UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Ex parte UDAY K. CHOLLETI, SRINIVAS JANDHYALA, and
BALUNAINI PRASAD

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Appeal 2018–005197
Application 14/307,567[1]
Technology Center 2100

_____

Before ROBERT E. NAPPI, CATHERINE SHIANG, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

SHIANG, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's
rejection of claims 15–26, which are all the claims pending and rejected in
the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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[1] Appellants identify International Business Machines Corporation as the
real party in interest. App. Br. 1.

STATEMENT OF THE CASE

Introduction

According to the Specification, the present invention relates to "enterprise content management (ECM), and more specifically, to document processing in ECM." Spec. ¶ 2. Claim 15 is exemplary:

> 15. A computer implemented method for content management system comprising:
> masking, by a processor, a first region of an image document based on a preference data, wherein the preference data is stored in a document object associated with the image document; and
> enhancing, by the processor, a second region of the image document based on the preference data, wherein the preference data comprises a filter, the filter identifying a subset of pixels within the second region and adjustment values indicating an amount by which to adjust a value of each pixel among the subset of pixels, wherein enhancing the second region comprises adjusting the value of each pixel among the subset of pixels by the amount indicated by the adjustment values provided by the filter.

References and Rejections[2]

Claims 15 and 17–21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cohen (US 2007/0263865 A1; published Nov. 15, 2007) and Gupta (US 6,204,858 B1; issued Mar. 20, 2001). Final Act. 6–10.

Claims 16, 22, 24, and 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cohen, Gupta, and Athsani (US 2010/0082677 A1; published Apr. 1, 2010). Final Act. 10–15.

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[2] Throughout this opinion, we refer to the (1) Final Rejection dated July 31, 2017 ("Final Act."); (2) Appeal Brief dated December 11, 2017 ("App. Br."); (3) Examiner's Answer dated February 16, 2018 ("Ans."); and (4) Reply Brief dated April 11, 2018 ("Reply Br.").

Claims 23 and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cohen, Gupta, and Yamanaka (US 7,324,673 B1; issued Jan. 29, 2008). Final Act. 15–17.

ANALYSIS

We disagree with Appellants' arguments, and agree with and adopt the Examiner's findings and conclusions in (i) the action from which this appeal is taken and (ii) the Answer to the extent they are consistent with our analysis below.[3]

Obviousness

On this record, the Examiner did not err in rejecting claim 1.

I

Appellants contend the Examiner improperly modified Cohen's method to incorporate Gupta's feature to teach "wherein enhancing the second region comprises adjusting the value of each pixel among the subset of pixels by the amount indicated by the adjustment values provided by the filter." *See* App. Br. 4–5; Reply Br. 2–3.

Appellants have not persuaded us of error. The U.S. Supreme Court has held "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007). Further, "[i]f the claim extends to what is obvious, it is invalid under § 103" and "the analysis need not seek out precise teachings directed to the specific subject

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[3] To the extent Appellants advance new arguments in the Reply Brief without showing good cause, Appellants have waived such arguments. *See* 37 C.F.R. § 41.41(b)(2).

matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.* at 418–19.

The Examiner has provided articulated reasoning with a rational underpinning as to why one skilled in the art would have found it obvious to modified Cohen's method to incorporate Gupta's feature. *See* Ans. 8 ("One of ordinary skill would . . . have been motivated to combine the filter of Gupta with Cohen because the filters of Gupta enhance images to which they are applied . . . , which is a function that Cohen is specifically concerned with.").[4] Appellants do not critique that reasoning, and do persuasively show why such reasoning is incorrect.

Appellants' arguments that "[i]n Cohen, the goal is not to distort an image or enhance an image but, instead, to replace an image" and "[t]he modification of Cohen with any reference to adjust pixel values by corresponding adjustment values changes the principle of operation of Cohen, which is image replacement" (App. Br. 5; *see also* Reply Br. 2) are speculative and unsupported by evidence. In particular, Appellants cite Cohen's paragraphs 54, 55, 57, and 71 (App. Br. 4–5), but those paragraphs do not state replacing an image is Cohen's goal or principle of operation, and only two of those paragraphs even mention replacing an image. *See* Cohen ¶¶ 54, 55, 57, and 71.

The Examiner's findings and conclusion are reasonable because the skilled artisan would "be able to fit the teachings of multiple patents together

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[4] Appellants dispute the Examiner's determination that the combination is a simple substitution. App. Br. 5; Reply Br. 2. Because that determination is unnecessary for our analysis, Appellants have not shown reversible error.

like pieces of a puzzle" since the skilled artisan is "a person of ordinary creativity, not an automaton." *KSR*, 550 U.S. at 420–21. Appellants do not present adequate evidence that the resulting arrangements would have been "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418–19).

Accordingly, we agree with the Examiner that applying Gupta's technique in the Cohen system would have predictably used prior art elements according to their established functions—an obvious improvement. *See KSR*, 550 U.S. at 417.

II

Appellants contend the "the Examiner errs in asserting . . . that Cohen's field of endeavor is image *enhancement*." App. Br. 5.

Appellants have not persuaded us of error.

> A reference qualifies as prior art for an obviousness determination under § 103 only when it is analogous to the claimed invention. . . . Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed ["Field Test"] and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved ["Problem Test"].

In re Klein, 647 F.3d 1343, 1348 (Fed. Cir. 2011) (citations omitted) (emphases added). "Whether a reference in the prior art is 'analogous' is a

fact question." *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992) (citations omitted).

To determine this invention's field of endeavor, we consider the "explanations of the invention's subject matter in the patent application, including the embodiments, function, and structure of the claimed invention." *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004) (citations omitted).

In response to Appellants' argument, the Examiner finds the Specification does not explicitly define what constitutes "enhancement." Ans. 4. The Examiner then cites excerpts of Cohen's Specification and explains why Cohen is in the field of image enhancement. Ans. 4.

Appellants respond by contending "not only the Specification (see e.g., paragraph [0043]) but also the claims themselves define [enhancement]." Reply Br. 2. We disagree with Appellants because neither paragraph 43 nor claim 15 explicitly defines "enhancement." Paragraph 43 merely provides *non-limiting, exemplary* embodiments of achieving enhancement. Spec. ¶ 43. Claim 15 is similarly non-limiting and open-ended because it recites "enhancing[5] . . . comprises . . . ." *See Gillette Co. v. Energizer Holdings, Inc.*, 405 F.3d 1367, 1371 (2005) ("claim 1 uses the 'open' claim term[] 'comprising' . . . in addition to other language, to encompass subject matter beyond [the explicitly recited limitations]"). In any event, because Appellants fail to persuasively respond to the Examiner's explanation (discussed above), they fail to show Examiner error.[6]

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[5] Claim 15 recites "enhancing," but does not recite "enhancement."
[6] As discussed above in Section I, Appellants' arguments that "[i]n Cohen, the goal is not to distort an image or enhance an image but, instead, to

III

Appellants contend "the computation of new pixel values in Gupta fails to teach the claimed filter, as asserted" and "[t]he computation of new pixel values in Gupta, even if the computation is deemed to represent an adjustment of pixel values, is not stored in any document object associated with any image document." App. Br. 5–6. Appellants argue:

> Claim 15 recites that "the preference data is stored in a document object associated with the image document . . . the preference data comprises a filter . . . the *filter identifying . . . adjustment values indicating an amount by which to adjust a value of each pixel among the subset of pixels.*" That is, a filter stored with preference data in a document object associated with the image document identifies adjustment values according to Claim 15.

App. Br. 5–6.

Appellants' arguments are unpersuasive because they are not directed to the Examiner's specific findings. The Examiner cites Cohen for teaching the claimed "filter," "wherein the preference data is stored in a document object associated with the image document," and "wherein the preference data comprises a filter." *See* Final Act. 7. Because Appellants have not persuasively shown the Examiner's findings based on Cohen are incorrect, Appellants have not shown Examiner error.

IV

In the Reply Brief and for the first time, Appellants belatedly argue Gupta does not teach the claimed "adjustment values." *See* Reply Br. 4.

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replace an image" and "the principle of operation of Cohen . . . is image replacement" (App. Br. 5) are unpersuasive.

Appellants' argument is untimely, and Appellants have not demonstrated any "good cause" for the belated presentation. *See* 37 C.F.R. § 41.41(b)(2).

Because Appellants have not persuaded us the Examiner erred, we sustain the Examiner's rejection of claim 15.

We also sustain the Examiner's rejection of corresponding dependent claims 16–26, as Appellants do not advance separate substantive arguments about those claims.

Double Patenting

Claims 15–24 are provisionally rejected on the ground of non–statutory double patenting as being unpatentable over claims 21–40 of Application No. 14/101,418. Final Act. 5. Because Application No. 14/101,418 was abandoned (Notice of Abandonment mailed February 22, 2018), we do not reach the merits of this rejection.

DECISION

We affirm the Examiner's decision rejecting claims 15–26.

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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED