

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 PATRICIA SCARDINO, ROBERT P. MORRIS,
and HUGH BLAKE SVENDSEN

Appeal 2007-0723
Application 10/310,527
Technology Center 2100

Decided: June 26, 2007

Before JAMES D. THOMAS, HOWARD B. BLANKENSHIP,
and JAY P. LUCAS, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1 through 12, 15 through 26, and 33, which constitute all claims pending in the application. We have jurisdiction under 35 U.S.C. §§ 6(b), 134(a).

Representative independent claim 1 is reproduced below:

1. A method for automatically organizing images uploaded from a computer to a server, comprising the steps of:
 - (a) receiving an upload of image files from the computer on the server, including a folder hierarchy defining in how the image files are stored on the computer; and
 - (b) automatically storing and organizing the image files on the server, such that the folder hierarchy of the image files is preserved.

The following references are relied on by the Examiner

Needham	US 2003/0033378 A1	Feb. 13, 2003 (Filed May 20, 2002)
Anderson	US 6,636,259 B1	Oct. 21, 2003 (Filed July 26, 2000)

All claims on appeal, claims 1 through 12, 15 through 26, and 33 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner relies upon Anderson in view of Needham.¹

Rather than repeat the positions of the Appellants and the Examiner, reference is made to the Brief and Reply Brief for Appellants' positions, and to the Answer for the Examiner's positions.

OPINION

We affirm, essentially for the reasons set forth by the Examiner as expanded upon here. Appellants' arguments in the Brief treat independent claims 1, 15, and 33 collectively. Separate arguments are presented as to dependent claim 5 as representative of dependent claim 20; the same may be said of dependent claim 7 as representative of dependent claim 22.

¹ A rejection of claims 15 through 26 and 33 under 35 U.S.C. § 101 was withdrawn by the Examiner as noted in the paragraph bridging pages 2 and 3 of the Answer.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1996). “[T]he Examiner bears the initial burden on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.3d 1443, 1445, 24 USPQ 1443, 1444 (Fed. Cir. 1992). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

As a starting point for our analysis, we make reference to the admitted prior art at Specification page 1, paragraph [002]. There it is made clear to the reader that it was known in the art that image files were organized into folders on a PC by users. This notion is expanded upon at Specification pages 4 and 5, paragraphs [014-016] and the showing in figure 2. Sources of image files were said to be digital cameras (such as the camera of Anderson). It is emphasized in paragraph [014] that files generally were stored on a computer in a hierarchical manner where the route for the various images in the folder hierarchy was characterized as a path. Software

applications permitted navigation of these files by the use of well known software applications and operating system file managers. One of these is an Explorer window depicted in figure 2 as comprising not only this file structure but the hierarchy is depicted as well. Significantly, each folder within this hierarchy has a name and, according to the discussion at Specification page 5, in paragraphs [015-016], the user has been known to organize the file by name in a certain manner. This is all consistent with standard features of the well known Windows operating system environment of which Explorer was well known.

Thus, the feature argued by Appellants in the Brief and Reply Brief of the absence of a teaching of a folder hierarchy was well known in the art according to their own recognition of it. The reception in representative independent claim 1 is a passive recitation of receiving this hierarchy from an existing passively recited computer. As it is very clear to the reader by now, the parsing capability of this claim and the ability to create online image albums was also well known in the art. These are not claimed to be done automatically by the process.

The Examiner has identified the paragraph at the bottom of column 4 of Anderson as indicating that the camera 14 in figure 1 contains computers or processors within the camera. This is made clear in the showing in figure 3 and the discussion of this figure beginning at column 6, line 7 where it specifically teaches that the computer/microprocessor includes an operating system within the camera for controlling the overall functionality of the camera. The discussion at this column and the later paragraphs indicate that it was also well known in the art, consistent with what we have already

identified Appellants have admitted was well known in the art, to store files within a file system and by use of system folders. We therefore, do not agree with Appellants urging in the Brief and Reply Brief that Anderson does not teach the use of the claimed passively recited computer and that Anderson teaches away from the claimed invention. The artisan well recognizes the teaching value in the background of Anderson beginning at column 1 as indicating that it was known in the art to use computers or PCs as a means for uploading images for photo sharing. According to this background and the teachings in Anderson, the artisan would understand that Anderson actually teaches moving a computer or PC in effect into the camera itself rather than having a separate PC, notebook, computer or PDA as the intermediate transfer device.

We make special note here of the teachings at column 3, lines 39 through 49; column 4, lines 18-19; the discussion beginning at column 8, line 5 with respect to the action list shown in figure 5 (particularly the discussion at column 8, lines 37- 42) and the discussion at column 12, lines 20 through 61. These teachings indicate that the user maintains the ability to manually organize images from those saved in MyShoeBox and to additionally have the capability within Anderson, based upon the action list 48 in figure 1, to automatically perform predefined tasks such as creating a new web album, or a new page within an existing album and to otherwise parse the images to extract other types of data. The teachings associated with these action lists permits the user to label with names the associated files and albums such as those discussed in the reference portion of column 12. These action lists are in effect a list of key words to the extent recited in

dependent claims 5, 20 and may be viewed by the artisan as constituting upload IDs of respective folders in accordance with the Appellants' own characterization of the admitted prior art. The entity names and entity folders noted by the Examiner in the Answer as taught in Anderson are consistent with these teachings.

To the extent Anderson does not teach explicitly and to the extent Appellants' own admitted prior art does not indicate either, the artisan would have interpreted Anderson as implicitly keeping the same hierarchical file structure known in the art upon transfer since it does not say so otherwise, but further permits the user to create the user's own. In this regard, the Examiner's reliance upon Needham is not misplaced even though the reader may, at first blush, consider otherwise. As urged by the Examiner, a consideration of the teaching value of Needham does clearly indicate that the transfer of files is consistent with the pre-existing file structure upon which it was created before it was sent. The discussion at page 1, column 1 of Needham makes reference to the same prior art operating systems and file structures as does Appellants' own admitted prior art in which the artisan would well appreciate in reading the nature of the operating systems utilized by Anderson as well. The nature of file structures associated with each table and the organization thereof as well as the hierarchy of them is discussed at page 2, columns 1 and 2 of Needham and shown generally in figures 3 through 5. Figures 10, 12, and 15 through 17 illustrate the formation of directories, subdirectories and their files as well at the trial web site and their associated data structures being preserved as well upon being copied when they are transferred to a production site and the like.

The use of directories, subdirectories and their respective files in Needham is consistent with Appellants' own recognized prior art data structures for files and the showing in what amounts to prior art figure 2 of the Specification as filed. The showing in Specification figure 5 is consistent with this admitted prior art or given path to the extent recited in dependent claims 5 and 20 on appeal. Correspondingly, the upload ID or each of the respective directories, subdirectories and files within each of them relate to the features of uploadable identifiers once a production web site is created in Needham utilizing the prior art operating systems in that reference. Moreover, the "can be used" capability of claim 5 and the "can quickly find" capabilities of dependent claim 7 are not positively recited recitations but mere capabilities of potential future acts which are clearly within the ambit of the prior art operating systems admitted by Appellants to be in the prior art and that are specifically taught as noted earlier in Needham.

This additional assessment of the teachings of Anderson and Needham and those which were identified by the Examiner in the Answer are consistent with the above-noted case law regarding combinability of teachings of the prior art as well as addressing the arguments of Appellants in the Brief and Reply Brief as to the noted features.

In view of the foregoing, the decision of the Examiner rejecting all claims on appeal under 35 U.S.C. § 103 is affirmed.

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

AFFIRMED

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