Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte KENJI SUZUKI and HITOSHI ONODA

Appeal No. 2002-2177
Application No. 08/777,424

ON BRIEF

Before THOMAS, DIXON, and BARRY, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claims 1-25. The appellants appeal therefrom under 35 U.S.C. § 134(a). We affirm-in-part.

BACKGROUND

The invention at issue on appeal is an editing device used to lay out and print photographs on a sheet of paper. According to the appellants, prior editing devices used templates to define possible layouts, with photographs being assigned to the different areas of the template. (Appeal Br. at 2.) Varying sizes of photographs,

however, required the preparation of a "huge" number of templates. (Spec. at 8.) The appellants found selecting from such so many templates to be "troublesome." (*Id.*)

In contrast, the appellants' editing device automatically selects a template from a plurality of templates based on data associated with photographs to be laid out. The photographs are laid out according to the template. Based on a user's subsequent input, the device then edits the layout. (Appeal Br. at 2.)

A further understanding of the invention can be achieved by reading the following claim.

1. An image edit device comprising:

> a layout unit for selecting a specific layout example from a plurality of layout examples in accordance with a predetermined criterion, and laying out a plurality of image data using said specific layout example;
>
> a manual input unit; and
>
> a correction unit for correcting at least one of said plurality of image data of said specific layout example selected by said layout unit on the basis of an input from said manual input unit,
>
> wherein the layout unit decides a layout of at least positions of said plurality of image data.

Claims 1-10 and 12-25 stand rejected under 35 U.S.C. § 103(a) as obvious over Japanese Kokai Patent Application No. 3-274047 ("Taniguchi")[1] and *Adobe Photoshop™ User Guide* ("Adobe"). Claim 11 stands rejected under § 103(a) as obvious over Taniguchi and U.S. Patent No. 5,576,836 ("Sano").

OPINION

Our opinion addresses the rejections of the claims in the following order:

- claims 1-10, 17, 20, and 21
- claims 12, 13, 18, and 23
- claims 14, 15, 19, and 24
- claims 16 and 25
- claims 11 and 22.

A. CLAIMS 1-10, 17, 20, AND 21

"[T]o assure separate review by the Board of individual claims within each group of claims subject to a common ground of rejection, an appellant's brief to the Board must contain a clear statement for each rejection: (a) asserting that the patentability of claims within the group of claims subject to this rejection do not stand or fall together, and (b) identifying which individual claim or claims within the group are separately patentable and the reasons why the examiner's rejection should not be sustained." *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) (citing 37 C.F.R. §1.192(c)(7) (2001)). "If the brief fails to meet either requirement, the Board is

[1]A copy of a translation is attached; we will refer to it by page number.

free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim." *Id.*, 63 USPQ2d at 1465.

Here, the appellants stipulate, "the claims can be grouped as follows: Group I - claims 1-7, 17, 20; Group II - claims 8, 9, 10, 21. . . ." (Appeal Br. at 3.) We select claims 1 and 8 from the respective groups as representative of the claims therein.

With this representation in mind, rather than reiterate the positions of the examiner or the appellants *in toto*, we address the following points of contention therebetween:

- correcting image data
- first and second units.

1. Correcting Image Data

Admitting that "Taniguchi *de facto* lacks an explicit recitation of 'correcting at least one of said image data,'" (Examiner's Answer at 7), the examiner asserts, "[i]t would have been obvious . . . to combine the techniques in Photoshop™ with Taniguchi, by reprogramming the console of Taniguchi with algorithms similar to those employed in Photoshop™, in order to center pictures which were off-center (per cropping), and in order to improve color and luminosity in poorly exposed photos." (*Id.*

at 8.) He adds, "[b]oth of these additional features would have had the benefit of vastly improving the quality of the photo album of Taniguchi, and significantly enhanced aesthetic value of Taniguchi's album." (*Id.*) The appellants argue, "[t]he combination of the Taniguchi, et al. patent, the Examiner's general reference to known user interfaces and the Adobe Photoshop™ reference would thus not teach or suggest the invention of claim 1, i.e., would not lead a skilled artisan to a device in which an automatic layout of photographic images occurs and the images of the layout can then be automatically corrected based on a user intention." (Appeal Br. at 13.)

In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the representative claims at issue to determine their scope. Second, we determine whether the construed claim would have been obvious.

a. Claim Construction

"Analysis begins with a key legal question -- *what* is the invention *claimed*?" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "the Board must give claims their broadest reasonable construction. . . ." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000).

Here, claim 1 recites in pertinent part the following limitations: "a layout unit for selecting a specific layout example from a plurality of layout examples in accordance with a predetermined criterion, and laying out a plurality of image data using said specific layout example . . . and a correction unit for correcting at least one of said plurality of image data of said specific layout example selected by said layout unit on the basis of an input from said manual input unit. . . ." Claim 8 includes similar limitations. Giving the representative claims their broadest, reasonable construction, the limitations require laying out image data using a pattern and correcting at least one of the image data based of an intention of a user.

b. Obviousness Determination

Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious. The question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently. . . ." *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697(Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ 1614, 1616 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995)). "'[T]he test [for obviousness] is what the combined teachings of the references would have suggested to those of ordinary skill in the art.'" *Cable Elec. Prods., Inc. v.*

Genmark, Inc., 770 F.2d 1015, 1025, 226 USPQ 881, 886-87 (Fed. Cir. 1985) (quoting *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)).

Here, Taniguchi discloses "an album printing device that lays out and prints photographic images for multiple film frames on printing paper. . . ." P. 2. As explained by the appellants, "[t]he device includes an arrangement pattern memory device in which are stored beforehand multiple arrangement or alignment patterns (templates). . . ." (Appeal Br. at 4.) The device's "reading unit reads information related to the orientation that is stored for each photographic image. An arrangement pattern detecting unit then detects or selects an arrangement or alignment pattern based on the read information." (*Id.*) We find that Taniguchi then lays out the image data constituting the photographs using the selected pattern, and "[t]he image data for the photographs in album form is printed based on the selected pattern (Page 2, lines 1-18; Page 14, lines 9-13)." (*Id.*)

For its part, Adobe "teaches techniques for using the Adobe Photoshop computer program," (*id.* at 5), *inter alia* "to resize and resample images," Adobe, p. 87, col. 1; "to make color corrections to images," p. 121, col. 1; and "to adjust the brightness, contrast, gamma, hue, and saturation in an image. . . ." (*Id.*) We find that Adobe corrects size, color, brightness, etc., based on an intention of a user. A user

who intends to equalize brightness values, for example, chooses the "Equalize command." P. 125, col. 2. Responding to the "command, Adobe Photoshop finds the brightest and darkest values in the image, and averages all the brightness values so that the darkest value represents black . . . and the brightest value represents white." (*Id.*)

Because Taniguchi lays out image data using a pattern, and Adobe corrects image data based of an intention of a user, we are persuaded that the combined teachings of the references would have suggested laying out image data using a pattern and correcting at least one of the image data based of an intention of a user. Therefore, we affirm the rejection of claim 1 and of claims 2-7, 17, and 20, which fall therewith.

2. First and Second Units

The appellants argue, "nothing is taught or suggested in th[e] cited art as to first and second automatic layout units and using the second automatic layout unit to receive a user intention and use same [sic] to correct an automatic layout result of the first automatic unit." (Appeal Br. at 15.) Noting that "[t]he Appellants did not claim that the units be two physically distinct units, nor does it appear that they intended to claim this feature as two physically distinct units," (Examiner's Answer at 29), the examiner

asserts "the combination as applied demonstrates the claimed 'units', because it discloses devices (e.g., controller) for performing the recited function." (*Id.*)

a. Claim Construction

"[L]imitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)). Here, claim 8 recites in pertinent part the following limitations: "said automatic layout unit comprises first and second automatic layout units, said first automatic layout unit includes, in an automatic layout operation thereof, selection of one of a plurality of predetermined standard patterns, and said second automatic layout unit comprises intention input unit for inputting an intention for additionally correcting a layout result of said first automatic layout unit, and correction unit for automatically correcting at least one of said plurality of image data of the layout result on the basis of the input intention. . . ." Contrary to the appellants' argument, the claim does not require correcting "an automatic layout result of the first automatic unit." (Appeal Br. at 15.) Giving the representative claim its broadest, reasonable construction, the limitations merely require that a first unit lay out image data using a pattern and a second unit correct at least one of the image data based of an intention of a user.

b. Obviousness Determination

As explained regarding the first point of contention, we have found that Taniguchi lays out image data using a pattern. Figure 1 of Taniguchi shows the components of its album printing device. We now find that those components that lay out the image data using a pattern constitute a first unit.

As also explained regarding the first point of contention, we have found that Adobe corrects image data based of an intention of a user. The appellants admit that Adobe "teaches . . . the Adobe Photoshop computer program. . . ." (Appeal Br. at 5.) We now find that the Adobe Photoshop computer program constitutes a second unit.

Because Taniguchi teaches a first unit to lay out image data using a pattern, and Adobe teaches a second unit to correct image data based of an intention of a user, we are persuaded that the combined teachings of the references would have suggested a first unit lay out image data using a pattern and a second unit correcting at least one of the image data based of an intention of a user. Therefore, we affirm the rejection of claim 8 and of claims 9, 10, and 21, which fall therewith.

B. CLAIMS 12, 13, 18, AND 23

The examiner admits, "Taniguchi fails to demonstrate 'wherein said display unit comprises a first display portion for displaying said plurality of input image data, a second display portion for displaying layout images laid out by said automatic layout unit, and a third display portion for expressing the intention input by said intention input unit, and concurrently performs display operations of said first to third display portions.'" (Examiner's Answer at 15.) Taking official notice "that it was notoriously well known in the art of compound document creation and or [sic] desktop publishing (e.g., text and pictures,), to have an image selection display portion, a composite image display portion, and intention input unit, for modifying compound document, particularly in a multi-window environment," (*id.*), the examiner asserts "[i]t would have been obvious . . . to . . . modify[] the device of Taniguchi to display these regions in order to facilitate selection of images to be replacements in a template." (*Id.*) The appellants argue, "the generic interfaces alluded to by the Examiner would not be enough to suggest use of the specifically claimed display unit in the system of the Taniguchi, et al. reference." (Reply Br. at 10.)

1. Claim Construction

Claim 12 recites in pertinent part the following limitations: "[a]n image edit apparatus comprising . . . a display unit . . . wherein said display unit comprises a first

display portion for displaying said plurality of input image data, a second display portion for displaying layout images laid out by said automatic layout unit, and a third display portion for expressing the intention input by said intention input unit, and concurrently performs display operations of said first to third display portions. . . ." Giving the claim its broadest, reasonable construction, the limitations require that an image editing device concurrently display a window showing image data inputted to the device, a window showing images as laid out by an automatic layout unit of the device, and a window allowing a user to input data reflecting his intentions.

2. Obviousness Determination

"In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "'A *prima facie* case of obviousness is established when the teachings from the prior art itself would . . . have suggested the claimed subject matter to a person of ordinary skill in the art.'" *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, we do not contest that displaying multiple windows was well known. Displaying an image selection window, a composite image window, and an intention input unit may also have been well known. Regardless, we are unpersuaded such knowledge would have suggested displaying a window showing images as laid out by Taniguchi's album printing device concurrent with a window showing image data inputted to the device and a window allowing a user to input data reflecting his intentions. The examiner does not allege, let alone show, that the addition of Adobe cures the aforementioned deficiency of Taniguchi. Absent a teaching or suggestion that an image editing device concurrently display a window showing image data inputted to the device, a window showing images as laid out by an automatic layout unit of the device, and a window allowing a user to input data reflecting his intentions, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the obviousness rejection of claim 12 and of claims 13, 18, and 23, which fall therewith.

C. CLAIMS 14, 15, 19, AND 24

Admitting that "Taniguchi *de facto* lacks an explicit recitation of 'correcting at least one of said image data,'" (Examiner's Answer at 7), the examiner asserts, "Adobe Photoshop explicitly demonstrates correction for digital pictures, and color correction for montages is *implied*, e.g., the multi-picture layouts such as Taniguchi et al. Therefore, the combination suggests a user input for correcting some and 'all' of the pictures."

(Examiner's Answer at 31.) The appellants make the following argument.

> [T]he Examiner has completely failed to address the limitations in claim 14 which require ["]a *display unit* having a *first correction intention input display displayed for only a specified one or some of said plurality of different image data* in the *vicinity of the specified image or images*, and a *second correction intention input display displayed for all the images*, wherein the automatic layout unit decides a layout of at least positions of said plurality of image data."

(Reply Br. at 10-11.)

1. Claim Construction

Claim 14 recites in pertinent part the following limitations: "[a]n image edit device comprising . . . a display unit having a first correction intention input display displayed for only a specified one or some of said plurality of different image data in the vicinity of the specified image or images, and a second correction intention input display displayed for all the images. . . ." Giving the claim its broadest, reasonable construction, the limitations require that an image editing device concurrently display a window allowing a user to input data for correcting all of images inputted to the device and a window near a subset of the images allowing a user to input data for correcting the subset.

2. Obviousness Determination

We do not contest that Adobe displays a window allowing a user to input data correcting **one** image. For example, a "Threshold dialog box . . . display[s] a histogram of the luminance levels of the pixels in the current selection." P. 126. A user can "[d]rag the slider below the histogram until the threshold level [he] want[s] appears at the top of the dialog box. As [he] drag[s], the image changes to reflect the new threshold setting." *Id.* We are unpersauded, however, that Adobe also displays a dialog box allowing a user to input data for correcting all images inputted.

Absent a teaching or suggestion that an image editing device display a window allowing a user to input data for correcting all images inputted to the device and a window near a subset of the images allowing a user to input data for correcting the subset, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the obviousness rejection of claim 14 and of claims 15, 19, and 24, which fall therewith.

D. CLAIMS 16 AND 25

Taking official notice "that multi-tasking was notoriously well-known," (Examiner's Answer at 18), the examiner asserts [i]t would have been obvious . . . to perform editing steps in Taniguchi during the sequential input operation element 21, Fig. 1, in order to save time by adding sufficient memory to perform these operations simultaneously."

(*Id.*) The appellants argue that the examiner "does not address the specific features of claim 16 which recites 'wherein said intention unit and correction means can operate during the sequential input operation of the digital data of the images.'" (Reply Br. at 11.)

1. Claim Construction

Claim 16 recites in pertinent part the following limitations: "[a]n image edit device . . . wherein said intention input unit and correction means can operate during the sequential input operation of the digital data of the images . . . ." Giving the claim its broadest, reasonable construction, the limitations require that an image editing device concurrently display a window allowing a user to input data for correcting an automatically generated layout of images, correct at least one of the images of the layout, and sequentially input digital data representing a plurality of different images.

2. Obviousness Determination

Here, we do not contest that multitasking was well known. We are unpersauded, however, that such knowledge would have suggested concurrently displaying a window allowing a user to input data for correcting an automatically generated layout of images, correcting at least one of the images of the layout, and sequentially inputting digital data

representing a plurality of different images. The examiner does not allege, let alone show, that the addition of Adobe cures the implicit deficiency of Taniguchi. Absent a teaching or suggestion that an image editing device concurrently displays a window allowing a user to input data for correcting an automatically generated layout of images, corrects at least one of the images of the layout, and sequentially inputs digital data representing a plurality of different images, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the obviousness rejection of claim 16 and of claim 25, which falls therewith.

E. CLAIMS 11 AND 22

Under 37 C.F.R. § 1.196(b) (2003), we enter a new ground of rejection against claims 11 and 22. The second paragraph of 35 U.S.C. § 112 requires that a specification conclude "with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." "The test for definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification." *Orthokinetics Inc., v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986).

Here, claim 11 recites in pertinent part the following limitations: "said automatic layout unit includes, in an automatic layout operation thereof, selection of one of a

plurality of predetermined standard patterns, comprises intention input unit for inputting an intention for additionally correcting at least one of said plurality of layout image data of a layout result, and can re-select another one of said plurality of predetermined standard patterns on the basis of the intention input by said intention input unit. . . ." These limitations leave us in a quandary what the claim specifies for four reasons.

First, we fail to grasp how the claimed "automatic layout unit" can "include" a step of "selection of one of a plurality of predetermined standard patterns." Second, we are uncertain which claimed element "comprises" the claimed "intention input unit." Third, the relationship, if any, between the "said plurality of different image data" laid out by the "automatic layout . . . in accordance with a predetermined criterion" and "said plurality of layout image data of a layout result" escapes us. Fourth, we are uncertain which claimed element "can re-select another one of said plurality of predetermined standard patterns on the basis of the intention input by said intention input unit."

Accordingly, we are unpersauded that one skilled in the art would understand the bounds of the claims when read in light of the specification. Therefore, we reject claim 11 and claim 22, which depends therefrom under 35 U.S.C. § 112, ¶ 2.

A rejection under 35 U.S.C. 103(a) should not be based on "speculations and assumptions." *In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). "All words in a claim must be considered in judging the patentability of that claim against the prior art. If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious -- the claim becomes indefinite." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Here, for the aforementioned reasons, speculations and assumptions would be required to decide the meaning of the terms employed in claims 11 and 22 and the scope of the claims.

Furthermore, the examiner's treatment of claims 11 and 22 puzzles us. Specifically, he rejects claim 11 as obvious over Taniguchi and Sano. (Examiner's Answer at 20.) Although claim 22 depends from claim 11, the examiner excludes Sano from its rejection as obvious over Taniguchi and Adobe. (*Id.* at 20.) Therefore, we reverse *pro forma* the rejections of the claims 11 and 22 as obvious. We emphasize that our reversal is based on procedure rather than on the merits of the obviousness rejection. The reversal does not mean that we consider the claims to be patentable *vel non* as presently drafted.

CONCLUSION

In summary, the rejection of claims 1-10, 17, 20, and 21 under § 103(a) is affirmed. The rejections of claims 11-16, 18, 19, and 22-25 under § 103(a), however, are reversed. "Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences. . . ." 37 C.F.R. § 1.192(a). Accordingly, our affirmance is based only on the arguments made in the briefs. Any arguments or authorities not included therein are neither before us nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.")

A new rejection of claims 11 and 22 under § 112, ¶ 2, is added. 37 C.F.R. § 1.196(b) (2003) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review." It also includes the following provisions.

> [T]he appellant, withing two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:
>
> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

JAMES D. THOMAS Administrative Patent Judge	)
JOSEPH L. DIXON Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
LANCE LEONARD BARRY Administrative Patent Judge	)

ROBIN BLECKER & DALEY
2ND FLOOR
330 MADISON AVENUE
NEW YORK, NY 10017