

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** JORG MAYER

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Appeal No. 95-4373  
Application 07/917,108<sup>1</sup>

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ON BRIEF

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Before HAIRSTON, MARTIN and FLEMING, **Administrative Patent Judges**.

FLEMING, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of claims 10 through 19. Claims 1 through 9 have been canceled.

The invention is directed to a process for preparing image data for transmission purposes, wherein the image data of an

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<sup>1</sup>Application for patent filed August 9, 1993.

original image are broken down into image zones, and transformation-coded data are prepared and/or a motion vector is determined per image zone as a function of a change criterion, for example a threshold value that serves to distinguish between changed and unchanged image zones.

Independent claim 10 is reproduced as follows:

10. In a process for preparing image data in the form of image data signals for transmission, wherein the image represents successive original images, each original image is divided into a plurality of image regions, each image region is associated with a respective portion of the image data and each image data portion has a characteristic, the process including comparing the characteristic of the image data portion associated with each image region of each original image with the characteristic of the image data portion of the same image region of the immediately preceding original image to produce an indication of any difference between the image data portions with respect to the characteristic, comparing each difference indication with a threshold value representing a selected difference indication, and, based on each difference indication which exceeds the threshold value, performing at least one operation selected from the group consisting of preparing transformation-coded data and determining a motion vector, the improvement comprising changing the threshold value from one original image to the next so that the threshold value has a low value for a first group of original images and a high value for a second group of original images, where the original images of the first group alternate with the original images of the second group, the high value being selected so that for each original image of the second group, said performing step based on each difference indication will be carried out for only a small number of image regions in which major changes occur relative to the preceding original image.

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The reference relied on by the Examiner is as follows:

Tzou                      4,698,689                      Oct. 06, 1987

This specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed. Claims 10 through 19 stand rejected under Claims 1 through 4 and 9 through 11 stand rejected under 35 U.S.C. § 112, first paragraph, for not having support from the specification, as originally filed. Claims 10 through 12 and 15 through 19 stand rejected under 35 U.S.C. § 102 as being anticipated by Tzou. Claims 13 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tzou. On page 2 of the Examiner's answer, the Examiner states that the rejection under 35 U.S.C. § 101 has been withdrawn.

Rather than repeat the arguments of Appellant or the

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Examiner, we make reference to the briefs<sup>2</sup> and the answer<sup>3</sup> for the details thereof.

#### **OPINION**

We will not sustain the rejection of claims 10 through 19 under 35 U.S.C. § 112, first paragraph.

"The function of the description requirement [of the first paragraph of 35 U.S.C. 112] is to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him." ***In re Wertheim***, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). "It is not necessary that the application describe the claim limitations exactly, . . . but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that appellants

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<sup>2</sup>Appellant filed an appeal brief on October 19, 1994. We will refer to this appeal brief as simply the brief. Appellant filed a supplemental appeal brief on December 19, 1994. We will refer to this supplemental appeal brief as the supplemental brief. Appellant filed a reply appeal brief on January 25, 1995. The Examiner's letter, paper number 24 mailed on March 15, 1995, states that the supplemental brief has been entered and considered by the Examiner, but the reply appeal brief has not been entered nor considered. Appellant filed another reply appeal brief on May 28, 1997. We will refer to this reply appeal brief as the reply brief. The Examiner responded to the reply brief with a letter, paper number 31 mailed on July 9, 1997, stating that the reply brief has been entered and considered by the Examiner but no further response by the Examiner is deemed necessary.

<sup>3</sup>The Examiner mailed an Examiner's answer on November 23, 1994. In response to our remand, the Examiner mailed another Examiner's answer on March 28, 1997. We note that the latter Examiner's answer is to replace the earlier answer. Thus, the March 28, 1997 Examiner's answer is the only Examiner's answer that is before us for our consideration. We will refer to the March 28, 1997 Examiner's answer as the answer.

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invented processes including those limitations." *Wertheim*, 541 F.2d at 262, 191 USPQ at 96 (*citing In re Smythe*, 480 F.2d 1376, 1382, 178 USPQ 279, 284 (CCPA 1973)). Furthermore, the Federal Circuit points out that "[i]t is not necessary that the claimed subject matter be described identically, but the disclosure originally filed must convey to those skilled in the art that applicant had invented the subject matter later claimed." *In re Wilder*, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 1209 (1985), (*citing In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

The Examiner argues on pages 3 and 4 of the answer that the disclosure as originally filed does not provide a description of the amendments to the specification which recite "setting the threshold value for an original image following a preceding original image so high" and "for those images which the threshold was set high." We note that appellant amended the specification by filing an amendment on April 28, 1994. On page 2 of this amendment, the specification is amended by adding the above language to the specification.

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Appellant argues on page 3 of the supplemental brief that these amendments to the specification are simply inserting the language found in the original claims. Appellant points out that original claim 1 recites "characterized in that the threshold value for the next original image following the original image is set so high that ...." Appellant points out on page 4 of the supplemental brief that original claim 3 recites "for those images in which the threshold was set high." Appellant argues that the amendment to the specification corresponds in substance, if not identically, to the recitation appearing in the original claims and therefore cannot constitute new matter.

The issue before us is whether the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him. We note that appellant's original claims are to be considered as the original disclosure as filed and are to be considered with the entire filing in our determination of whether the inventor had possession at the time of the filing date of the application.

We find that the above amendments to the specification correspond in substance to the recitations found in the original claims as filed on the application date and thereby Appellant did

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have possession at the time of the filing date of the application. Therefore, we will not sustain the Examiner's rejection of claims 10 through 19 under 35 U.S.C. § 112, first paragraph.

The Examiner further argues that claim 12 recites "transmitting the prepared image data" which is not supported in the original disclosure. However, we note that claim 12 was amended so the claim does not recite this limitation. Therefore, this argument is moot.

We now turn to the rejection under 35 U.S.C. § 102. After a careful review of the evidence before us, we do not agree with the Examiner that claims 10 through 12 and 15 through 19 are anticipated by the applied references.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. ***See In re King***, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and ***Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.***, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

Appellant argues on page 12 of the brief that Tzou fails to teach Appellant's claimed invention of having two different threshold values which alternate with one another from one

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original image to the next. Appellant further argues on pages 2 and 3 of the reply brief that Appellant's independent claims 10 and 12 recite this limitation. In particular, Appellant states that the Examiner has not taken into account the following limitation of claims 10 and 12:

the improvement comprising changing the threshold value from one original image to the next so that the threshold value has a low value for a first group of original images and a high value for a second group of original images, **where the original images of the first group alternate with the original images of the second group.** [Emphasis added].

Appellant argues that Tzou fails to teach a procedure in which the high threshold value will alternate with a low threshold value from one original image to the next.

On pages 4 and 5 of the answer, the Examiner argues that Tzou teaches changing the threshold for the original image to the next in tables 1 and 2 and in column 5, lines 32-36 and column 6, lines 12-29. The Examiner argues that Appellant's claims do not require only two different threshold values which alternate.

However, we find that when reading the Appellant's claims as a whole, the claims do require a process in which the high threshold value will alternate with a low threshold value from

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one original image to the next when properly taking into account that the claims require the original images of the first group that are assigned a low threshold value to alternate with the original images of the second group that are assigned a high threshold value. Upon a careful review of Tzou, we fail to find that Tzou teaches this process. Therefore, we find that Tzou fails to teach all of the limitations of claims 10 through 12 and 15 through 19, and thereby the claims are not anticipated by Tzou.

In regard to the rejection of claim 13 and 14 under 35 U.S.C. § 103 as being unpatentable over Tzou, we note that the Examiner is relying on the above argument. Therefore, we will not sustain this rejection as well for the same reasons as above.

In view of the foregoing, the decision of the Examiner rejecting claims 10 through 19 is reversed.

***REVERSED***

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KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
	)	
	)	
JOHN C. MARTIN	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
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MICHAEL R. FLEMING	)	
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