

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 MARK DAVID SEAMAN, GREGORY A. BRAKE,  
and ROBERT D. THOMPSON

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Appeal No. 2006-2848  
Application No. 09/999,791<sup>1</sup>

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ON BRIEF

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Before KRASS, BLANKENSHIP, and SAADAT, Administrative Patent Judges.

SAADAT, Administrative Patent Judge.

DECISION ON APPEAL AND REMAND TO THE EXAMINER

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner=s final rejection of claims 1-4 and 6-20. Claim 5 has been canceled.

We reverse and remand.

BACKGROUND

Appellants= invention is directed generally to image capture devices, and specifically, to a system for generating and

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<sup>1</sup> Application for patent filed October 31, 2001.

implementing an image capture procedure for a digital image capture device. The image capture procedure enumerates a plurality of predefined situations for capturing an image associated with a predefined event. 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 device, comprising:

a user interface device; and

logic comprising information corresponding to an image capture procedure, the image capture procedure enumerating a plurality of predefined situations for capturing an image, the plurality of predefined situations for capturing an image associated with a predefined event;

logic for enabling a user to generate the image capture procedure via the user interface device;

logic for displaying the image capture procedure on the user interface device; and

logic for capturing an image.

The following references are relied on by the Examiner:

Anderson	6,222,538	Apr. 24, 2001
Steinberg et al. (Steinberg)	6,750,902	June 15, 2004 (filed Dec. 20, 1999)

Claims 1-4, 6 and 10-20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Anderson.<sup>2</sup>

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<sup>2</sup> Anderson is also a reference under 35 U.S.C. § 102(a) as it was published prior to the filing date of the instant application.

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Claims 7-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson and Steinberg.

Rather than reiterate the opposing arguments, reference is made to the briefs and answer 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

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 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).

Appellants argue that although Anderson discusses image capture sequences, Anderson states that these sequences are either built-in functions of a digital image device or loaded into the camera after they are generated externally to the camera (brief, sentence bridging pages 8-9). Appellants further assert that the reference provides no teaching or suggestion for

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generating these sequences via a user interface of the digital camera (brief, page 9). Relying on the absence of any explicit prompts to the user for entering commands in Anderson, Appellants argue that no assistance is provided to direct generating an image capture procedure (brief, page 10; reply brief, page 3).

In response, the Examiner relies on the user selection of a sequence in step 708 in Figure 11 of Anderson (col. 10, lines 50-56) and argues that once selected, the translation of a sequence into an executable series of steps can be interpreted as generating a sequence (answer, pages 11-12). The Examiner further takes the position that the term "generating" is broad enough to read on producing commands to perform the image capture sequence from a stored script (answer, page 12).

After reviewing the claimed subject matter and the applied reference, we remain unconvinced by the Examiner's position that selecting a pre-defined or stored sequence by a user can be equated to the claimed enabling a user to generate the procedure via a user interface. Anderson uses procedures that are either provided as built-in (col. 9, lines 58-61) or externally loaded into the camera (col. 9, lines 62-67). What the user selects in Anderson is an already loaded script which is converted into commands to be executed by the camera (col. 10, lines 50-56).

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Contrary to the Examiner=s reasoning, the user selection of one of the built-in sequences merely indicates which one of many sequences should be used without making any changes to the script, let alone generating a sequence.

In view of the discussion above, we find that Anderson fails to teach every recited limitation and therefore, cannot anticipate claim 1. Claims 10, 13, 17 and 19 include similar limitations related to constructing an image capture procedure or prompting the user to do so which, as discussed above with respect to claim 1, are absent in Anderson. Accordingly, as the Examiner has failed to set forth a prima facie case of anticipation, the 35 U.S.C. § 102 rejection of independent claims 1, 10, 13, 17 and 19 as well as claims 2-4, 6, 11, 12, 14-16, 18 and 20, dependent thereon, over Anderson cannot be sustained.

With respect to the rejection of claims 7-9, the Examiner further relies on Steinberg, which teaches nothing related to generating an image capture sequence by a user and fails to overcome the deficiencies of Anderson discussed above with respect to claim 1. Therefore, the 35 U.S.C. § 103 rejection of claims 7-9 over Anderson and Steinberg is not sustained.

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REMAND TO THE EXAMINER

We observe that after filing their appeal, Appellants submitted an Information Disclosure Statement (filed August 25, 2006), which included an English translation of a German Office Action and identified Hiroyuki<sup>3</sup>, a Japanese published application, as a material reference. The abstract of Hiroyuki describes an electronic camera in which, without an external device, a user is allowed to create a script for operating a desired sequence for capturing images. Based on the teachings present in the abstract of Hiroyuki, we recommend that the Examiner consider the entire reference in evaluating the claims by obtaining an English translation.

Pursuant to our authority under 37 CFR § 41.50(a)(1), we remand this application to the Examiner to consider rejecting claims 1-20 over Hiroyuki, alone or in combination with other prior art.

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<sup>3</sup> Hiroyuki JP 2000-316117, Nov. 14, 2000.

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CONCLUSION

In view of the foregoing, the decision of the Examiner to reject claims 1-4, 6 and 10-20 under 35 U.S.C. § 102 and claims 7-9 under 35 U.S.C. § 103 is reversed. The application is remanded to the Examiner for the reasons discussed above.

REVERSED and REMANDED

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ERROL A. KRASS	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
HOWARD B. BLANKENSHIP	)	
Administrative Patent Judge	)	APPEALS AND
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	)	INTERFERENCES
	)	
MAHSHID D. SAADAT	)	
Administrative Patent Judge	)	

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