

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHISEKI YAMAGUCHI

Appeal No. 97-3749
Application 08/360,069¹

ON BRIEF

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

JERRY SMITH, Administrative Patent Judge.

¹ Application for patent filed December 20, 1994.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-8, which constitute all the claims in the application.

The disclosed invention pertains to a color image forming device which modifies color image data based on the type of recording medium to receive the color image. Specifically, the type of recording medium is identified which causes color image data to be modified and stored as optimized data. The optimized data is then used to control the exposure of an optical system to generate the color image on the identified medium.

Representative claim 1 is reproduced as follows:

1. A color image forming device which forms images from color image data for use with different types of recording media, comprising:

modification executing means for modifying the color image data in response to an indication of a particular type of a recording medium on which a color image is to be formed, to thereby provide a modified image data;

recording medium indicating means for supplying said indication of the type of said recording medium to said modification executing means;

optimized data storing means for storing said modified image data as optimized data; and

optical means for carrying out exposure in accordance with said optimized data supplied from said optimized data storing means.

The examiner relies on the following references:

Jamzadeh	5,369,426	Nov. 29, 1994 (filed Mar. 31, 1993)
Yip	5,369,499	Nov. 29, 1994 (filed Nov. 13, 1991)
Hirai et al. (Hirai) ² (Japanese Kokai)	01-152482	June 14, 1989

In the final rejection, claims 1-8 were rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Hirai in view of Jamzadeh and Yip. Two additional rejections were made in the examiner's answer and were nominally designated as new grounds of rejection. First, claims 1-3 were rejected under 35 U.S.C. § 103 as unpatentable over Yip in view of Hirai. Second, claims 4-8 were rejected under 35 U.S.C. § 103 as unpatentable over Yip in view of Hirai and further in view of Jamzadeh. Thus, it is noted that the new rejections set forth in the answer use the same prior art references that were used in the final rejection or a lesser number thereof.

² Our understanding of Hirai is based on a translation provided by Diplomatic Language Services, Inc. for the United States Patent and Trademark Office. A copy of this translation is attached to this decision.

Rather than repeat the arguments of appellant or the examiner, we make reference to the brief³ and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. 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 rejections 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 1-8. Accordingly, we reverse.

³ Although the answer indicates that new grounds of rejection had been made, appellant did not file a reply brief responsive to the new grounds of rejection. Since the initial appeal brief contains arguments as to why the collective teachings of Hirai, Jamzadeh and Yip do not render the claimed invention obvious, these arguments necessarily also respond to a rejection made on the same references or a lesser number of these references. Therefore, appellant's failure to file a reply brief to the new grounds of rejection cannot be considered as an acquiescence to these new grounds of rejection.

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 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).

We consider first the rejection of claims 1-8 under 35 U.S.C. § 103 as unpatentable over Hirai in view of Jamzadeh and Yip. With respect to independent claim 1, the examiner has referred to Hirai as the primary reference and has indicated which features

of claim 1 are not found in Hirai [answer, pages 2-3]. The examiner cites Jamzadeh and Yip as teaching the features missing in Hirai, and the examiner asserts that it would have been obvious to the artisan to incorporate the teachings of Jamzadeh and Yip into Hirai [id., pages 3-4].

Appellant argues that Hirai does not teach or suggest a modification execution means for modifying color image data as recited in claim 1. Instead, Hirai only adjusts transfer voltages [brief, page 8]. Appellant argues that Jamzadeh does not overcome this deficiency in Hirai. Finally, appellant argues that the lookup tables of Yip cannot be considered as the optimized data storing means as recited in claim 1 [id., pages 12-13]. Thus, appellant points out perceived errors in the examiner's position which are argued to result in the lack of a prima facie case of obviousness.

The examiner does not directly continue his support of this rejection in the response to argument section of the answer, but instead, asserts that the new rejection of Yip in view of Hirai shows that Yip teaches the modification executing means and that Yip in view of Hirai meets the invention of claim 1 [answer, pages 8-9]. We will consider the examiner's new rejections below. For now, we are only interested in the initial rejection formulated by the examiner based on Hirai in view of Jamzadeh and Yip.

We will not sustain this rejection of claims 1-8 as formulated by the examiner. We agree with appellant that there is no motivation for the artisan to modify the teachings of

Hirai with those of Jamzadeh and Yip. Jamzadeh appears to be especially irrelevant to the claimed invention because it is directed to the synchronization of the printing operation to a preliminary scanning operation. Although Jamzadeh does modify the resultant images based on the scanned data, there is no suggestion in Jamzadeh that the image data should be modified, optimized and stored as recited in the claimed invention. Yip teaches the modification of digital image data to control the gray scale appearance of a hard copy record of the image as well as a video output of the image. We can find no basis, however, to combine the teachings of Yip with those of Hirai in the absence of a hindsight attempt to reconstruct the claimed invention. Even if one assumed arguendo that the teachings of Hirai and Yip suggest combining their teachings, there still is no teaching of the claimed optimized data storing means as recited in independent claim 1. The lookup tables of Yip do not meet this claim recitation for reasons which will be made more apparent below. Since there is no basis to combine the teachings of Hirai, Jamzadeh and Yip as proposed by the examiner, we do not sustain the rejection of claims 1-8 as presented by the examiner.

We now consider the examiner's new ground of rejection of claims 1-3 under 35 U.S.C. § 103 as being unpatentable over the teachings of Yip in view of Hirai. Although our previous discussion established that the teachings of the three cited references do not suggest the claimed invention in the manner proposed by the examiner, we consider this

rejection separately because the examiner modified the rationale for combining these teachings in the examiner's answer and because appellant did not additionally respond to this new ground of rejection.

Although this new rejection relies on only two of the three references considered above, it actually appears as a stronger rejection because it does not appear to be based on hindsight as much as the earlier rejection. Additionally, Yip appears to be a better primary reference because Figure 10 at least shows a system for modifying image data (LUT₁, 28) before the data is employed by optical means for carrying out exposure of the image data. However, Yip does not teach a recording medium indicating means nor an optimized data storing means.

The examiner considers the lookup table 28 in Yip to be the optimized data storing means, but as argued by appellant, this position cannot meet the claimed invention. Claim 1 recites that the image data is modified and stored as optimized data. Since the lookup table in Yip is the only means available for implementing the claimed modification function, it cannot also be the optimized data storing means because this storing means must store the data after it is modified and not before the modification takes place. In other words, the output of Yip's lookup table 28 is the modified data in Yip, and there is no further storage of optimized data suggested in Yip.

We also find no basis to use Hirai's designation of recording medium with Yip's gray scale computer. Yip would require that different lookup tables be prepared for each different type of hard copy product to be generated. Thus, the lookup tables in Yip already include information related to the nature of the hard copy product, and therefore, Hirai's medium designation would serve no purpose in Yip. Hirai would also have suggested modifying the Yip data at the film processing stage as opposed to the image data stage as recited in the claimed invention. Since the combination of Yip and Hirai do not teach all the recitations of independent claim 1, we do not sustain the examiner's new ground of rejection of claims 1-3.

We now consider the examiner's new ground of rejection of claims 4-8 under 35 U.S.C. § 103 as being unpatentable over the teachings of Yip in view of Hirai and further in view of Jamzadeh. These claims are all dependent claims which depend from independent claim 1. Since Jamzadeh does not overcome the deficiencies in the combined teachings of Yip and Hirai, dependent claims 4-8 are patentable over the applied art of record at least for the reasons discussed above with respect to claim 1. We also agree with appellant that Jamzadeh does not suggest any of the modifications recited in claims 6-8. Therefore, we do not sustain the examiner's new ground of rejection of claims 4-8.

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In summary, we have not sustained any of the examiner's rejections of the claims under 35 U.S.C. § 103. Accordingly, the decision of the examiner rejecting claims 1-8 is reversed.

REVERSED

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James D. Thomas)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
John C. Martin)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
Jerry Smith)	
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