

ALERT

Federal Circuit Patent Bulletin: *In re Imes*

January 30, 2015

"A second reference may be used to show that a feature is inherent in a first reference if the first reference is silent with regard to the inherent feature. However, the evidence must make clear that the missing characteristic is 'necessarily present' in the first reference."

On January 29, 2015, in *In re Imes*, the U.S. Court of Appeals for the Federal Circuit (Lourie, Moore,* Chen) reversed and remanded the U.S. Patent and Trademark Office (USPTO) Patent Trial and Appeal Board decision upholding the patent examiner's rejections under 35 U.S.C. §§ 102 and 103 of certain claims of U.S. patent application Serial No. 09/874,423, which related to a device for communicating digital camera image and video information over a network. The Federal Circuit stated:

Independent claims 34 and 43 each recite a communications device comprising, among other features, a "communications module . . . operable to wirelessly communicate streaming video to a destination." The examiner rejected claim 34 as anticipated by [U.S. Patent No. 7,173,651 (Knowles)] and claim 43 as obvious over Knowles in view of U.S. Patent No. 7,372,485 (Bodnar). The examiner found that Knowles discloses the recited communications module operable to wirelessly communicate streaming video to a destination. Knowles discloses a wireless digital camera system that transmits images over the Internet. Knowles's camera system allows a user to take multiple consecutive still images and queues the images so that they can be serially transmitted to a server while allowing the user to take subsequent pictures without waiting for the previous picture to be transmitted. The server then transmits the images via e-mail. Noting that Figure 12 of Knowles shows a repetitive loop where images are transmitted so long as they are in the queue, the examiner concluded that Knowles discloses "streaming video." The examiner explained that "[a] continuous process of sending images is the equivalent of streaming video." The examiner also noted that Knowles discloses that its invention can be implemented on a Sony Vaio C1 Picture-book that incorporates a digital camera. The examiner then cited a press release explaining that the Sony Vaio C1 Picturebook can send both still images and digital video clips over the Internet as e-mail attachments.

The Board affirmed. It construed “operable to wirelessly communicate streaming video to a destination” as “capable of wirelessly communicating continuous video transmission.” Like the examiner, it determined that the Figure 12 embodiment of Knowles and the implementation on a Sony Vaio C1 Picturebook disclose this limitation.

We see no error in the Board’s construction of the streaming video limitation as “capable of wirelessly communicating continuous video transmission.” There is, however, no substantial evidence supporting its determination that Knowles discloses streaming video. Knowles discloses a system that sends a series of individual still images as e-mail attachments. Sending a series of e-mails with attached still images is not the same as streaming video. Such a construction is unreasonable as it comports with neither the plain meaning of the term nor the specification. Streaming video is the continuous transmission of video. A series of e-mails with attachments does not meet the definition of “streaming” and still images do not meet the definition of “video.” . . .

We also hold that substantial evidence does not support the Patent Office’s finding that Knowles’s reference to a Sony Vaio C1 Picturebook discloses the streaming video limitation. Knowles itself indicates that its invention may be implemented on a number of different devices, including the Sony Vaio C1 Picturebook. Knowles does not mention any specific features of the Sony Vaio C1 Picturebook other than that it incorporates a digital camera. Instead, the examiner relied on a press release in which Sony announced its new Vaio notebook computer to show the inherent characteristics of the Sony Vaio C1 Picturebook. In particular, this press release indicates that the digital camera is capable of capturing digital still images and video clips and sending them as attachments to e-mail messages. A second reference may be used to show that a feature is inherent in a first reference if the first reference is silent with regard to the inherent feature. However, the evidence must make clear that the missing characteristic is “necessarily present” in the first reference. Here, the Sony Vaio press release does not disclose that the Sony Vaio C1 Picturebook is capable of “streaming video” or “continuous video transmission.” The press release only discloses that the Sony Vaio C1 Picturebook can send out “digital video clips and still pictures . . . attached to e-mail messages.” Sending out an e-mail message with a video file attached does not disclose streaming video or, as construed, continuous video transmission. In fact, the ‘423 application distinguishes between streaming video and sending a video file: “a user may want to wirelessly communicate streaming video or a video file.” The Sony Vaio press release does not discuss streaming or continuous transmission of anything—it merely discloses sending a video file as an attachment to an e-mail.

Nowhere in the record did the examiner or the Board explain how implementing Knowles's disclosed image transmission method on a Sony Vaio C1 Picturebook discloses streaming video or continuous video transmission. Instead, both the Board and the examiner found that Knowles discloses continuous image transmission and that Knowles can be implemented on the Sony Vaio C1 Picturebook, which is capable of sending video files via email. These two findings do not provide substantial evidence that Knowles discloses, expressly, inherently, or even implicitly, streaming video capabilities. For these reasons, we hold that the Board erred in concluding that Knowles discloses the claimed "communications module . . . operable to wirelessly communicate streaming video to a destination."