

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN F. OMVIK and EARLE B. STOKES

Appeal No. 1999-0533
Application 08/614,775

ON BRIEF

Before KRASS, JERRY SMITH and BARRY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-10, which constitute all the claims in the application. The examiner has now indicated that claims 3 and 4 contain allowable subject matter [answer, page 5]. Therefore, this appeal is now directed to the rejection of claims 1, 2 and 5-10.

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The disclosed invention pertains to a method for modifying a color value in a digital image.

Representative claim 1 is reproduced as follows:

1. A method for modifying a color value in a digital image, comprising the steps of:

selecting a region of said digital image containing a color value to be modified;

superimposing a control mechanism for modifying said color value on said digital image adjacent said selected region;

superimposing a graphic readout providing information corresponding to said color value on said digital image adjacent said selected region;

modifying said color value by manipulating said control mechanism;

updating said digital image according to the modification of said color value; and

displaying information corresponding to the modification of said color value on said graphic readout.

The examiner relies on the following references:

McLaughlin et al. (McLaughlin) 5,499,040 Mar. 12, 1996
(filed June 27,
1994)

The admitted prior art set forth in appellants' application.

Claims 1, 2 and 5-10 now stand rejected under 35
U.S.C.

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§ 103. As evidence of obviousness the examiner offers the admitted prior art in view of McLaughlin.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the 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 of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the 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 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, 2 and 5-10. Accordingly, we reverse.

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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

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Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the

arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

The examiner's rejection asserts that the admitted prior art differs from the claimed invention in that the admitted prior art does not disclose using a separate control mechanism for modifying the color value. The examiner cites

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McLaughlin as teaching a graphical interface for modifying a color value which uses two different mechanisms for modifying the color value. The examiner finds that it would have been obvious to the artisan to use McLaughlin's control mechanism in the admitted prior art [answer, pages 4-5].

Appellants make the following arguments: 1) appellants argue that the color modification tool 34 illustrated in Figure 1 of the application is not superimposed on the digital image 30 as

recited in independent claims 1 and 10; 2) appellants argue that McLaughlin is not in the same field as the claimed invention; and 3) appellants argue that the claim 1 recitation of a graphic readout superimposed on the digital image adjacent to the selected region is not taught or suggested by McLaughlin [brief, pages 4-7].

With respect to the first and third arguments, the examiner responds that "the digital image as claimed broadly reads on the entire display image displayed on the display screen of the applicant's admitted prior art. Fig. 2 of the

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applicant's admitted prior art teaches superimposing the graphic readout on the digital image (the entire display) exactly the same way as the present application does in the disclosure (see Figs. 4-7)" [answer, page 6].

Figure 2 of the application shows a conventional color modification tool. This tool corresponds to tool 34 shown in Figure 1 of the application. The digital image of claims 1 and 10 is intended by appellants to read on the image 30 of Figure 1. As argued by appellants, there is nothing superimposed on the image 30 of Figure 1 (or Figures 2 and 3). Appellants'

invention, on the other hand, shows a control mechanism 60 and a graphic readout 62 superimposed on the image 30 [note Figures 4-6]. The appropriate question is whether the examiner's interpretation of the claimed digital image as reading on the entire display screen of the admitted prior art is reasonable.

We agree with appellants that the examiner's interpretation of independent claims 1 and 10 is not

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reasonable. The specification makes it reasonably clear that a digital image refers to images which have been digitized such as by a scanner and which are reproduced on a display system. The whole point of the disclosed invention is that the control mechanism and the graphic readout are to be superimposed on this digital image as shown in Figures 4-6 of the application. The examiner's attempt to read the claimed digital image on either the display of the color modification tool 34 or on the entire display area 31 is simply an attempt to ignore the steps of superimposing which appellants have tried to emphasize. The examiner's interpretation of independent claims 1 and 10 is unreasonable.

Since the examiner's interpretation of independent claims 1 and 10 and the findings with respect to the admitted prior art

are fundamentally flawed, the examiner has failed to establish a prima facie case of obviousness. Therefore, we do not need to consider appellants' other arguments. For these reasons, we do not sustain the examiner's rejection of the appealed

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claims. Accordingly, the decision of the examiner rejecting
claims 1, 2 and 5-10 is reversed.

REVERSED

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| ERROL A. KRASS |) | |
| Administrative Patent Judge |) | |
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| JERRY SMITH |) | BOARD OF PATENT |
| Administrative Patent Judge |) | APPEALS AND |
| |) | INTERFERENCES |
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| LANCE LEONARD BARRY |) | |
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