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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JIN-SEUNG CHOI, JAE-CHUL LIM, JAE-BUM PARK,
HONG-KEUN JI, JONG-HO KIM, DO-WAN KIM, HYUN-JUN OH,
DONG-WON NA, and WON-HEE SULL

Appeal 2014-001212
Application 11/911,879
Technology Center 2600

Before JOHN A. JEFFERY, BRADLEY W. BAUMEISTER, and
DENISE M. POTHIER, *Administrative Patent Judges*.

POTHIER, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–23, which constitute all the claims pending in this application.¹ App. Br. 1. We have jurisdiction under 35 U.S.C. § 6(b). We reverse. Pursuant to our authority under 37 C.F.R. § 41.50(b), we newly reject claims 1 and 15 under 35 U.S.C § 103(a).

¹ Throughout this Opinion, we refer to (1) the Final Rejection (Final Act.) mailed February 19, 2013, (2) the Appeal Brief (App. Br.) filed June 28, 2013, (3) the Examiner's Answer (Ans.) mailed August 30, 2013, and (4) the Reply Brief (Reply Br.) filed October 29, 2013.

INVENTION

Appellants' invention provides location-based services using location information inserted in an image. Spec. ¶ 6. For example, location-based services include displaying a map showing the location where the image was captured. *Id.* Claim 1, reproduced below with our emphasis, is illustrative:

1. A location-based service method using image data provided by a terminal equipped with a camera, and using location data that includes location information of the terminal, comprising:

(a) a step of generating first image data with the terminal at a predetermined location;

(b) a step of receiving location data of the predetermined location;

(c) a step of *prompting a user to choose whether or not to insert the received location data into the first image data to generate a second image data* and, if the user chooses to do so, inserting the received location data into the first image data to generate a second image data; and

(d) a step of transmitting the second image data, the second image data including the first image data and the location data, to another terminal and providing a location-based service to the another terminal using the location data of the second image data.

The Examiner relies on the following as evidence of unpatentability:

Clapper	US 6,023,241	Feb. 8, 2000
Haruki	US 2002/0135680 A1	Sept. 26, 2002
Takahashi	US 2004/0229656 A1	Nov. 18, 2004
Basir	US 2006/0077055 A1	Apr. 13, 2006

THE REJECTIONS

Claims 1, 3, 5–9, and 11–16 are rejected under 35 U.S.C. § 103(a) as unpatentable over Clapper and Takahashi. Final Act. 2–7.

Claims 2 and 17 are rejected under 35 U.S.C. § 103(a) as unpatentable over Clapper, Takahashi, and Haruki. Final Act. 7–8.

Claims 4, 10, and 18–23 are rejected under 35 U.S.C. § 103(a) as unpatentable over Clapper, Takahashi, and Basir. Final Act. 8–10.

OBVIOUSNESS REJECTION OVER CLAPPER AND TAKAHASHI

Contentions

Claim 1 recites, in pertinent part, “prompting a user to choose whether or not to insert the received location data into the first image data to generate a second image data.” The Examiner finds that Clapper teaches all of the limitations of independent claim 1 except for the steps of prompting a user and inserting the location data. Final Act. 2–4. The Examiner turns to Takahashi for these features in concluding that the claim would have been obvious. *Id.* As best understood, the Examiner finds that Takahashi prompts and waits for user input. *Id.* at 4. According to the Examiner, Takahashi’s user invokes the position data insertion function while the system is waiting for the user’s keystrokes. *See* Ans. 3.

Among other contentions, Appellants argue that Takahashi does not prompt a user to choose whether to insert location data. App. Br. 8–10. According to Appellants, Takahashi’s waiting state does not prompt the user and is irrelevant to inserting location data. *Id.* at 9–10 (citing Takahashi ¶¶ 68, 94).

Issue

Under § 103, has the Examiner erred in rejecting claim 1 by finding that Takahashi would have taught or suggested “a step of prompting a user

to choose whether or not to insert the received location data into the first image data to generate a second image data”?

Analysis

To address the recited prompting, the Examiner relies upon Takahashi’s method alone. *See* Final Act. 4 (stating that “Clapper does not explicitly disclose a step of prompting a user”); *see also* Ans. 3 (discussing only Takahashi in responding to Appellants’ arguments). We, therefore, confine our discussion to Takahashi.

Takahashi waits for a user’s keystroke, then performs a corresponding function. *See* Takahashi ¶ 68, *cited in* Final Act. 4; Takahashi ¶¶ 52–53, 55–56, *cited in* Ans. 3. As best understood, the Examiner finds that Takahashi’s waiting state involves prompting a user. *See* Final Act. at 4. Even assuming, without deciding, that this finding is correct, the Examiner has not shown that Takahashi prompts the user to insert position data. As discussed in detail below, the Examiner cites Takahashi’s first, second, and fourth embodiments. *See* Final Act. 4; Ans. 3. But none of these embodiments disclose the limitation at issue.

Takahashi’s first and second embodiments (Takahashi ¶¶ 51–59, 68) lack the recited prompting. In particular, we are persuaded by Appellants’ argument (App. Br. 9) that Takahashi’s first and second embodiments (Takahashi ¶¶ 51–59, 68) play an image sequence without inserting location data. For example, Takahashi enlarges or scrolls an image. *See, e.g., id.*, Figs. 10A–C; *id.* ¶ 64. To direct this playback, Takahashi’s system waits for the user to press a key. *See id.* ¶ 68, *cited in* Final Act. 4; *see also* Takahashi ¶¶ 44, 52–53, 55–56, *cited in* Ans. 3. But the Examiner does not

cite (*see* Final Act. 4; Ans. 3), and we do not find, that Takahashi's system waits for or prompts the user to press a key to insert position data.

With respect to the fourth embodiment, the Examiner specifically points to the "System Configuration." Final Act. 4 (citing Takahashi ¶ 94). To be sure, Takahashi's fourth embodiment does insert position data in an image. Takahashi ¶ 94, *cited in* Final Act. 4. But we agree with Appellants that the Examiner has not shown that Takahashi's user is prompted before inserting this position data. App. Br. 10. In this section of the embodiment, Takahashi discloses that phone 3a "has a function to insert" a location into an image file. Takahashi ¶ 94. But Takahashi is silent with respect to a prompt or even a waiting state to do so. *Id.*

Other sections describing Takahashi's fourth embodiment (*see, e.g., id.* ¶¶ 105–08) contradict the Examiner's position that a user invokes the position data insertion function during a waiting state. Ans. 3. For example, in the section "Operation of the Fourth Embodiment," Takahashi explains the flow chart in Figure 23. *Id.* ¶¶ 105–07. In this explanation, the only evidence of user input is the shutter-key operation. *Id.* There is no evidence of any intervening prompts or wait states during these steps. *See id.* Even in blocks S132 to S140 of Figure 23, Takahashi forms the image file by searching for the IHDR header (image header) without waiting for any key operation. *Compare id.* ¶ 107 (stating "operation proceeds" and "operation repeats") *with id.* ¶ 108 (stating "operation then becomes the wait state for the key operation"). Accordingly, this record does not support the Examiner's finding that Takahashi's fourth embodiment prompts a user as recited. Ans. 3.

As such, we are constrained by this record to find that the Examiner has erred in establishing that Takahashi teaches the recited prompting.

For the foregoing reasons, Appellants have persuaded us of error in the rejection of (1) independent claim 1, (2) independent claim 15, which recites similar limitations, and (3) dependent claims 3, 5–9, 11–14, and 16, for similar reasons.

THE OTHER OBVIOUSNESS REJECTIONS

We also do not sustain the Examiner’s rejections of dependent claims 2, 4, 10, and 17–23 for the same reasons discussed above in connection with claim 1. The additional references—Haruki and Basir—were not relied upon to teach the recited “prompting” step that is missing from Takahashi, and, thus, do not cure the deficiency explained previously given the record. *See* Final Act. 7–9.

NEW GROUND OF REJECTION

Pursuant to our discretionary authority under 37 C.F.R. § 41.50(b), we enter a new ground of rejection for claims 1 and 15 under 35 U.S.C. § 103(a) as obvious over Clapper.

As described in detail below, Clapper’s method of creating and providing multimedia excursions (Clapper, Figs. 7 and 9) constitutes “[a] location-based service method using image data provided by a terminal equipped with a camera, and using location data that includes location information of the terminal,” as recited in claim 1.

Likewise, claim 15 recites the steps of claim 1 as functions performed by various descriptive “sections.” We find that the recited terminal

corresponds to Clapper's terminal 10 (*see id.*, Fig. 1). The recited steps of claim 1 and terminal sections of claim 15 are discussed below.

Step (a)

Claim 1 recites “(a) a step of generating first image data with the terminal at a predetermined location.” Likewise, the user in Clapper either provides an image or is prompted for an image input at blocks 82, 88, and 90 (Clapper, Fig. 6) and, in response, generates first image data. *See id.*, col. 4, ll. 53–54, 57–61, 64–66. As for the “at a predetermined location” limitation, the image is taken at a location and, thus, generated “at a predetermined location,” as broadly as recited. *See id.*

For these reasons, Clapper also discloses claim 15's camera section.

Step (b)

Claim 1 further recites “(b) a step of receiving location data of the predetermined location.” Clapper receives the recited “location data” as global position system (GPS) coordinates in block 86. *Id.*, col. 4, ll. 53–57 and Fig. 6. For these reasons, Clapper also discloses a terminal configured to receive location data, as recited in claim 15.

Step (c)

Claim 1 further recites “(c) a step of prompting a user to choose whether or not to insert the received location data into the first image data to generate a second image data and, if the user chooses to do so, inserting the received location data into the first image data to generate a second image data.”²

² Notably, this phrase includes a conditional limitation, “inserting the received location data into the first image data . . .,” that need only be performed if the user chooses to insert location data into the image data.

Clapper teaches a prompt at block 88.³ Clapper, Fig. 6. In particular, Clapper's block 88 leads to block 92 where GPS data may be superimposed over the first image data, generating a second image. *Id.*; *see also id.*, col. 4, ll. 57–67. That is, Clapper's image 108, including GPS data 110, becomes the recited second image because it is generated from the first image and the GPS location information. *Id.*; *see also id.*, Fig. 7. However, when the user is prompted for an image at block 88, there is no further prompt to choose whether or not to insert the received location data as recited.

Yet, we conclude that it would have been obvious to prompt Clapper's user to superimpose the GPS data. Specifically, Clapper provides two embodiments for inserting GPS data in an image. *See id.*, col. 4, l. 64 to col. 5, l. 7. In one embodiment, GPS data is inserted in the first image to generate a second image as discussed previously. *See id.*, col. 4, ll. 57–67. In a second embodiment, Clapper provides GPS data in a second frame separate from the first image. *Id.*, col. 5, ll. 2–7. This illustrates that Clapper teaches and has the ability to store the first image data separate from a second image data containing GPS data.

Furthermore, Clapper demonstrates that having prompts for different functionalities to solicit user input is known in the art. *See, e.g., id.*, col. 4, ll. 57–59, 64–65; Fig. 6 (prompting a user for an image to be associated with GPS data); *id.*, col. 5, ll. 8–9; Fig. 6 (prompting a user for audio at block 94); *id.*, col. 4, ll. 4–9 and 25–27, Figs. 4–5 (prompting a user for an identifier). Given that Clapper teaches it was known to prompt a user for different functionalities, and given that Clapper has the ability to store a first image

³ The Specification also discloses first image data being generated in step S206, after inquiring whether to insert the location data. Spec. ¶ 29; Fig. 2.

separate from a second image, it would have been obvious to one skilled in the art to include a prompt to ask the user whether to insert GPS data into the first image or to store it separately. For example, it would have been obvious to include such a prompt between Clapper's blocks 90 and 92 in Figure 6. This combination of Clapper's teachings would not change how a prompt works, and, therefore, would have constituted nothing more than a combination of prior art elements yielding a predictable result. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007).

For these reasons, the location data processing section and image data storing section in claim 15 are also taught or suggested by Clapper, as explained previously in connection with claim 1.

Step (d)

Claim 1 further recites “(d) a step of transmitting the second image data, the second image data including the first image data and the location data, to another terminal and providing a location-based service to the another terminal using the location data of the second image data.”

Appellants' arguments regarding the transmitting step are premised on the Examiner's position that Clapper's map data (*see* App. Br. 7–8) or alternatively, Clapper's recorded landmark (*see* Reply Br. 4–5) being the second image data. These arguments, however, are moot because unlike the Examiner, we find that the second image data is the image shown in Clapper's image 108 having GPS data 110 (*see* Clapper, Fig. 7), as discussed previously.

Regarding the “transmitting” step, Clapper's terminal 10 stores the second image as multimedia data. *See id.*, col. 1, ll. 58–60, col. 3, ll. 61–67, col. 4, ll. 12–19 and 39–41, and col. 5, ll. 8–17. This multimedia data is

used in a presentation downloaded from excursion server 42 where a user can take an excursion or guided multimedia tour without a personal guide. *Id.*, col. 6, ll. 31–46. Figure 2 shows bi-directional communication between server 42 and terminal 10 through computer 36. *See also id.*, col. 7, ll. 8–15 (disclosing a user uploading data from terminal 10). So, as recited in claim 1, terminal 10 transmits the second image data including the first image data (*id.*, Fig. 7 (showing an image of a monument)) and the location data (*id.*, col. 4, ll. 57–67 (GPS data)) to another terminal (*id.*, Fig. 2, computer 36).

Regarding the “providing” step, Clapper provides a location-based service from the excursion server 42 in the form of a preprogrammed excursion, for example. *Id.*, col. 6, ll. 31–46. These preprogrammed excursions are downloaded from server 42 to the terminal 10. *Id.* Clapper’s computer 36 connects the excursion server 42 to terminal 10. *See id.*, Fig. 2. Because the downloaded excursions must pass through computer 36, Clapper’s excursion server 42 provides this location-based service to another terminal (e.g., computer 36), as recited. Moreover, Clapper provides these excursions using the current GPS coordinates matched with the location data of the second image data. *See id.*, col. 6, ll. 42–46. In this way, Clapper provides “a location-based service to the another terminal using the location data of the second image data,” as recited.

For these reasons, Clapper also teaches the transmitting section in claim 15.

Although we decline to reject every claim under our discretionary authority under 37 C.F.R. § 41.50(b), we emphasize that our decision does not mean that the remaining claims are necessarily patentable. Rather, we

merely leave the patentability determination of these claims to the Examiner.
See MPEP § 1213.02.

DECISION

The Examiner's decision rejecting claims 1–23 is reversed.

Pursuant to 37 C.F.R. § 41.50(b), we enter a new ground of rejection for claims 1 and 15 under 35 U.S.C. § 103.

Section 37 C.F.R. § 41.50(b) states that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Furthermore, 37 C.F.R. § 41.50(b) also provides that Appellants, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED
37 C.F.R. § 41.50(b)