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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PATRICIA A. TORRENS-BURTON

Appeal 2010-007811
Application 10/045,134
Technology Center 3600

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1, 3-6, 9-10, and 13-29 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We REVERSE.

THE INVENTION

The Appellant's claimed invention is directed to a method and apparatus for creating and delivering customized souvenir photographs showing the customer at an event site (Spec. 1: 4-6). Claim 1, reproduced below with the numbering in brackets added, is representative of the subject matter on appeal.

> 1. A method of providing souvenir images to event site customers, comprising:
>
> capturing motion video data during an event, said event being attended by a set of event site customers;
>
> automatically generating a plurality of images of different event site locations of a plurality of event site locations within an event site from said motion video, wherein each image of said plurality of images is associated with a respective one of said event site locations, wherein each said event site location is occupied during said event by a respective discrete subset of said set of event site customers, each said subset being different and containing at least one and fewer than all respective event site customers of said set of event site customers, each said event site customer occupying only a single respective event site location of said different event site locations during said event;

> [1] receiving, in an automated interactive device, an input from a customer specifying a desired event site location [2] from among said plurality of event site locations, said receiving step being performed after said step of capturing motion video data;
>
> [3] responsive to said step of receiving a user input, automatically displaying to the customer in said automated interactive device at least one image associated with the desired event site location; [4] and
>
> responsive to receiving in said automated interactive device a customer confirmation, automatically providing the at least one image to the customer.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Catanoso	US 6,892,388 B1	May 10, 2005

The following rejections are before us for review:

1. Claims 1, 3-6, 9-10, and 13-29 are rejected under 35 U.S.C. § 103(a) as unpatentable over Catanoso.

THE ISSUES

With regard to claim 1, the issue turns on whether it would have been obvious to modify Catanoso to obtain claim limitations [1] and [3].

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence.[1] Additional facts may appear in the Analysis section below.

FF1. Catanoso had disclosed a video recording and production system that is used at events (Title, Abstract).

FF2. Catanoso has disclosed that the system may be used at events such as amusement rides and athletic events and may provide an on the spot souvenir for the amusement park rider. Workstation 10 may record from different cameras on different cars to generate tapes of different riders. All riders are recorded and video or other media are produced only when a rider purchases them. No rider intervention is required for recording. (Col. 5: 44-6:15).

ANALYSIS

The Appellant argues that the rejection of claim 1 is improper because Catanoso fails to disclose claim limitations [1] and [3] and that the modification to obtain these claim limitations would not have been obvious. (Br. 9-17).

In contrast, the Examiner has determined that the rejection of record is proper (Ans. 3-4, 8).

We agree with the Appellant. The Examiner has cited to Catanoso which teaches that at events such as amusement rides and athletic events providing an on the spot souvenir for the amusement park rider (FF2). In

[1] *See Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

Catanoso, all riders are recorded and video or other media are produced only when a rider purchases them and no rider intervention is required for recording (FF2).

The Examiner acknowledges that Catanoso does not teach "displaying images of a certain spot in response to input from the customer or specifically being able to use the playback monitor at more than one location" but has determined that such a modification would have been obvious to allow the user to specify the location and get videos of more than one location without having to go to multiple locations (Ans. 4). The Examiner has also asserted that Catanoso "does disclose an input" because if there were no input, the system would not know what to sell (Ans. 8).

Claim limitations [1] - [3] are listed below and require:

> [1] receiving, in an automated interactive device, an input from a customer specifying a desired event site location [2] from among said plurality of event site locations, said receiving step being performed after said step of capturing motion video data;
> [3] responsive to said step of receiving a user input, automatically displaying to the customer in said automated interactive device at least one image associated with the desired event site location;

While Catanoso has disclosed that the system may be used at events such as amusement rides and athletic events and may provide an on the spot souvenir for the amusement park rider there is no specific disclosure of receiving, in an automated interactive device, an input from a customer specifying a desired event site location, and responsive to said step of receiving a user input, automatically displaying to the customer in said automated interactive device at least one image associated with the desired event site location.

In *KSR Int'l Co. v. Teleflex Inc*., 550 U.S. 398 (2007) the Supreme Court at 418 noted that in an obviousness analysis that"[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness".

Here, while the prior art of Catanoso has disclosed using cameras to take pictures of an amusement park rider on a ride and to then to offer the souvenirs for sale, there is no articulated reasoning with rational underpinnings to take the steps required by claim limitations [1] and [2] without impermissible hindsight. In Catanoso, the pictures can be displayed to the user but it has not been disclosed that this in response to an input from a customer specifying a desired event location.

Here, the claims do require receiving a request in a device from the customer about a specified desired event location and then responsive to this input, then displaying the image in the device and there is no articulated reasoning with rational underpinnings to take these two claimed cited steps without impermissible hindsight and a prima facie case of obviousness has not been established. The Examiner also has determined that the customer "must be in a location" however a mere "location" alone is not the sole requirement of claim limitations [1] and [3] as discussed above. For these reasons the rejection of claim 1 and its dependent claims is not sustained. Claims 16 and 25 contain similar claim limitations and the rejection of these claims, and there dependent claims, is not sustained for the same above reasons.

Claim 24 contains limitations including an "automated kiosk" with "an automated document reader that receives a physical document evidencing an

assigned seat location from a customer" and "a display that displays...an image...associated with the assigned seat location. ..reader" that has not been shown in Catanoso and this is also not an obvious modification in light of the rejection that has been presented. This cited rejection of record lacks articulated reasoning with rational underpinnings to take the steps required for "an automated document reader that receives a physical document evidencing an assigned seat location from a customer" in relation to other cited claim elements. For this reason the rejection of claim 24 and its dependent claims is not sustained.

CONCLUSIONS OF LAW

We conclude that Appellant has shown that the Examiner erred in rejecting claims 1, 3-6, 9-10, and 13-29 under 35 U.S.C. § 103(a) as unpatentable over Catanoso.

DECISION

The Examiner's rejection of claims 1, 3-6, 9-10, and 13-29 is reversed.

REVERSED

MP