

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 STEVEN J. SIMSKE

Appeal 2007-0245
Application 10/238,126
Technology Center 2100

Decided: March 27, 2007

Before JOSEPH L. DIXON, JEAN R. HOMERE, and JAY P. LUCAS,
Administrative Patent Judges.

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-6, 10-14, and 16-19. Claims 7-9, 15, and 20 have been objected to and indicated as allowable if rewritten to include the intervening limitations (Answer 4).

We REVERSE.

BACKGROUND

Appellant's invention relates to a system for automatic generation for photo location information. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method of generating image annotation information comprising:

selecting images to be annotated;

analyzing said selected images to identify associated information;

generating annotation information from at least one of said selected images using said associated information; and

annotating said selected images with the annotation information.

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Gabbe	US 5,550,965	Aug. 27, 1996
King	US 5,600,775	Feb. 4, 1997
Ayer	US 6,208,353	Mar. 27, 2001

REJECTIONS

Claims 1-6, 10, 12-14 stand rejected under 35 U.S.C. 102(e) as being anticipated by Ayer.

Claims 17-19¹ stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ayer, as applied to claim 1, in view of King.

Claims 11 and 16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ayer, as applied to claim 1, in view of Gabbe.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellant regarding the above-noted rejection, we make reference to the Examiner's Answer (mailed Mar. 13, 2006) for the reasoning in support of the rejections, and to Appellant's Brief (filed Dec. 27, 2005) and Reply Brief (filed Apr. 10, 2006) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellant's Specification and claims, to the applied prior art references, and to the respective positions articulated by Appellant and the Examiner. As a consequence of our review, we make the determinations that follow.

35 U.S.C. § 102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior

¹ At the outset, we note that the Examiner indicated the claims 7-9 and 15-20 are objected to and then the Examiner rejected claims 16-19. We find that the Examiner intended to reject those claims and made a typographical error in using a dash rather than using "and."

art reference. *Verdegaal Bros. Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). 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 reference, i.e., all limitations of the claim are found in the reference, or ‘fully met’ by it.” While all elements of the claimed invention must appear in a single reference, additional references may be used to interpret the anticipating reference and to shed light on its meaning, particularly to those skilled in the art at the relevant time. *See Studiengesellschaft Kohle v. Dart Indus., Inc.*, 726 F.2d 724, 726-727, 220 USPQ 841, 842-843 (Fed. Cir. 1984).

The Examiner contends that Ayer teaches all of the limitations of independent claim 1 and relies upon the teachings of Ayer at col. 2-3 to teach the steps of analyzing, generating, and annotating the “selected images” (Answer 5).

Appellant argues that Ayer does not teach “analyzing said selected images to identify associated information” and that associated information is used in “generating annotation information from at least one of said selected images using said associated information” (Br. 7-8; Reply Br. 4-6).

Additionally, Appellant argues that Ayer does not teach annotating multiple selected images with the annotation information (Br. 8-9; Reply Br. 7-8).

The Examiner maintains that Ayer teaches analysis of the digital map and extracting features of a map in order to match the feature to the image (Answer 8-9). We cannot agree with the Examiner’s correlation of the

teachings of Ayer to the recited claim limitations since we cannot agree with the Examiner that the map image is a selected image which is to be annotated. Here, we find that the pictorial image data would be the selected images to be annotated and the cartographic image data is stored reference image data which is not annotated. The claim language requires that the selected [plural] images are to be annotated. Since the cartographic image data is not to be annotated, we cannot agree with the Examiner's correlation. We find that the cartographic image data cannot reasonably be one of the selected images.

We agree with the Examiner that the teachings of Ayer may be interpreted to teach that the selected pictorial image is analyzed to apply the cartographic image annotations to the pictorial image to create an integrated image/view (Answer 10). However, we cannot agree with the Examiner that Ayer's disclosure teaches plural selected images as required by the language of independent claim 1. We make no findings relative to obviousness and the application of multiple similar pictorial images to a single pictorial reference since the Examiner has not applied the teachings of Ayer under obviousness to independent claim 1. As discussed above, we find that the Examiner has not met the initial burden of establishing a prima facie case of anticipation since the Examiner has not shown that Ayer teaches the invention as recited in independent claim 1. Therefore, we cannot sustain the rejection of independent claim 1 and its dependent claims 2-6, and 10.

Additionally, the Examiner has not shown that Ayer teaches the recited "means" as set forth in independent claim 12. We find that the Examiner has not met the initial burden of establishing a prima facie case of anticipation since the Examiner has not shown that Ayer teaches the

Appeal 2007-0245
Application 10/238,126

invention as recited in independent claim 12. Therefore, we cannot sustain the rejection of independent claim 12 and its dependent claims 13-14.

35 U.S.C. § 103(a)

With respect to the rejection under 35 U.S.C. § 103(a) of independent claim 17 and dependent claim 11, 16, 18 and 19, the Examiner has not identified how the teachings of King or Gabbe would remedy the deficiency in Ayer. Therefore, the Examiner has not set forth a prima facie case of obviousness, and we will not sustain the rejection of claims 11 and 16-19.

CONCLUSION

To summarize, we have not sustained the rejection of claims 1-6, 10-14, and 16-19 under 35 U.S.C. §§ 102 and 103(a).

Appeal 2007-0245
Application 10/238,126

REVERSED

JLD

ELD

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400