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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SENICHI ONODA, YOSHIYASU KADO, and JUN TAKEMURA

Appeal 2015-004322
Application 13/082,371[1]
Technology Center 2600

Before JEAN R. HOMERE, HUNG H. BUI, and JOHN F. HORVATH, *Administrative Patent Judges*.

BUI, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner's Final Office Action rejecting claims 1–3, 5, 7–11, 18–20, and 22, which are all of the claims pending on appeal. App. Br. 3. Claims 4, 6, 12–17, 21, 23, and 24 are cancelled. Claims App'x. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.[2]

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[1] According to Appellants, the real party in interest is Panasonic Corporation. App. Br. 2.

[2] Our Decision refers to Appellants' Appeal Brief filed October 7, 2014 ("App. Br."); Reply Brief filed February 26, 2015 ("Reply Br."); Examiner's Answer mailed December 31, 2014 ("Ans."); Final Office Action mailed April 21, 2014 ("Final Act."); and original Specification filed April 7, 2011 ("Spec.").

STATEMENT OF THE CASE

Appellants' invention relates to an image display apparatus and an image editing apparatus configured to distinguish between (1) still image data extracted from moving picture data that has already been encoded, and (2) still image data generated through a normal shooting process. Spec. ¶ 8.

Claims 1, 5, and 7 are independent. Claim 1 is illustrative of Appellants' invention, as reproduced with disputed limitations emphasized below:

> 1. An image display apparatus comprising:
>
> a determination unit configured to *determine whether a stored image data is a first still image data, or a second still image data, based on auxiliary information that distinguishes between the first still image data and the second still image data*;
>
> *the first still image data extracted from encoded moving picture data*, and separate from the encoded moving picture data;
>
> *the second still image data generated through a normal image capturing process*; and
>
> a display management unit configured to display still image data such that when the determination unit determines that the stored image data is the first still image data, the display management unit displays a first still image and a mark on a display unit, the first still image being displayed based on the first still image data, the mark indicating that the first still image data has been extracted from encoded moving picture data, and
>
> when the determination unit determines that the stored image data is the second still image data, the display management unit displays a second still image on a display unit without the mark, the second still image based on the second still image data, respectively.

App. Br. 24 (Claims App.).

Examiner's Rejection and References

Claims 1–3, 5, 7–11, 18–20, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsumoto, US 2003/0052986 A1; pub. Mar. 20, 2003 ("Matsumoto"), Kim, US 2008/0267581 A1; pub. Oct. 30, 2008 ("Kim"), and Migiyama et al., US 2011/0050942 A1; pub. Mar. 3, 2011. Final Act. 4–19; App. Br. 6.

ANALYSIS

With respect to independent claim 1, the Examiner finds Matsumoto teaches an image display apparatus, shown in Figure 1, comprising:

> a determination unit . . . configured to determine whether a stored image data is [1] a first still image data, or [2] a second still image data, based on stored moving data that distinguishes between the first still image data and the second still image data . . .
>
> a display management unit configured to display still image data such that when the determination unit determines that the stored image data is the first still image data, the display management unit displays a first still image and a mark on a display unit, the first still image being displayed based on the first still image data, the mark indicating that the first still image data has been extracted from encoded moving picture data, and
>
> when the determination unit determines that the stored image data is the second still image data, the display management unit displays a second still image on a display unit without the mark, the second still image based on the second still image data, respectively.

Final Act. 5, 8–9 (citing Matsumoto ¶¶ 53, 54, 57, 69–70, Figs. 3 and 5). According to the Examiner, "Matsumoto stores still image data from both normal shooting process and moving image data," including "still image []

created from normal shooting process" and "still image [] generated from moving image data." Ans. 4 (citing Matsumoto ¶¶ 54, 60, Fig. 4).

The Examiner acknowledges, however, Matsumoto fails to disclose certain well known features, including (1) the use of auxiliary information, i.e., metadata to distinguish between the first still image data and the second still image data, as evidenced from Migiyama, and (2) the extraction of still image from encoded moving picture data, as evidenced from Kim in order to support the conclusion of obviousness. *Id*. at 5–6 (citing Migiyama ¶ 29, Figs. 3, 4A–4D; and Kim ¶ 26).

Appellants dispute the Examiner's factual findings regarding Matsumoto and the Examiner's rationale for making the combination. In particular, Appellants contend Matsumoto does not disclose "the first still image data extracted from encoded moving picture data . . . the second still image data generated through a normal image capturing process." App. Br. 16. According to Appellants, "[t]humbnails, as described by Matsumoto, are all extracted still images," i.e., "extracted from the original captured image data." *Id*. at 17–18 (citing Matsumoto ¶ 53). As such, Appellants argue "[a]n image <u>extracted</u> from still image data [as disclosed by Matsumoto] is not ***generated through a normal image capturing process*** as recited in the claims." *Id*. at 18. Appellants further argue the "thumbnail image" as disclosed by Matsumoto cannot be both (1) first still image data extracted from encoded moving picture data, and (2) second still image data generated through a normal image capturing process. Reply Br. 3.

In addition, Appellants contend (1) the Examiner has failed to present any type of rationale available under M.P.E.P. § 2143 (citing *KSR Int'l Co. v. Teleflex Corp.*, 550 U.S. 398, 406–7 (2007)); and (2) the Examiner's

stated rationale for combining the teachings of Matsumoto, Migiyama, and Kim, i.e., "to get auxiliary information which provides moving image file related to still image so that co-relation could be found between moving and still image" is conclusory and is based on impermissible hindsight because the "co-relation … between moving and still image" has been improperly gleaned from Appellants' own Specification. App. Br. 18–21 (citing Appellants' Spec. ¶9); Reply Br. 4–6.

We do not find Appellants' arguments persuasive. Instead, we find the Examiner has provided a comprehensive response to Appellants' arguments supported by a preponderance of evidence. Ans. 2–22. As such, we adopt the Examiner's findings and explanations provided therein. *Id.* For additional emphasis, we note Appellants cannot show nonobviousness by attacking references individually where the rejection is based on combinations of references. *In re Keller*, 642 F.2d 413 (CCPA 1981). The test of obviousness is not whether the claimed invention is expressly suggested in anyone or all of the references, but whether the claimed subject matter would have been obvious to those of ordinary skill in the art in light of the *combined teachings* of those references. *In re Keller,* 642 F.2d at 425. Contrary to Appellants' arguments, Migiyama and Kim, and not Matsumoto, are relied upon for teaching "extraction of still image from encoded moving picture." Ans. 3 (citing Migiyama ¶ 29; Kim ¶ 26); *see also* Kim's Figure 7. As further recognized by the Examiner, "Matsumoto stores still image data from both normal shooting process and moving image data," including "still image [] created from normal shooting process" and "still image [] generated from moving image data." *Id.* at 4 (citing Matsumoto ¶¶ 54, 60, Fig. 4). These features are well known in the art and any effort to combine these old

features along with the use of auxiliary information (metadata) to distinguish between different type of still image data, as evidenced from Migiyama, would have been obvious to those skilled in the art because these features perform the same known function and yield no more than one would expect otherwise. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). A skilled artisan would "be able to fit the teachings of multiple patents together like pieces of a puzzle" since the skilled artisan is "a person of ordinary creativity, not an automaton." *Id.* at 420–21.

We recognize that the Examiner must articulate some "reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). However, the Examiner's reasoning need not appear in, or be suggested by, one or more of the references on which the Examiner relies upon. Instead, a reason to combine teachings from the prior art "may be found in explicit or implicit teachings within the references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved." *WMS Gaming Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1355 (Fed. Cir. 1999) (citing *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). "Under the correct [obviousness] analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 420 (2007). Here, the Examiner has provided rationale supporting motivation by a skilled artisan to achieve the claimed subject matter, i.e., (1) to get easy identification of still images which are extracted from moving images, and (2) by "adding the extraction of still image from encoded moving image data as taught by Kim as part of

Matsumoto's moving image . . . to provide still image from moving image during moving image capture as well as during reproduction." *See* Ans. 14, 16. Appellants have not demonstrated which rationale is erroneous or why a person of ordinary skill in the art *would not* have reached the conclusions reached by the Examiner. *See DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1368 (Fed. Cir. 2006) ("[T]he proper question is whether the ordinary artisan possesses knowledge and skills rendering him *capable* of combining the prior art references."). Consequently, we are not persuaded that the Examiner failed to articulate a rationale for combining the references. Nor do we find any evidence in the record to support Appellants' contention that the rejection is based on "impermissible hindsight." That argument, however, is essentially a repackaging of the argument that there is insufficient evidence of a motivation to combine the references, with which we disagree. *See In re Cree*, 818 F.3d 694, 702, n.3 (Fed. Cir. 2016) (Appellants' hindsight argument is of no moment where the Examiner provides a sufficient, non-hindsight reason to combine the references).

Lastly, we note Appellants have not demonstrated the Examiner's proffered combination of references would have been "uniquely challenging or difficult for one of ordinary skill in the art." *See Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418). Nor have Appellants provided objective evidence of secondary considerations which our reviewing court guides "operates as a beneficial check on hindsight." *Cheese Systems, Inc. v. Tetra Pak Cheese and Powder Systems*, 725 F.3d 1341, 1352 (Fed. Cir. 2013).

For these reasons, we sustain the Examiner's obviousness rejection of independent claim 1 and similarly, independent claims 5 and 7 and their respective dependent claims 2, 3, 8–11, 18–20, and 22, which Appellants do not argue separately. App. Br. 22.

CONCLUSION

On the record before us, we conclude Appellants have not demonstrated the Examiner erred in rejecting claims 1–3, 5, 7–11, 18–20, and 22 under 35 U.S.C. § 103(a).

DECISION

As such, we AFFIRM the Examiner's final rejection of claims 1–3, 5, 7–11, 18–20, and 22.

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