

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID W. SHEN, LISA D. HOLZHAUSER
and AMANDA ROPA

Appeal No. 1997-0197
Application No. 08/195,676¹

ON BRIEF

Before URYNOWICZ, FLEMING, and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed February 16, 1994.

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This is a decision on appeal from the final rejection of claims 1, 3-7, and 9-12, all of the claims pending in the present application. Claims 2 and 8 have been canceled.

The claimed invention relates to a method and apparatus for automatically changing the resolution setting of an image recording device when storage capacity will not permit the storing of images at an existing resolution setting. More particularly, Appellants indicate at pages 2 and 3 of the specification that, after an amount of available memory space is determined, the image resolution is automatically switched from a high resolution to a low resolution when the available memory space is above a first predetermined level and below a second predetermined level.

Claim 1 is illustrative of the invention and reads as follows:

1. A method for handling different resolution images in an electronic imaging device having a plurality of resolution settings, comprising the steps of:

determining available memory in a memory means;

automatically switching the resolution of the imaging device from a high resolution to a low resolution when available memory is above a first predetermined level and below a second predetermined level;

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forming an image with the selected resolution setting; storing said image in said memory means; and displaying at least the selected resolution setting and the number of images that can be further stored in said memory means for the selected resolution setting.

The Examiner relies on the following prior art:

Sakata et al. (Sakata) 1992	5,105,284	Apr. 14,
Sakai et al. (Sakai) 1994	5,285,290	Feb. 08,

Claims 1, 3-7, and 9-12 stand finally rejected under 35 U.S.C. § 103 as being unpatentable over Sakai in view of Sakata.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs² and 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

² The Appeal Brief was filed March 4, 1996. In response to the Examiner's Answer dated May 21, 1996, a Reply Brief was filed July 22, 1996 which was acknowledged and entered by the Examiner without further comment on August 7, 1996.

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of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs 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 collective 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, 3-7, and 9-12. 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

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having ordinary skill in the pertinent art would have been led
to

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 Hospital Systems, Inc. v.
Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933
(Fed.

Cir. 1984). These showings by the Examiner are an essential
part

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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).

With respect to independent claims 1 and 7, the Examiner proposes to modify the image storing system of Sakai by relying on Sakata to supply the missing teaching of a display which displays the selected resolution setting as well as the number of images that can be further stored at the selected resolution setting. In the Examiner's view, the skilled artisan would have found it obvious to utilize the display features of Sakata in the system of Sakai to provide a user with a fast and readily understandable indication of memory capacity to enable evaluation of alternative operational settings (Answer, page 6).

While Appellants have made several arguments in response, the primary thrust of the arguments centers on the alleged deficiency of either Sakai or Sakata in disclosing the claimed feature of automatically changing a selected resolution setting in response to an indication of insufficient memory

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capacity. We note that the relevant portion of independent claim 1 (a similar recitation in method form appears in independent claim 7) recites:

means for automatically changing the resolution setting from high to low when the available memory in the storing means is above a first predetermined level and below a second predetermined level;

The Examiner contends (Answer, page 4) that the system of Sakai which reduces the magnification or size of an image on an indication of insufficient memory capacity inherently results in a reduction in resolution since the number of pixels used to represent the image data is reduced.

Upon careful review of the Sakai reference, however, we are in agreement with Appellants' stated position in the Briefs that the Examiner's attempt to equate a reduction in size of an image with a reduction in resolution is in error. In our view, Appellants are correct in their assertion that resolution relates to the quality of an image, i.e., the amount of data contained in a unit area of an image. A reduction in image size, as in Sakai, reduces the total amount of data used to represent an image but the amount of data in a unit area remains the same.

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The Examiner has further argued the functional equivalence of resolution reduction and size reduction by asserting the end result of reduced data to represent an image in both cases. However, even assuming arguendo that this was correct, such a position does not address the question of the obviousness of choosing one approach instead of the other. The Examiner's conclusion (Answer, page 4) that the skilled artisan would have found it obvious to reduce the resolution of an image instead of the size or magnification in Sakai since both approaches result in total data reduction of a displayed image is totally without support on the record. We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference, common knowledge or capable of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a prima facie case. In re Knapp-Monarch Co., 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); In re Cofer, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

Since all of the claim limitations are not taught or suggested by the applied prior art, it is our opinion that the

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Examiner has not established a prima facie case of obviousness with respect to the claims on appeal. Accordingly, we do not sustain the Examiner's 35 U.S.C. § 103 rejection of independent claims 1 and 7, nor of claims 3-6 and 9-12 dependent thereon.

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Therefore, the Examiner's decision in rejecting claims 1, 3-7,
and 9-12 is reversed.

REVERSED

STANLEY M. URYNOWICZ JR.)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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APJ FLEMING

APJ URYNOWICZ

DECISION: REVERSED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s):
Prepared: October 26, 2000

Draft Final

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OB/HD GAU

PALM/ACTS 2/BOOK
DISK(FOIA)/REPORT