

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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT D. BARNES
and ROBERT C. GEMPERLINE

Appeal No. 2004-1031
Application No. 09/448,952

ON BRIEF

Before HAIRSTON, GROSS, and BARRY, Administrative Patent Judges.
HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 5, 7 through 14, 16 through 28 and 30 through 41.

The disclosed invention relates to a method of compressing uncompressed image data based upon descriptive data associated with the uncompressed image data.

Appeal No. 2004-1031
Application No. 09/448,952

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

1. A method for compressing image data from an uncompressed image file including image data and descriptive data characterizing the image, the method comprising the steps of:

- (a) receiving a [sic, an] uncompressed image file;
- (b) reviewing descriptive data associated with the uncompressed image file for predetermined image characteristics;
- (c) selecting a data compression routine from a plurality of candidate routines based at least partially on the descriptive data, wherein the predetermined image characteristics include an imaging modality from a plurality of imaging modalities; and
- (d) compressing at least the image data in accordance with the selected routine.

The references relied on by the examiner are:

Ema et al. (Ema)	5,779,634	July 14, 1998
Ito	5,901,249	May 4, 1999
Jago et al. (Jago)	5,938,607	Aug. 17, 1999
Dieterich	6,100,940	Aug. 8, 2000
		(filed July 28, 1998)
Sasano et al. (Sasano)	6,198,837	Mar. 6, 2001
		(filed Aug. 19, 1997)
Makiyama et al. (Makiyama)	6,310,981	Oct. 30, 2001
		(effective filing date Oct. 8, 1996)
Kohm et al. (Kohm)	6,323,869	Nov. 27, 2001
		(filed Apr. 24, 1998)
Sitka et al. (Sitka)	6,349,373	Feb. 19, 2002
		(filed Feb. 20, 1998)

Appeal No. 2004-1031
Application No. 09/448,952

Claims 1 through 3, 5, 7 through 11 and 39 through 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dieterich in view of Kohm.

Claims 3, 4, 12, 13, 16, 18, 20 through 28, 31, 33 and 35 through 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dieterich in view of Kohm and Sasano.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Dieterich in view of Kohm, Sasano and Ema.

Claims 14 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dieterich in view of Kohm, Sasano and Sitka.

Claims 19 and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dieterich in view of Kohm, Sasano, and Ito.

Claims 17 and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dieterich in view of Kohm, Sasano and Makiyama.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Dieterich in view of Kohm and Jago.

Claim 40 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Dieterich in view of Kohm and Makiyama.

Appeal No. 2004-1031
Application No. 09/448,952

Reference is made to the final rejection (paper number 5), the briefs (paper numbers 9 and 11) and the answer (paper number 10) for the respective positions of the appellants and the examiner.

OPINION

We have carefully considered the entire record before us, and we will sustain the 35 U.S.C. § 103(a) rejection of claims 1 through 5 and 7 through 11, and reverse the 35 U.S.C. § 103(a) rejection of claims 12 through 14, 16 through 28 and 30 through 41.

Dieterich discloses a method of compressing image data from an uncompressed image file (e.g., a movie or a television program wherein each is nothing more than a file of similarly structured data) (column 3, lines 22 through 27) that includes image data and descriptive data (i.e., side information) (column 1, line 65 through column 2, line 10) that characterizes or relates to the image data. The input video 105 received by the coding apparatus 100 (Figure 1) includes both the uncompressed image data and the side information/descriptive data. The coding apparatus 100 reviews the descriptive data associated with the uncompressed image file for predetermined image characteristics, and selects a data compression routine from a plurality of candidate routines based at least partially on the descriptive data, and wherein the predetermined image characteristics include an imaging modality

Appeal No. 2004-1031
Application No. 09/448,952

from a plurality of imaging modalities that are appropriate for a movie, a TV program or music (column 3, lines 22 through 27; column 4, lines 62 through 67; column 8, lines 30 through 33; column 9, lines 23 through 27). Based upon the selected routine/imaging modality, the image data is compressed by encoder 180 (Figure 1; column 8, lines 30 through 33; column 9, lines 23 through 27). The side information/descriptive data is referred to as a header (column 13, lines 16 and 17).

Appellants' argument (brief, pages 9 through 12) that Dieterich is non-analogous art is without merit because Dieterich, while not in the medical field, addresses and solves the same problem that confronted the appellants. "A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992). The problem confronting appellants was the selection of an appropriate compression routine for uncompressed image data received at a receiver, and the problem confronting Dieterich was the selection of the appropriate compression routine for uncompressed image data received at a receiver. Appellants' argument (brief, page 11) to

Appeal No. 2004-1031
Application No. 09/448,952

the contrary notwithstanding, claim 1 on appeal is not limited to medical images, and the selection of an appropriate medical imaging modality. The same solution (i.e., send descriptive data along with the image data to help the receiver select the appropriate compression routine) was found by both the appellants and Dieterich. Thus, Dieterich is analogous art because he addresses the same problem and arrives at the same solution as the disclosed and claimed invention.

In view of the foregoing, the obviousness rejection of claims 1 through 3 is sustained based upon the teachings of Dieterich. In sustaining a multiple reference rejection under 35 U.S.C. § 103, the Board may rely on one reference alone without designating it as a new ground of rejection. In re Bush, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961); In re Boyer, 363 F.2d 455, 458, n.2, 150 USPQ 441, 444, n.2 (CCPA 1966). The transmission of descriptive header data along with image data teachings of Kohm are merely cumulative to the teachings of Dieterich. We agree with appellants' argument (brief, page 8), however, that Kohm uses the header data to adjust the tone of the image data, and not to compress the image data.

Appeal No. 2004-1031
Application No. 09/448,952

The obviousness rejection of claims 5 and 7 through 11 is likewise sustained because appellants have chosen to let these claims stand or fall with claim 1 (brief, page 5). The obviousness rejection of claim 4 is sustained because appellants have not presented any patentability arguments for this claim apart from those presented for claim 1 (brief, page 30).

The obviousness rejections of claims 12 through 14, 16 through 28 and 30 through 41 are reversed because we agree with the appellants' arguments (brief, pages 12 through 16) that the examiner has not presented a convincing line of reasoning for modifying the film/movie image teachings of Dieterich with the medical image teachings of Kohm. The examiner's reasoning (i.e., "improving image quality, depending on the modality") (final rejection, page 3) is nothing more than the examiner's unsupported opinion. The factual question of motivation should be resolved based on evidence of record, and not on the subjective belief and unknown authority expressed by the examiner. In re Lee, 277 F.2d 1338, 1343-44, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). As indicated supra, the teachings of Kohm would have only suggested that the tone of the film/movie images in Dieterich be adjusted based upon the descriptive data. Stated differently, nothing in the applied

Appeal No. 2004-1031
Application No. 09/448,952

references teaches or would have suggested to the skilled artisan to select a medical imaging modality based upon the descriptive data.

DECISION

The decision of the examiner rejecting claims 1 through 5, 7 through 14, 16 through 28 and 30 through 41 under 35 U.S.C. § 103(a) is affirmed as to claims 1 through 5 and 7 through 11, and is reversed as to claims 12 through 14, 16 through 28 and 30 through 41.

Appeal No. 2004-1031
Application No. 09/448,952

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

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ANITA PELLMAN GROSS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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LANCE LEONARD BARRY)	
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Appeal No. 2004-1031
Application No. 09/448,952

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