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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/201,432	08/11/2005	James Thomas Edward McDonnell	82177574	5654
22879	7590	03/07/2013	EXAMINER	
HEWLETT-PACKARD COMPANY Intellectual Property Administration 3404 E. Harmony Road Mail Stop 35 FORT COLLINS, CO 80528			ZARKA, DAVID PETER	
			ART UNIT	PAPER NUMBER
			2669	
			NOTIFICATION DATE	DELIVERY MODE
			03/07/2013	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAMES THOMAS EDWARD MCDONNELL and
ABIGAIL JANE SELLEN

Appeal 2010-005953
Application 11/201,432
Technology Center 2600

Before ROBERT E. NAPPI, KALYAN K. DESHPANDE, and MIRIAM L.
QUINN *Administrative Patent Judges*.

DESHPANDE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE¹

The Appellants seek review under 35 U.S.C. § 134(a) of a final rejection of claims 1-7 and 9-11, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

We AFFIRM.

The Appellants invented a method of creating a subset of images from a library of images where each image is stored in digital form and in physical form. Specification 1:5-7.

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below:

1. A method of creating a subset of images from a library of images, there being a set of physical image prints of the images in the library and associated with each physical image print a memory tag with digital image data of the image stored therein, the method comprising:

locating first physical image prints from the set of physical image prints;

using a reader to read the digital image data of the image corresponding to each of the located first physical image prints to be included in the subset from the relevant memory tags; and

downloading the selected subset of digital image data to a first location.

REFERENCES

The Examiner relies on the following prior art:

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed September 25, 2009) and Reply Brief ("Reply Br.," filed March 15, 2010), and the Examiner's Answer ("Ans.," mailed January 25, 2010), and Final Rejection ("Final Rej.," mailed June 25, 2009).

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Weston	US 6,608,563 B2	Aug. 19, 2003
Tutt	US 6,785,739 B1	Aug. 31, 2004
Hikichi	US 2004/0196485 A1	Oct. 7, 2004

REJECTIONS²

Claims 1-6 and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tutt and Hikichi.

Claims 7 and 10-11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tutt, Hikichi, and Weston.

ISSUE

The issue of whether the Examiner erred in rejecting claims 1-7 and 9-11 turns on whether the cited prior art teaches or suggests “using a reader to read the digital image data of the image corresponding to each of the located first physical image prints to be included in the subset from the relevant memory tags,” as per claim 1; whether the cited prior art teaches or suggests “the reader is pre-programmed to read digital image data for a predetermined number of images before downloading the selected subset of digital image data is commenced,” as per claim 9; and whether Tutt teaches away from the claimed invention.

ANALYSIS

Claims 1-6 and 9 rejected under 35 U.S.C. §103(a) as being unpatentable over Tutt and Hikichi

Claims 1-4 and 6

² The Examiner has withdrawn the previously asserted rejection of claims 8 and 12 under 35 U.S.C. 103(a) as unpatentable over Tutt, Hikichi, and Weston. Ans. 3.

The Appellants first contend that the combination of Tutt and Hikichi fails to teach or suggest “using a reader to read the digital image data of the image corresponding to each of the located first physical image prints to be included in the subset from the relevant memory tags,” as recited in claim 1. App. Br. 9-10. The Appellants specifically contend that Tutt fails to teach or suggest this limitation. App. Br. 9-10.

We disagree with the Appellants. First, we note that, in rejecting claim 1, the Examiner has relied on Hikichi as describing this limitation. Since the Appellants’ argument fails to rebut the findings of the Examiner, we do not find the Appellants’ argument to be persuasive. Furthermore, we note the claims and Specification fail to narrow the scope of the term “digital image data,” and accordingly under the broadest reasonable construction “digital image data” even encompasses the address data retrieved from still images. Tutt 5:17-22.

The Appellants further contend that Tutt teaches away from the claimed invention and that there is no motivation to modify Tutt to include the feature of “using a reader to read the digital image data of the image corresponding to each of the located first physical image prints to be included in the subset from the relevant memory tags.” App. Br. 10-11 and Reply Br. 5-6. The Appellants specifically argue that Tutt describes retrieving address information from the image and using that address information to retrieve image data that is stored remotely, and therefore Tutt teaches away from reading image data locally on the reader. App. Br. 10-11 and Reply Br. 5-6. The Appellants also argue that Tutt discourages storing image data within the image because Tutt discloses that it is an advantage to store image data remotely and thereby reduce the amount of memory needed

locally. App. Br. 11. The Examiner responds that Tutt does not require image data to be stored remotely. Ans. 12. The Examiner further responds that the Appellants have merely demonstrated that Tutt describes an embodiment, but does not discourage a modification to store image data locally on the reader. Ans. 12-13.

We agree with the Examiner. ““A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.”” *Ricoh Co., Ltd. v. Quanta Computer, Inc.*, 550 F.3d 1325, 1332 (Fed. Cir. 2008) (citations omitted). A reference does not teach away if it merely expresses a general preference for an alternative invention from amongst options available to the ordinarily skilled artisan, and the reference does not discredit or discourage investigation into the invention claimed. *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

Here, we agree with the Examiner that the Appellants have demonstrated that Tutt expresses a general preference to store only image data address information to locate image data remotely and does not discourage or discredit storing image data locally on the reader. While Tutt does describe storing only address information and using that address information to locate digital image data (Tutt 5:17-25), Tutt does not discourage or discredit storing digital image data locally. Furthermore, as discussed *supra*, Tutt describes that some digital image data, such as address information, is stored locally, which supports the position that Tutt does not discourage such a modification. Additionally, Hikichi explicitly provides the motivation for a person with ordinary skill in the art to modify Tutt to

include the advantages of locally storing digital image data, where Hikichi describes that all of the needed information is stored locally and thus “data leakage to the outside can be prevented and maintenance of the server is not necessary.” Hikichi ¶ 0027. As such, we do not find the Appellants’ arguments persuasive.

Claim 5

The Appellants contend that the combination of Tutt and Hikichi fails to teach or suggest “wherein the reader is pre-programmed to read the digital image data in a first order before reading the digital image data from the relevant memory tags commences.” App. Br. 11. We disagree with the Appellants. The Appellants merely recite the claim language of claim 5 and generally allege that the prior art fails to teach or suggest the claim. Accordingly, we do consider the Appellants’ statement to be an argument for separate patentability. *See* 37 C.F.R. § 41.37(c)(1)(vii) (“A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.”); *In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”).

The Appellants specifically argue in the Reply Brief that “Tutt teaches RFIDing a first physical image print by the user and the RFIDing a second physical image print by the user is an order that the reader was preprogrammed to read before the reader did so. However, Tutt fails to describe any preprogramming of the reader and the Examiner has failed to

provide support for the assertion.” Reply Br. 7-8. However, this issue was first raised in a Reply Brief, was not a response to a new argument presented by the Examiner, and Appellants have not shown any cause as to why this issue was first raised in the Reply Brief. Thus, it is untimely. *See Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (Informative) (“the reply brief [is not] an opportunity to make arguments that could have been made in the principal brief on appeal to rebut the Examiner's rejections, but were not.”).

Claim 9

The Appellants first contend that Tutt teaches away from the claimed invention for the same reasons submitted in support of claim 1. App. Br. 12 and Reply Br. 8. We disagree with the Appellants. The Appellants’ argument was not found to be persuasive *supra* and is not persuasive here for the same reasons.

The Appellants also contend that Tutt fails to teach or suggest “the reader is pre-programmed to read digital image data for a predetermined number of images before downloading the selected subset of digital image data is commenced.” App. Br. 12 and Reply Br. 8-9. The Examiner found, and the Appellants agree, that Tutt describes reading RFID tags of various images one at a time. Ans. 15-16 and Reply Br. 8. The Examiner found that the reader in Tutt must be pre-programmed to read digital image data for one image before downloading and as such describes claim 9. Ans. 15-16. The Appellants argue that Tutt is silent as to being pre-programmed and this fact is supplied solely by the Examiner. Reply Br. 8-9.

We disagree with the Appellants. Claim 9 recites “the reader is pre-programmed to read digital image data for a predetermined number of images before downloading the selected subset of digital image data is commenced.” The scope of this limitation encompasses a reader that is pre-programmed to read any predetermined number of images before downloading, including the number one. If the reader is set to read a single image at a time, then it is pre-programmed to perform this function. The Appellants do not provide any additional evidence or rationale that this disclosure of Tutt fails to teach or suggest claim 9. As such, we do not find the Appellants’ arguments to be persuasive.

Claims 7 and 10-11 rejected under 35 U.S.C. §103(a) as being unpatentable over Tutt, Hikichi, and Weston

The Appellants contend that claims 7-8 and 10-11 depend from claims 1 and 9, and that the Examiner erred in rejecting claims 7-8 and 10-11 for the same reasons as claims 1 and 9. App. Br. 12 and Reply Br. 9. We disagree with the Appellants. The Appellants’ arguments in support of claims 1 and 9 were not found to be persuasive *supra* and are not persuasive here for the same reasons.

CONCLUSIONS

The Examiner did not err in rejecting claims 1-7 and 9-11.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 1-7 and 9-11 is sustained.

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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)(1)(iv) (2011).

AFFIRMED

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