

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL JOSEPH CHANG, JOHN C. HUFFMAN, BENJAMIN J.
MCCURTAIN, JONATHAN REIS, and BRADFORD V. HEBERT

Appeal No. 2004-1450
Application No. 09/449,015

ON BRIEF

Before JERRY SMITH, BARRETT, and BLANKENSHIP, 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 1-19, which constitute all the claims in the application.

The disclosed invention pertains to a method and apparatus for communicating a plurality of views for a source image.

Representative claim 1 is reproduced as follows:

1. A method for communicating a plurality of views for a source image, said method comprising the steps of:

transmitting, from an image sender computer to a recipient computer, a static reference to identify a source image on a server;

generating, at said image recipient computer, a first request for a view of said source image to said server based on said static reference;

transmitting data from said image server to said image recipient computer in response to said request;

displaying said first view of said source image at said image recipient computer;

receiving input from a user at said image recipient computer to select a second view of said source image;

generating a second request to said image server for said second view;

transmitting from said image server additional data to generate said second view of said source image; and

displaying said second view of said source image at said image recipient computer.

The examiner relies on the following references:

Tomassi et al. (Tomassi)	5,606,707	Feb. 25, 1997
Popa	6,006,231	Dec. 21, 1999
		(filed Sep. 10, 1997)
Slotznick	6,011,537	Jan. 04, 2000
		(filed Jan. 27, 1998)
Wong et al. (Wong)	6,260,021	Jul. 10, 2001
		(filed Jun. 12, 1998)

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Claims 1-19 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Wong in view of Popa with respect to claims 1, 3, 6-8, 10-12, 14 and 17-19, Wong in view of Popa and Slotznick with respect to claims 2, 9 and 13, and Wong in view of Popa and Tomassi with respect to claims 4, 5, 15 and 16.

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 not have suggested to one of ordinary skill

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in the art the obviousness of the invention as set forth in claims 1-19. 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

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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 § 41.37(c)(1)(vii)(2004)).

We consider first the rejection of claims 1, 3, 6-8, 10-12, 14 and 17-19 based on Wong and Popa. The examiner's rejection is set forth on pages 4-9 of the answer. With respect to each of the independent claims, appellants argue, inter alia, that Wong does not teach or suggest transmitting an identification from an image sender computer (first computer) to a recipient computer (second computer) of an image located on a

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server (third computer). Appellants also argue that the applied prior art fails to teach or suggest the transmission of a static reference to a dynamic image as claimed. With respect to independent claim 7, appellants also argue that neither Wong nor Popa teaches a technique that permits an image sender to transmit a view of an image for a source image that includes multiple views (brief, pages 3-11).

The examiner responds that Wong teaches a three-tier architecture in which a server operates as a second tier between first and third tier computers. The examiner also responds that Popa is relied on for sending multiple versions of an image (answer, pages 12-15).

Appellants respond that the three-tier computer architecture taught by Wong does not meet the claimed invention. Specifically, appellants assert that Wong does not disclose limitations for transmitting a static reference between an image sender computer and an image recipient computer and for using the static reference at a server to obtain an image (reply brief).

We will not sustain the examiner's rejection of claims 1, 3, 6-8, 10-12, 14 and 17-19 based on the teachings of Wong and Popa because the three-tier computer architecture as taught by

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Wong fails to teach or suggest the system architecture recited in the claimed invention. As noted by the examiner, Wong teaches a three-tier computer architecture in which the server computer 12 operates in-between the hospital computers and the client computers. The diagram of Wong's system architecture in Figure 1 indicates that there are no direct communications between the hospital computers and the client computers. All communications between the hospital computers and the client computers must go through the server computer. Appellants' claims, however, recite that a sender computer sends a static reference to a recipient computer which identifies a source image on the server computer. Thus, the claimed invention eliminates the need for the sender computer to communicate with the server. As noted by appellants, this architecture permits the static reference to be sent from the sender computer to the recipient computer over a low bandwidth link while the recipient computer can receive the images from the server computer over a high bandwidth link. Since the architecture required by the claimed invention is not the same as the architecture taught by Wong, and since the

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examiner has not addressed the obviousness of this difference, the examiner has failed to establish a prima facie case of obviousness.

With respect to the dependent claims which are rejected using the additional teachings of Slotznick or Tomassi, the rejection of these claims relies on the same improper combination of Wong and Popa. Since neither Slotznick nor Tomassi overcomes the deficiencies in the main combination of references discussed above, we do not sustain the examiner's rejection of claims 2, 4, 5, 9, 13, 15 and 16 for the same reasons discussed above.

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In summary, we have not sustained any of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-19 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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HOWARD B. BLANKENSHIP)	
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