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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JI-YOUNG YOON, HO-WOUNG LEE, and BYOUNG-SOO KIM

Appeal 2011-002424
Application 10/899,491[1]
Technology Center 2600

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

HUGHES, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-25, which are all the claims remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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[1] Application filed on Jul. 26, 2004, claiming benefit from Republic of Korea Application No. 2004-08184, filed Feb. 7, 2004. The Real Party in Interest is Samsung Digital Imaging Co., Ltd.

Invention

Appellants' invention relates to a method of controlling a digital photographing apparatus and a digital photographing apparatus using the same and, more particularly, to a method of controlling a digital photographing apparatus storing moving image data recorded on a recording medium in a moving image photographing mode and a digital photographing apparatus using the same. (Spec. 1, ll. 11-15.)[2]

Representative Claim

Independent claim 1, reproduced below with the key disputed limitations emphasized, further illustrates the invention:

> 1. A method of recording moving image data, the method comprising:
>
> operating a digital photographing apparatus to capture a moving image and create moving image data representative thereof;
>
> creating a moving image file in a recording medium;
>
> *storing the moving image data in the moving image file as the moving image is being captured and the moving image data is being created, when a first primary signal is generated*;
>
> *stopping the digital photographing apparatus from capturing the moving image, and stopping storing of the moving image data in the moving image file, if moving image data is being stored, when a secondary signal is generated*;
>
> *operating the digital photographing apparatus to further capture a moving image and create further moving image data representative thereof, and storing the further moving image*

[2] We refer to Appellants' Specification ("Spec."); Reply Brief ("Reply Br.") filed Sept. 8, 2010 and Appeal Brief ("App. Br.") filed April 21, 2010. We also refer to the Examiner's Answer ("Ans.") mailed Jul. 8, 2010.

data in the moving image file, as the moving image is being further captured and the further moving image data is being created, if moving image data is not being stored and a second primary signal has not been generated, when another secondary signal is generated; and

stopping storing of the further moving image data and completing the moving image file including the moving image data and the further moving image data, wherein the moving image data and the further moving image data are divided into different time frames, when the second primary signal is generated.

Rejections on Appeal

1. The Examiner rejects claims 1-5, 11, 13, 15-17, and 19-21 under 35 U.S.C. § 103(a) as being unpatentable over Cook (US Patent 6,714,724 B1 issued Mar. 30, 2004) and Yamasaki (US Patent Application Pub. 2004/0120689 A1 published June 24, 2004).

2. The Examiner rejects claims 6, 7, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Cook, Yamasaki, and Takemoto (US Patent No. 5,065,246, issued Nov. 12, 1991).

3. The Examiner rejects claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Cook, Yamasaki, Takemoto, and Fernandes (US Patent No. 6,014,135 issued Jan. 11, 2000).

4. The Examiner rejects claims 9, 10, and 12 under 35 U.S.C. § 103(a) as being unpatentable over Cook, Yamasaki, and Misawa (US Patent 7,248,291 B2 issued Jul. 24, 2007 (filed Feb. 21, 2002)).

5. The Examiner rejects claims 14, 22, 23, and 25 under 35 U.S.C. § 103(a) as being unpatentable over Cook, Yamasaki, and Tanaka (US Patent Application Pub. 2001/0043277 A1 published Nov. 22, 2001).

6. The Examiner rejects claim 24 under 35 U.S.C. § 103(a) as being unpatentable over Cook, Yamasaki, Tanaka, and Iwasaki (US Patent Application Pub. 2002/0031335 A1 published Mar. 14, 2002).

Grouping of Claims

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

ISSUES

1. Under § 103, did the Examiner err in finding that the combination of Cook and Yamasaki would have taught or suggested "*stopping the digital photographing apparatus from capturing the moving image, and stopping storing of the moving image data in the moving image file,* if moving image data is being stored, when a secondary signal is generated" (emphasis added), within the meaning of independent claim 1?

2. Under § 103, did the Examiner err in finding that the combination of Cook and Yamasaki, collectively, would have taught or suggested:

> *operating the digital photographing apparatus to further capture a moving image and create further moving image data representative thereof, and storing the further moving image data in the moving image file,* as the moving image is being further captured and the further moving image data is being created, if moving image data is not being stored and a second primary signal has not been generated, when another secondary signal is generated

(emphasis added) within the meaning of independent claim 1?

3. Under § 103, did the Examiner err in combining Cook and Yamasaki?

ANALYSIS

Appellants contend that Cook does not teach storing image data in a same file following resumption from a pause, either explicitly or implicitly. (App. Br. 22.) More particularly, Appellants argue:

> Cook fails to teach the pausing of recording the moving image data while generating the moving image file, and it cannot be determined from the teaching of Cook whether the releasing of the record/pause key 20 is the stopping of generating a moving image file, since Cook does not disclose the resumption of the recording moving image data. Therefore, the releasing of the record/pause key 20 in cook should be interpreted as the stopping of generating a moving image file rather than the pausing, as presently claimed. In other words, Appellants assert that the Examiner has failed to show how Cook teaches or suggests at least this required element.

(*Id*.) We disagree for the reasons discussed below.

We agree with and adopt the Examiner's findings with respect to the limitation at issue. (Ans. 5-7, 33-34.) As found by the Examiner, Cook discloses pressing the record/pause key 20 saves image data and pressing the record/pause key a second time stops data acquisition. (Cook, col. 5, ll. 36-43.) Regarding Appellants' argument that Cook does not explicitly disclose resuming recording of the image data, we find that the differences between the prior art and the presently claimed invention would have been obvious to one of ordinary skill in the art.

> 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., 550 U.S. 398, 406 (2007).

This line of reasoning is applicable in the present case. As discussed above, the Examiner has demonstrated through Cook that it was well known in the art at the time of the present invention to acquire image data and stop acquisition of the image data by pressing the record/pause button 20. Therefore, we conclude that the differences between the prior art and Appellants' invention – pressing the record/pause button 20 an additional (third) time to resume image acquisition – was well within the realm of one skilled in the art at the time of the invention. Therefore, we find Appellants' argument unpersuasive.

Based on this record, we also conclude that the Examiner did not err in finding that the cited references collectively would have taught or suggested "*stopping the digital photographing apparatus from capturing the moving image, and stopping storing of the moving image data in the moving image file*" (claim 1).

Storing Further Moving Image Data in the Moving Image File

Appellants contend that the cited references, namely Cook, fail to teach or suggest resumption of recording after pausing the recording and directing the newly and subsequently captured image data to the same file. (App. Br. 23.) We disagree.

Appellants' understanding of Cook is that, if the device is recording, pressing the record/pause key 20 terminates a recording session wherein image data is being acquired directly and continuously after the record/pause

key is initially pressed and "thus a subsequent 'resuming' of the recording occurs within a new recording session and thus, under a new file." (Reply Br. 2-5; App. Br. 23.)

We agree with and adopt the Examiner's findings with respect to the limitation at issue. (Ans. 6, 35.) In particular, we note Cook teaches that image and sound data acquired during a recording session are saved under a single file *until the new file key 22 is pressed*. (Cook, col. 6, ll. 8-14.) Therefore, we conclude that Cook teaches or suggests that subsequent recording of image data is saved in the same file.

Appellants contend that the new file key 22 in Cook does not teach or suggest the *second primary* signal of the last claimed element. (App. Br. 25-26.) However, we agree with and adopt the Examiner's construction regarding the claimed first and second primary signal (starting / stopping the recording session) and the first and second secondary signals (pause / resume). (Ans. 39-40.) Moreover, we observe that representative claim 1 does not indicate how any of the aforementioned *signals* are generated and, therefore, does not preclude the Examiner's interpretation.

Based on this record, we conclude that the Examiner did not err in finding that the cited references would have taught or suggested storing the further moving image data in the moving image file, as recited in claim 1.

Stopping capturing and stopping storing according to the signal generation

Appellants contend that Yamasaki fails to teach stopping capturing and stopping storing according to the signal generation specified in claim 1. (App. Br. 27.)

We observe that the Examiner relied on Cook to teach or suggest the limitation at issue. (Ans. 5.) The Examiner relied on Yamasaki as evidence that resuming recording after recording had been paused and that the image data and further image data are divided into different time frames were well-known in the art at the time of Appellants' invention. (Ans. 7.) Thus, we find that Appellants have not addressed the Examiner's specific findings and Appellants' individual attack of Yamasaki is unavailing.

Appellants also contend that, even if Cook inherently discloses a resumption of the recording, there is certainly no teaching or suggesting as to what signals would be used to do so. (App. Br. 28.) Appellants also allege that there is no teaching or suggestion in Yamasaki as to the signaling required by claim 1 to initiate respective recording stages. (App. Br. 28.) We agree with the Examiner's findings that, while Cook does not explicitly disclose resuming recording after recording had been paused, such a feature was well-known in the art at the time of Appellants' invention. (Ans. 6-7, 33-34.) Further, as discussed above, representative claim 1 does not recite how the signals are generated and, therefore, does not preclude the Examiners' broad and reasonable interpretation. (Ans. 39-40.)

Appellants further contend that Yamasaki fails to disclose pausing and resuming recording the moving image data. (App. Br. 29.) The Examiner found that Cook teaches starting recording and pausing recording while creating a single file, but Cook does not explicitly disclose that recording is resumed after being paused. (Ans. 7.) However, the Examiner relied on Yamasaki to *explicitly* disclose the same. (*Id*.) We find that, while Cook does not explicitly disclose resumption of recording after pausing, doing so would have merely required pressing the same record/pause button 20 that is

used to start recording thereby creating further moving image data. Thus, it is our view that the Examiner's use of Yamasaki in this regard is cumulative.

Appellants further contend that Yamasaki does not disclose starting and completing generating a moving image file. (App. Br. 30.) We observe that the Examiner relied on Cook to teach or suggest this limitation. (Ans. 5-6.) Therefore, Appellants have not addressed the Examiner's specific findings, and we find Appellants' single attack of Yamasaki unavailing.

Combinability

Appellants contend that it would not have been obvious to combine the teaching of Cook into the teaching of Yamasaki because combining the stop function that stops acquisition of data in Cook would be contrary to the principle of operation in Yamasaki where the pause function does not halt the acquisition of data. (App. Br. 31.)

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) (citations omitted). This reasoning is applicable in the present case.

The Examiner relied on Yamasaki as evidence that moving image data and further image data are divided into different time frames and recording of image data being resumed after acquisition of the image data has been paused were well-known in the art at the time of Appellants' invention. Therefore, we conclude that the Examiner did not err in combining Cook and Yamasaki.

Based on this record, we conclude that the Examiner did not err in finding that the cited combination of references would have taught or

suggested the limitations of representative claim 1. Accordingly we affirm the Examiner's rejection of representative claim 1.

We further observe that Appellants did not urge patentability of dependent claims 6-10, 12, 14, 18, and 22-25 with specificity. Accordingly, we affirm the rejection of claims 6-10, 12, 14, 18, and 22-25 for the same reasons discussed *supra* regarding claim 1.

CONCLUSION OF LAW

Appellants have not shown that the Examiner erred in rejecting claims 1-25 under 35 U.S.C. § 103(a).

DECISION

We affirm the Examiner's rejections of claims 1-25 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

peb