The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIC C. ANDERSON, JOHN F. PAVLEY, and BRUCE W. SOUTHWICK

Appeal No. 2003-0288
Application No. 09/107,920

ON BRIEF

Before HAIRSTON, JERRY SMITH, and FLEMING, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal of claims 1, 3, 4, 6, 8, 10, 11, 13, 15 and 17 through 28.

The disclosed invention relates to a method and system for applying a template to an image on a printer based upon a plurality of tags in a template file. The plurality of tags provides instructions for the application of a plurality of plane files to the image.

Claim 1 is illustrative of the claimed invention, and it reads as follows:

> 1. A method for applying a template to an image on a printer, comprising the steps of:
>
> (a) storing the template in a template file, the template file comprising a plurality of tags, wherein the plurality of tags provides instructions for the application of a plurality of plane files to the image and instructions for automating a process of shaping the image or the template in order to fit them together properly in a print area; and
>
> (b) applying the template to the image based on the instructions in the tags, wherein the instructions comprise:
>
> (b1) automatically rendering a first plane of the image,
>
> (b2) automatically rendering a second plane of the image and combining the second plane with the first plane, and
>
> (b3) automatically rending [sic, rendering] a third plane of the image and combining the third plane with the combined first and second planes.

The references relied on by the examiner are:

Gentile	5,544,290	Aug. 6, 1996
Matsuo	5,838,333	Nov. 17, 1998 (filed Feb. 28, 1996)
Cyman, Jr. et al. (Cyman)	5,845,302	Dec. 1, 1998 (filed Dec. 29, 1995)
Maruyama et al. (Maruyama)	5,892,534	Apr. 6, 1999 (filed Sep. 30, 1996)
King et al. (King)	5,956,737	Sep. 21, 1999 (filed Sep. 9, 1996)
Edmunds	6,006,281	Dec. 21, 1999 (filed Jan. 8, 1998)

Claims 1, 3, 4, 18 and 23 through 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cyman in view of Maruyama.

Claims 8, 10 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cyman in view of Maruyama and Edmunds.

Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cyman in view of Maruyama and Matsuo.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cyman in view of Maruyama and Gentile.

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cyman in view of Maruyama, Edmunds and Gentile

Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cyman in view of Maruyama, Matsuo and Gentile.

Claims 19 through 22[1] stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cyman in view of Maruyama and King.

[1] Although claim 22 is not among the listed claims (paper number 21, page 15), it is discussed in the statement of the rejection (paper number 21, page 17).

Reference is made to the last Office Action in the record (paper number 21), the brief (paper number 23) and the answer (paper number 24) for the respective positions of the appellants and the examiner.

OPINION

We have carefully considered the entire record before us, and we will reverse the 35 U.S.C. § 103(a) rejection of claims 1, 3, 4, 6, 8, 10, 11, 13, 15 and 17 through 28.

With respect to independent claims 1 and 18, the examiner is of the opinion (paper number 21, page 4) that Cyman discloses all of the limitations of these claims except for specifically stating that "the tags include instructions for automating a process of shaping the image or template in order to fit them together properly in a print area." For such a teaching, the examiner turns to Maruyama (paper number 21, pages 4 and 5), and concludes that "[i]t would have been obvious to one of ordinary skill in the art to utilize the teachings of Cyman to [sic, in] combination with the key information template instructions of Maruyama to allow for a control means to change or modify the picture data so as to correspond to the shape data included in the key information that corresponds to the requirements of the user selected template." The examiner states (paper number 21,

page 5) that the rejection involves "reading each picture data selected by the user as a separate plane" in Maruyama.

Appellants argue (brief, page 16 and 17) that:

> Cyman in view of Maruyama and the present invention may result in the same final image, as seen by the user, however, the final image[s] are created in a significantly different manner.
>
> Because Cyman in view of Maruyama do not teach multiple planes, they also do not teach the storing of the template in a template file with each *plane* in separate plane files. Similarly, they also do not teach the automatic rendering of these multiple planes.

We agree with the appellants' arguments. Cyman discloses "data files of exemplary templates" 112 (Figure 1; column 6, lines 32 through 34), and tags that serve as "tools to position the variable information (text, graphics or images) from the data tape and other memory sources onto the page layouts of a document" (column 3, lines 16 through 18), however, such templates and tags are not "instructions for the application of a plurality of plane files to the image and instructions for automating a process of shaping the image or the template in order to fit them together properly in a print area" as set forth in the claims on appeal. Cyman does not apply the template to an image based on the instructions in the tags to automatically render a first plane of the image, a second plane of the image

that is combined with the first plane, and a third plane of the image that is combined with the first and second planes as claimed. Maruyama's teachings of inserting picture data into an insertion pattern or template (column 23, line 46 through column 24, line 50) are equally inapplicable to the claimed steps of applying the template to the image to automatically render first, second and third planes of the image. Thus, the 35 U.S.C. § 103(a) rejection of independent claims 1 and 18, and dependent claims 3, 4 and 23 through 28 is reversed.

The 35 U.S.C. § 103(a) rejection of independent claim 8 and dependent claims 10 and 11 is reversed because the printer with template software teachings of Edmunds (column 9, line 65 through column 10, line 5) do not cure the noted shortcomings in the teachings of Cyman and Maruyama.

The 35 U.S.C. § 103(a) rejection of independent claim 15 is reversed because even if the tagged foreground color area and the tagged background color area in Matsuo (Figure 16; column 14, lines 37 through 55) are treated as two planes, the combined teachings of the references would still lack the claimed third image plane.

The 35 U.S.C. § 103(a) rejection of dependent claim 6 is reversed because the graphical processing teachings of Gentile do not cure the noted shortcomings in the teachings of Cyman and Maruyama.

For all of the reasons expressed supra in connection with independent claim 8, and dependent claim 6, the 35 U.S.C. § 103(a) rejection of dependent claim 13 is reversed.

For all of the reasons expressed supra in connection with independent claim 15, and dependent claim 6, the 35 U.S.C. § 103(a) rejection of dependent claim 17 is reversed.

The 35 U.S.C. § 103(a) rejection of dependent claims 19 through 22 is reversed because the teachings of King do not cure the noted shortcomings in the teachings of Cyman and Maruyama.

DECISION

The decision of the examiner rejecting claims 1, 3, 4, 6, 8, 10, 11, 13, 15 and 17 through 28 under 35 U.S.C. § 103(a) is reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)	
JERRY SMITH Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
MICHAEL R. FLEMING Administrative Patent Judge	)	

KWH:hh

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