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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* TREVOR SIMMONDS, GORDON REYNEN, and DAVID  
EVANS

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Appeal 2011-000014  
Application 12/407,037  
Technology Center 2600

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Before JOSEPH F. RUGGIERO, DENISE M. POTHIER, and JAMES B.  
ARPIN, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-9, 11-14, and 19-21, which are all of the pending claims (App. Br. 2). Claims 10 and 15-18 have been canceled. An oral hearing was conducted on this appeal on January 15, 2013. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Rather than reiterate the arguments of Appellants and the Examiner, we refer to the Appeal Brief (filed June 15, 2010), the Answer (mailed July 2, 2010), and the Reply Brief (filed Sept. 1, 2010). We have considered in this decision only those arguments Appellants actually raised in the Briefs. Any other arguments, which Appellants could have made, but chose not to make, in the Briefs, are deemed to be waived. *See* 37 C.F.R. §41.37(c)(1)(iv).

### *Appellants' Invention*

Appellants' invention relates to a method for printing an electronic image including a plurality of pixels onto a substrate using a computer-assisted image processing system. Alpha channel information is used in combination with substrate color information to calculate the transparency level that needs to be applied to each pixel. *See generally* Spec. ¶ 0014.

Claims 1 and 19 are illustrative of the invention and read as follows:

1. A method of printing an electronic image comprising a plurality of pixels onto a substrate using a computer-assisted image processing system, said method comprising using alpha channel information in combination with substrate color information to calculate a transparency level that needs to be applied to each pixel to produce an underbase that is printed on the substrate, wherein the transparency level ranges from 0 percent to 100 percent.

19. A method of printing an image on a substrate, comprising:  
using alpha channel information to calculate a transparency level for producing an underbase that is printed on the substrate; and  
printing the underbase that was calculated with the alpha channel information on the substrate which is a different color than the substrate, wherein:

the color of the substrate forms a portion of the image to be printed, and the underbase is printed over and makes no part of the image to be printed.

*The Examiner's Rejections*

The Examiner's Answer cites the following prior art references:

Barmettler	US 6,738,071 B2	May 18, 2004
Ellis	US 2007/0067928 A1	Mar. 29, 2007
Elwakil	US 2007/0188535 A1	Aug. 16, 2007

Claims 1-6, 9, 11, 13, and 14 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Barmettler in view of Ellis.

Claims 7 and 8 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Barmettler in view of Ellis and Elwakil.

Claims 12 and 19-21 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Ellis in view of Barmettler.

ANALYSIS

*Claims 1-6, 9, 11, 13, and 14*

Appellants argue, with respect to the obviousness rejection of independent claim 1, that the Examiner has not provided a proper basis for the proposed combination of Barmettler and Ellis. Initially, Appellants contend, and rely upon the 37 C.F.R. § 1.132 (Rule 132) Fresener declaration for support, that the Examiner erred in relying upon the alpha channel information teachings of Barmettler. According to Appellants, the alpha channel information described by Barmettler is strictly for *display* purposes, not for *printing* as claimed (App. Br. 7-13; Reply Br. 10-12). In

Appellants' view, therefore, the ordinarily skilled artisan would not have contemplated combining Barmettler with the substrate printing teachings of Ellis to arrive at the claimed invention (App. Br. 13).

Appellants' arguments are not persuasive. We find that ample evidence exists within the disclosure of Barmettler to support the Examiner's stated position (Ans. 3, 4, 19, and 20). As described by Barmettler, alpha channel information along with background color information contributes to the final image which is "displayed on the monitor or *printer*."<sup>1</sup> (Barmettler, col. 3, l. 62 to col. 4, l. 15 (emphasis added)). Barmettler further discloses (col. 3, ll. 3-4) that RGB information read out of memory can be displayed or *printed*, while Figure 7, and the accompanying description beginning at column 4, line 46, discloses a "*printer* that uses the processes of the present invention." (Emphasis added).

Further, we find that the Examiner has provided an articulated line of reasoning with a rational underpinning to support the conclusion of obviousness for the proposed combination of Barmettler and Ellis. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). We agree with the Examiner (Ans. 4 and 16) that, while Barmettler does not explicitly disclose that the "background" upon which the final image, i.e., the underbase, is printed is a substrate, an ordinarily skilled artisan would have recognized and appreciated the obviousness of printing an underbase on a substrate in view of the teachings of Ellis.

We are not persuaded by Appellants' further contention that Ellis has no teaching or suggestion of using alpha channel information to produce an

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<sup>1</sup> The Examiner's stated position interprets the "final image" to be printed in Barmettler as corresponding to the claimed "underbase." (Ans. 3).

underbase and, therefore, does not overcome this alleged deficiency of Barmettler. (App. Br. 13-16; Reply Br. 7-12.) As pointed out by the Examiner (Ans. 23); however, it is Barmettler, not Ellis, which is relied upon for a teaching of using alpha channel information to produce a printed underbase. Similarly, while Appellants contend (Reply Br. 8-10) that Barmettler does not disclose using substrate color information to calculate a transparency level since Barmettler does not disclose a substrate, the Examiner relies upon Ellis, not Barmettler, for a substrate teaching.

Further, as we noted above, Appellants' arguments challenging the Examiner's proposed combination of Barmettler and Ellis rely heavily upon the expert testimony presented in the Fresener declaration. As summarized by Appellants (App. Br. 12; Reply Br. 11), Mr. Fresener concludes that any transparency information that uses alpha channel information in Barmettler would be flattened during the printing process and, therefore, Barmettler's alpha channel information is used strictly for display purposes, not for printing (*see* Fresener Decl. ¶¶ 20-21).

We agree with the Examiner's ultimate conclusion, however, that the evidence presented in the Fresener declaration is not persuasive when balanced against the explicit and unambiguous disclosure in Barmettler that alpha channel and background information contribute to the final image, i.e., the underbase, which is printed (col. 3, l. 62 to col. 4, l. 15).<sup>2</sup>

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<sup>2</sup> The Examiner's comments in the Answer suggest the untimeliness of the filing of the Fresener declaration (Ans. 17-18). As noted by Appellants, however, evidence presented in the Advisory action (mailed May 3, 2010) indicates that the Examiner has entered the Fresener declaration into the record and has in fact considered the merits of the declaration.

We further recognize that Appellants, for the first time in the Reply Brief, has presented arguments contending that the Examiner erred in equating the “final image” in Barmettler with the claimed “underbase.” According to Appellants, the Examiner’s position is inconsistent with the meaning provided to the term “underbase” in Appellants’ Specification, as well as being inconsistent with the ordinary meaning of the term, i.e., an underbase is applied prior to applying the final image which is printed on the underbase (Reply Br. 3-8).<sup>3</sup> Since this issue was raised for the first time on appeal in the Reply Brief, it is, therefore, deemed to be waived. *See Ex parte Borden*, 93 USPQ2d 1473, 1473-74 (BPAI 2010) (“informative”<sup>4</sup>) (absent a showing of good cause, the Board is not required to address an argument newly presented in the Reply Brief that could have been presented in the principal Brief on Appeal).

For the above reasons, the Examiner’s § 103(a) rejection of independent claim 1, as well as of dependent claims 2-6, 9, 11, 13, and 14 not separately argued by Appellants, is sustained.

#### *Claims 7 and 8*

We also sustain the Examiner’s obviousness rejection of dependent claims 7 and 8, in which Elwakil is applied to the combination of Barmettler and Ellis to teach or suggest the translucent/transparent substrate features of the rejected claims. Appellants (App. Br. 16) rely upon arguments asserted

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<sup>3</sup> The Examiner has taken the position equating Barmettler’s “final image” with the claimed “underbase” at least as far back as the Final Office action (mailed Nov. 25, 2009).

<sup>4</sup> Designated as “Informative Opinion” at <http://www.uspto.gov/ip/boards/bpai/decisions/inform/index.jsp>.

against the rejection of independent claim 1, which arguments we find unpersuasive as discussed *supra*.

*Claims 12 and 19-21*

We also sustain the Examiner's obviousness rejection of independent claim 19, and its dependent claims 12, 20, and 21, based on the combination of Ellis and Barmettler. Independent claim 19 differs from previously discussed independent claim 1 by including a recitation that the underbase is printed over and "makes no part of the image to be printed." In addressing this claimed feature, the Examiner proposes the same Barmettler/Ellis combination as applied against independent claim 1, but relies on Ellis as the primary reference.

Appellants argue that, in contrast to the claimed invention, Ellis discloses that the underbase forms part of the final printed image and cites paragraphs 0013, 0014, and 0103 of Ellis in support (App. Br. 17-19). We do not agree with Appellants. We find that the embodiment disclosed in paragraph 0103 of Ellis, in particular, supports the Examiner's determination (Ans. 25) that the underbase is printed over by a color and forms no part of the printed image. As described by Ellis, the white ink underbase is printed onto the substrate, and the final image is printed "at least" over the underprint portion of the substrate (§ 0103, ll. 1-4). While paragraph 0014 of Ellis suggests an embodiment in which the white underlayer "may extend" beyond the dimensions of the printed image, this does not contradict the explicit teachings of the embodiment of paragraph 0103, which discloses the complete overprinting of the underbase.

Appellants' arguments with respect to Barmettler, including a reliance on the Fresener declaration, reiterate those asserted against the rejection of claim 1 (App. Br. 19-24; Reply Br. 10-12). As previously discussed, we find these arguments unpersuasive.

#### CONCLUSION OF LAW

We conclude that the Examiner did not err in rejecting claims 1-9, 11-14, and 19-21 under § 103(a).

#### DECISION

We affirm the Examiner's decision rejecting claims 1-9, 11-14, and 19-21 under § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2010).

AFFIRMED

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