

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT M. COLEMAN

Appeal No. 1998-2683
Application 08/579,386

ON BRIEF

Before JERRY SMITH, HECKER and LEVY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-19, 32 and 33. Pending claims 20-31 have been indicated to contain allowable subject matter.

The disclosed invention pertains to a method and apparatus for determining whether an area to be printed in black should be printed using a black colorant (color black)

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or process black. The invention makes a pixel by pixel determination based on a background color assigned for each pixel.

Representative claim 1 is reproduced as follows:

1. In a system which uses electronic signals to specify black and non black colorants to be used in a printing process to print a black area over a background area, a method for determining colorants to be used to print said black area comprising the steps of:

testing said signals to determine if the background is to be printed using a non black colorant,

if a non black colorant is to be used to print the background, generate a signal specifying that said black color will be printed using a first black color,

if no non black colorants are used to print the background, generate a signal specifying that said black color will be printed using a second black color, and

printing said black area.

The examiner relies on the following references:

Nickell et al. (Nickell)	5,113,356	May 12, 1992
Vaughn et al. (Vaughn)	5,475,800	Dec. 12, 1995

The admitted prior art described in appellant's specification.

Claims 1-19, 32 and 33 stand rejected under 35 U.S.C.

§ 103. As evidence of obviousness the examiner offers the admitted prior art in view of Vaughn with respect to claims 1-7, 32 and 33, and the examiner adds Nickell with respect to

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claims 8-19.

Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-19, 32 and 33. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine,

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837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument

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and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Passaic, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

With respect to the rejection of claims 1-7, 32 and 33, the examiner refers to the admitted prior art but admits that the admitted prior art "does not teach selection between generating a black color containing a non black colorant and generating a black color that does not contain a non black colorant (i.e., the black color is true black), depending on whether the background is to be printed with color containing a black colorant" [answer, page 4]. The examiner cites Vaughn as teaching the concept of determining whether a black pixel should be printed using a black colorant or process black. The examiner simply asserts the obviousness of the claimed

invention based on these teachings [id.].

Appellant argues that the examiner has misunderstood what is described and claimed when a background color of a pixel is referred to. Appellant also argues that Vaughn teaches the use of process black or color black based on the state of neighboring pixels, and appellant argues that the test in Vaughn is not the same test as the claimed test and that the Vaughn test produces different results from the claimed invention [brief, pages 4-6]. The examiner responds that the Vaughn test and the claimed invention are "closely related," and the background color of the claimed invention is "interpreted to mean[s] the background pixel(s) under test includes a neighboring pixel(s) which is also used by Vaughn et al." [answer, page 7].

We agree with the position argued by appellant. Although Vaughn and the claimed invention each determines whether a pixel to be printed in black should be printed using color black or process black, Vaughn uses a different test to make this determination, and the result of Vaughn's test does not produce the same results as the claimed invention for all pixels. Specifically, Vaughn and the claimed invention would

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produce different results at points where the background color changes from a color background to a white background. In the claimed invention, a black pixel over the color background would be printed in process black while the black pixel over the adjacent white background would be printed in color black. In Vaughn both of these pixels would be printed in process black because a color black pixel in Vaughn will not be printed next to a neighboring background color. Thus, the specific test recited in the claimed invention produces a different result from the test taught by Vaughn.

Vaughn also does not suggest the specific test of the claimed invention within the meaning of 35 U.S.C. § 103 because the test in Vaughn actually teaches away from the claimed invention. That is, since the claimed invention results in some black pixels being printed in color black which Vaughn teaches should not be printed in color black, Vaughn would not have suggested a test producing the results of the claimed invention. Therefore, we do not sustain the rejection of claims 1-7, 32 and 33 based on the admitted prior art and Vaughn.

With respect to the rejection of claims 8-19, the

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examiner relies on the admitted prior art and Vaughn as discussed above. Nickell is additionally cited for its teachings of the use of a page description language (PDL). Since the collective teachings of the admitted prior art are deficient as discussed above, and since Nickell does not overcome these deficiencies, we also do not sustain the rejection of claims 8-19 based on the admitted prior art, Vaughn and Nickell.

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In summary, we have not sustained either of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-19, 32 and 33 is reversed.

REVERSED

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JERRY SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
STUART N. HECKER)	
Administrative Patent Judge)	APPEALS AND
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STUART S. LEVY))
Administrative Patent Judge)	

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