

REMARKS

Claims 1-38 have been cancelled, and new claims 39-84 are being submitted herewith for the Examiner's consideration. The new claims have been submitted to more clearly claim the applicant's invention, and to better highlight how the claims distinguish over all the prior art of record in this and the parent application, either taken alone or in any purported combination.

In the parent of this application, the undersigned attorney submitted information about various digital cameras and software provided by Eastman Kodak, Sony, Polaroid, Canon, Olympus, and Casio, and asked the Examiner to assume that this information is prior art. Assuming that it is prior art, this information, together with the other camera related patents are of record in the parent application, evidences that it was the accepted state of the art in the digital camera field around the time of the claimed invention to require a user to load applications software onto a computer before image data could be transferred to the computer from a digital camera. The scanner related references (*e.g.*, USP 5,508,821) also require user intervention of some sort to allow scanned images to be transferred over to a personal computer.

Deviations away from the accepted state of the art are evidence of patentability of an invention. *See, W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1552 (C.A.Fed.1983) (The fact that "Dr. Gore . . . proceeded contrary to the accepted wisdom of the prior art . . . is strong evidence of nonobviousness."). *See also, Tec Air, Inc. v. Denso Mfg. Mich., Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999) ("To rebut a prima facie case of obviousness based on prior art, objective evidence of nonobviousness may be used, including whether the invention was contrary to accepted wisdom of the prior art."). The recent Supreme Court

decision in the KSR case does not overrule and is not inconsistent with the above-noted *Gore* or *Tec Air* decisions of the Federal Circuit.

All of the currently pending claims require an *automatic and without user intervention* feature that allows a computer to understand how to talk to and receive data from the claimed device without a user having to, for example, load applications software onto a computer before being able to transfer data to it. It is respectfully submitted that, in accordance with the above-referenced case law, all currently pending claims should be found to be patentable. One reason for this is that the present invention deviates away from the accepted state of the art evidenced by the camera, software and scanner references of record, which affirmatively require user intervention – a user must, for example, load applications software onto a computer to be able to transfer pictures to it from a digital camera.

The currently pending claims should be found to be patentable for a number of additional reasons. For example, the new claims further specify that the claimed device is capable of generating digitized analog data sets before the claimed device is connected to a personal computer. The undersigned attorney is not aware of any proper combination of references that teaches or suggests this claim element.

As one example, and assuming for the sake of argument that a “plug and play keyboard” is prior art and that it is proper to combine such assumed prior art with a camera reference such as US Patent No. 5,470,335, such a purported combination of references would not render obvious the subject matter of the currently pending claims. One reason for this is that all claims require the capability of generating digitized analog data before the claimed device is connected to a personal computer. In direct contrast to this, keyboards create useful data only after they are

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connected to a personal computer and, therefore, the combination of the keyboard with the '335 patent would be able to create useful data on a plug and play basis only after the combination is connected to a personal computer. For this additional reason, for example, it is respectfully submitted that all currently pending claims should be found to be patentable.

The Examiner's attention is drawn to the fact that each independent claim includes a dependent claim that recites a combination of a personal computer with the device claimed in the corresponding independent claim. It is the specific intention of the client and the undersigned attorney to ensure that all currently pending claims are first directly infringed by the manufacture or sale of the claimed device, not by the combination of the claimed device and a personal computer.

As a follow-up to the previously filed notice of litigation, additional lawsuits involving Fujifilm, Samsung, Olympus, MEI and JVC have been filed with respect to the same patents at issue in the previous notice. A multi-district litigation may be declared in the future.

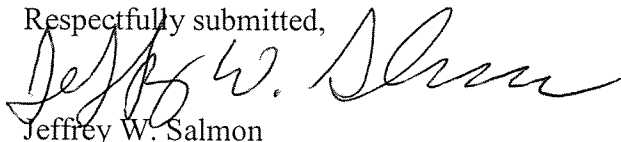
The undersigned attorney requests the Examiner to review all the prior art submitted in connection with this and the parent application, and to base his decision on the patentability of the currently pending claims only on the remarks made in this paper, not on arguments or amendments made in any other paper or any application of which this application claims priority.

It is the specific intention of the applicant that the independent claims noted above should be interpreted to stand on their own. In this regard, the limitations of the claims depending from any dependent claim should not be read into any independent claim for any reason.

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It is respectfully submitted that the new claims are in condition for allowance and, therefore, a formal notice to that effect is earnestly solicited. In this regard, the Examiner is respectfully requested to contact the undersigned attorney upon entry of this amendment.

Respectfully submitted,



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