

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CARY LEE BATES and PAUL REUBEN DAY

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Appeal No. 2002-2053  
Application No. 09/329,135

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ON BRIEF

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Before THOMAS, BARRY, and LEVY, Administrative Patent Judges.  
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 2, 8, 9, 11, 19, 21, 22, 28, 29, 31, 36, 38-41, 47-50, 52, and 60. Claims 3-7, 10, 12-18, 20, 23-27, 30, 32-35, 37, 42-46, 51, 53-59, and 61 have been indicated as allowable if rewritten in independent form (final rejection, page 5).

BACKGROUND

Appellants' invention relates to an automatic color contrast adjuster. An understanding of the invention can be derived from a reading of exemplary claim 21, which is reproduced as follows:

21. A method for improving color contrast between computer displayed text objects and background objects, the method comprising the steps of:

determining if a current color combination for at least one text object and a background object is a problem color;

selecting one of a plurality of color combinations for at least one text object and a background object based on the current color combination, if the current color combination is a problem color; and

applying the selected color combination to the at least one text object and the background object.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Cowart, "Mastering Windows 3.1 Special Edition" (Mastering Windows), Sybex, p. 154-157, 1993

Kirkner, "Running A Perfect Netscape Site" (Netscape), Que, p. 400-405, 1996

Claims 1, 2, 8, 21, 22, 28, 38-41, and 47 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Mastering Windows.

Claims 9, 11, 19, 29, 31, 36, 48-52, and 60 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Netscape.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 12, mailed April 26, 2002) and the final rejection (Paper No. 7, mailed September 20, 2001) for the examiner's complete reasoning in support of the rejections, and to appellants' brief (Paper No. 11, filed March 18, 2002) for appellants' arguments thereagainst. 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).

#### OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of anticipation 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 rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we affirm-in-part. Appellants (brief, page 3) lists independent claim 21 as representative of the claims rejected under 35 U.S.C. § 102(b) as anticipated by Mastering Windows. Appellants (brief, pages 3 and 4) additionally list independent claim 29 as representative of the claims rejected under 35 U.S.C. § 103(a) as anticipated by Netscape. Consistent with these representations, appellants only argue the limitations of independent claims 21 and 29. Accordingly, we select claims 21 and 29 as being representative of the rejected claims. We begin with the rejection of claims 1, 2, 8, 21, 22, 28, 38-41, and 47 under 35 U.S.C. § 102(b) as being anticipated by Mastering Windows. We turn to independent claim 21.

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). The examiner's position is set forth, in detail, on pages 2 and 3 of the final rejection<sup>1</sup>. Appellants' position (brief, page 4) is that Mastering Windows does not disclose a mechanism that "1) determines whether a

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<sup>1</sup> The rejections set forth in the final rejection have been incorporated into the examiner's answer (answer, page 3).

particular color combination is problematic for a particular text object and background, 2) selects an alternate color combination based on the current color combination, and 3) applies the selected color combination to the particular text object and background." It is argued that instead, Mastering Windows describes a settings page that informs a user as to a current color combination and a series of alternate combinations, with which a user can change a current color combination to an alternate combination. It is further argued (id.) that Mastering Windows does not anticipate the claims of Group I because the reference simply does not describe, in any way, "1) problem colors, 2) how problem colors are determined, and 3) how alternate color combinations can be selected based upon the current/problem combination."

Before addressing the examiner's rejections based upon prior art, it is an essential prerequisite that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. See Smithkline

Diagnosics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988).

Before turning to the proper construction of the claim, it is important to review some basic principles of claim construction. First, and most important, the language of the claim defines the scope of the protected invention. Yale Lock Mfg. Co. v. Greenleaf, 117 U.S. 554, 559 (1886) ("The scope of letters patent must be limited to the invention covered by the claim, and while the claim may be illustrated it cannot be enlarged by language used in other parts of the specification."); Autogiro Co. of Am. v. United States, 384 F.2d 391, 396, 155 USPQ 697, 701 (Ct. Cl. 1967) ("Courts can neither broaden nor narrow the claims to give the patentee something different than what he has set forth [in the claim]."). See also Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U.S. 405, 419 (1908); Cimiotti Unhairing Co. v. American Fur Ref. Co., 198 U.S. 399, 410 (1905). Accordingly, "resort must be had in the first instance to the words of the claim" and words "will be given their ordinary and accustomed meaning, unless it appears that the inventor used them differently." Envirotech Corp. v. Al George, Inc., 730 F.2d 753, 759, 221 USPQ 473, 477 (Fed. Cir. 1984). Second, it is equally "fundamental that claims are to be construed in the light of the

specification and both are to be read with a view to ascertaining the invention." United States v. Adams, 383 U.S. 39, 49, 148 USPQ 479, 482 (1966).

Furthermore, the general claim construction principle that limitations found only in the specification of a patent or patent application should not be imported or read into a claim must be followed. See In re Priest, 582 F.2d 33, 37, 199 USPQ 11, 15 (CCPA 1978). One must be careful not to confuse impermissible imputing of limitations from the specification into a claim with the proper reference to the specification to determine the meaning of a particular word or phrase recited in a claim. See E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1433, 7 USPQ2d 1129, 1131 (Fed. Cir.), cert. denied, 488 U.S. 986 (1988).

What we are dealing with in this case is the construction of the limitations recited in the appealed claims. As stated by the court in In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) "[t]he name of the game is the claim." Claims will be given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims. In re Etter, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985).

We find that the claimed steps "determining if a current color combination for at least one text object and a background object is a problem color; selecting one of a plurality of color combinations for at least one text object and a background object based on the current color combination, if the current color combination is a problem color; and applying the selected color combination to the at least one text object and the background object" as broadly recited, do not set forth a mechanism for carrying out the steps, as asserted by appellants. In addition, we note that the steps are not presented in a format of "step plus function" that would invoke the sixth paragraph of 35 U.S.C. § 112. Instead, as drafted, the steps are broad enough to be carried out by a user utilizing the Mastering Windows reference, as set forth by the examiner (answer, page 5, para. 2 through the end of page 6).

From our review of Mastering Windows, we find that the step of "determining if a current color combination for at least one text object and a background object is a problem color" is met by the disclosure of Mastering Windows (page 154) that "[i]f you don't like the color schemes supplied, you can make up your own," see also "[i]f you don't like the colors that are available, you can create your own." (page 155) Although these passages do not

recite the phrase "problem color" we find that if a user does not like the color and decides to change the color, the color that is not liked may be considered by the user to be a problem color. In addition, because a user can select a different color to replace a color that the user does not like by "[c]lick [ing] on one of the 48 colors ... to assign it to the chosen element" (page 155), we find that Mastering Windows meets the claimed step of "selecting one of a plurality of color combinations for at least one text object and a background object based on the current color combination, if the current color combination is a problem color." See also the disclosure on page 154 of using solid colors for window text and background. Moreover, the claimed "applying the selected color combination to the at least one text object and the background object" is met by the disclosure (page 155) of clicking the OK button and saving the selected color scheme. Thus, although we are cognizant of the fact that Mastering Windows does not disclose automatic contrast adjustment, we find that claim 21, as drafted, is broad enough to read on the disclosure of Mastering Windows. Moreover, although the examiner has not given weight to the preamble of the claim (answer, page 5), we find that the language of the preamble is

met by Mastering Windows because the reference provides for changing the color of text and background, which will improve color contact.

From all of the above, we find that the examiner has set forth a prima facie case of anticipation of independent claim 21, which has not been successfully rebutted by appellants.

Accordingly, the rejection of claim 21 under 35 U.S.C. § 102(b) is affirmed. As claims 1, 2, 8, 22, 28, 38-41, and 47 fall with independent claim 21 (brief, page 3), the rejection of claims 1, 2, 8, 22, 28, 38-41, and 47 under 35 U.S.C. § 102(b) is affirmed.

We turn next to the rejection of claims 9, 11, 19, 29, 31, 36, 48-50, 52, and 60 under 35 U.S.C. § 102(b) as being anticipated by Netscape. We turn to independent claim 29. The examiner's position can be found on page 4 of the final rejection. Appellants assert (brief, page 4) that Netscape simply describes a mechanism for identifying custom colors, and that (brief, page 5) "[t]here is no discussion whatsoever about problem color combinations, comparing a current combination against one or more problem color combinations, or selecting and applying a preferred color combination when a current color combination matches a problem color combination."

From our review of claim 29, we find that the claim requires user preferences comprising problem color combinations and preferred color combinations, both of which reside in memory. The claim additionally recites searching user preferences and comparing the current color combination with at least one of the plurality of problem color combinations. The claim additionally recites selecting and applying the preferred color combination if it matches the problem color combination in the user preferences. Because the claim recites that the problem color combinations and the preferred color combinations reside in memory, we find that the claim is not anticipated by Netscape because there is no disclosure in Netscape of having problem and preferred color combinations in memory, which are compared to select and apply a preferred color combination that matches the problem color combination. We are not persuaded by the examiner's assertion (answer, page 9) that because Netscape discloses a plurality of color combinations in memory, that whether the combination is problematic or preferred is up to the user's interpretation of what color the user wants to use. The fact that there are colors residing in memory is not a disclosure of the memory having a plurality of problem color combinations and a plurality of preferred color combinations, from which the user can compare a

select a preferred color combination which matches the problem color combination. Nor are we persuaded by the examiner's assertion (answer, page 10) that with respect to the selecting step, the user makes the comparison and does the matching.

Because the problem and preferred color combinations are stored in memory, we find that the claim requires that the comparison is done by a comparison of the two sets of data in the memory, and is not broad enough to read upon the user looking at the possible color combinations and deciding which combination to choose.

From all of the above, we find that the examiner has failed to establish a prima facie case of anticipation of claim 29 under 35 U.S.C. § 102(b). Accordingly, the rejection of independent claim 29, and claims 31 and 36 which depend therefrom, is reversed.

In addition, we reverse the rejection of independent claim 9, as well as claims 11 and 19 which depend therefrom, because the claim also recites that problem color combinations and preferred color combinations reside in memory, which is not taught by Netscape, and does not read on the step being performed by a user, as advanced by the examiner. We additionally reverse the rejection of independent claim 9 because the claim requires that the color contrast adjuster resides in memory and performs

the selecting and applying steps, which is not taught by Netscape.

Turning to independent claim 48, we reverse the rejection of this claim, as well as claims 49, 50, 52, and 60 which depend therefrom, because the claim requires that the color contrast adjuster selects the preferred color combination that corresponds to the problem color combination, which distinguishes from the user performing the limitation, as advanced by the examiner.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 8, 21, 22, 28, 38-41, and 47 under 35 U.S.C. § 102(b) is affirmed. The decision of the examiner to reject claims 9, 11, 19, 31, 36, 48-50, 52, and 60 under 35 U.S.C. § 102(b) is reversed. No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136 (a).

AFFIRMED-IN-PART

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
LANCE LEONARD BARRY	)	APPEALS
Administrative Patent Judge	)	AND
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STUART S. LEVY	)	
Administrative Patent Judge	)	

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