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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* DAN L. DALTON and WILFRED F. BRAKE

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Appeal 2010-012189  
Application 11/260,354<sup>1</sup>  
Technology Center 2600

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Before THU A. DANG, JAMES R. HUGHES, and  
GREGORY J. GONSALVES, *Administrative Patent Judges*.

HUGHES, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> Application filed on Oct. 27, 2005. The Real Party in Interest is Hewlett Packard Development Company LP. (App. Br. 1.)

## STATEMENT OF CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-4 and 6-20. Claim 5 was canceled during prosecution. (App. Br. 2.) We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

### *Invention*

Appellants' invention is directed to a demonstration ("demo") dock that includes dock firmware detectable by a digital camera inserted therein or coupled thereto (i.e., docked), which identifies the dock as a demo dock. (Spec. 2, ¶ [0009].)<sup>2</sup>

### *Representative Claim*

1. An apparatus comprising:  
a demo dock comprising a dock connector and a detectable feature that identifies the demo dock; and a digital camera connectable to the demo dock that comprises demo firmware that begins an interactive demonstration of the camera in response to the removal of the camera from the dock and resets the camera for normal camera operation when the demonstration is terminated.

### *Rejections on Appeal*

1. The Examiner rejects claims 1, 3, 4, 7, 8, 11, 13-15, and 17 under 35 U.S.C. § 103(a) as being unpatentable over Nozawa (JP -2003-271117 published Sep. 25, 2003) and Fredlund (U.S. Pat. Pub. No. 2004/0041933 A1, published Mar. 4, 2004).

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<sup>2</sup> We refer to Appellants' Specification ("Spec."); Reply Brief ("Reply Br.") filed Jul. 19, 2010; and Appeal Brief ("App. Br.") filed Mar. 9, 2010. We also refer to the Examiner's Answer ("Ans.") mailed June 11, 2010.

2. The Examiner rejects claims 2, 6, 9, 10, 12, 16, and 18-20 under 35 U.S.C. § 103(a) as being unpatentable over Nozawa, Fredlund, and Battles (US Pat. Pub. No. US 2004/0070681 A1, published Apr. 15, 2004).

### *Grouping of Claims*

Based on Appellants' arguments in the Brief, we will decide the appeal on the basis of representative claims 1 and 18. *See* 37 C.F.R. § 41.37(c)(1)(vii).

### ISSUES

1. Under § 103, did the Examiner err in finding that the cited references collectively would have taught or suggested:

a digital camera connectable to the demo dock that comprises demo firmware *that begins an interactive demonstration of the camera in response to the removal of the camera from the dock* and resets the camera for normal camera operation when the demonstration is terminated.

(emphasis added) within the meaning of independent claim 1 and the commensurate language of independent claim 11?

2. Under § 103, did the Examiner err in combining Nozawa and Fredlund?

3. Under § 103, did the Examiner err in finding that the cited references collectively would have taught or suggested “upon removal, presenting an interactive demonstration using audio-visual capabilities of the camera, and activating certain navigation buttons of the camera to allow interaction with the demonstration,” within the meaning of independent claim 18?

## FINDINGS OF FACT

We adopt the Examiner's findings in the Answer and the Final Office Action as our own, except as to those findings that we expressly overturn or set aside in the analysis as follows.

## ANALYSIS

### *Claims 1-4, and 6-17*

Appellants argue, *inter alia*;

However, none of these three scenarios, as characterized by the Examiner, teaches or suggests that the demo firmware begins an interactive demonstration of the camera in response to the removal of the camera from the dock, as recited in claim 1. None of the three scenarios by which demo mode is initiated in the Fredlund reference teach or suggest that the stimulus for such demo mode initiation is the removal of the camera from the demo dock.

(App. Br. 7.)

The Examiner found that the cited references, notably Nozawa, taught a demo dock comprising a dock connector (cradle 200) and a detectable feature that identifies the demo dock (battery-charger primary detecting element 112). (Ans. 4.) The Examiner also found that the cited references taught a digital camera that comprises demo firmware that begins an interactive demonstration of the camera. (Ans. 5.) We agree with and adopt the Examiner's findings with respect to independent claims 1 and 11.

Initially, we note that the features argued by Appellants merely constitute non-functional descriptive material (data) and statements of intended use of the recited data. Representative apparatus claim 1 simply recites an apparatus that comprises a demo dock and a digital camera that is

connectable to the demo dock. Claim 1 then recites functionality of the demo firmware to begin an interactive demonstration. Thus Appellants' arguments are directed to the software (firmware) contained within the apparatus. We conclude that the demo firmware does not further limit the structure of the claimed apparatus. The firmware contained in the digital camera constitutes non-functional descriptive material, which "does not lend patentability to an otherwise unpatentable computer-implemented product or process." *Ex parte Nehls*, 88 USPQ2d 1883, 1889 (BPAI 2008) (precedential). *See Ex parte Curry*, 84 USPQ2d 1272, 1274 (BPAI 2005) (informative) (Fed. Cir. Appeal No. 2006-1003, aff'd, (Rule 36) (June 12, 2006) ("wellness-related" data in databases and communicated on distributed network did not functionally change either the data storage system or the communication system used in the claimed method). *See also In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004); *Nehls*, 88 USPQ2d at 1887-90 (discussing non-functional descriptive material). Similarly, "[a]n intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates." *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003). Accordingly we need not attribute any distinguishing character to the asserted claim features.

Based on this record, Appellants' have not shown that the Examiner erred in rejecting apparatus claims 1 and 11.

#### *Combinability*

Appellants' argue, *inter alia*;

There is no articulated reason with some rational underpinning that would have prompted one of ordinary skill to combine the prior art elements in the manner claimed because the Nozawa

reference provides the benefits stated by the Examiner without requiring the teachings of the Fredlund reference.

(App. Br. 10.) Appellants contend that: 1) the Nozawawa reference, by itself, allows the user to learn the features of the camera via the demo when the camera is out of the dock – it does not require the teachings of the Fredlund reference in order to do so and 2) the immediacy with which the camera of the Nozawa reference may be operated, and pictures taken, is not improved by combining in the teachings of Fredlund. (App. Br. 10-11.)

Where, as here, an invention requires more than a straight-forward combination of the prior art, the Examiner must articulate a reasoning with some rational underpinning to support the legal conclusion of obviousness.<sup>3</sup> We conclude the Examiner provided an articulated reasoning with some rational underpinning for combining the cited references, i.e., improved functionality (allowing a user to immediately view a demonstration). (Ans. 8-9.) Moreover, after considering the evidence before us, it is our view that Appellants' arguments do not take into account what the collective teachings of the prior art would have suggested to one of ordinary skill in the art and are, therefore, ineffective to rebut the Examiner's prima facie case of obviousness.

“What appellants overlook is that it is not necessary that the inventions of the references be physically combinable to render obvious the invention under review.” *In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983) (citations omitted); *see also In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973)

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<sup>3</sup> “[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.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

“Combining the *teachings* of references does not involve an ability to combine their specific structures.”). The test for obviousness is not whether the features of a reference may be bodily incorporated into the structure of another reference but what the combined teachings of those references would have suggested to one of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). This reasoning is applicable in the present case.

Based on the two issues discussed above, we conclude that the Examiner did not err in rejecting representative claim 1. Accordingly, we affirm the Examiner’s rejection of claims 1, 3, 4, 7, 8, 11, 13-15, and 17.

*Claims 2, 6, 9, 10, 12, and 16*

As noted above, the Examiner rejected dependent claims 2, 6, 9, 10, 12, and 16 as being unpatentable over Nozawa, Fredlund, and Battles. Appellants did not argue the patentability of the above-mentioned claims with particularity. (App. Br. 13-14.) Therefore, we affirm the rejection of the above-mentioned claims for the same reasons discussed with respect to independent claims 1 and 11.

*Claims 18-20*

*Upon removal, presenting an interactive demonstration*

Similar to the arguments discussed above regarding independent claim 1, Appellants contend that the cited combination of references fail to teach or suggest the limitation that the camera begins an interactive demonstration *in response to* the removal of the camera from the dock. (App. Br. 12.) We agree essentially for the reasons argued by Appellants.

The Examiner argues that Fredlund teaches a system that goes into demonstration mode and can be programmed to start the demonstration at

any time, which includes when the camera is out of the cradle. (Ans. 22.)  
However, we agree with Appellants that, according to the claim language, removal of the camera from the dock is the stimulus to begin an interactive demonstration of the camera. (App. Br. 12.)

Based on this record, we conclude that the Examiner erred in rejecting independent claim 18. Accordingly, we reverse the Examiner's rejection of claims 18-20.

#### CONCLUSION OF LAW

Appellants have not shown that the Examiner erred in rejecting claims 1-4 and 6-17 under 35 U.S.C. § 103(a).

Appellants have shown that the Examiner erred in rejecting claims 18-20 under 35 U.S.C. § 103(a)

#### DECISION

We affirm the Examiner's rejection of claims 1-4 and 6-17 under 35 U.S.C. § 103(a).

We reverse the Examiner's rejection of claims 18-20 under 35 U.S.C. § 103(a).

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