

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RANDY UBILLOS

Appeal No. 2003-1480
Application No. 09/226,526

ON BRIEF

Before JERRY SMITH, BLANKENSHIP, and SAADAT, Administrative Patent Judges.

SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-20, which are all of the claims pending in this application.

We reverse and enter a new ground of rejection under 37 CFR § 41.50(b).

BACKGROUND

Appellant's invention is directed to a video editing system for controlling velocity of an object movement following a path

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in a display device. According to Appellant, a plurality of handles provided along the path are used to control a velocity of the object in the display.

Representative independent claim 1 is reproduced as follows:

1. A method comprising:

providing a path an object will follow in a display;

providing a plurality of handles along said path; and

controlling a velocity of said object moving on said path using said handles.

The Examiner relies on the following references in rejecting the claims:

Watanabe et al. (Watanabe)	5,717,848	Feb. 10, 1998
Higasayama et al. (Higasayama)	5,923,561	Jul. 13, 1999

Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Higasayama and Watanabe.

We make reference to the answer (Paper No. 11, mailed December 31, 2002) for the Examiner's reasoning in support of the rejection, and to the appeal brief (Paper No. 10, filed October 9, 2002) and the reply brief (Paper No. 12, filed March 4, 2003) for Appellant's arguments thereagainst.

OPINION

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of

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obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). Furthermore, for an invention to be obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention. Karsten Mfg. Corp. v. Cleveland Gulf Co., 242 F.3d 1376, 1385, 58 USPQ2d 1286, 1293 (Fed. Cir. 2001). The Examiner must also produce a factual basis supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration, consistent with the holding in Graham v. John Deere Co., 383 U.S. 1 (1966). However, "the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Appellant argues that Higasayama uses a CAD (computer aid design) system for generating a curve representing a cutter path based on the geometry data (brief, page 8). Appellant further points out that the velocity of the cutter along the cutter path is determined by taking into account the capabilities of the machine and the geometry of the work piece (brief, page 9)

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instead of using handles. In that regard, Appellant further argues that Higasayama's discrete points, which are automatically calculated by a computer and, if altered, will change the cutter path simulated from the geometry of the piece (brief, pages 12 & 13; reply brief, page 4). Additionally, Appellant asserts that the combination of Higasayama and Watanabe lacks a proper motivation since displaying the actual path the cutting tool is following based on the geometry of the work piece is of little interest to the skilled artisan compared to the cutter's physical operation (brief, page 12). Appellant further asserts that, in fact, any manipulation of the discrete points along the path would be detrimental to the accuracy of the path and cause the path to deviate away from the desired geometry of the work piece (reply brief, page 2).

In response to Appellant's arguments, the Examiner asserts that Watanabe is relied on only for suggesting the displaying of the path the object will follow whereas Higasayama teaches that the cutter's velocity variation depends on the placement of the discrete points (answer, page 6). The Examiner concludes that the discrete points of Higasayama can be reasonably interpreted as the claimed handles as the velocity of the cutter depends on these points (answer, page 9).

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As the Examiner and Appellant concede, Higasayama teaches that a cutter path is defined by a succession of discrete points which generated using the cutter path data (col. 1, lines 18-22). The movement velocity of the cutter is determined by a curvature radius of the path estimate and a space interval of the points (col. 2, lines 1-7) whereas the acceleration and deceleration of the cutter depends on the disposition of the points to be followed by the cutter (col. 2, lines 42-46). Therefore, as correctly identified by Appellant, the discrete points, even if displayed, cannot be repositioned by a user since they are the defining points along the cutter path and calculated based on a "curve defining equation" (col. 12, lines 7-16). In fact, as pointed out by Appellant (reply brief, page 2), any changes to the movement characteristics of the cutter by altering the discrete points defining the path would have to be performed based on the geometry data of the work piece and not by using the displayed points.

Turning now to Watanabe, we find that the reference also relates to a method of setting object display attributes and a method of generating an object motion path for three-dimensional computer graphics (col. 1, lines 14-17). In particular, Watanabe teaches that the position of an object, the magnitude and direction of an object velocity and time may be dynamically

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changed (col. 1, lines 59-63) while an object motion path can be more finely designated by providing a new velocity attribute at an optional point designated on the path (col. 2, lines 8-11). Thus, Watanabe uses additional points along the path of an object movement to alter the movement characteristics of the object on display. However, this altering is completely different from defining the cutter path of Higasayama using a plurality of points with pre-calculated positions and spacing which do not gain any advantage or enhanced functionality by being displayed. Therefore, one of ordinary skill in the art would not be led, let alone motivated, to display these points as any changes to the points must be made only by calculations, not by manipulating the points on a display.

Based on our findings above, we agree with Appellant that the plurality of points defining the cutter path of Higasayama cannot simply be displayed similar to the motion path of the object in Watanabe and be used to control the velocity of the cutter along the path. We also remain unconvinced by the Examiner's arguments that one of ordinary skill in the art would have displayed the cutter path of Higasayama in order to monitor the motion of the cutter since the movement and velocity of the cutter along its path requires inspecting the workpiece and not whether the path is displayed. The Examiner has not pointed to,

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nor do we find, any teaching in Higasayama that would have suggested the need, the benefit, or even possibility of such combination. Therefore, as the combination of prior art fails to teach or suggest the path, the handles and the velocity control features of claim 1, as well as the similar features of independent claims 6, 11 and 16, the Examiner has not established a prima facie case of obviousness. Accordingly, we do not sustain the 35 U.S.C. § 103 rejection of claims 1-20 over Higasayama and Watanabe.

CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1-20 under 35 U.S.C. § 103 is reversed.

We make the following new ground of rejection for claims 1, 6, 11 and 16 under 35 U.S.C. § 102 as being anticipated by Watanabe pursuant to 37 CFR § 41.50(b). We only consider the independent claims, but encourage the Examiner to consider other claims for possible rejections over Watanabe or in combination with other prior art.

Claims 1, 6, 11 and 16 are rejected under 35 U.S.C. § 102(e)(2) as being anticipated by Watanabe.

We note that the claims recite a plurality of handles along a path an object follows which are used for controlling a velocity of the object moving on the path. As discussed above,

Watanabe relates to generating an object motion path for three-dimensional display which reads on the claimed "path an object will follow in a display." Watanabe specifically teaches that the position of an object, the magnitude and direction of an object velocity and time may be dynamically changed (col. 1, lines 59-63) and an object motion path may be more finely designated by providing a new velocity at an optional point designated on the path (col. 2, lines 8-11). Watanabe uses both or one of the position and velocity of an object at key frames to generate a motion path between the frames (col. 2, lines 24-27). The method of generating the object motion path of Watanabe is performed on a computer system (Figure 1, col. 3, line 66 through col. 4, line 5) that includes a computer having a display screen 101, a key board (alphanumeric device) 104 and a mouse 103 (cursor control device). Using a new key frame, the motion path on the display screen is defined as described in column 6, lines 24-32 as follows:

The motion path set and displayed on the display screen 101 may be changeably designated more finely as illustrated in FIGS. 5a-5c. FIG. 5a shows a path 500 already displayed on the display screen 101, a start point 511, a start point velocity 512, an end point 521, and an end point velocity 522. First, as shown in FIG. 5b, a new key frame is designated. An operator enters from the input device a position 501 where the path is to be corrected or changed, the position being thereby displayed on the display screen. [Emphasis added.]

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Therefore, the additional point 501, together with the start and end points 511 and 521, are used to correct or alter the movement characteristics (such as velocity) of the object moving along path 500 on the display screen and read on the claimed "handles along said path." Watanabe further discloses that by changing the velocity vector from velocity 502 to velocity 503 at point 501, a new path 504 defines the new motion path (col. 6, lines 52-55) which reads on the claimed "controlling a velocity of said object."

In view of the discussion above, Watanabe discloses all the claimed elements and therefore, anticipates the independent claims. Accordingly, we find that claims 1, 6, 11 and 16 are unpatentable under 35 U.S.C. § 102 over Watanabe.

In addition to reversing the Examiner's decision rejecting the claims, this decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(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

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rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .37
CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

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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 § 41.50(b)

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