

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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARIO BLAUM and CONSTANTIN MICHAEL MELAS

Appeal No. 2000-0380
Application No. 08/816,648

ON BRIEF

Before JERRY SMITH, FLEMING and BLANKENSHIP, **Administrative Patent Judges.**

FLEMING, **Administrative Patent Judge.**

DECISION ON APPEAL

This a decision on appeal from the final rejection of claims 25 through 28 and 44 through 47, all of the claims pending in the present application. Claims 1 through 24 and 29 through 43 have been cancelled.

The invention relates to a method and apparatus for storing input groups of

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uncoded binary data on a magnetic recording medium to enhance timing recovery.

Independent claim 25 is reproduced as follows:

25. A method for storing input groups of uncoded binary data on a magnetic recording medium to enhance timing recovery, each said group comprising a sequence of uncoded binary data, wherein the method comprises the steps of:

encoding each input group using an m/n rate block coded sequence and impressing a predetermined bit pattern thereon to provide corresponding output groups of encoded binary data; and

storing the output groups on the magnetic recording medium.

The sole reference relied on by the Examiner is as follows:

Knudson	5,521,945	May 28, 1996
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Claims 25 through 28 and 44 through 47 stand rejected under 35 U.S.C. § 102 as being anticipated by Knudson.

Rather than repeat the arguments of Appellants and the Examiner, we make reference to the briefs¹ and the answer for the details thereof.

OPINION

After a careful review of the evidence before us, we do not agree with the Examiner that claims 25 through 28 and 44 through 47 are anticipated by Knudson.

It is axiomatic that anticipation of a claim under §102 can be found only if the prior

¹ Appellants filed an appeal brief on May 3, 1999. Appellants filed a reply brief on July 7, 1999. The Examiner mailed an office communication on July 22, 1999 stating that the reply brief had been entered and considered.

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art reference discloses every element of the claim. **See *In re King***, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and ***Lindemann Haschinenfabrik GMBH v. American Hoist & Derrick Co.***, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

On page 4 of the brief, Appellants argue that claim 25 recites the step of “impressing a predetermined bit pattern thereon to provide corresponding output groups of binary data”. We note that the other independent claim 44 recites “an encoder to encode . . . while impressing a predetermined bit pattern thereon to provide corresponding output groups of encoded binary bits”. Appellants further argue on page 4 of the brief that Knudson does not teach predetermined, preselected, preordained or “impressed” on or in an m/n rate block coded sequence. On page 5 of the brief, Appellants argue that since Knudson fails to teach an “impressed” bit pattern on an m/n block coded sequence the claims are not anticipated.

On page 5 of the answer, the Examiner argues that Knudson discloses in column 4, lines 53-56, a 8/9 modulation code in which certain write sequences may occur. The Examiner further argues that since the end of the 8/9 modulation code encodes 8 uncoded bits to a 9 encoded bit, the 9 encoded bits presumably would include a “predetermined bit pattern”.

To establish inherency, the extrinsic evidence “must make clear that the missing

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descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by person of ordinary skill." *In re Robertson*, Slip Op 98-1270 (Fed. Cir. February 25, 1999) *citing Continental Can Co. v. Monsanto Co.*, 948 F.3d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result for a give set of circumstances is not sufficient." *Id. citing Continental Can Co. v. Monsanto Co.*, 948 F.3d 1264, 1269, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991).

From our review of Knudson and, in particular, our review of column 4, we fail to find a teaching that Knudson shows an encoder to encode each input group using m/n rate block coded sequence while impressing a predetermined bit pattern thereon to provide corresponding output groups of encoded binary bits. While we agree with the Examiner that the write sequences shown in Knudson provide a sequence of ones and zeros, we fail to find that Knudson teaches that a predetermined bit pattern is impressed to provide corresponding output groups of encoded binary data. The Examiner has not shown that Knudson's disclosure necessarily teaches that a predetermined bit pattern is impressed on an m/n block coded sequence. We remind the Examiner that inherency may not be established by probabilities or possibilities.

In view of the foregoing, the decision of the Examiner rejecting claims 25 through 28 and 44 through 47 is reversed.

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REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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HOWARD B. BLANKENSHIP)	
Administrative Patent Judge)	

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