390 (Fed. Cir. 1984), citing In re Kalm, 378 F.2d 959, 962, 154 USPQ 10, 12 (CCPA 1967), (anticipation stated as being the "epitome of obviousness"). Accordingly, we also sustain the 35 U.S.C. § 103 rejection of claims 1-20.

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CONCLUSION

In view of the forgoing, the decision of the Examiner rejecting claims 1-20 under 35 U.S.C. § 102 and under 35 U.S.C. § 103 is affirmed

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
MAHSHID D. SAADAT	)	APPEALS
Administrative Patent Judge	)	AND
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ALLEN R. MACDONALD	)	
Administrative Patent Judge	)	

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