

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte THEODORE W. NEFF, JEFFREY P. LEE  
and PATRICIA D. LOPEZ

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Appeal No. 2002-0279  
Application No. 09/164,795

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ON BRIEF

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Before KRASS, JERRY SMITH and RUGGIERO, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-23.

The invention is directed to a user interface for initiating a final scan using a drag and drop technique whereby image data is transferred from scanner software to a software application.



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Claims 1-4, 6 and 10-14 stand rejected under 35 U.S.C. § 102(a) as anticipated by IBM.

Claims 1-4, 6, 7, 9-16 and 20-23 stand rejected under 35 U.S.C. § 103 as unpatentable over IBM. Claim 5 stands rejected under 35 U.S.C. § 103 as unpatentable over IBM in view of Sobol. Claims 8 and 17-19 stand rejected under 35 U.S.C. § 103 as unpatentable over IBM in view of Photoimpact.

Reference is made to the brief and answer for the respective positions of appellants and the examiner.

#### OPINION

At the outset, we note that, in accordance with appellants' grouping at pages 3-4 of the brief, claims 1-6, 8-15 and 17-23 will stand or fall together and claims 7 and 16 will stand or fall together.

The examiner contends that IBM discloses a preview scan at page 36, meeting the claim language, "launching a preview scan of a document creating a preview scan of said document." The preview scan area is said to be disclosed at page 37 of IBM, for a disclosure of the claimed, "displaying said preview scan data

on a monitor connected to said computer system." Page 37 of IBM is also said to disclose a user defined box in the prescanned image, meeting the claim language, "selecting a region of interest from said preview scan data displayed on said monitor." The examiner points to the checked "Export to application" box near the prescan area, at page 37 of IBM to show that the scanner software initiates export when a final scan is initiated. This is said to meet the claimed, "receiving, into a memory in said computer system, an input signal, wherein said input signal selects said software application, and further wherein said software application was previously loaded into said memory in said computer system." The examiner maintains that IBM discloses a final scan, from the scanner software, corresponding to a selected region, pointing to page 36, item Prescan, and page 37, user selected area and OK button. This is said to meet the claimed, "launching, with said scanner software, a final scan of said document creating said image data, wherein said image data of said document corresponds to said selected region of interest." The examiner further explains that it is inherent within scanner software operating in a computer environment to temporarily store scanned images within the memory of a computer prior to further action, meeting the claimed, "receiving said

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image data in said memory in said computer system." Finally, the examiner contends that IBM discloses sending a final scan image data to application software, at page 26, noting Action Creator, Dependent Application, p.37 at arrows, and page 38. This is said to meet the claimed, "sending said image data to said selected software application."

The examiner appears to establish a prima facie case of anticipation with regard to the subject matter of independent claim 1 by identifying each and every claimed limitation and specifically pointing out where in the reference each claimed element is found. The burden now shifts to appellants to show error in the examiner's analysis.

It is appellants' position that the independent claims require that an area of a scanned document be selected first, narrowing the options to the one or more formats, or types, of the data available, and then a software application is selected that can utilize one of the formats selected. In contrast, contend appellants, IBM requires that the data format be predefined before a region is selected so that the user must first know that the area selected from the document will generate the correct format of data that the software application can use, otherwise the software application will fail (see brief-page 4).

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While this may, in fact, be a difference between appellants' invention and that disclosed by IBM, we find nothing in the instant *claimed* invention about data formats. Arguments directed to subject matter not appearing in the claims are not persuasive.

Appellants further explain that the *sequence* of steps in the instant claimed invention and those taught by IBM are not equivalent. While such an argument regarding a method claim may have some credence, where a method is performed in specifically ordered steps, in the instant case, we agree with the examiner that the instant independent claims "do not specifically recite a cause and effect order of limitations" (answer-page 22). Accordingly, while certain steps of instant claim 1, for example, must be performed in a specific order, such as first launching a preview scan, then displaying the preview scan and then selecting a region of interest from the preview scan, it does not follow that step (d), receiving an input signal for selecting the software application, must, necessarily follow steps (a)-(c). Even step (e), which states that the image data "corresponds to said selected region of interest," does not require that it follow step (c), selecting a region of interest, because even where the selection of a region of interest is selected after creation of image data, the image data may still "correspond" to

the selected region of interest. Thus, the claim language itself does not require the steps of independent claim 1 to be specifically followed in the sequence recited. If the specific sequence of one step after another was intended by appellants, they could easily have made this clear in the claim.

At page 8 of the brief, appellants argue that the process taught by IBM "cannot select any region of the document and *send it to an arbitrary application program* **after** selecting the region...Because the process of IBM determines in advance which software application will receive the type of data, it thereby limits the type of data that can be selected. In stark contrast, Appellants' invention allows a user to select the area of interest of the document (thereby identifying the type of data contained therein), and then select which software application can process the selected type of data."

Again, appellants' argument does not appear to be commensurate in scope with the claim language. We find nothing in the claim language regarding "arbitrary application programs" or sending documents to such programs "after" selecting a region of interest. It may very well be, as appellants state, at page 9 of the brief, that "[b]ecause the user may not know the data formats that can be retrieved from a particular region of a

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document, Appellants' claimed invention provides a clear advantage by allowing the user to **first** select the region to be scanned, thereby indirectly selecting one or more formats of data, and **then** the user finds an application program to process that format (or formats) of data." However, it is not clear to us where this argued "advantage" is apparent in the language of the instant *claimed* subject matter.

Accordingly, while we understand that the instant *disclosed* subject matter differs from that of the applied reference, appellants have not convinced us of an error in the examiner's finding of anticipation with regard to the instant *claimed* subject matter. Thus, we will sustain the rejection of claims 1-4, 6 and 10-14 under 35 U.S.C. § 102(a).

Since claims 8, 9, 15 and 17-23 stand or fall with claim 1, by appellants' grouping of the claims at pages 3-4 of the brief, we also will sustain the rejection of these claims under 35 U.S.C. § 103.

With regard to claim 7, the examiner contends that IBM teaches the supply of a scanned data format to a software application (referring to page 37, item File format, Export to application) and that this meets the claim limitation of "supplying at least one data format for said scanned data to said

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software application." However, the examiner recognizes that IBM did not specifically teach a software application requesting data formats, and receiving a data format selected by a software application. The examiner contends that this would have been obvious because IBM teaches that if "Export to application" is selected, "one must be sure to *receiving a signal from said software application displayed on said monitor indicating that said software application requests data formats available* choose a file format that an application will accept (ie. Paintbrush will only accept BMP and PCX formats), suggesting the advantage of format compatibility between applications (IBM p.35 paragraph 3...)" (sic) (answer-pages 13-14).

We find ourselves in agreement with appellants that claim 7 specifically requires that the application program selects the data format whereas IBM teaches that a user must select the type of data. The examiner's response is that nothing in claim 7 precludes user interaction to help achieve the claimed limitations, i.e., the selection of a data type. We disagree. The last step in claim 7 clearly calls for "receiving a selected data format, said selected format being selected from said at least one data format *by said software application*" (emphasis ours). Thus, claim 7 does require that the application selects

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the data format while IBM teaches the user selecting the data format. The examiner has made no convincing showing as to why it would have been obvious to modify the teaching of a user-selected data format by making it a software application-selected data format, as claimed. Accordingly, we will not sustain the rejection of claim 7 under 35 U.S.C. § 103.

Similarly, we will not sustain the rejection of claim 16 under 35 U.S.C. § 103 because claim 16 stands with claim 7 and claim 16 also includes the limitation of selecting a region of a document and then selecting an application program that will accept data in a format available from the preselected region.

While appellants group claim 5 in Group I, with claims 1-4, 6, 8-15 and 17-23, appellants do make a separate argument as to claim 5, at page 17 of the brief. Accordingly, we will treat this claim separately.

The examiner's position is that IBM teaches scanning black and white text images (page 29-The Settings Box) but does not teach a scalable vector. The examiner relies on Sobol for a disclosure of black and white data values, with an image being scaled as necessary, referring to column 8, lines 25-30 and 37-42. The examiner says this is equivalent to the claimed "...black and white scalable vector..." and that it would have

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been obvious to apply Sobol to IBM because of Sobol's "taught advantage of scalable vectors, providing the advantage of scaling to IBM" (answer-page 19). The examiner further states that the Windows Metafile Clipboard format is a well known data format for the transfer of data within the software art.

It is appellants' position that Sobol teaches data compression and the ability to compress grayscale data, "which is a totally different concept" (brief-page 17).

Since the examiner points out that column 8, lines 39-42, of Sobol clearly teaches that the compressed data file may also be accessed immediately to "allow the image represented thereby to be scaled and/or rotated as necessary..." and appellants do not respond, we find for the examiner and hold that Sobol does teach that a data type for a region of a document may be a black and white scalable vector, as claimed. In addition, since the examiner has set forth a reasonable basis for making the combination, which is not convincingly rebutted by appellants, we will sustain the rejection of claim 5 under 35 U.S.C. § 103.

We have sustained the rejection of claims 1-4, 6 and 10-14 under 35 U.S.C. § 102(a). We have sustained the rejection of claims 1-6, 8-15, 17-19 and 20-23 under 35 U.S.C. § 103. We have

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not sustained the rejection of claims 7 and 16 under 35 U.S.C.  
§ 103.

Accordingly, the examiner's decision is affirmed-in-part.

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

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