

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANGELICA QUINTANA

Appeal 2007-3047
Application 10/117,543
Technology Center 2600

Decided: January 31, 2008

Before ANITA PELLMAN GROSS, ROBERT E. NAPPI, and JOHN A. JEFFERY, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-6, 10-18, and 25-34.¹ We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part.

¹ A previous rejection of claim 1 under 35 U.S.C. § 112, second paragraph has been withdrawn (Ans. 2, 13).

STATEMENT OF THE CASE

Appellant invented a system that enables a user to send pictures from a digital camera to a recipient via an instant messaging service. In one aspect of the invention, an image file is automatically transmitted from the camera to the recipient when the recipient logs into the instant messaging service.² Claim 1 is illustrative:

1. An imaging system comprising:

a digital camera, the digital camera including an intent module, wherein the intent module accepts user input through a user interface of said camera, said user input including an intent specification to transmit a particular file created by said digital camera via an electronic instant messaging service, said intent specification specifying a recipient to which said particular file created by the digital camera is to be sent via said electronic instant messaging service, wherein said recipient is a registered user of said instant messaging service;

wherein, after said digital camera is brought into communication with a device with access to said instant messaging service and that has logged into said instant messaging service, a determination is made as to whether said recipient is also logged into said instant messaging service and said particular image file is transmitted to said recipient automatically if said recipient is logged into said instant messaging service.

The Examiner relies on the following prior art references to show unpatentability:

Center, Jr.	US 2002/0163572 A1	Nov. 7, 2002 (filed Nov. 13, 2001)
Bateman	US 2002/0194414 A1	Dec. 19, 2002 (filed Jun. 15, 2001)
Parker	US 6,677,976 B2	Jan. 13, 2004 (filed Feb. 28, 2002)

² See generally Spec. 0009-0013.

Appeal 2007-3047
Application 10/117,543

Ward	US 6,784,924 B2	Aug. 31, 2004 (filed Jan. 7, 1998)
Bengtsson	US 6,865,191 B1	Mar. 8, 2005 (filed Aug. 3, 2000)

1. Claims 25 and 26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Bengtsson.
2. Claim 27 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Bengtsson and Parker.
3. Claims 1-6, 11-17, 28-30, 32, and 33 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Ward and Parker.
4. Claims 10 and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Ward, Parker, and Center.
5. Claim 31 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Ward, Parker, and Bengtsson.
6. Claim 34 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Ward, Parker, and Bateman.

Rather than repeat the arguments of Appellant or the Examiner, we refer to the Briefs and the Answer for their respective details. In this decision, we have considered only those arguments actually made by Appellant. Arguments which Appellant could have made but did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

OPINION

The Anticipation Rejection

We first consider the Examiner's rejection of claims 25 and 26 under 35 U.S.C. § 102(e) as being anticipated by Bengtsson. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444 (Fed. Cir. 1984); *W.L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554 (Fed. Cir. 1983).

The Examiner has indicated how the claimed invention is deemed to be fully met by the disclosure of Bengtsson (Ans. 3). Regarding independent claim 25, Appellant argues that Bengtsson does not teach or suggest that an instant messaging address is entered into the camera or terminal of Bengtsson such that the file will be automatically transmitted when the camera is subsequently connected to a system having the instant messaging service as claimed. According to Appellant, Bengtsson does not teach or suggest any activity that takes place on the terminal while it is not connected to any system (App. Br. 9-10; Reply Br. 4-5).

The Examiner construes the recited supporting system to correspond to the network in Bengtsson that uses Wireless Access Protocol (WAP). According to the Examiner, the camera/terminal in Bengtsson is not connected to this or any supporting system unless the network is accessed. The Examiner adds that recipients' addresses are entered into the camera via a user interface before the camera/terminal is connected to the network (Ans. 14-15).

The issue before us, then, is whether Bengtsson expressly or inherently discloses entering an instant messaging address into the camera when the camera is not connected to any supporting system as recited in independent claim 25. For the following reasons, we find that Bengtsson does not expressly or inherently disclose this limitation.

Bengtsson discloses a radio communication system which enables users to attach files (e.g., image files) to standard Short Message Service (SMS)³ messages (Bengtsson, col. 3, ll. 24-30; col. 5, ll. 4-7). To this end, the user's terminal can have a digital camera built into the terminal; the camera can also be detachably associated with the terminal (col. 4, ll. 27-57). Upon creating a conventional SMS message, the user can attach a file either via system prompting, menu selections, or keypad entries. If the user attaches a file, the attached file is sent to a special server 32 via the WAP protocol. The text portion of the SMS message, however, is sent to a different server, SMS server 36. From that server, the SMS message's text portion is then sent to the receiving party 34 (Bengtsson, col. 5, ll. 7-34; Figs. 2 and 3).

Alternatively, the URL address of the attachment can be included in the SMS text message. In this case, the receiving party can download the image from server 32 to their terminal 34 via the WAP protocol (Bengtsson, col. 5, ll. 40-54).

We find nothing in Bengtsson that expressly or inherently discloses entering an instant messaging address into the camera when the camera is

³ SMS is a message function service within the GSM radio communication standard that enables transmission of messages with up to 160 alphanumeric characters to a subscriber at a mobile unit (Bengtsson, col. 1, ll. 17-27).

not connected to *any* supporting system as recited in independent claim 25. Bengtsson says nothing about exactly when a recipient's address is entered into the camera/terminal and therefore does not expressly disclose the limitation.

Nor is this limitation inherent in Bengtsson. Even if we assume that the recipient's address is entered into the camera/terminal before it is connected with the network using the WAP protocol, such an entry would still not necessarily occur when the camera/terminal is not connected to *any* supporting system as claimed -- an SMS system or otherwise. Although the addresses could be entered in the camera/terminal prior to transmitting the images to server 32, Bengtsson simply does not say exactly when these entries are made with respect to connection to any "supporting system." That is, even if we consider the path between the camera/terminal 30 and server 32 to be the recited "supporting system," the camera/terminal 30 could still be connected to this "supporting system" (or other "supporting systems") during entry of the addresses and before transmitting image data to the server 32.

Furthermore, even if the addresses are entered before connecting to Bengtsson's radio communication system, the addresses could be entered when the camera is connected to *another* supporting system distinct from the disclosed radio communication system. Claim 25 requires entering addresses when the camera is not connected to "*any*" supporting system -- not just "*a*" supporting system. The Examiner has simply not shown that this entry necessarily occurs when the camera is not connected with *any* supporting system -- an essential requirement for anticipation by inherency.

For the foregoing reasons, we will not sustain the Examiner's rejection of independent claim 25 or dependent claim 26 for similar reasons.

The Obviousness Rejections

Claim 27

We now consider the Examiner's rejection of claim 27 under 35 U.S.C. § 103(a) as unpatentable over Bengtsson and Parker. 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 (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 (1966).

Discussing the question of obviousness of a patent that claims a combination of known elements, *KSR Int'l v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007), explains:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida [v. AG Pro, Inc.]*, 425 U.S. 273 (1976)] and *Anderson's-Black Rock[, Inc. v. Pavement Salvage Co.]*, 396 U.S. 57 (1969)] are illustrative—a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

KSR, 127 S. Ct. at 1740. If the claimed subject matter cannot be fairly characterized as involving the simple substitution of one known element for

another or the mere application of a known technique to a piece of prior art ready for the improvement, a holding of obviousness can be based on a showing that “there was an apparent reason to combine the known elements in the fashion claimed.” *Id.* at 1740-41. Such a showing requires “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.” *Id.* at 1741 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

If the Examiner’s burden is met, the burden then shifts to the Appellant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Regarding claim 27, although the Examiner adds the disclosure of Parker to Bengtsson (Ans. 4), we find that Parker does not cure the deficiencies of Bengtsson that we noted above with respect to claims 25 and 26. We therefore will not sustain the Examiner’s rejection of claim 27 for the same reasons we discussed with respect to claims 25 and 26.

The Rejection of Claims 1-6, 11-17, 28-30, 32, and 33

Claims 1-6, 11, 32, and 33

We now consider the Examiner’s rejection of claims 1-6, 11-17, 28-30, 32, and 33 under 35 U.S.C. § 103(a) as unpatentable over Ward and Parker. The Examiner’s rejection essentially finds that Ward discloses all of

the claimed subject matter except for (1) an instant messaging service; (2) the recipient being a registered user of the instant messaging service; and (3) determining whether the user is logged in to this service after the digital camera is brought into communication with a device with access to the instant messaging service. The Examiner cites Parker as teaching these features and concludes that it would have been obvious to the skilled artisan at the time of the invention to modify Ward's camera to transmit a file to a registered recipient via an electronic instant messaging service (Ans. 5-6; 15-17).

Regarding representative claim 1,⁴ Appellant argues that Ward does not disclose transmitting a file created by the digital camera via an electronic instant messaging service as claimed (App. Br. 11-12; Reply Br. 5).

Regarding Parker, Appellant adds that any image content captured by the video camera in the reference is not transmitted by an instant messaging service, but rather is transmitted using a separate video telephony server application and corresponding client application (App. Br. 12; Reply Br. 6).

We will sustain the Examiner's rejection of representative claim 1. Ward discloses a digital camera 10 that interfaces with a host computer 12. The camera includes a "send" button or icon that allows the user to transmit selected images to a desired destination via a wired or wireless communications interface. To this end, a network configuration file containing instruction information for communicating with a selected destination is generated at the computer and downloaded to the camera.

⁴ Appellant argues claims 1-6, 11, 32, and 33 together as a group. *See* App. Br. 11-13. Accordingly, we select claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(vii).

When the user transmits selected images to a desired destination, information pertaining to this transmission is read from the network configuration file (e.g., communications port settings, user account specifics, etc.) to simplify transfer of the images to different destinations and online services (Ward, col. 1, ll. 25-67; col. 2, ll. 39-58; col. 3, ll. 14-65; Figs. 1, 2).

Parker discloses a system that integrates video telephony with chat and internet messaging applications. To this end, a central server 13 runs (1) a video telephony server application 50, (2) a chat server application 51, and (3) an instant messaging server application 52. The server also maintains the databases of registered users for each of these communication services (video telephony, chat, and instant messaging) (Parker, col. 7, ll. 23-38; Fig. 7).

Users' computers 10 and 11 communicate with the central server 13 via a public data network (e.g., the Internet). As shown in Figure 8, the user interface includes a video camera 61 and a display monitor 60. Each client application (i.e., video telephony, chat, and instant messaging) runs in a respective program window (Parker, col. 7, ll. 40-53; Fig. 8).

To establish a video telephony call, a call request is sent from user #1 to the central server. The central server then forwards the request to user #2 who can then accept or decline the call by selecting the appropriate button on the generated prompt. If the call is accepted, both computers launch a respective video telephony client application and exchange live video signals from their respective cameras (Parker, col. 8, l. 53 - col. 9, l. 2; Fig. 10).

In another implementation, Parker discloses a video telephony system where one user dials another user's telephone phone number. The dialed number is captured by a computer and forwarded to the central server 13 as

part of an access request. Central server then sends an initiation message to user #2's computer. If user #2 accepts, data messages can be exchanged between application programs running on both users' computers 10, 11. The application programs can perform file transfers of various types of files, video data or frames for video telephony, or other real-time data. Data exchange can continue until either user deactivates their application program (Parker, col. 4, l. 59 - col. 5, l. 14; col. 5, l. 53 - col. 6, l. 30; Figs. 2 and 3).

Based on this functionality, we find that the collective teachings of Ward and Parker amply suggest the limitations of representative claim 1. First, although a video telephony application is used in Parker for video data communication as Appellant argues, we agree with the Examiner (Ans. 18) that the video telephony service is but one of the instant messaging services in Parker.

Nevertheless, even if we assume, without deciding, that video telephony somehow cannot be considered "electronic instant messaging" under the term's broadest reasonable interpretation, the central server 13 nonetheless fully meets the recited "electronic instant messaging service" since the server provides, among other things, instant messaging capability. As shown in Figure 7 of Parker, data transferred from User #1's computer to User #2's computer passes through the central server 13. Therefore, even if all image data between users is handled by the server's video telephony application, the image data is nonetheless transmitted to the recipient through "an electronic instant messaging service" 13.

We also agree with the Examiner (Ans. 17) the recipient's ability to accept or decline a video telephony call in Parker certainly suggests that the recipient is logged into the system. Significantly, video telephony calls can

be made after establishing a “supplemental communication” – an initial contact between users that can be via instant messaging (Parker, col. 8, ll. 37-42; Fig. 9 (Step 84)). At a minimum, this initial “supplemental communication” using instant messaging would establish whether the recipient is logged into the system prior to transmitting image data to the recipient.

Parker further teaches that commensurate video telephony applications (e.g., the embodiment of Figures 2 and 3) can exchange not only video data, but also files or other real-time data upon acceptance of a call initiation message (Parker, col. 5, ll. 6-13). We agree with the Examiner (Ans. 18) that this embodiment reasonably meets an “instant messaging service” under the term’s broadest reasonable interpretation. Moreover, we see no reason why this functionality (i.e., transferring data and files in real-time in conjunction with a video telephony application) could not be applied to the system shown in Figure 7. In addition, we see no reason why Parker’s system would not be capable of transferring image files from a digital camera, such as that disclosed in Ward. In this regard, we find the references’ teachings reasonably combinable as both references pertain to transmitting image data to remote online destinations.

For at least these reasons, we find that the collective teachings of Parker and Ward amply suggest all recited limitations of representative claim 1. Therefore, we will sustain the Examiner’s rejection of claim 1 and claims 2-6, 11, 32, and 33 which fall with claim 1.

Claims 12-15 and 28-30

We will also sustain the Examiner's rejection of representative claim 12 calling for, in pertinent part, entering an address for an instant messaging recipient through a user interface of the digital camera, and automatically sending a selected image file to the recipient via an instant messaging service. As we discussed previously in connection with claim 1, we find the collective teachings of Ward and Parker amply suggest these limitations, particularly with respect to the instant messaging service. Our previous discussion of Parker and Ward applies equally here and we incorporate that discussion by reference.⁵ We also agree with the Examiner (Ans. 17) that Ward reasonably suggests entering data into the camera via a user interface. Accordingly, we will sustain the Examiner's rejection of representative claim 12 as well as claims 13-15 and 28-30 which fall with claim 12.

Claims 16 and 17

We will also sustain the Examiner's rejection of claims 16 and 17 for the same reasons as we indicated previously and we incorporate that discussion by reference.⁶ Regarding the recited pre-defined text message, we note that not only does Parker teach transferring data messages in conjunction with transfers of files or other real-time data (Parker, col. 5, ll. 9-14), but also ordinarily skilled artisans would readily recognize that the *file name itself* would constitute a pre-defined text message as claimed. We will therefore sustain the Examiner's rejection of representative claim 16 and claim 17 which falls with claim 16.

⁵ See p. 9-11, *supra*, of this opinion.

⁶ See *id.*

The Obviousness Rejections of Claims 10, 18, 31, and 34

Regarding the Examiner's rejections under 35 U.S.C. § 103(a) of (1) claims 10 and 18 over Ward, Parker, and Center; (2) claim 31 over Ward, Parker, and Bengtsson; and (3) claim 34 over Ward, Parker, and Bateman, we find that the Examiner has established at least a prima facie case of obviousness of those claims that Appellant has not persuasively rebutted. Specifically, the Examiner has (1) pointed out the teachings of Ward and Parker, (2) noted the perceived differences between these references and the claimed invention, and (3) reasonably indicated how and why these references would have been modified in view of the cited secondary references to arrive at the claimed invention (Ans. 10-13). Once the Examiner has satisfied the burden of presenting a prima facie case of obviousness, the burden then shifts to Appellant to present evidence or arguments that persuasively rebut the Examiner's prima facie case. Appellant did not persuasively rebut the Examiner's prima facie case of obviousness, but merely noted that claims 10, 18, 31, and 34 are patentable by virtue of their dependence from patentable independent claims (App. Br. 16-17; Reply Br. 8). Since we have found the independent claims to be unpatentable, the rejections of claims 10, 18, 31, and 34 are therefore sustained.

DECISION

We have sustained the Examiner's rejections with respect to claims 1-6, 10-18, and 28-34. We have not, however, sustained the Examiner's

Appeal 2007-3047
Application 10/117,543

rejection of claims 25-27. Therefore, the Examiner's decision rejecting claims 1-6, 10-18, and 25-34 is affirmed-in-part.

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-IN-PART

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