

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ERIC C. ANDERSON

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Appeal No. 2003-0557  
Application 09/121,760

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ON BRIEF

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Before THOMAS, FLEMING, and BARRY, Administrative Patent Judges.  
THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 1, 5-21 and 25-44. Representative claim 1 is reproduced below:

1. A hand held image capture device for automatically categorizing images, wherein said hand held image capture device captures raw image data of a live view subject, comprising:

a processor within said hand held image capture device for converting the raw image data into processed image data during an image processing process;

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an analysis module configured to analyze said raw image data during said image processing process in order to identify one or more categories to which each of said images may relate, said analysis module being run by said processor; and

category tags attached by said analysis module to each of said images corresponding to said categories, said category tags stored with each of said images, thereby enabling said processor to automatically sort said images into different categories.

The following references are relied on by the examiner:

Parulski et al. (Parulski)	5,633,678	May 27, 1997
Jamzadeh	5,889,578	Mar. 30, 1999 (filing date Oct. 26, 1993)
Anderson et al. (Anderson)	6,028,611	Feb. 22, 2000 (filing date Aug. 29, 1996)

Claims 1, 5-21 and 25-44 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Jamzadeh as to claims 1, 5-7, 9, 16-21, 25-27, 29 and 36-42. The examiner has added Anderson to Jamzadeh as to claims 8, 12-15, 28 and 32-35, and the examiner has added Parulski to Jamzadeh as to claims 10, 11, 30, 31, 43 and 44.

Rather than repeat the positions of the appellant and the examiner, reference is made to the brief and reply brief for the appellant's positions, and to the answer for the examiner's positions.

OPINION

For the reasons set forth by the examiner in the answer, we sustain the rejection of all claims on appeal under 35 U.S.C. § 103. Essentially, we agree with the examiner's general positions with respect to the statement of the rejection and the responsive arguments in the answer, with the following embellishments.

At the outset, we note that appellant treats each independent claim 1, 21, 41 and 42 consistent with the arguments presented as to representative independent claim 1 on appeal. We do the same. No arguments are presented as to any dependent claim.

As noted by the examiner, the image data manager IDM 30 in Figure 1 of Jamzadeh is taught at column 3, lines 48 to 50 as comprising "a low-cost general purpose personal computer or a high performance work station, depending on the level of performance." We agree with the examiner's reasoning in the answer that such a general purpose personal computer was a laptop as representative of what the artisan obviously would have considered as comprising the noted teaching. Therefore, the examiner's reasoning as to this well-known device comprising the

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claimed "hand-held image capture device" is fully agreed with by us.

Clearly, the software discussed in detail in Jamzadeh is consistent with the feature of automatically categorizing images. In fact, the bulk of the disclosure in this reference from Figures 2A through 7 is consistent with the corresponding columnar teachings about the automatic categorization of the digital images stored in this reference as not only comprising the claimed categories of image data but also the corresponding claimed category tags attached to each of the respective images such that they are automatically sorted by these category identifiers. Notwithstanding these considerations, these noted features have not been argued as distinguishing over the teachings and suggestions of Jamzadeh by appellant in the brief and reply brief.

Appellant repeatedly argues in the brief and reply brief that the disclosed invention relates to a digital camera. On the other hand, there is no such recitation in the claims on appeal, and for emphasis, there is no separate element within the claims to comprise the ability to capture raw image data in any form any differently than the whole device itself that is claimed. Moreover, representative claim 1 does not exclude intermediate

steps such as the beginning teachings of the reference of exposing on conventional film an image which is then scanned digitally by the film scanner 32 in Figure 1 to be received by the image data manager 30. We therefore agree with the examiner's views best expressed at page 10 of the answer that "Jamzadeh discloses that image data manager 30 receives image signal from the film scanner, it clearly shows that the image data manager 30 includes an input terminal to receive or to capture image signal." As essentially argued by the examiner, the data bus 34 in this figure feeding the image data from the scanner 32 directly provides a input to the image data manager's terminal a source of captured raw image data. The mere "capture" of image data in claim 1 is not coextensive with the positive recitation of a digital camera which claim 1 clearly does not require. The capturing of the information is consistent with the concept in the reference and the claim of capturing or acquiring or receiving information from an indirectly or non-recited source. Therefore, the basic view of the examiner that the image data manager 30 comprises the hand-held image captured device of claim 1 of appeal is consistent with our understanding of the claim and the teachings of the reference, whereas appellant's

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arguments appear to be more specific than the actual recitations of claim 1 on appeal anyway.

The feature in the preamble of claim 1 of the device capturing raw image data of a live view subject is equally non-distinguishing. The examples given at column 3, lines 18-36 of Jamzadeh of the nature of the data received by the IDM 30 includes photographs of a family reunion and several close-up shots of the photographer's graduating son, both of which examples are clearly live view subjects to the extent recited in the preamble of representative claim 1 on appeal.

Besides essentially teaching this feature, it is well stated that a different intended use of the same structure as in the prior art does not prohibit a statutory anticipation rejection, for example. Indeed, it has been stated by our reviewing court that "the absence of a disclosure relating to function does not defeat the Board's finding of anticipation. It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable (case citations omitted)." In re Schrieber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). The court concludes at 128 F.3d 1477, 44 USPQ2d 1431-32, that "Schrieber's contention that his structure will be used to dispense popcorn does not have

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patentable weight if the structure is already known, regardless of whether it has ever been used in anyway in connection with popcorn (emphasis added)." Such reasoning obviously applies to rejections under 35 U.S.C. § 103. Schrieber confirms the guidance provided in Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Int. 1987), that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus for a prior art apparatus satisfying the claimed structural limitations. Note also Ex parte Wikdahl, 10 USPQ2d 1546, 1548 (Bd. Pat. App. & Int. 1989) and In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238, CCPA 1967).

Appellant's position at the bottom of page 8 of the brief that Jamzadeh's system does not teach or suggest performing automatic image analysis of raw image data at the time of image capture inside an integrated hand-held capture device is misplaced. The claim does not require that such analysis occur at the time of image capture. The claim merely requires that the analysis occur "during an image processing process." In any event, our earlier discussion in this opinion clearly indicates that we consider Jamzadeh to not only perform the image analysis during an image processing process to the extent actually recited

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in the claim, as well as at the time of image capture as we have interpreted at claim earlier in this opinion as to this feature. To the extent actually recited in the claims on appeal, the examiner's basic view that the image data manager 30 comprises the processing element, the analysis module, and the category tags and performance of image capturing and analyses functions is consistent with the noted features of the representative claim 1 on appeal to the extent recited thereon.

Lastly, the examiner's mention of Official Notice at page 11 of the answer is noted. While the general use of such an approach is generally highly disfavored, our decision here is not based upon any reliance upon Official Notice since the evidence of record relied upon by the examiner for obviousness clearly does not require a connection of a camera to a computer where image data capture by a camera would be downloaded to a computer for further processing as argued by the examiner. Such is not required by the representative claim 1 on appeal anyway and the examiner's view at page 10 of the answer and our embellishment thereon earlier in this opinion indicates that the scope of the subject matter of the claim does not require a separate recitation of a camera. The claim permits the data inputting from the scanner 32 on the bus 34 into the IDM 30 and

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such is all that is required to meet the capturing feature to the extent recited in representative claim 1 on appeal.

Appellant has indicated at the bottom of page 3 of the principal brief on appeal that all claims on appeal "stand or fall together and form one group." Appellant's arguments as to the second and third stated rejections, separately relying upon the additional teachings of Anderson and Parulski, respectively, rely for patentability at pages 7 and 8 of the principal brief on the arguments already made with respect to the independent claims 1 and 21. Appellant's additional comment at page 8 of the principal brief that appellant "incorporates by reference herein the arguments presented relating to these [respective] claims in earlier responses" as to the second and third stated rejections is not well received. 37 CFR § 1.192(a) requires appellants to place into their brief all arguments that they want us to hear. Thus, any attempt to incorporate by reference arguments made during earlier prosecution is not well taken. Additionally, there are no arguments presented before us in the brief challenging the propriety of the combination within 35 U.S.C. § 103 of Anderson and Jamzadeh and Parulski and Jamzadeh as to their respectively rejected claims.

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In view of the foregoing, the decision of the examiner rejecting claims 1, 5-21 and 25-44 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

James D. Thomas	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
Michael R. Fleming	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
Lance Leonard Barry	)	
Administrative Patent Judge	)	

JDT/cam

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