

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT J. GOVE

Appeal No. 1997-1413
Application 07/765,757¹

ON BRIEF

Before JERRY SMITH, BARRETT, and RUGGIERO, Administrative
Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134
from the examiner's final rejection of claims 1, 3, 4, 6, 10,
13-18, 40 and 41 which constitute all the claims remaining in

¹ Application for patent filed September 26, 1991.

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the application. An amendment after final rejection was filed on January 18, 1994 to amend claims 15 and 16, but this amendment was denied entry by the examiner. Appellant has withdrawn the appeal with respect to claims 15 and 16.

Therefore, this appeal is directed to the rejection of claims 1, 3, 4, 6, 10, 13, 14, 17, 18, 40 and 41.

The disclosed invention pertains to a photographic device capable of exposing using entered sketches on the photographic medium along with the object being photographed.

Representative claim 1 is reproduced as follows:

1. A photographic device capable of placing captions and logos onto images recorded using said photographic device, comprising:

a camera body operable to record an image onto a photographic media;

an electronic writing pad mounted on said camera body, on which a user inputs information to be superimposed onto said image; said writing pad being operable to accept a sketch drawn by user;

said writing pad including a matrix of touch sensitive cells;

a processor for sampling said information on said writing pad for converting said information into display signals which display the information;

a display coupled to said processor and responsive to said display signals for displaying the sketch drawn by user;

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and

an output device attached to said body, responsive to said display, and operable to record said information onto said photographic media, thereby superimposing said information onto said image.

The examiner relies on the following references:

Hattori	4,330,186	May 18, 1982
Sakurada et al. (Sakurada)	4,449,805	May 22, 1984
Ishii et al. (Ishii)	4,742,369	May 03, 1988
Johnston et al. (Johnston)	4,814,760	Mar. 21, 1989
Arifuku et al. (Arifuku)	5,103,250	Apr. 07, 1992

(filed July 02, 1990)

The following rejections are on appeal before us:

1. Claims 1, 3, 4, 6, 10, 17, 18 and 40 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Sakurada in view of Johnston and Arifuku.

2. Claims 1, 6, 13, 14, 17, 40 and 41 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Ishii in view of Johnston and Arifuku.

3. Claims 1, 6, 17 and 40 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Hattori in view of Johnston and Arifuku.

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Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs² and the answers for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answers.

It is our view, after consideration of the record before us, that the evidence including Ishii and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as

² We have considered all the briefs filed by appellant except for the original reply brief which was denied entry by the examiner. The examiner's decision to deny entry of this reply brief was upheld after appellant filed a petition to the Commissioner to have the reply brief entered [Decision mailed June 5, 1996].

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set forth in

claims 1, 6, 13, 14, 17, 40 and 41. We reach the opposite conclusion with respect to the rejections based on Sakurada and Hattori. Accordingly, we affirm-in-part.

Appellant has nominally indicated that the claims do not stand or fall together [brief, pages 4-5], but he has not specifically argued the limitations of each of the claims. To the extent that appellant has properly argued the reasons for independent patentability of specific claims, we will consider such claims individually for patentability. To the extent that appellant has made no separate arguments with respect to some of the claims, such claims will stand or fall with the claims from which they depend. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In

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so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis

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of the evidence as a whole. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the briefs have not been considered [see 37 CFR § 1.192(a)].

1. The rejection of claims 1, 3, 4, 6, 10, 17, 18 and 40 based on the teachings of Sakurada, Johnston and Arifuku.

This rejection is fully explained on pages 4-8 of the answer. Essentially, the examiner cites Sakurada as teaching a camera in which user entered information is exposed onto film along with the image of the object being photographed. The examiner notes that Sakurada does not teach an electronic writing pad of the type claimed, but the examiner cites Johnston as disclosing such an electronic writing pad. The examiner asserts that it would have been obvious to the artisan to substitute Johnston's electronic writing pad for the keyboard input of Sakurada. The rejection also notes that

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it would have been obvious to design the output device to be capable of recording data entered in a free-hand fashion based on the non-alphanumeric characters exposed on film as taught by Arifuku.

With respect to independent claims 1 and 18, appellant argues that there is no motivation within the applied prior art to have a photographic device with a writing pad as claimed. Specifically, appellant argues that there is no suggestion of a writing pad in Sakurada and Arifuku, and there is no suggestion of using Johnston's writing pad with a photographic device. Appellant asserts that none of the applied prior art suggests putting a handwritten sketch on film and the examiner is guilty of hindsight reconstruction of the invention [brief, pages 5-7]. The examiner responds that the motivation for substituting Johnston's writing pad for Sakurada's keyboard is to replace one kind of input device with another, similar kind of input device having more flexibility [answer, pages 13-16]. Appellant argues that the characters suggested in Arifuku for exposure on a photographic medium are not handwritten sketches as claimed, but rather, are characters which have been prestored in a memory

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[substitute reply brief, pages 2-3].

We agree with appellant that the collective teachings of Sakurada, Johnston and Arifuku would not have suggested the obviousness of using a writing pad operable to receive sketches drawn by a user for input to a photographic device as recited in these claims. The only suggestion for using such a writing pad with a camera comes from appellant's own disclosure. Johnston teaches nothing more than that writing pads in general were known. We can find no reason why the artisan would have been motivated to replace the keyboard of Sakurada with a writing pad. Sakurada uses the keyboard to simplify the entry of numbers which may not have to be changed from photograph to photograph. A writing pad for entry of user drawn sketches would not be consistent with the type of input desired by Sakurada. Therefore, we are of the view that the only motivation for combining the teachings of Sakurada with those of Johnston comes from an improper reliance on appellant's own disclosure.

In summary, the invention of independent claims 1 and 18 is not rendered obvious by the teachings of Sakurada, Johnston and Arifuku within the meaning of 35 U.S.C. § 103.

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Therefore, we do not sustain this rejection of independent claims 1 and 18 or of claims 3, 4, 6, 10, 17 and 40 which depend from claim 1.

2. The rejection of claims 1, 6, 13, 14, 17, 40 and 41 based on the teachings of Ishii, Johnston and Arifuku.

This rejection is fully explained on pages 8-10 of the answer. Essentially, the examiner cites Ishii as teaching a camera in which user entered information is exposed onto film along with the image of the object being photographed. In this regard, Ishii is similar to Sakurada as discussed above. Johnston and Arifuku are applied in the same manner discussed above. Ishii has the additional teaching that arbitrary information can be supplied to an image memory using an input device other than a keyboard [column 14, lines 47-57].

Appellant argues that Ishii does not teach or suggest a writing pad for accepting a sketch drawn by a user. Appellant also repeats the arguments with respect to Johnston and Arifuku [brief, page 9]. Appellant also argues that the portion of Ishii noted above simply suggests pattern recognition of an alpha-numeric character and does not suggest

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a writing pad for converting sketches into display signals as claimed [substitute reply brief, pages 3-5]. Finally, appellant argues that the outputs of Ishii's keyboard input go to the display only and not to the film.

We do not agree with appellant's arguments with respect to the teachings of Ishii. Figure 23 of Ishii shows that Ishii contemplated entering captions for photographs by use of a keyboard. Ishii refers to these captions as "arbitrary messages," and Ishii notes that "a data input means is not limited to a keyboard, but can be an input device which recognizes a manually input character pattern [column 14, lines 55-57]. The artisan would have understood this portion of Ishii as suggesting that a writing pad be used instead of the keyboard because such writing pads were conventional devices for inputting "character patterns" as an alternative to a traditional keyboard. Given that the quoted portion of Ishii would have suggested a writing pad to the artisan, the artisan would also have recognized that any type of writing pad would be acceptable such as the writing pad disclosed by Johnston. The writing pad of Johnston displays exactly what is drawn by the user. Appellant's argument that the

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information from Ishii's keyboard in Figure 23 only goes to the display and not to the film is untenable. All the embodiments of Ishii are directed to the manually entered input data and/or the data representative of the object to be photographed being stored in memory such as memory 105 before it is transferred to the film for printing. It also makes no sense that the entered caption such as shown in Figure 23 would not appear on the exposed film since the whole purpose of Ishii's device is to expose additional information onto the photographic film with the object to be photographed.

Appellant's argument that Ishii relates to pattern recognition rather than a user drawn sketch is not persuasive. Ishii suggests that any information can be entered for exposure on the film, and the suggestion of a writing pad, as discussed above, would also have suggested the capability of entering sketches as taught by Johnston. Therefore, we sustain this rejection of independent claim 1. Dependent claims 6, 17 and 40

fall with claim 1 because appellant has not presented arguments sufficient to have these claims considered

separately.

Dependent claim 41 is similar to claim 1 except that it recites that the user entered inputs are converted into video signals. The examiner interprets "video signals" as requiring nothing more than signals "which are suitable, after further processing, to be displayed as images on a video display" [supplemental answer, pages 3-4]. Appellant argues that a photographic image is not a video signal, and that video refers to the visual elements of a television [substitute reply brief, page 5].

Regardless of whose definition of video signals is correct, we are of the view that the recitation of video signals would have been obvious to the artisan in view of the collective teachings of the applied prior art. Although Ishii is primarily directed to a still camera, we see no reason why the artisan would not have found it obvious to apply the exact same principles to a video camera. There is nothing about the processing of images in Ishii which would preclude a similar operation being performed on "video signals." Therefore, we sustain this rejection of claim 41 and of claims 13 and 14 which depend therefrom.

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It is noted that we basically find Arifuku unnecessary to support this rejection of the claims. The obviousness of hand drawn input characters for which Arifuku was cited is clearly taught by the writing pad of Johnston which was obviously substituted for Ishii's keyboard for reasons discussed above.

3. The rejection of claims 1, 6, 17 and 40 based on the teachings of Hattori, Johnston and Arifuku.

This rejection is explained on pages 11-13 of the answer and is essentially the same as the previous rejections with Hattori taking the place of Sakurada or Ishii. Appellant argues

that Hattori, like the other references, does not teach or suggest a writing pad operable to accept a sketch drawn by a user [brief, page 11].

We find that Hattori suffers the same deficiencies noted above with respect to Sakurada. That is, there is no suggestion in Hattori for replacing the disclosed keyboard with a writing pad operable to accept a sketch drawn by a

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user. The only motivation for making this substitution comes from an improper attempt to reconstruct appellant's invention in hindsight. Therefore, we do not sustain this rejection of claims 1, 6, 17 and 40.

In summary, the rejection of claims 1, 3, 4, 6, 10, 17, 18 and 40 based on the teachings of Sakurada, Johnston and Arifuku is not sustained. The rejection of claims 1, 6, 13, 14, 17, 40 and 41 based on the teachings of Ishii, Johnston and Arifuku is sustained. The rejection of claims 1, 6, 17 and 40 based on the teachings of Hattori, Johnston and Arifuku is not sustained. Accordingly the decision of the examiner rejecting claims 1, 3, 4, 6, 10, 13, 14, 17, 18, 40 and 41 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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	Administrative Patent Judge)	
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