



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/870,862	08/30/2010	Brett D. Johnson	060039 CON	1714
38516	7590	07/08/2015	EXAMINER	
AT&T Legal Department - SZ			PAULS, JOHN A	
Attn: Patent Docketing				
Room 2A-207			ART UNIT	
One AT&T Way			PAPER NUMBER	
Bedminster, NJ 07921			3626	
			MAIL DATE	
			DELIVERY MODE	
			07/08/2015	
			PAPER	

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

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRETT D. JOHNSON, LAURENCE SIEGEL, MARTY SMITH,
ADRIAN POPESCU, CHARLES FREDERICK HART, and
LARRY KENT, JR.

Appeal 2012-007289
Application 12/870,862
Technology Center 3600

Before JOSEPH A. FISCHETTI, MICHAEL W. KIM, and
BRADLEY B. BAYAT, *Administrative Patent Judges*.

KIM, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1–20. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6.

The invention relates generally to “more efficient systems and methods for both viewing data-intensive images at remote locations and supplying notification of the readiness of such images for viewing to the relevant individuals.” Spec. ¶ 7.

Independent claim 1, reproduced below, is further illustrative of the claimed subject matter.

1. A method for processing an image, comprising:
 - receiving a notification at a computer indicating that a medical image is available for transmission from a remote location and indicating unprocessed medical images in a queue that have yet to be processed for transmission from the remote location;
 - displaying the notification at the computer as a listing of images in the queue;
 - visually distinguishing the medical image in the listing of images from the unprocessed medical images in the queue;
 - requesting the medical image from the computer;
 - receiving the medical image at the computer; and
 - storing the medical image in memory of the computer.

Claims 1–20 are rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness.

Claims 18–20 are rejected under 35 U.S.C. § 101, for failing to recite statutory subject matter.

Claims 1–20 are rejected under 35 U.S.C. § 103(a) as unpatentable over Heere (US 2005/0148849 A1, pub. July 7, 2005) in view of Pressly (US 2002/0065854 A1, pub. May 30, 2002).

We AFFIRM.

ANALYSIS

Indefiniteness Rejection of Claims 1–20

We are not persuaded the Examiner erred in asserting that claims 1–20 are indefinite. App. Br. 6–8. There are two bases for indefiniteness set forth by the Examiner.

Using independent claim 1 as an example for all of independent claims 1, 10, and 18, each of the requesting, receiving, and storing steps recite “the medical image.” The Examiner asserts that it is unclear whether

“the medical image” refers to the earlier recited “a medical image [that] is available for transmission” or “unprocessed medical images in a queue.” The Appellants assert that one of ordinary skill would understand that “the medical image” only refers to the earlier recited “a medical image [that] is available for transmission,” and not “unprocessed medical images in a queue.” We agree primarily because “the medical image” would more logically relate back to “a medical image,” as opposed to “unprocessed medical images.”

We find that such a distinction is not as clear for the second basis for the indefiniteness rejection. Specifically, independent claim 1 recites “a medical image . . . unprocessed medical images in a queue . . . a listing of images in the queue; visually distinguishing the medical image in the listing of images from the unprocessed medical images in the queue.” Essentially, it is unclear which images are in the queue. The receiving step recites that only “unprocessed medical images” are in the queue. The displaying step, however, treats the queue as including both “a medical image” and “unprocessed medical images,” and the visually distinguishing step could be consistent with either interpretation. As both interpretations cannot logically be correct, we agree with the Examiner that independent claim 1 is indefinite. Independent claims 10 and 18 suffer from the same ambiguity.

We sustain the indefiniteness rejection of claims 1–20.

Statutory Subject Matter Rejection of Claims 18–20

The Appellants have not challenged the rejection of claims 18–20 under 35 U.S.C. § 101, for failing to recite statutory subject matter. Accordingly, this rejection is summarily sustained.

Obviousness Rejection of Claims 1, 2, and 5–7

We are not persuaded the Examiner erred in asserting that a combination of Heere and Pressly renders claims 1–20 obvious. App. Br. 8–11. As an initial matter, we note that while the Appeal Brief only challenges the rejection based upon a teaching away analysis, the Reply Brief sets forth many more arguments than the Appeal Brief. Insofar as the arguments from the Reply Brief differ materially from the line of arguments set forth in the Appeal Brief, they are deemed waived. *See* 37 C.F.R. § 41.41(b)(2) (2011) (“Any argument raised in the reply brief which was not raised in the appeal brief, or is not responsive to an argument raised in the examiner’s answer, including any designated new ground of rejection, will not be considered by the Board for purposes of the present appeal, unless good cause is shown”). Nevertheless, we have considered all arguments in the Reply Brief even relating tangentially to “teaching away.”

The Appellants assert that Heere discloses providing an image notification *after* image download. App. Br. 9–10. The Appellants assert further that because the proposed modifications involve providing an image notification *prior to* image download, and that such modifications would change the principle of operation of Heere, they are impermissible, and hence unobvious. *Id.* at 10–11. We disagree. To disallow modifications because the modification changes the operation of the underlying reference in any way would render all modifications impermissible. Instead, the relevant question is whether the change is in the *principle* of operation of the reference. To that end, Heere discloses it is directed to “a system for facilitating the communication of images in a digital format between various individuals and/or entities.” Heere ¶ 2. We are unpersuaded that the

proposed modification of changing the timing of the notification relative to the image download would change this principle of operation of Heere.

Furthermore, the Examiner notes that Heere discloses that a remote computer determines whether an image is available for download without user input. Ans. 10 (citing Heere ¶ 19). We determine that one of ordinary skill would have known that such a determination could have been accomplished by a human. Indeed, Heere indicates that this was known. Heere ¶ 12. Hence, the human would have been notified of the availability of the image prior to its download, just as in the claimed invention. Given this, we are unpersuaded that the proposed timing modification would require the significant changes to Heere that are asserted by the Appellants. Indeed, we are unclear as to why this new “notification” in Heere, before download, cannot coexist with the later “notification” in Heere, after download, that the Appellants assert is the core of Heere’s invention.

Insofar as the Appellants are asserting that such a modification would lengthen the time necessary for Heere to complete its operations, and Heere places a premium on speed, we are not persuaded of error because the Appellants conflate desirability with obviousness. Every modification has potential advantages and disadvantages. So long as such a modification would have been within the abilities of one of ordinary skill, as it is here, regardless of advantages or disadvantages, it is obvious.

We sustain the obviousness rejection of claims 1–20.

DECISION

The decision of the Examiner to reject claims 1–20 is **AFFIRMED**.

AFFIRMED