The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK ALAN SCHULTZ AND
GREG ALAN KRANAWETTER

Appeal No. 2003-0739
Application No. 09/319,763

ON BRIEF

Before RUGGIERO, BLANKENSHIP, and NAPPI, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-8, which are all of the claims pending in the present application.

The claimed invention relates to a system and method for processing MPEG based compressed data. The compressed data is decompressed and data-reduced by a subsampling network and

recompressed by a recompression network. The recompression network is selectively inhibited when the subsampling network is activated.

Claim 1 is illustrative of the invention and reads as follows:

> 1. In a system for processing a datastream of MPEG coded image representative data, an MPEG compatible signal processing system comprising:
>
> a decompressor for decompressing MPEG compressed data to produce decompressed data;
>
> a data reduction network for data-reducing said decompressed data to produce data-reduced information, said data reduction network comprising a recompression network and a subsampling network;
>
> an image data processor responsive to said data-reduced information; and
>
> a control network for inhibiting said recompression network selectively when said subsampling network is activated.

The Examiner relies on the following prior art:

Canfield et al. (Canfield)	5,825,424	Oct. 20, 1998 (filed Jun. 19, 1996)

Claims 1-8 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Canfield.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (Paper No. 8) and Answer (Paper No. 9) for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Brief along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as recited in claims 1-8. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to

modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of appealed independent claims 1 and 6, Appellants assert that the Examiner has failed to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied Canfield reference. In particular, Appellants contend (Brief, pages 3 and 4) that the Examiner has misinterpreted the disclosure of Canfield as providing a description of the claimed selective inhibition of a

recompression network when a subsampling network is activated, a feature set forth in each of the appealed independent claims 1 and 6.

After reviewing the Canfield reference in light of the arguments of record, we are in general agreement with Appellants' position as stated in the Brief. Initially, we are in agreement with Appellants that the Examiner's attempt (Answer, page 4) to draw a correspondence between Canfield's variable length and fixed length compressors (Canfield, Figure 3) and the claimed recompression and subsampling networks is without merit. While we do not dispute the Examiner's assertion that both types of networks are ultimately directed to the goal of achieving data reduction, this does not necessarily lead to the conclusion that they have the same structure or operate in the same manner to produce the data reduction result.

We recognize that the Examiner at page 5 of the Answer, has expanded the stated position of obviousness by referring to a portion of Canfield (column 2, lines 24-28) which discloses a dual mode data reduction network in which data recompression and horizontal decimation (subsampling) are selectively employed. According to the Examiner (Answer, page 5), this "selective employment" disclosure can be interpreted as suggesting that

selection of one data reduction function “inhibits” the non-selected function.

It is our view, however, that even assuming, arguendo, that, as asserted by the Examiner, selection of one of two functions necessarily means inhibition of the non-selected function, the specific claim language of independent claims 1 and 6 requires that the recompression network be inhibited when the subsampling network is activated. We find no disclosure in Canfield that would satisfy this claim limitation since the recompression network in Canfield is always active. While portions of Canfield’s disclosure suggest that in certain situations the subsampling network can be used together with the recompression network to achieve increased data reduction, there is no disclosure by Canfield of using the subsampling network without the recompression network.

We note that it is proper for an Examiner to consider, not only the specific teachings of a reference, but inferences a skilled artisan might draw from them. It is equally important, however, that the teachings of prior art references be considered in their entirety. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968); W.L. Gore & Associates, Inc. V. Garlock, Inc., 721 F.2d 1540, 1548, 220 USPQ 303, 311 (Fed. Cir. 1983),

cert denied, 469 U.S. 851 (1984). In particular, in order for us to accept the Examiner's conclusions in the present factual situation, we would have to improperly selectively ignore significant portions of the disclosure of the Canfield reference.

Lastly, we address the Examiner's comments (Answer, pages 5 and 6) directed to Appellants' argument that Canfield "teaches away" from the claimed invention by suggesting (column 3, lines 42 and 43) that "horizontal decimation without compression is not a recommended practice for this system." In the Examiner's view, despite Canfield's disparaging of using decimation (subsampling) without compression (or recompression), the limitations of claims 1 and 6 are satisfied since the disclosure of subsampling without compression does in fact exist in Canfield.

We do not find this assertion by the Examiner to be persuasive since it ignores the specific language of the claims. In our view, appealed claims 1 and 6 do not simply require performance of subsampling without recompression as the Examiner would have us believe but, rather, as claimed, the recompression network must be selectively inhibited when the subsampling network is activated. In other words, even if one of ordinary skill were to perform the non-recommended procedure of Canfield, i.e., subsampling without recompression, there is no evidence

that this would necessarily mean an inhibition of the recompression function since no recompression network may actually be present in the system to be inhibited.

CONCLUSION

In conclusion, since we are of the opinion that the prior art applied by the Examiner does not support the obviousness rejection, we do not sustain the rejection of independent claims 1 and 6, nor of claims 2-5, 7, and 8 dependent thereon. Therefore, the decision of the Examiner rejecting claims 1-8 under 35 U.S.C. § 103(a) is reversed.

REVERSED

JOSEPH F. RUGGIERO Administrative Patent Judge	)	
HOWARD B. BLANKENSHIP Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ROBERT E. NAPPI Administrative Patent Judge	)	

JFR/dpv

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