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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RONALD A. LOUKS,
NADI SAKIR FINDIKLI, and
GERARD JAMES HAYES

Appeal 2011-003670
Application 11/750,358¹
Technology Center 2600

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

HUGHES, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application filed on May 18, 2007 claiming benefit of Provisional Application 60/863,382 filed Oct. 29, 2006. The Real Party in Interest is Sony Ericsson Mobile Communications AB. (App. Br. 1.)

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1, 3-14, and 16-26, which are all the claims remaining in the application. Claims 2 and 15 were canceled during prosecution. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' Invention

Appellants' invention relates generally to digital cameras and, more particularly, to wireless adapters for digital cameras that enable digital cameras to communicate with remote devices. (Spec. 1, ¶ [0002].)²

Representative Claim

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

1. A wireless adaptor for a digital camera comprising:
 - a camera interface configured to interface the wireless adaptor to a digital camera;
 - a wireless interface configured to interface the wireless adaptor to a wireless communication network; and
 - a file transfer agent configured to:
emulate a printer; and
associate the emulated printer with a destination device accessible through the wireless communication network, such that the file transfer agent transfers image data received from the digital camera to the destination device responsive to the digital camera printing to the emulated printer.*

² We refer to Appellants' Specification ("Spec."); Reply Brief ("Reply Br.") filed Oct. 19, 2010; and Appeal Brief ("App. Br.") filed May 17, 2010. We also refer to the Examiner's Answer ("Ans.") mailed Aug. 19, 2010.

Rejections on Appeal

1. The Examiner rejects claims 1, 3, 10, 16-20, and 23-26 under 35 U.S.C. § 103(a) as being unpatentable over Eckl (US Pat. App. Pub. No.: 2006/0017822 A1, published Jan. 26, 2006) and Lewis (GB Patent App. No.: GB 2388942 A, published Nov. 26, 2003).

2. The Examiner rejects claims 4-6 under 35 U.S.C. § 103(a) as being unpatentable over Eckl, Lewis, and Rea (US Pat. App. Pub. No.: 2005/0036034 A1, published Feb. 17, 2005).

3. The Examiner rejects claims 7-9, 11, 14, 21, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Eckl, Lewis, and Onishi (US Pat. App. Pub. No.: 2004/0239772 A1, published Dec. 2, 2004).

4. The Examiner rejects claims 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Eckl, Lewis, and Narayanan (US Pat. App. Pub. No.: 2007/0030517 A1, published Feb. 8, 2007 (filed Aug. 3, 2006)).

Grouping of Claims

Based on Appellants' arguments in the Brief, we will decide the appeal on the basis of representative claims 1, 3, and 18. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

Based upon our review of the administrative record, Appellants' contentions, and the Examiner's findings and conclusions, we have determined that the following issues are dispositive in this appeal:

1. Under § 103, did the Examiner err in concluding that Eckl and Lewis collectively teach or would have suggested:

a file transfer agent configured to[] emulate a printer; and associate the emulated printer with a destination device accessible through the wireless communication network, such that the file transfer agent transfers image data received from the digital camera to the destination device responsive to the digital camera printing to the emulated printer,
within the meaning of independent claim 1 and the commensurate limitations of claims 17 and 19?

2. Under § 103, did the Examiner err in combining Eckl and Lewis?
3. Under § 103, did the Examiner err in finding that Eckl and Lewis collectively teach or would have suggested “that the file transfer agent transfers the image data to the destination device according to destination parameters stored in memory” (claim 3), within the meaning of dependent claim 3 and commensurate language of claim 20?
4. Under § 103, did the Examiner err in finding that Eckl and Lewis collectively teach or would have suggested “receiving image data from the digital camera that is targeted to a destination device includes identifying the targeted destination device based on which emulated printer is selected by the digital camera” (claim 18), within the meaning of dependent 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

File transfer agent

Appellants contend that the cited combination of references would not have taught or suggested a file transfer agent as recited in representative claim 1. (App. Br. 7-10.) We conclude that Appellants have not shown that the Examiner erred in rejecting claim 1 for the reasons that follow.

The Examiner concluded that Eckl taught or suggested the claimed file transfer agent except that the file transfer agent is configured to emulate a printer. (Ans. 4.) The Examiner relied on Lewis to show that a device that is configured to emulate a printer was well known in the art at the time of Appellants' invention. (*Id.*)

Appellants essentially argue that Eckl does not teach or suggest the claimed file transfer agent, which emulates a printer, while admitting that the Examiner relied on Lewis to teach or suggest a transfer agent that emulates a printer. (App. Br. 8.) Appellants then argue that Lewis fails to teach or suggest the claimed file transfer agent. (App. Br. 9-10.) Appellants then conclude that “[n]either Eckl nor Lewis alone teaches or suggests the claimed file transfer agent and, since both references alone fail to teach or suggest this limitation, their combination necessarily fails to teach or suggest this limitation.” (App. Br. 10.) We further observe that Appellant's arguments in the Reply Brief are singularly directed to Eckl. (Reply Br. 3-6.)

We agree with the Examiner that Appellants' singular attacks of the cited references are unavailing. (Ans. 29.) One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d

1091, 1097 (Fed. Cir. 1986); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). This reasoning is applicable in the present case. We agree with the Examiner that Appellants' arguments consist of singular attacks on Eckl and Lewis respectively as well as a conclusion that since the references, individually, do not teach or suggest the limitation at issue, then the combination necessarily fails to teach or suggest the limitation. However, Appellants' arguments fail to appreciate the *collective teachings* of the cited references and, therefore, are unpersuasive.

In addition, we observe that claim 1 recites a transfer agent *configured to perform the functions of emulating a printer, and associate the emulated printer with a destination device*. The claimed functions are not positively recited. Therefore, we deem the claimed functions merely to be statements of intended use of the transfer agent. "An[]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.

Combinability

Appellants contend that there is no reason for one skilled in the art to modify Eckl with Lewis as asserted by the Examiner.³ (Ans. 5.) Appellants

³ As asserted by the examiner: "Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to have the file transfer agent taught by Eckl emulate a printer in association with the destination device as taught by Lewis and transfer image data responsive to outputting the image data to the emulated printer as taught by Lewis as a way of using a known technique (i.e. the emulation of a printer taught by

contend that 1) adding the emulator of Lewis would not produce a wireless card with the ability to communicate over a network because the card already performs that function (App. Br. 10-11); and 2) modifying Eckl to include the emulator functionality of Lewis would not produce the claimed invention (App. Br. 11; Reply Br. 7-9).

After considering the evidence before us, we conclude 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 is therefore ineffective to rebut the Examiner's prima facie case of obviousness. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (“*The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art*” (citations omitted, emphasis added)). This reasoning is applicable in the present case.

Appellants further contend that the Examiner's motivation to combine the references is conclusory. (App. Br. 11.) However, Appellants' argument merely discusses Eckl and does not address why Eckl is not combinable with Lewis under § 103 – i.e., the combination produces unpredictable results, etc. As explained by the Examiner, utilizing a known technique, of emulating a printer, to improve a similar device, Eckl's controller, is within the skill of one skilled in the art at the time of Appellants' invention. (Ans. 5.) *See KSR Int'l Co. v. Teleflex, Inc.*, 550

Lewis) to improve a similar device (i.e. the controller taught by Eckl) in the same way (i.e. such that images can be transferred via conventional print commands).” (Ans. 5.)

U.S. 398, 417-18 (2007). Based on the above, we conclude that the Examiner did not err in combining Eckl and Lewis.

Based on this record, we conclude that Appellants have not shown the Examiner erred in finding that the cited combination of references collectively, would have taught or suggested the claimed file transfer agent. Accordingly, we affirm the Examiner's rejection of representative claim 1 and claims 16-19, and 24-26, not separately argued with particularity, which stand therewith.

Destination Parameters - Claims 3, 10, 20, and 23

Appellants further contend that Eckl does not teach or suggest that the destination parameters for the remote station are stored in a memory circuit included on a wireless card. (App. Br. 14.) We disagree for the reasons discussed *infra*.

The Examiner found that Eckl discloses a transceiver that establishes automatic call connection with a remote station (destination device). (Ans. 5.) The Examiner further found that “[a]s this is done “automatically” by the card controller (18) of the wireless adapter (8, paragraph 0016) “after each picture is taken,” the wireless adapter (8) must have stored destination parameters identifying one or more destination devices (i.e. remote stations). (Ans. 34.) We agree with and adopt the Examiner's findings. We observe that Appellants did not rebut the Examiner's findings in the Reply Brief. (Reply Br. 10.)⁴

⁴ With respect to all claims before us on appeal, arguments which Appellants could have made but chose not to make have not been considered and are deemed to be waived. *Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (informative)

Based on this record, we conclude that the Examiner did not err in rejecting representative claim 3. Accordingly, we affirm the Examiner's rejection of claims 3, 10, 20, and 23.

Claim 16

Appellants contend that “[b]ecause the wireless card does not function as the claimed file transfer agent, it cannot possibly comprise the claimed circuits that execute program instructions defining the operations of the claimed file transfer agent.” (App. Br. 15.) Similar to claim 1 (*supra*), Appellants' argument is directed to the bodily incorporation of Eckl and Lewis and does not consider what the combined teachings of the references would have suggested to those of ordinary skill in the art. Therefore, we find Appellants' arguments unavailing. Based on this record, we conclude that the Examiner did not err in rejecting claim 16. Accordingly, we affirm the Examiners' rejection of dependent claim 16.

Identifying the Targeted Destination Device - Claim 18

Appellants contend;

The Examiner asserts that only Lewis teaches this limitation. However, the assertion is without merit. The emulator software in Lewis is the final destination of the printed image data. Therefore, when the image data arrives at the emulator in Lewis, it simply renders the image on the display. There is no need for the emulator to identify a targeted destination device in Lewis because the emulator is the targeted destination device. Therefore, the rejection to claim 18 should be reversed.

(App. Br. 15.)

The Examiner interpreted presenting a destination device to the user (e.g., as if it were simply a conventional printer), as taught by Lewis, to be the emulation of the printer. Accordingly, the Examiner did not interpret

rendering printed data as emulation of a printer (Ans. 35-36), as asserted by Appellants (App. Br. 15). We agree with and adopt the Examiner's findings. (Ans. 35-36.) We find that Lewis teaches presenting a destination device as if it were a printer i.e., destination device. (Lewis, p. 6, ll. 7-10.)

Based on this record, we conclude that the Examiner did not err in rejecting dependent claim 18. Accordingly, we affirm the Examiners' rejection of claim 18.

Claims 7-9, 11-14, 21, and 22

As noted above, the Examiner rejected claims 7-9, 11-14, 21, and 22 as unpatentable over various combinations of the cited references. However, Appellants did not separately argue patentability of the above-identified claims with particularity. (App. Br. 17.) Therefore, we affirm the Examiner's rejections of these claims for the same reasons as the independent claims from which the above-identified claims depend.

REPLY BRIEF

While we have fully considered Appellants' responses in the Reply Brief, we decline to address any new arguments not originally presented in the principal Brief and we deem these newly presented arguments to be waived. *See Borden*, 93 USPQ2d at 1474 (absent a showing of good cause, the Board is not required to address arguments in the Reply Brief that could have been presented in the principal Brief). With respect to all claims before us on appeal, arguments which Appellants could have made but chose not to make have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). *See also In re Watts*, 354 F.3d 1362, 1368 (Fed. Cir. 2004).

Appeal 2011-003670
Application 11/750,358

CONCLUSION OF LAW

Appellants have not shown that the Examiner erred in rejecting claims 1, 3-14, and 16-26 under 35 U.S.C. § 103.

DECISION

We affirm the Examiner's rejections of claim 1, 3-14, and 16-26 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

Vsh