The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT B. TAYLOR, III, KEVIN BIER
and ROBERT C. BORCIC and JAN E. IDOMIR

Appeal No. 2003-0781
Application 09/373,499

ON BRIEF

Before HAIRSTON, KRASS and JERRY SMITH, 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 rejection of claims 1-46, which constitute all the claims remaining in the application.

The disclosed invention pertains to a method and apparatus for processing graphical images in a plurality of formats. More particularly, the invention provides the combination of a format independent interface (FII) and an associated plurality of image format handling (IFH) modules. The invention permits an application program to read, display and save graphics image files irrespective of the format of the image file.

Representative claim 1 is reproduced as follows:

1. A computer system for processing graphical images that can be stored in a plurality of file formats, comprising:

a format independent interface (FII), wherein the FII communicates with an application program and routes image data and the application program commands; and

a plurality of image format handling (IFH) modules, wherein each module can process format specific graphical image data and interface with the FII.

The examiner relies on the following references:

Otala	6,154,208	Nov. 28, 2000 (filed Oct. 06, 1997)
Morcos et al. (Morcos)	6,167,404	Dec. 26, 2000 (filed Nov. 04, 1997)
Anderson	WO 99/27470	June 03, 1999

The following rejections are on appeal before us:

1. Claims 1-7, 21-25 and 34-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Otala in view of Morcos.

2. Claims 8-20, 26-33 and 39-46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Otala in view of Morcos and Anderson.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs 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 appellants' arguments set forth in the briefs 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 have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. 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 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). 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 and are deemed to be waived [see 37 CFR § 1.192(a)].

We consider first the rejection of claims 1-7, 21-25 and 34-38 based on the teachings of Otala and Morcos. With respect to independent claim 1, the examiner essentially finds that Otala teaches the claimed invention except that Otala does not teach the format independent interface (FII). The examiner cites Morcos as teaching a standard component object model (COM) which,

according to the examiner, meets the claimed FII. The examiner finds that it would have been obvious to the artisan to incorporate the teachings of Morcos into the system of Otala [answer, pages 4-6].

Appellants argue that the examiner's interpretation that the COM of Morcos is the claimed FII is incorrect. Specifically, appellants argue that the fact that the claimed FII can be implemented as a COM does not mean that the COM of Morcos implements the claimed functions of the FII. Appellants assert that nowhere in Morcos is it disclosed that the FII communicates with the application program, interfaces with a plurality of image format handling modules, and routes image data and application commands as claimed. Appellants also argue that the examiner has failed to indicate how the system of Otala would be modified to include the COM of Morcos. Appellants observe that the proposed modification would result in a substantial reconstruction of the Otala architecture [brief, pages 5-9].

The examiner responds by essentially repeating the rejection [answer, pages 17-20].

We will not sustain the examiner's rejection of independent claim 1 for essentially the reasons argued by appellants in the main brief. We agree with appellants that the applied prior art does not support the examiner's finding that the COM of Morcos is the same as the claimed FII. We also agree with appellants that there is no support for the finding that if the COM of Morcos is substituted as an FII in Otala, that the FII would communicate with application programs, route image data and application commands, and interface with a plurality of image format handling modules as claimed. Since appellants' arguments are persuasive and remain essentially unrebutted by the examiner, the rejection of claim 1 on this record cannot stand.

Independent claims 21 and 34 contain limitations similar to claim 1, and these claims are rejected by the examiner on the same basis as claim 1. Therefore, we do not sustain the examiner's rejection of claims 21 and 34 on this record for the same reasons discussed above with respect to claim 1. Since we have not sustained the examiner's rejection of independent claims 1, 21 and 34, we also do not sustain the rejection of dependent claims 2-7, 22-25 and 35-38.

We now consider the examiner's rejection of claims 8-20, 26-33 and 39-46 based on Otala, Morcos and Anderson. These claims are all dependent claims which depend from one of claims 1, 21 or 34. Anderson is apparently only cited to teach various image file formats. There is no suggestion by the examiner on this record that Anderson overcomes the deficiencies of the main combination of references discussed above with respect to claim 1. Therefore, the evidence to support this rejection suffers the same deficiencies we discussed above. Accordingly, we also do not sustain the examiner's rejection of claims 8-20, 26-33 and 39-46.

In summary, we have not sustained either of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-46 is reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)	
ERROL A. KRASS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JERRY SMITH Administrative Patent Judge	)	

JS/ki

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