

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte J. RICHARD AYLWARD

Appeal No. 2002-1689
Application No. 08/796,285

HEARD: MARCH 5, 2003

Before FLEMING, SAADAT, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 30-32¹.

BACKGROUND

Appellants' invention relates to surround sound channel encoding and decoding. An understanding of the invention can be derived from a reading of exemplary claim 30, which is reproduced as follows:

¹ The rejection of claims 31 and 32 under 35 U.S.C. § 103(a) has been withdrawn by the examiner. Claims 31 and 32 have been indicated (answer, page 5) as being objected to as dependent from a rejected base claim.

March 23, 2001) and reply brief (Paper No. 26, filed August 16, 2001) for appellants' arguments thereagainst. 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).

OPINION

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

We begin with the rejection of claims 30-32 under 35 U.S.C. § 112, second paragraph. The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language

employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art.

Id. The examiner's position (answer, pages 3 and 4) is that:

It is not clear[ly] whether a plurality of the first transmitted signals claimed in claims 30-32 are the same first transmitted signal. If it [is] the case then the same first transmitted signal would be connected to the first input of the first decoder, the first output of the first decoder and the first input of the second decoder. Therefore, the first decoder would be bypassed because the same first transmitted signal [would be] connected to both the input and the output. This remark is also applied to the second input and output of the first decoder, the second decoder, the third decoder and the fourth decoder. Secondly, it is not clearly what type of decoder is [being claimed]."

Appellant responds (reply brief, page 2) that "Claims 30-32 are readable upon the apparatus of FIGS. 17 and 18. These claims do not recite a plurality of first transmitted signals. These claims recite decoders with inputs and outputs corresponding to what is disclosed FIG. 17. Each recited decoder has first and second inputs for receiving or normally receiving transmitted signals, these inputs labeled with a subscript t. The decoders in FIG. 17 are characterized by having first, second and third outputs." We agree. We find that claim 30 does not recite a

plurality of first transmitted signals, but rather that each decoder has two inputs and three outputs. In addition, we agree with appellant that page 28, line 9 et seq. of the specification defines the decoder system of figure 17 as a multiple axis decoding system that uses stereo decoders. We therefore find claim 30 to be definite, and accordingly reverse the rejection of claims 30-32 under 35 U.S.C. § 112, second paragraph.

We turn next to the rejection of claim 30 under 35 U.S.C. § 102(e) as anticipated by Embree. To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). The examiner (answer, page 4) relies upon 406 of Embree as the first decoder, 448 of Embree as the second decoder, and additionally relies upon figure 6 and the abstract of Embree. Appellant asserts (brief, page 6) that claim 30 recites that each decoder provides "a greater number of outputs than number of inputs." The examiner argues (answer, page 5) that "[i]n response to Appellant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., claim 30 calls for surround

sound decoding apparatus having cascaded decoders expanding the number of channels, that is to say, each decoder provides a greater number of outputs than number of inputs) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)." Appellant acknowledges (brief, page 6) that as shown in figure 6 of Embree, sum-difference matrix 406 could be considered a decoder having two input channels and four output channels, but that adaptive matrix 448 does not provide an increase in the number of channels as required by claim 30.

We find that in Embree (figure 6) adaptive matrix 448 receives 4 inputs L, R, C, S from sum-difference matrix 406, and four inputs from Look Up Tables (LUTS) 440, 442, 444, and 446). Adaptive matrix 448 has four outputs; i.e., L_{out} , R_{out} , C_{out} , and S_{out} . Thus, we find that adaptive matrix 448 does not have more outputs than inputs, as required by claim 30, which recites that each of the decoders has two inputs and three outputs. Accordingly, we find that Embree does not anticipate claim 30, as advanced by the examiner. The rejection of claim 30 under 35 U.S.C. § 102(e) is therefore reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 30-32 under 35 U.S.C. § 112, second paragraph, is reversed. The decision of the examiner to reject claim 30 under 35 U.S.C. § 102(e) is reversed.

REVERSED

MICHAEL R. FLEMING)	
Administrative Patent Judge)	
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