UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD C. MAURO and ANTHONY M. KELLY

Appeal 2008-4084
Application 10/124,118
Technology Center 3600

Decided: November 21, 2008

Before HUBERT C. LORIN, MURRIEL E. CRAWFORD, and BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-31. Claims 32-38 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We AFFIRM.

THE INVENTION

The Appellants' claimed invention is directed to a system for photofinishing digital images which automatically assigns customer billing and customization data to a customer order that originates from a storage medium such as a memory card. A label is encoded with information relating to photofinishing services and provided on the storage medium (Spec. 2:10-25). Claim 1, reproduced below, is representative of the subject matter of appeal.

> 1. A method of offering imaging services to a customer, the method comprising the steps of:
>
> providing a label having encoded information thereon to a customer, said label being adapted to be affixed onto a removable digital image storage medium, said encoded information providing a database link to associated label information associated with the customer;
>
> entering the label information associated with the encoded information into a database to store the label information;
>
> reading the encoded information on the label when the customer places a removable digital image storage medium with the label affixed thereon into an imaging station having a reader, the images on the digital image storage medium being loaded from the digital image storage medium to the imaging station:
>
> linking the encoded information on the label of the digital image storage medium with the stored label information in the database; and
>
> providing imaging services to images loaded to the imaging station from the digital image storage medium based on at least the linked stored label information in the database.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Boyd	US 2002/0143762 A1	Oct. 3, 2002
Iida	US 6,900,882 B2	May 31, 2005

The following rejections are before us for review:

1. Claims 1-31 are rejected under 35 U.S.C. § 103(a) as unpatentable over Iida and Boyd.

THE ISSUE

The issue is whether the Appellants have shown that the Examiner erred in rejecting claims 1-31 under 35 U.S.C. § 103(a) as unpatentable over Iida and Boyd.

This issue turns on whether it would have been obvious to combine the disclosed teachings of Iida and Boyd to meet the claimed limitations.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence[1]:

FF1. Iida discloses a print order receiving machine 102 with an encoding section 132 that sends information to a label writer 130. The label writer prints the information on a label 64 which is placed on the photographic print 62. The label 64 is two dimensional bar code (Fig. 2 and Col. 9:38-54).

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[1] *See Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF2. Iida discloses that the order information is placed in the two dimensional barcode that is stored on the print 62B (Col. 14:43-49).

FF3. Image processing is carried out based on the order information (Col. 14:50-58).

FF4. Iida does not disclose that a database is used for the information on the photographic print 62.

FF5. Boyd discloses that keywords or text descriptions for photographs such as "Christmas 2000" or "Hawaii" may be utilized [0014].

FF6. Boyd discloses that a database application generates labels to be used with storage structures for the photographs [0016].

FF7. Boyd does disclose that information relating to the photographs is stored and provided in a database.

PRINCIPLES OF LAW

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, (1966). *See also KSR*, 127 S. Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that "the principles laid down in *Graham* reaffirmed the 'functional approach' of *Hotchkiss*, 11 How. 248." *KSR*, 127 S. Ct. at 1739 (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." The Court also stated "[i]f a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability." *Id.* at 1740. The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.*

The Court noted that "[t]o facilitate review, this analysis should be made explicit." *Id.* at 1741 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness")). However, "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.*

ANALYSIS

The Appellants argue that the rejection of claims 1-31 under 35 U.S.C. § 103(a) as unpatentable over Iida and Boyd is improper because neither reference teaches, discloses, or suggests entering label information into a database including information from which imaging services are performed (Br. 7-8, 10-11). The Appellants further argue that there is no motivation to combine the references of Iida and Boyd (Br. 8-12). The Appellants argue that there is no teaching or suggestion to move the photo processing information from the image itself as disclosed in Iida to the database of Boyd. The Appellants further argue that in Idia there is no means taught or suggested to accommodate storage and retrieval of such information in a database (Br. 8). The Appellants argue that one of ordinary skill in the art would not look to Boyd, which discloses a method of organizing physical storage, as a means of recording print-specific information necessary for reprints (Br. 9).

The Examiner in contrast has found that Idia discloses that photo processing information is stored on a bar code and recorded on a photographic print (Ans. 17). The Examiner has also found that Boyd discloses a database which stores user and photograph information and creates a label which may be affixed to a storage structure used to retain the photographs (Ans. 17). The Examiner has found that it would have been obvious to store photo processing information in the database as disclosed by Boyd instead of a barcode to look up the needed information. The Examiner has found that Iida would be motivated to make such a modification to reduce the amount of information that is stored on the barcode and to be more efficient and encode a pointer in a database (Ans. 4).

We agree with the Examiner. Iida discloses that order information is made into a two dimensional barcode that is stored on a photographic print (FF 1 & 2). Iida has also disclosed that image processing is carried out based on the order information in the barcode (FF3). Boyd has disclosed that information relating to the photographs is stored and provided in a database (FF6). Iida's disclosure limits the photo imaging information to a single barcode on the print which cannot be modified if information changes. Boyd's teaching of the use of a database to store photo information would allow changes to the database and easier transfer of information for other uses. We find that modifying the disclosure of Iida's fixed barcode to store imaging services information with the disclosure of Boyd to store information related to photographs in a database for more efficient storage of photo imaging services information to be an obvious, predictable result of prior art elements according to their established functions with articulated reasoning and rational underpinning.

For the above reasons we sustain the rejection of claims 1, 11 and 22 under 35 U.S.C. § 103(a) as unpatentable over Idia and Boyd. The Appellant has not separately argued dependent claims 2-10, 12-21, and 23-31 and the rejection of these claims under 35 U.S.C. § 103(a) as unpatentable over Idia and Boyd is accordingly sustained for the same reasons as above.

CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1-31 under 35 U.S.C. § 103(a) as unpatentable Iida and Boyd.

DECISON

The Examiner's rejection of claims 1-31 is sustained.

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) (2007).

AFFIRMED

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