

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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES C. ZANDEE

Appeal No. 1998-0626
Application No. 08/593,114

ON BRIEF

Before KRASS, HECKER and LALL, ***Administrative Patent Judges.***

HECKER, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 5 through 7, all claims pending in this application.

The invention relates to a method of producing graphic images. The current state of a graphics environment is specified by a collection of information fields and is modified at times by an image source. A record is maintained of a previous state of the graphics environment, and the current state of the graphics environment is compared to the

previous state. If any information fields have changed, a current value of each changed information field is recorded in a uniquely identifiable location. The current state is then recorded using a record specifying the current values of each changed information field by reference to the uniquely identifiable location. Image capture is thereby accomplished. (Specification page 4, line 28 to page 5, line 13.)

Independent claims 5 is reproduced as follows:

5. Using a computer having a memory system, a method for use in producing a graphic image using a set of graphics primitives each of which is executed in accordance with a current state of a graphics environment at a time when a command invoking the graphics primitive was received, the current state of the graphics environment including a plurality of state elements and being changed at times by an image source, the method comprising the steps of:

each time a state element has changed from when a previous command involving a graphics primitive was received to when a current command involving a graphics primitive was received:

saving in the memory system an instance of that state element containing current information for that state element;
and

saving in the memory system a graphics state object including for each of said plurality of state elements a pointer to a most recently saved instance of that state element;

wherein each graphics state object includes a pointer to only one instance of a given state element, and at least some

Appeal No. 1998-0626
Application No. 08/593,114

instances of state elements are pointed to by multiple graphics state objects.

The Examiner relies on the following references:

Doyle et al. (Doyle)	5,097,411	Mar. 17, 1992
Epard et al. (Epard)	5,241,625	Aug. 31, 1993
Zimmerman 1981	EPO 0 027 566	Apr. 29,

Claims 5 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Doyle in view of Zimmerman.

Claim 7 stands rejected under 35 U.S.C. § 103 as being unpatentable over Doyle and Zimmerman, and further in view of Epard.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the brief and answer for the respective details thereof.

OPINION

After a careful review of the evidence before us, we will not sustain the rejection of claims 5 through 7 under 35 U.S.C.

Appeal No. 1998-0626
Application No. 08/593,114

§ 103.

The Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." *Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) (*citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

With regard to claim 5, the Examiner reasons that Doyle teaches the claimed invention but does not explicitly teach pointing to the most recently saved state element. The Examiner notes that Zimmerman,

Appeal No. 1998-0626
Application No. 08/593,114

suggests that it is well known in the art to point to the recently saved element (or element to be changed)(abstract, lines 8-15, [i.e.], the pointers can be used to indicate changes to a selected group of elements or to modify only to a selected element (character image)). It would have been obvious to one of ordinary skill in the art to provide the graphics data structure of Doyle et al. with the means to point to the current saved element as taught by Zimmerman, in order to reduce the number of location[s] where changes have to be made and reducing the amount of memory needed to store[] the changes in state elements, by only recording the changes in the state elements of the state elements being modif[ied]. [Answer-pages 4 and 5.]
We note that claim 5 recites:

saving in the memory system a graphics state object including for each of said plurality of state elements **a pointer to a most recently saved instance of that state element;** [emphasis added]

Although the Examiner contends this is suggested by Zimmerman in the abstract, we can find no such suggestion of a **most recently saved state element** or something equivalent thereto.

On pages 5 through 7 of the brief, Appellant argues that Doyle fails to disclose several of the elements recited in claim 5. For example, Appellant argues Doyle is "composed of various nodes that are linked together by pointers" (brief-page 5), and that a "reference node" may point to multiple other nodes. "Nevertheless a reference node is not the same

Appeal No. 1998-0626
Application No. 08/593,114

as a graphics state object, as recited in Claim 5." (Brief-
page 6.)

The Examiner responds that "one cannot show non-
obviousness by attacking references individually" (answer-page
7), and that Doyle teaches saving state elements at "(page 22,
lines 12 thru page 26 . . .)." ¹

¹ We assume "page" means "column".

Appeal No. 1998-0626
Application No. 08/593,114

We find Appellant's argument appropriate. Appellant's argument that Doyle does not disclose a claimed element, is not a "non-obviousness" showing "by attacking references individually, as alleged by the Examiner." Furthermore, the Examiner has still not shown that the node structures of Doyle meet the claimed saved state elements.

One must first have a prior art disclosure of the required elements before one can consider the propriety of a combination. Since the Examiner has not shown where the cited references disclose the limitations of claim 5, we cannot proceed to the question of motivation to combine the references.

In view of the foregoing, since the prior art has not been shown to teach or suggest the limitations of claims 5, we will not sustain the Examiner's rejection of claim 5.

The remaining claims on appeal also contain the above limitations discussed in regard to claim 5 and thereby, we will not sustain the rejection as to these claims.

Appeal No. 1998-0626
Application No. 08/593,114

We have not sustained the rejection of claims 5 through 7 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	
)	
)	BOARD OF PATENT
STUART N. HECKER)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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PARSHOTAM S. LALL)	
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Appeal No. 1998-0626
Application No. 08/593,114

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Appeal No. 1998-0626
Application No. 08/593,114