

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte MAMORU UEDA

---

Appeal No. 2001-2005  
Application 08/893,024

---

ON BRIEF

---

Before THOMAS, KRASS, and BLANKENSHIP, Administrative Patent Judges.  
THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 10-15 and 17-22. Representative claim 10 is reproduced below:

10. Apparatus for processing a digital video signal, comprising:

a processor for generating block units of a predetermined size from said digital video signal and adding block number information and color field information indicating a phase-shift of a subcarrier of said digital video signal to said block units, said block number information indicating the sequential order of said block units; and



Appeal No. 2001-2005  
Application 08/893,024

information "indicating a phase-shift of a subcarrier of said digital video signal."

The arguments presented by appellant in the brief and reply brief do not argue against the combinability of Oguro and Montgomery within 35 U.S.C. § 103. Moreover, we agree with the examiner's understanding that Oguro teaches everything of representative claim 10 on appeal except for the disputed feature noted earlier. Based upon our study of the examiner's positions with respect to Montgomery in the final rejection, the advisory action and the answer, we conclude that there is no teaching or suggestion of the disputed feature within this reference.

Based upon our study of each of the portions urged by the examiner as teaching or suggesting the disputed feature, we conclude that there is no such teaching or suggestion. The discussion referenced by the examiner at column 5 (and we note the bottom of column 8) of this reference does recognize a known phase relationship between a data carrier with a color frame as to the first embodiment of the transmitter in Figure 1 of this reference. Yet, this feature alone does not come close to indicating a phase-shift of a subcarrier in association with color field information coded for digital video information. The examiner's reference to the phase synch markers at column 10,

lines 17-24, which are further developed according to the discussion at column 12, lines 20-39, and the discussion at the bottom of column 11 of Montgomery also fail to teach or suggest within Montgomery the coding within a color field information portion any data indicating a phase-shift of a subcarrier of the digital video information. All of these noted locations relate to the mere synchronization of data and not any phase-shift of a subcarrier related to color field information. Basically, the phase-synchs taught in Montgomery as a whole and these latter noted locations relied on by the examiner clearly indicate to us that phase synchronization is not a phase-shift as claimed.

Our study of Montgomery therefore is consistent with the arguments presented by appellant at pages 5 and 6 of the principal brief on appeal and the similar arguments raised at pages 2 and 3 of the reply brief. We also find ourselves generally in agreement with appellant's urging at the top of page 3 of the reply brief that Montgomery does not disclose the addition of timing information (such as phase-shift information of a subcarrier associated with color field information as claimed) to the digital video information during an encoding or generation of video block units as in claim 10. The discussion

Appeal No. 2001-2005  
Application 08/893,024

of phase compensation noted by the examiner at the top of column 7 of Montgomery is in the context of a receiver in Figure 2 and not the transmitter in Figure 1, and it is not in the context of encoding or generation of digital video information.

NEW REJECTIONS UNDER 37 CFR § 1.196(b)

Claims 10-15 and 17-22 are rejected under the enablement and written description portions of 35 U.S.C. § 112, first paragraph. The disputed language of independent claims 10 and 17 on appeal "indicating a phase-shift of a subcarrier" of the digital video signal was added by the amendment filed on May 13, 1999. Our study of the specification as filed, the drawings and the original claims leads us to conclude there is no disclosure at all of any specific teaching or showing of color field information "indicating a phase-shift of a subcarrier" to the extent presently recited in each of the claims on appeal. Thus, there is a clear absence of any enablement for this feature and any written description therefore from the specification as a whole as originally filed.

In summary, we have reversed the outstanding rejection of claims 10-15 and 17-22 under 35 U.S.C. § 103. Additionally, we have introduced rejections of these claims under the enablement

Appeal No. 2001-2005  
Application 08/893,024

and written description portions of 35 U.S.C. § 112, first paragraph. These two new rejections are entered within 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Appeal No. 2001-2005  
Application 08/893,024

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b)

James D. Thomas	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
Errol A. Krass	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
Howard B. Blankenship	)	
Administrative Patent Judge	)	

JDT/cam

FROMMER LAWRENCE & HAUG  
745 Fifth Avenue  
New York, NY 10151