

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YOSHIKO SHIIMORI, YOSHINORI OHTA, KOICHI SAKAMOTO,
NORIHISA HANEDA, and NOBUYOSHI NAKAJIMA

Appeal No. 2005-2554
Application No. 09/107,486
Technology Center 2600

HEARD: December 13, 2005

Before GROSS, BARRY, and SAADAT, *Administrative Patent Judges*.
GROSS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 10, 12 through 20, 22 through 36, 38 through 43, and 45 through 50, which are all of the claims pending in this application.

Appellants' invention relates to an image communication system having an image server and a client computer that are capable of communicating with each other. The invention makes it possible to reduce the data quantity of image data transmitted from an image server to a client computer and to shorten the time required to transmit the image data. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. An image communication system in which an image server and a client computer having a display device are capable of communicating with each other, the image server storing film image data that has undergone display direction conversion processing, the film image data representing an image,

wherein said client computer comprises:

a first transmission device transmitting, to said image server, a command to transmit a thumbnail of the film image data that has undergone direction conversion processing and stored in said image server; and

a second transmission device transmitting, to said image server, display information relating to said display device, said first and second transmission devices transmitting the respective command and display information to reduce the amount of film image data that said image server is required to process, and

wherein said image server comprises:

a data quantity reduction device reducing the data quantity of the film image data to be transmitted to editing image data and further reducing to thumbnail image data, in response to the image transmission command transmitted from said first transmission device transmitting the thumbnail image data to the client computer, in response to the display information transmitted from said second transmission device transmitting the editing image data to the client computer, the thumbnail image data and the editing image data displayed in a correct direction on the display device due to the display direction conversion processing, and

an image data transmission device transmitting, to said client computer, the reduced film image data.

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

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|-----------|--------------|-------------------------------|
| Kurahashi | 5,687,332 | Nov. 11, 1997 |
| Uda | 5,720,013 | Feb. 17, 1998 |
| Hunt | 5,764,235 | Jun. 09, 1998 |
| Hirono | 5,926,154 | Jul. 20, 1999 (Nov. 13, 1995) |
| Maniwa | 5,933,584 | Aug. 03, 1999 (May 14, 1997) |
| Cok | 6,370,280 B1 | Apr. 09, 2002 (Jan. 16, 1996) |

Claims 1 through 10, 12 through 18, 29, and 33 stand rejected under 35 U.S.C. § 112, first paragraph, as containing new matter.

Claims 26, 30, 34 through 36, 38 through 43, 45 through 48, and 50 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kurahashi in view of Cok.

Claim 25 stands rejected under 35 U.S.C. § 103 as being unpatentable over Kurahashi in view of Cok and Maniwa.

Appeal Number: 2005-2554
Application Number: 09/107,486

Claims 29 and 33 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kurahashi in view of Cok and Hunt.

Claims 19, 20, 22 through 24, 27, 28, 31, and 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hunt in view of Cok.

Claims 5 through 7 and 13 through 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hunt in view of Cok and Maniwa.

Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Hunt in view of Maniwa, Cok, and Uda.

Claims 10 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Uda in view of Maniwa and Cok.

Claim 49 stands rejected under 35 U.S.C. § 103 as being unpatentable over Uda in view of Maniwa, Cok, and Hirono.

Reference is made to the Examiner's Answer (mailed October 22, 2003) for the examiner's complete reasoning in support of the rejections, and to appellants' Brief (filed July 24, 2003) and Reply Brief (filed December 18, 2003) for appellants' arguments thereagainst.

OPINION

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellants and the examiner. As a consequence of our review, we will reverse the new matter rejection of claims 9, 29, and 33, affirm the new matter rejection of claims 1 through 8, 10, and 12 through 18, reverse the obviousness rejections of claims 19, 20, 22 through 25, 27, 28, 31, 32, 35, 36, 38 through 43, 45 through 47, and 50, and affirm the obviousness rejection of claims 5 through 8, 10, 12 through 18, 26, 29, 30, 33, 34, 48, and 49.

With regard to the new matter rejection, "when filing an amendment an applicant should show support in the original disclosure for new or amended claims. See MPEP § 714.02 and § 2163.06 ("Applicant should * * * specifically point out the support for any amendments made to the disclosure.')." See MPEP §2163.06 IIA3(b). The examiner (Answer, pages 4-6) lists several phrases from claims 1, 3, 5, 9, 10 and 12, 13

and 17, and 29 and 33, asserting that they all recite subject matter which was not described in the specification, with no further explanation. Appellants (Brief, pages 25-26) direct our attention to several pages of the specification as support for the various limitations, without specifying which limitations can be found where. We have reviewed the entire specification, with particular attention drawn to the pages listed by appellants, and we will affirm the new matter rejection of claims 1 through 8, 10, and 12 through 18.

We were able to find many of the limitations recited by the examiner. Specifically, the claim 1 limitations of “reducing the data quantity of the film image data to be transmitted to editing image data and further reducing to thumbnail image data,” “in response to the image transmission command transmitted from said first transmission device transmitting the thumbnail image data to the client computer,” and “the thumbnail image data and the editing image data displayed in a correct direction on the display device due to the display direction conversion processing,” are disclosed in the specification, for example, at page 38, lines 1-4, page 42, line 23- page 43, line 12, and page 38, lines 7-10, respectively. Also, the claim 3 limitation of “thinning out the editing image data,” is disclosed on page 38, lines 1-5, and page 47, lines 8-24, and the claim 10 and claim 12 limitation of “reading film image data,” can be found at page 35, lines 22-24. The claim 9 limitations recited by the examiner correspond to claim 1 limitations described *supra*. Since we find all of claim 9 to be disclosed in the specification, we must reverse the new matter rejection of claim 9. Also, the claim 29 and claim 33 limitation of “the information relating to the film image data corresponding to the type and resolution of a display device in the client computer and the number of colors of the display device,” is clearly disclosed on page 43, line 23-page 44, line 7. Accordingly, we cannot sustain the new matter rejection of claims 29 and 33.

However, other limitations recited by the examiner we were not able to locate, and appellants have not aided us in either the Brief or the Reply Brief by, for each limitation in question, pointing to a specific portion of the disclosure. In particular, with regard to the claim 1 and claim 5 limitation of “storing film image data *that has undergone display direction conversion processing*” (emphasis ours), appellants disclose (specification, page 37, lines 13-15 and page 38, lines 1-10) that image data is stored,

then editing image data and thumbnail image data are generated, and then the editing image data and thumbnail image data are subjected to display direction conversion processing. Thus, the editing image data and thumbnail image data undergo display direction conversion processing, not the film image. Similarly, although the command to transmit a thumbnail of the film image data is disclosed, for example, on page 42, lines 23-24, we find no command to transmit a thumbnail of the film image data *that has undergone direction conversion processing*, as recited in claim 1, since it is the thumbnail that undergoes direction conversion processing, not the film image data. Accordingly, we will sustain the new matter rejection of claims 1 and 5 and their dependents, claims 2 through 4 and 6 through 8.

In claims 10 and 12, appellants recite “color conversion processing on the read film image data,” and “transmitting the second color converted film image data to said client computer after subjecting the second color converted film image data to display direction conversion processing so that the film image is displayed on said display device in a correct direction.” On page 47, appellants disclose that the data quantity of the editing image data is reduced and then color space conversion is performed (page 48, lines 20-24, and page 49, lines 12-13) on the editing image data, not the read film image data. Further, as indicated at page 50, lines 5-8, it is the editing image data, not color converted film image data, that is subjected to display direction conversion. Accordingly, we will sustain the new matter rejection of claims 10 and 12.

Last, regarding claims 13, 17, and 18, it is unclear what corresponds to the claim limitation of “displaying a plurality of sample film images.” Since appellants have not specifically addressed this limitation by directing our attention to a particular portion of the disclosure, we will sustain the new matter rejection of claims 13, 17, and 18, and claims 14 through 16, which depend from 13.

As to the obviousness rejection of claims 26, 30, 34 through 36, 38 through 43, 45 through 48, and 50 over Kurahashi in view of Cok, appellants assert (Brief, page 19) that the reasons stated by the examiner, to “allow the image to be created in a flexible manner usable over a wide distribution to diverse producers” and to “allow users to create realistic images at low cost,” do not deal with issues with which Kurahashi was

concerned. Thus, appellants conclude (Brief, pages 18-19) that the examiner's motivation for combining Kurahashi and Cok amounts to impermissible hindsight.

Cok discloses (column 2, lines 23-28) that an object of the invention is "to provide a method for controlling the use of artistic and personal images in composite imagery in a manner that is very flexible, is useful over a wide distribution to diverse producers, inhibits fraud, and can adapt to a variety of circumstances without compromising the secure use of the imagery." Thus, the motivation cited by the examiner (Answer, page 8) for using film image data as the image data in Kurahashi is actually the advantages of Cok's entire method, not of using film image data. Accordingly, we agree with appellants that the examiner has failed to provide proper motivation for combining of Kurahashi and Cok. However, as indicated by the examiner (Answer, page 30), the origin of the data, or whether the data is a filmed image or another type of image, does not matter to the computer/server. In other words, the type of image data processed by the claimed methods and systems does not functionally change the methods or systems. Thus, the type of data lacks a functional relation thereto, and the limitation specifying the type of image data as film image data is not entitled to patentable weight. Accordingly, Cok is merely cumulative.

Appellants only other argument (Brief, page 20) is that Kurahashi fails to disclose re-editing of the initially edited image and judging whether initial editing or subsequent re-editing is allowed based on a transmitted execution command. We first note that claims 26, 30, 34 and 48 do not recite re-editing nor judging whether editing or re-editing is allowed based on a transmitted execution command. Therefore, with respect to claims 26, 30, 34, and 48, appellants' argument is unpersuasive, and we will sustain the obviousness rejection over Kurahashi in view of Cok.

Further, claims 35, 40 through 42, and 47 do not require re-editing. Thus, arguments regarding re-editing are unpersuasive with respect to claims 35, 40 through 42, and 47. As to the remaining claims, the examiner explains (Answer, page 34) that Kurahashi teaches (in column 9, lines 5-20) sending editing information back and forth such that the computer can edit the image data more than one time, thereby disclosing re-editing. Appellants merely assert (Brief, page 20) that Kurahashi fails to disclose re-

editing, and do not explain why the examiner's analysis is incorrect. In the absence of any convincing arguments to the contrary, we agree with the examiner that Kurahashi discloses re-editing.

Nonetheless, all of claims 35 through 36, 38 through 43, 45 through 47, and 50 recite the judging limitation. The examiner (Answer, page 13) points to Kurahashi's analysis of editing data, and decision as to whether the image is to be processed by the image server or by the client (column 7, lines 1-5) to satisfy this limitation. We disagree with the examiner. The decision as to whether the image is to be processed by the image server or by the client is not a judgment as to whether editing is allowed, but rather a judgment as to which device should perform the editing. Therefore, we find no judging, as recited in claims 35 through 36, 38 through 43, 45 through 47, and 50, in Kurahashi. Consequently, we cannot sustain the obviousness rejection of claims 35 through 36, 38 through 43, 45 through 47, and 50 over Kurahashi in view of Cok.

Regarding the obviousness rejection of claim 25 over Kurahashi in view of Cok and Maniwa, appellants contend (Brief, pages 13-14) that Maniwa discloses "a facsimile server software has a filter function to rotate read image data before sending the image data to a print server software, and a function to automatically rotate an image when the paper feed direction in the printer is different from that of reading by the scanner." Appellants continue (Brief, page 14) that display conversion is not disclosed, just rotation for a print/copying function. The examiner (Answer, pages 31-32) explains that Kurahashi discloses the image server sending image data to a printer 134, that the image must go through display direction conversion for the image to be printed in the correct orientation, and that Maniwa shows rotating an image when the reading direction of the scanner differs from the feed direction of the printer. The examiner also explains (Answer, page 32) that he has read the display of claim 25 as displaying a printed image to a human observer.

We disagree with the examiner. The rotation of the image in Maniwa is based on the feed direction of the printer, or information sent from the printer regarding the feed direction. If one were to read the displaying of the printed image as the claimed display, then the display direction conversion would be the rotation of the image to be printed in

the correct direction. However, claim 25 requires the display direction conversion to be on the basis of information relating to the film image data transmitted from said client computer, not information from the printer. Accordingly, the examiner's interpretation fails to meet all of the limitations of the claim, and we cannot sustain the obviousness rejection of claim 25 over Kurahashi in view of Cok and Maniwa.

As to claims 29 and 33, appellants argue (Brief, page 16) that the arguments discussed *supra* regarding the combination of Cok with Kurahashi apply to the rejection of claims 29 and 33. We agree, but note that we determined that the film image limitation constitutes nonfunctional descriptive material and, therefore, is not given patentable weight, thereby rendering Cok merely cumulative. Appellants further argue (Brief, page 17) that Hunt fails to disclose that the information relating to the film image data corresponds to the type and resolution of a display in the client computer and the number of colors of the display device. However, Kurahashi discloses (column 1, lines 45-55) that in the prior art, the image server provides image data without taking into account the characteristics of the image processing apparatus in the workstation. For example, the image server may send color image data even when the workstation is only capable of displaying monochromatic images. Kurahashi solves the problems of the prior art (column 7, line 67-column 8, line 12) by sending to the image server editing data information on image data suitable for display by the workstation display unit, "such as resolution and color information." Thus, Kurahashi discloses sending display type, resolution, and the number of colors (e.g., monochromatic, or one color, versus color, or three colors), and Hunt is merely cumulative. Thus, we will sustain the obviousness rejection of claims 29 and 33.

Claims 19, 20, 22 through 24, 27, 28, 31, and 32 all recite that reduced or compressed data is sent by the client computer to the image server. The examiner (Answer, page 22) applies Hunt in view of Cok against the claims. Appellants (Brief, page 22) argue that "Hunt fails to disclose the client reducing film image data and transmitting the reduced data to the server." The examiner asserts (Answer, page 22) that Hunt discloses in column 2, lines 30-32, transmitting reduced image data to the server. We disagree with the examiner. Our review of column 2, lines 30-43, reveals that the

server receives a request from the client for a graphical image, the server determines how much data is appropriate to be transmitted, the appropriate amount being less than or equal to the total image size, and the server transmits to the client the reduced image. Nowhere in the reference does the client reduce data to send to the server. As Cok does not remedy the deficiency of Hunt, we cannot sustain the obviousness rejection of claims 19, 20, 22 through 24, 27, 28, 31, and 32 over Hunt in view of Cok.

For claims 5 through 7 and 13 through 18, the examiner again applies Hunt in view of Cok, with the addition of Maniwa. Appellants (Brief, page 21) refer to the arguments “applied above” as applicable to the combination of the three references. However, claims 5 through 7 and 13 through 18 do not recite that reduced or compressed data is sent by the client computer to the image server. Therefore, the application of Hunt against these claims does not suffer the same deficiency argued by appellants and discussed *supra* with regard to claims 19, 20, 22 through 24, 27, 28, 31, and 32. Further, we found that the arguments regarding Cok were unpersuasive because the language in the claims for which Cok was applied is nonfunctional descriptive material and, therefore, not given patentable weight. Thus, the only remaining issue relates to Maniwa. Since all of claims 5 through 7 and 13 through 18 recite display direction conversion, the question is whether Maniwa teaches this limitation.

Appellants argue (Brief, page 14) that “Maniwa discloses at most a rotational component for a print/copying function, not for a display function. No *display* direction conversion . . . is disclosed by Maniwa.” Printing is one way to display an image to a user. Maniwa discloses (column 29, lines 50-61) that when a scanning direction differs from a print feed direction, the image should be rotated before sending to the printer, so that the image prints in the correct direction. In other words, Maniwa discloses direction conversion when the image is sent to a printer. As a display is a known alternative to a printer for displaying an image to a user, the skilled artisan would recognize that if the scan direction were different from the display direction, the image would need to be rotated in a similar manner to that disclosed by Maniwa so that the image would display in the correct direction. The level of the skilled artisan should not be underestimated. *See In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). As each of

Appeal Number: 2005-2554
Application Number: 09/107,486

independent claims 5, 13, 17, and 18 recites transmitting an image from the image server after display direction conversion, so that the image will display in the correct direction, we will sustain the obviousness rejection of claims 5 through 7 and 13 through 18.

Regarding claim 8, which depends from claim 5, and, therefore, includes all of the limitations of claim 5, the examiner (Answer, page 27) adds Uda to the combination of Hunt, Cok, and Maniwa, discussed *supra*, to satisfy the additional limitation of a printer. Appellants' sole argument (Brief, page 24) is that "Uda fails to make up for the above noted deficiencies noted in the combination of Hunt, Cok and Maniwa." However, we found no deficiency in the combination of the three references. Thus, the rejection of claim 8 is sustained for the same reasons discussed *supra* with respect to claims 5 through 7 and 13 through 18.

The examiner (Answer, page 25) rejects claims 10 and 12 over Uda in view of Maniwa and Cok. Appellants do not contest the merits of Uda. Appellants merely rely (Brief, page 23) on the argument discussed *supra* that Maniwa fails to teach display direction conversion. As we have determined that Maniwa does suggest display direction conversion, we will sustain the obviousness rejection of claims 10 and 12.

Regarding claim 49, the examiner adds Hirono to the combination of Maniwa, Cok, and Uda. Appellants (Brief, page 24) again refer to the arguments discussed *supra* and found unpersuasive with regard to Uda, Cok, and Maniwa. In addition, appellants argue (Brief, pages 24-25) that Hirono fails to teach display direction conversion and, therefore, fails to cure the shortcomings of the combination of Uda, Cok, and Maniwa. However, as indicated *supra*, the combination of Uda, Cok, and Maniwa suggests display direction conversion. Accordingly, Hirono is merely cumulative. Consequently, we will sustain the obviousness rejection of claim 49.

Appeal Number: 2005-2554
Application Number: 09/107,486

CONCLUSION

The decision of the examiner rejecting claims 1 through 10, 12 through 18, 29, and 33 under 35 U.S.C. § 112, first paragraph, is reversed with respect to claims 9, 29, and 33, but affirmed with respect to claims 1 through 8, 10, and 12 through 18. The decision of the examiner rejecting claims 5 through 8, 10, 12 through 20, 22 through 36, 38 through 43, and 45 through 50 under 35 U.S.C. § 103 is affirmed with respect to claims 5 through 8, 10, 12 through 18, 26, 29, 30, 33, 34, 48, and 49 and reversed with respect to claims 19, 20, 22 through 25, 27, 28, 31, 32, 35, 36, 38 through 43, 45 through 47, and 50.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a). *See* 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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| ANITA PELLMAN GROSS |) | |
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Appeal Number: 2005-2554
Application Number: 09/107,486

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