

The opinion in support of the decision being entered today  
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* DOUGLAS K. GENNETTEN and  
ANDREW C. GORIS

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Appeal 2007-0434  
Application 10/041,207  
Technology Center 2100

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Decided: August 14, 2007

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Before KENNETH W. HAIRSTON, LANCE LEONARD BARRY, and  
JAY P. LUCAS, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1 and 3-33. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

#### A. INVENTION

The invention at issue on appeal identifies a digital image. Relatively inexpensive digital cameras and scanners have facilitated sharing images via the Internet. For example, new parents may share a digital photograph of their newborn baby with friends and relatives by attaching the photograph to an electronic mail ("e-mail") message and sending message, with the attachment, to those friends and relatives. Upon receipt of the message, a friend or relative may view the photograph of the newborn baby. Alternatively, the new parents may post the digital photograph to an Internet web page thereby allowing family and friends to view the photo by visiting the web page. (Specification 1.)

In contrast, the Appellants' invention allows a user to share a digital image with others almost immediately after acquiring the image. More specifically, once a digital camera or scanner captures a digital image, the invention assigns an identifier thereto. To share the image, the user provides the identifier to the others who may then, assuming that the device upon which the image is stored is linked to the Internet, use the identifier to access the image. The Appellants assert that their invention eliminates the time-consuming process of uploading or transferring the digital image from the device in which it is stored to an e-mail message or Internet web page. (*Id.* 3.)

## B. ILLUSTRATIVE CLAIMS

Claims 1 and 9, which further illustrate the invention, follow.

1. A method, comprising:

using a digital camera to acquire a digital image; and  
automatically assigning an identifier to said digital image, said identifier uniquely identifying said digital image so that said digital image can be accessed over a network.

9. The method of claim 1, wherein said identifier comprises a permanent unique uniform resource locator.

## C. REJECTIONS

Claims 1, 3-8, 11, 18-21, 23, and 28-30 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,810,149 ("Squilla"). Claims 9, 10, 12-16, 22, 24<sup>1</sup>-27, 31, and 32 stand rejected under 35 U.S.C. § 103(a) as obvious over Squilla and U.S. Patent No. 6,523,022 (Hobbs). Claim 17 stands rejected under § 103(a) as obvious over Squilla and U.S. Patent No. 5,119,465 (Jack). Claim 33 stands rejected under § 103(a) as obvious over Squilla, Hobbs, and U.S. Patent No. 6,694,145 (Riikonen).

## II. CLAIMS 1, 3-8, 11, 17-21, 23, AND 28-30

"Rather than reiterate the positions of parties *in toto*, we focus on the issue therebetween." *Ex Parte Filatov*, No. 2006-1160, 2007 WL 1317144,

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<sup>1</sup> Although the Examiner's statement of the obviousness rejection includes claim 23, (Answer 7), his explanation thereof omits the claim. (*Id.* 10.) Furthermore, both the statement and explanation of the anticipation rejection include claim 23. (*Id.* 3, 6.) Therefore, we treat the claim as omitted from the obviousness rejection.

at \*2 (BPAI 2007). The Examiner asserts, "In column 4 lines 38-45, Squilla discloses using icons or text to identify individual images and that the individual icon or text is used to personalize or identify the pictures either by category or individually (see also; *column 9, lines 30-32*)." (Answer 14.) The Appellants argue, "Squilla never states (nor even implies), that the identifiers should (or even could) uniquely identify each digital image for network access." (Reply Br. 2.) Therefore, the issue is whether the Examiner has shown that Squilla assigns to a digital image an identifier that is unique to a network.

"Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. . . . The second step in the analyses requires a comparison of the properly construed claim to the prior art." *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933, 69 USPQ2d 1283, 1286 (Fed.Cir. 2003) (internal citations omitted).

#### A. CLAIM CONSTRUCTION

"Our analysis begins with construing the claim limitations at issue." *Ex Parte Filatov*, No. 2006-1160, 2007 WL 1317144, at \*2 (BPAI 2007). "[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324, 72 USPQ2d 1209, 1211 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d

1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Here, independent claims 1 and 21 recite in pertinent part the following limitations: "assigning an identifier to said digital image, said identifier uniquely identifying said digital image so that said digital image can be accessed over a network." Giving the independent claim the broadest, reasonable construction, the limitations require assigning to a digital image an identifier that is unique within a network.

#### B. ANTICIPATION AND OBVIOUSNESS ANALYSIS

"Having construed the claim limitations at issue, we now compare the claims to the prior art to determine if the prior art anticipates those claims." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002). "[A]nticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. . . ." *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984)). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986).

Here, Squilla describes "software and [a] system for cataloging digital images into an electronically stored collection or library." (Col. 1, ll. 7-9.) "Referring to FIG. 2, there is illustrated a flow diagram of the operation of . .

. [the] computer software program. . . ." (Col. 3, ll. 36-37.) "[T]he first step 30 of [the] software program allows the user to obtain digital images from any appropriate source. For example, as illustrated by FIG. 1, digital images may be obtained by scanning of images by the user, or from a digital device such as a digital camera. . . ." (*Id.* ll. 41-46.) "Alternatively, the images may be obtained from the third party 28 over a communication network such as the internet 24." (*Id.* ll. 46-48.)

"In the next step 32, the selected images are reviewed and categorized. (*Id.* ll. 54-55.) "After completion of step 32, the images at step 34 are used as desired. For example, the categorized images would be sent to a data storage file, to a third party, a service provider for obtaining desired goods and/or services, or possibly to a printer." (*Id.* ll. 54-60.)

"In the particular embodiment [described by the reference], there is [sic] provided five (5) selection categories 40, 42, 44, 46, and 48. In particular selection category 40 is directed to 'Who', meaning who are the individuals in the image 44 that are to be identified with the image." (Col. 4, ll. 23-27.) "In selection category 40, there is provided a plurality of the image icons 50, 52, 54, and 56 for allowing the user to quickly and easily categorize the image 4[1]." (*Id.* ll. 27-30.) "In the particular embodiment illustrated, icon 50 identifies individual name 'Dan', icon 52 identified the individual 'Sally", icon 54 identifies 'Mom' and icon 56 identifies 'Dad'." (*Id.* ll. 35-39.)

The primary passage of Squilla relied on by the Examiner explains "that the various icons can be used to identify anyone or subject desired by the user," (*id.* ll. 39-40), and that "these individual icons may be personalized in accordance with the wishes of the user. Thus, each of the icons can represent a name, a relationship, or any other desired reference." (*Id.* ll. 41-44.) Regardless of how the icons are personalized, however, we agree with the Appellants that "[b]y definition, identifiers used to categorize are not unique, except in the trivial case (clearly not contemplated by Squilla) where each image would be its own category. However, in that trivial case, a category is no category at all." (Reply Br. 2.)

The absence of assigning to a digital image an identifier that is unique within a network negates anticipation. Therefore, we reverse the anticipation rejection of claims 1 and 21 and of claims 3-8, 11, 18-20, 23, and 28-30, which depend therefrom.

The Examiner does not allege, let alone show, that the addition of Jack cures the aforementioned deficiency of Squilla. Therefore, we reverse the obviousness rejection of claim 17, which also depends from claim 1.

### III. CLAIMS 9, 10, 12-16, 22, 24-27, AND 31-33

The Examiner finds, "Hobbs discloses a (network resource that can be identified by a Uniform Resource Locator (URL), a URI or a URN. . .) [see Hobbs, *column 14, lines 21-35*]." (Answer 7.) He further finds that "there is clear teaching of the advantages of using a unique permanent uniform resource locator (URL) of Hobbs as another means to identify pictures for

access on a network (see also Squilla; *column 9, lines 30-32. . . .*" (*Id.* 15.)

The Appellants make the following arguments.

Squilla does not want his identifiers to uniquely identify the digital images, because to do so would frustrate a purpose of his invention. Namely, the categorization of images. Because Squilla clearly does not intend each image to be its own unique category, there is no need in Squilla, thus no suggestion or incentive, to provide an alternative means (such as disclosed in Hobbes) for assigning a unique identifier to the digital images.

(Reply Br. 3.) Therefore, the issue is whether the Appellants have shown that adding URLs or Uniform Resource Identifiers ("URIs") to Squilla's images would have rendered the reference inoperable for its intended purpose.

#### A. PRINCIPLES OF LAW

The presence or absence of a reason "to combine references in an obviousness determination is a pure question of fact." *In re Gartside*, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007). A reason to combine teachings from the prior art "may be found in explicit or implicit teachings within the references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved." *WMS Gaming Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1357, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999) (citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1456

(Fed. Cir. 1998)). Of course, the U.S. Court of Appeals for the Federal Circuit "has previously found a proposed modification inappropriate for an obviousness inquiry when the modification rendered the prior art reference inoperable for its intended purpose." *In re Fritch*, 972 F.2d 1260, 1266 n.12, 23 USPQ2d 1780, 1783 n.12 (Fed. Cir. 1992) (citing *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).

## B. ANALYSIS

Here, the Appellants admit that handling an individual image was known in the art; "[f]or example, new parents may share a digital photograph or image of their newborn baby with friends and relatives. . . ." (Specification 1.) Squilla also discloses the handling of individual images. For example, "the images may be selected **individually** for categorization." (Col. 8, ll. 44-45 (emphasis added).) Once categorized, moreover, the reference's computer program "retriev[es] at least **one** image from a plurality of images that have been previously categorized. . . ." (Col. 1, ll. 63-64 (emphasis added).)

For its part, Hobbes discloses the use of "the Uniform Resource Identifier (URI); Uniform Resource Locator (URL); or Uniform Resource Name (URN) to indicate the network resource to which a method is to be applied. A network resource is a network data object or service that can be identified by a URI, URL or URN." (Col. 14, ll. 26-31.) Those skilled in the art would have known, moreover, that URLs and URIs uniquely identify that object or service.

Those skilled in the art also would have understood that assigning a unique identifier to an image would have facilitated its individual handling. We agree with the Examiner that the need to handle an image individually, and the fact that a unique URI or URL would have facilitated individual handling thereof, would have prompted a person of ordinary skill in the relevant field to assign an URI or URL to individual images.

The Appellants' aforementioned argument that assigning an URI or URL to individual images would frustrate Squilla's categorization of images appears to be based on the premise that combining teachings of Squilla and Hobbes would have necessitated replacing Squilla's selection categories with the URIs or URLs. To the contrary, the Examiner has proposed to employ the URIs or URLs "as another mean[s]," (Answer 15), to identify images. In other words, the images would be identified both individually by URIs or URLs and collectively by categories. Because the categories would be supplemented (by the URIs or URLs), rather than eliminated, a user would still be able to use the selection categories to categories images. Therefore, we affirm the obviousness rejections of claims 9, 10, 12-16, 22, 24-27, and 31-33.

#### IV. ADDITIONAL OBSERVATIONS

Our reversal of the rejections of claims 1, 3-8, 11, 17-21, 23, and 28-30 was based on the Examiner's inability to show that Squilla assigns to a digital image an identifier that is unique to a network. As mentioned regarding claims 9, 10, 12-16, 22, 24-27, and 31-33, however, a person of ordinary skill in the relevant field would have been prompted to assign an

URI or URL to individual images based *inter alia* on the teachings of Hobbs. Those skilled in the art would have known, moreover, that URLs and URIs uniquely identify objects or services to which they are assigned. The Examiner would do well to consider rejecting claims 1, 3-8, 11, 17-21, 23, and 28-30 over a combination of references that includes Squilla and Hobbs.

#### V. ORDER

In summary, the rejection of claims 1, 3-8, 11, 18-21, 23, and 28-30 under § 102(e) and the rejection of claim 17 under § 103(a) are reversed. The rejections of claims 9, 10, 12-16, 22, 24-27, and 31-33 under § 103(a), however, are affirmed.

"Any arguments or authorities not included in the brief or a reply brief filed pursuant to [37 C.F.R.] § 41.41 will be refused consideration by the Board, unless good cause is shown." 37 C.F.R. § 41.37(c)(1)(vii). Accordingly, our affirmance is based only on the arguments made in the brief(s). Any arguments or authorities omitted therefrom are neither before us nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1367, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.")

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

Appeal 2007-0434  
Application 10/041,207

AFFIRMED-IN-PART

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