

File

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 22

**MAILED**

UNITED STATES PATENT AND TRADEMARK OFFICE

**AUG 14 1996**

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

**PAT.&T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Ex parte TADAO KITAZUMI

Appeal No. 96-0235  
Application 07/805,063<sup>1</sup>

ON BRIEF

Before THOMAS, JERRY SMITH and FLEMING, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 1-19, which constitute all the claims in the application.

Representative claim 18 is reproduced below:

<sup>1</sup> Application for patent filed December 11, 1991.

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18. A method for color selection in a multicolor expression graphics display system using color palettes in order to maintain high interchangeability between digitized color image data of an original lower order format and digitized color image data of an extended format in which the number of selectable colors and the number of palette colors are increased, comprising the steps of:

(a) dividing a color space into  $n$  regions ( $D_1, D_2, \dots, D_n$ ), where  $n$  is an integer, corresponding to the number of colors of preextension color palettes for corresponding to  $n$  palette number groups of extended palettes; and

(b) dividing each region ( $D_1, \dots, D_n$ ) into  $m$  subregions ( $D_1(1), D_1(2), \dots, D_1(m), \dots, D_n(1), \dots, D_n(m)$ ), where  $m$  is an integer, which correspond to an extended color number  $mn$  for association with  $mn$  palette numbers of the extended color palettes.

The following reference is relied on by the examiner:

Hoshino et al. (Hoshino)                      4,689,669                      Aug. 25, 1987

Claims 1-19 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Hoshino.

Rather than repeat the positions of the appellant and the examiner, reference is made to the briefs and the answer for the respective details thereof.

#### OPINION

For the reasons generally expressed by appellant in the brief and the reply brief, we will reverse the outstanding rejection of the claims under 35 U.S.C. § 103.

We agree with the initial assessment by appellant at page 5 of the principal brief on appeal that Hoshino fails to teach or

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suggest to the artisan performing color selection for extension color palettes as is required by each claim on appeal. This feature is set forth in the preamble of each independent claim 1, 4, 10 and 18, where the extended format includes an increased number of selectable colors and a number of palette colors. The extended color palettes are said in the preamble of each claim to have a second predetermined number of extension colors larger than the first predetermined number. The body of each independent claim also reflects this extension of color palettes.

Page 8 of appellant's brief also indicates that his understanding of Hoshino is that the end product of Hoshino's process is a single color palette of 16 colors. This position is essentially developed in greater detail at page 3 of the reply brief. This understanding of appellant is consistent with our own understanding and thus the basic feature of each claim on appeal of extending color palette with a larger number of predetermined extension colors cannot be met.

For his part, the examiner's reasoning at page 3 of the answer appears to attempt to correlate the teachings of Hoshino to the basic features set forth in the claims on appeal. The examiner's reasoning appears to be based on conjecture as to how the artisan would have arrived at the basic requirement of each

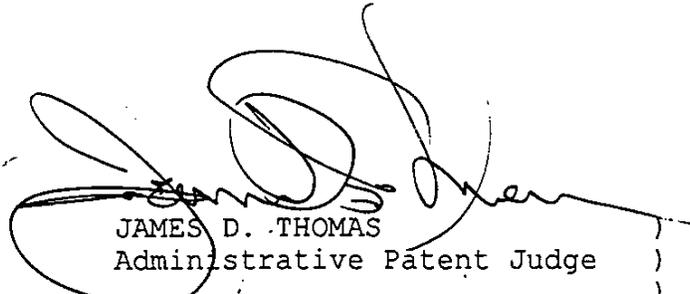
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claim on appeal of extendable color palettes. We do not agree with the examiner's conclusory statement that since the number of original color data is much larger than the number of selected colors, it would have been obvious to the artisan to have divided palette numbers into different groups of palettes such that each group would have a same predetermined number of colors. In responding to appellant's observation that the number of extended color palettes of Hoshino is the same as the number of the original color palettes, at the bottom of page 4 and the top of page 5 of the examiner's answer, the mere fact that the various color groupings "can be divided" into further different sets of colors or palettes appears to us to beg the question. There is essentially no rational basis set forth by the examiner from the teachings and suggestions of Hoshino or any persuasive line of reasoning by the examiner based upon these teachings or suggestions for the artisan to have done what the examiner essentially asserts would have been obvious. Thus, we conclude that the examiner's position is essentially based upon prohibitive hindsight analysis using the disclosed and/or claimed invention as a guide.

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In view of the foregoing, the decision of the examiner  
rejecting claims 1-19 under 35 U.S.C. § 103 is reversed.

REVERSED



JAMES D. THOMAS  
Administrative Patent Judge )



JERRY SMITH  
Administrative Patent Judge )



MICHAEL R. FLEMING  
Administrative Patent Judge )

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