

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YUKARI MAEDA

Appeal No. 2000-2184
Application 08/629,626

ON BRIEF

Before HAIRSTON, JERRY SMITH and LEVY, 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 1-32. An amendment after final rejection was filed on April 5, 1999 and was entered by the examiner. This amendment cancelled claims 27-29.

Therefore, this appeal is directed to the rejection of claims 1-26 and 30-32.

The disclosed invention pertains to a method and apparatus for adjusting the focus of a film. More particularly,

Appeal No. 2000-2184
Application 08/629,626

the invention reads images from a film and extracts signals caused by the graininess of the film. These signals are used to calculate a contrast value which, in turn, is used to adjust the focus of the film.

Representative claim 1 is reproduced as follows:

1. A film image reading method, comprising:

reading the film image to create image signals,

extracting signals caused by a graininess of the film from the image signals read, wherein film graininess is a characteristic attributed to particles forming the film,

calculating an image contrast value based on the signals extracted, and

adjusting a focus of the film using said image contrast value.

The examiner relies on the following references:

Yamada et al. (Yamada) 5,212,516 May 18, 1993

The admitted prior art described in appellant's specification.

Claims 1-26 and 30-32 stand rejected under 35 U.S.C.

§ 103. As evidence of obviousness the examiner offers Yamada in view of the admitted prior art.

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

OPINION

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

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-26 and 30-32. Accordingly, we reverse.

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 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

Appeal No. 2000-2184
Application 08/629,626

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 of the evidence as a whole and the relative persuasiveness of the arguments. 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.

Appeal No. 2000-2184
Application 08/629,626

Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellant [see 37 CFR § 1.192(a)].

With respect to independent claims 1, 6, 11 and 17, it is the examiner's position that Yamada teaches the claimed invention except for the application of its method to captured film images. The examiner notes that the admitted prior art teaches that contrast detection of captured film images using high pass filters was well known in the art. The examiner finds that the artisan would have the basic knowledge that signals generated from the graininess of the film would have high frequencies in which the contrast of the image varies most due to defocusing. The examiner concludes that it would have been obvious to the artisan to apply the method of Yamada to extract film image signals caused by the graininess of the film to simplify the construction of the hardware [answer, pages 4-5].

With respect to claims 1, 6 and 17, appellant argues that the high frequency signals extracted in Yamada are not signals caused by the graininess of the film, and appellant argues that the admitted prior art does not disclose or suggest that the focus of the film could be adjusted using an image contrast value which is calculated from signals related to the graininess of the

Appeal No. 2000-2184
Application 08/629,626

film [brief, pages 4-7].

The examiner responds that the graininess of the film is an inherent property of the film and, therefore, the image reading method of Yamada in view of the admitted prior art would inherently be reading signals from the film that are defocused due to the graininess of the film's material [answer, pages 6-7].

We agree with appellant that the examiner has failed to establish a prima facie case of the obviousness of the invention recited in claims 1, 6 and 17. The examiner's position that the method of Yamada, when applied to a captured film image, would inherently extract signals caused by the graininess of the film is not supported by any evidence on this record. Yamada teaches that the high frequency components of the object image itself are extracted. There is no teaching on this record, other than appellant's own disclosure, that the high frequency components caused by the graininess of the film can be substituted for the actual object image signals. The examiner's view that the Yamada method, when applied to captured film images, would inherently operate to extract signals caused by the graininess of the film is pure speculation on the part of the examiner. The examiner cannot support a prior art rejection based on such speculation, especially when the property upon which the speculation is based

Appeal No. 2000-2184
Application 08/629,626

is completely disputed by appellant. Therefore, we do not sustain the examiner's rejection of independent claims 1, 6 and 17.

With respect to independent claim 11, appellant argues that Yamada and the admitted prior art do not teach or suggest the claimed step of calculating a contrast value nor the claimed step of extracting attribute information regarding the film [brief, pages 11-13].

The examiner disagrees with the first argument, and the examiner finds that the high frequency components of Yamada meet the claim limitation of "attribute information" [answer, pages 8-9].

We again agree with the position argued by appellant. More particularly, we find that the high frequency signals measured in Yamada, as modified by the admitted prior art, do not relate to attribute information regarding the film. As noted above, there is no evidence on this record to support the examiner's opinion that any attributes of the film would affect the high frequency signals of the object image itself as detected by Yamada. Again, the only suggestion that an attribute of the film can be used to calculate contrast values comes from appellant's own disclosure. Therefore, we do not sustain the

Appeal No. 2000-2184
Application 08/629,626

examiner's rejection of independent claim 11.

Since we have not sustained the examiner's rejection of any of the independent claims, we also do not sustain the rejection of any of the claims which depend therefrom. Although appellant has separately argued many of the dependent claims on appeal, there is no need to consider these separate arguments in view of our decision with respect to the independent claims.

In summary, the decision of the examiner rejecting claims 1-26 and 30-32 is reversed.

REVERSED

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KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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JERRY SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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STUART S. LEVY)	
Administrative Patent Judge)	

Appeal No. 2000-2184
Application 08/629,626

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