

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte EARLE B. STOKES,  
JOHN F. OMVIK,  
and  
JOHN MERECKI

---

Appeal No. 1999-0035  
Application No. 08/661,261

---

ON BRIEF

---

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

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-10, all of the claims pending in the present application.

The claimed invention relates to a method of examining a high resolution scan of an image in which a portion of a low resolution preview scan is specified for high resolution

Appeal No. 1999-0035  
Application No. 08/661,261

scanning. A detail area is selected within the specified portion for examination in high resolution. The high resolution image data corresponding to the selected detail area is displayed after or during the high resolution scan.

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

1. A method for examining a high resolution scan of an image during scanning, comprising the steps of:

performing a low resolution scan on an image to obtain low resolution image data;

displaying said low resolution image data;

specifying a portion of said low resolution image data to be scanned at a high resolution;

selecting at least one detail area within said specified portion of said low resolution image data to be examined in high resolution;

performing a high resolution scan on the image based on the specified portion of said low resolution image data to obtain high resolution image data;

saving said high resolution image data; and

displaying the high resolution image data corresponding to said detail area after it becomes available during the high resolution scan.

The Examiner relies on the following prior art:

Liston  
1993

5,185,662

Feb. 09,

Appeal No. 1999-0035  
Application No. 08/661,261

Graham et al. (Graham)  
1993

5,222,154

Jun. 22,

Appeal No. 1999-0035  
Application No. 08/661,261

Claims 1, 5, and 6 stand finally rejected under 35 U.S.C. § 102(b) as being anticipated by Graham. Claims 2-4 and 7-10 stand finally rejected under 35 U.S.C. § 103 as being unpatentable over Graham in view of Liston.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (paper no. 11) and Answer (paper no. 12) for the respective details.

#### OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, and the evidence of anticipation and obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' 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 Graham does not fully meet the invention as set forth in claims 1, 5, and 6. We are also of the view that the evidence relied upon and the level of skill in the particular art would

Appeal No. 1999-0035  
Application No. 08/661,261

not have suggested to one of ordinary skill in the art the obviousness of the invention as recited in claims 2-4 and 7-10. Accordingly, we reverse.

We consider first the rejection of claims 1, 5, and 6 under 35 U.S.C. § 102(b) as being anticipated by Graham. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to independent claims 1 and 6, the Examiner attempts (Answer, page 3) to read the various claim limitations on the disclosure of Graham.<sup>1</sup> In particular, the Examiner points to the discussion at column 6, lines 27-54 of

---

<sup>1</sup>The Examiner's statement of the grounds of rejection refers to the final Office action mailed May 11, 1998, paper no. 9.

Appeal No. 1999-0035  
Application No. 08/661,261

Graham which describes the selection of a portion of a low resolution preview scanned image for examination at a higher resolution.

In response, Appellants initially note (Brief, page 6) that Graham's selection or "cropping" of a preview scan for examination at a higher resolution does in fact correspond to the first three steps in each of appealed independent claims 1 and 6. Appellants assert, however, that the selection of a detailed area within the cropped portion for examination and display at the higher resolution, as recited in subsequent steps of claims 1 and 6, is not found in Graham.

After reviewing the disclosure of Graham in light of the arguments of record, we are in agreement with Appellants' position as stated in the Brief. We find no disclosure of a further selection of a detailed image area within a previously selected or cropped image to be examined at a high resolution as set forth in Appellants' claims. In our view, the portion of the disclosure of Graham cited by the Examiner, i.e., column 6, lines 51-54, merely refers to the manner of selecting or cropping a low resolution image area, not a suggestion of selecting a detailed area within a cropped image

Appeal No. 1999-0035  
Application No. 08/661,261

for further high resolution review.

In view of the above discussion, it is our opinion that,  
since all of the claim limitations are not present in the

Appeal No. 1999-0035  
Application No. 08/661,261

disclosure of Graham, the Examiner's 35 U.S.C. § 102(b) rejection of independent claims 1 and 6, as well as claim 5 dependent on claim 1, can not be sustained.

Turning to a consideration of the Examiner's 35 U.S.C. § 103 rejection of dependent claims 2-4, 7, and 8 and independent claims 9 and 10 based on the combination of Graham and Liston,

we do not sustain this rejection as well. It is apparent from the Examiner's analysis that Liston has been combined with Graham for the sole purpose of addressing the claimed feature of terminating a high resolution scan if the displayed high resolution data is of unacceptable quality. Our review of Liston reveals that it is directed to the compression of high resolution scanned image data from a copier if screen resolution does not permit full display. We find no disclosure in Liston of any selection of a detailed image area within a cropped image for higher resolution review, features present in independent claims 9 and 10 and in independent claims 1 and 6 upon which claims 2-4, 7 and 8 are dependent, that would overcome the innate deficiencies of Graham discussed supra. It is also apparent

Appeal No. 1999-0035  
Application No. 08/661,261

from the line of reasoning in the Answer that since the Examiner has, in our view, mistakenly interpreted the disclosure of Graham as describing a selection of a detailed area within a cropped image area for further review, the issue of the obviousness of this feature has not been addressed. Accordingly, since the Examiner has failed to establish a prima facie case of obviousness, we do not sustain the 35 U.S.C. § 103 rejection of appealed claims 2-4 and 7-10.

In conclusion, we have not sustained either of the Examiner's rejections of the claims on appeal. Accordingly, the Examiner's decision to reject claims 1-10 is reversed.

REVERSED

ERROL A. KRASS )  
Administrative Patent Judge ) )  
 )  
 )  
 ) BOARD OF PATENT  
MICHAEL R. FLEMING )  
Administrative Patent Judge ) APPEALS AND  
 )  
 ) INTERFERENCES  
 )

Appeal No. 1999-0035  
Application No. 08/661,261

JOSEPH F. RUGGIERO                    )  
Administrative Patent Judge         )

JFR:hh

Appeal No. 1999-0035  
Application No. 08/661,261

JOHN A. MERECKI  
SCHMEISER, OLSEN & WATTS  
3 Lear Jet Lane, Suite 201  
Latham, NY 12110