

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY ALAN DIETZ, WALID KOBROSLY,
and NADEEM MALIK

Appeal 2007-2386
Application 10/205,636
Technology Center 2100

Decided: September 8, 2008

Before LANCE LEONARD BARRY, ST. JOHN COURTENAY III, and
THU ANN DANG, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-31. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

The invention at issue on appeal conserves bandwidth and storage capacity by reducing the number of colors in the color palettes of Web page images. "In other words the quality of the Web page images is sacrificed . . . to save transmission bandwidth and storage capacity required by the transmitted Web pages." (New Br. 11.)

B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows.

1. In a communication network with user access via a plurality of data processor controlled interactive receiving display stations for displaying hypertext documents transmitted to the receiving display stations from document sources remote from said stations, an electronic document distribution system comprising:

means in the document transmission path intermediate said sources and said receiving display stations for determining the number of colors in the color palettes of images in transmitted documents;

means responsive to said determining means for selectively converting said color palettes to color palettes having a lower number of colors for said images; and

means for transmitting said documents having said converted color palettes with a lower number of colors for said images.

C. REJECTION

Claims 1-31 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,581,109 ("Fields").

II. ISSUE

"Rather than reiterate the positions of the parties *in toto*, we focus on an issue therebetween." *Ex parte Kuruoglu*, No. 2007-0666, 2007 WL 2745820, at *2 (BPAI 2007). The Examiner makes the following findings.

Fields disclosed an image pre-processor that generates a color-adjusted image, said image pre-processor using a color palette adjustment routine (Fields- Column 4 Lines 60-65). Furthermore, as shown in Figure 5, the process of calibration includes reducing the number of colors. In Figure 5 the colors red, green or blue may be reduced as specified in the calibration process.

(Ans. 8.) The Appellants argue "that such adjusting a color image to suit the receiving display computer based upon a predetermined calibration profile is not a disclosure of selectively converting said color palettes to color palettes having a lower number of colors for transmitted images." (New Br. 13.) Therefore, the issue is whether the Examiner has shown that Fields determines the number of colors in the color palettes of images in transmitted documents and, responsive to that determination, converts the color palettes to color palettes having a lower number of colors for the images.

III. AUTHORITIES

"[A]nticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim . . ." *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1457 (Fed. Cir. 1984)). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in

the reference, and that it would be so recognized by persons of ordinary skill." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (quoting *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991)). "Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981) (citing *Hansgirg v. Kemmer*, 102 F.2d 212, 214 (1939)). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986).

IV. FINDINGS OF FACT

Here, Fields' "dynamic image processor 34 is the component that receives a default image 36 as an input and generates a color-adjusted image 36' for service to the client machine." (Col. 4, ll. 48-50.) "Typically, the dynamic image processor 34 includes a set of one or more compensation routines 38a-38n that provide the color adjust functionality." (*Id.* ll. 54-56.) "A representative compensation routine 38 is a gamma (midrange response) correction filter." (*Id.* ll. 59-60.) "Other compensation routines include a routine for resolution adaptation, a routine to correct or adjust given color characteristics (i.e. brightness, contrast, etc.), a color palette adjustment routine, and the like." (*Id.* ll. 60-64.)

V. ANALYSIS

Although the first part of Fields on which the Examiner relies mentions "a color palette adjustment routine," the reference does not disclose the details thereof. The Examiner relies on Figure 5 of Fields to furnish some of those details. The Figure "illustrates how the user may perform a gamma correction test" (col. 3, ll. 33-34), however, rather than the aforementioned color palette adjustment routine.

The Examiner has not made clear that the reference's color palette adjustment routine necessarily determines the number of colors in the color palettes of images in transmitted documents and, responsive to that determination, converts the color palettes to color palettes having a lower number of colors for the images, and that it would be so recognized by persons of ordinary skill. The mere fact that color palette adjustment routine may do so is insufficient for anticipation. *See Robertson*, 169 F.3d at 745.

VI. CONCLUSION

The absence of a showing that Fields determines the number of colors in the color palettes of images in transmitted documents and, responsive to that determination, converts the color palettes to color palettes having a lower number of colors for the images negates anticipation.

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VII. ORDER

Therefore, we reverse the rejection of claims 1-31 under § 102(e).

REVERSED

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