

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JONATHAN R.MERRIL, PETER A. MANGIAFICO,
RITA ROY, PAUL MCGUIRE
and TORSTEN KOEHLER

Appeal No. 2003-1858
Application No. 09/073,871¹

HEARD: FEBRUARY 19, 2004

Before JERRY SMITH, BARRY 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 51 and 55-68. Claims 1-50 have been cancelled and claims 52-54 have been objected to by the Examiner who has indicated their allowability if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

¹ Application for patent filed May 7, 1998.

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We reverse.

BACKGROUND

Appellants' invention relates generally to data processing systems for digitally recording lectures and presentations and, more specifically, to a system that allows a presenter to store the contents of a lecture so that it may be broadcast across the Web and capable of searching and retrieval of the lecture material. According to Appellants, the invention provides for (1) capturing the lecture and storing it into a computer memory or database, (2) generating a transcript from the lecture and the slides and automatically summarizing and outlining the transcripts and (3) publishing the lecture on the Internet for use by client computers (specification, page 6).

Representative independent claim 51 is reproduced below:

51. A method of capturing a live presentation, comprising the steps of:

capturing still images from a display device which displays said still images for viewing by an audience during a live presentation;

during the live presentation, detecting the change over form [sic, from] one still image to another;

recording the audio portion of a speaker's presentation during a live presentation; and

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in response to said detected change over from one still image to another, automatically synchronizing change over from one still image to another with the audio recording.

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

Ellozy et al. (Ellozy)	5,649,060	Jul. 15, 1997
Shipp	6,031,526	Feb. 29, 2000 (filed Aug. 8, 1996)
Qureshi et al. (Qureshi)	6,084,582	Jul. 4, 2000 (filed Jul. 2, 1997)

Claims 51, 55 and 57-59 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shipp.

Claims 56, 60, 61 and 66-68 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shipp and Qureshi.

Claims 62-65 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shipp, Qureshi and Ellozy.

We make reference to the answer (Paper No. 27, mailed February 14, 2003) for the Examiner's reasoning, and to the appeal brief (Paper No. 26, filed November 22, 2002) for Appellants' arguments thereagainst.

OPINION

With respect to the rejection of claims 51, 55 and 57-59, Appellants point out that, in contrast with the claimed detection of change over from one still image to another during a live presentation, Shipp provides for a physician to selectively

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capture frames of the video stream while the monitor displays video images (brief, page 6). Appellants further point to column 3, lines 4-11 of Shipp and assert that the disclosed "frame grabber" in the reference merely allows the surgeon to electronically grab a frame from the video stream without detecting change over from one still image to another (brief, page 7). Appellants further point out that without such detection, the system cannot automatically synchronize the change over from one still image to another with the audio recording (brief, page 8; oral hearing).

In response to Appellants' arguments, the Examiner asserts that Shipp discloses still images displayed on the monitor in a live presentation since the surgeon can capture a still image and can dictate pertinent information related to the image (answer, page 11). The Examiner further relies on the voice command of Shipp which is used to grab a frame to be stored and reasons that the reference suggests detecting the change over from one still image to another when a voice command is received (id.).

As a general proposition, in rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) and In re Fine,

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837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993); In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992); Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985). In considering the question of the obviousness of the claimed invention in view of the prior art relied upon, the Examiner is expected to make the factual determination 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. See also In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998).

After reviewing Shipp, we agree with Appellants' assertion that the claimed steps of detecting the change over from one still image to another and automatically synchronizing the change over from one still image to another with the audio recording,

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are absent in the reference. Shipp relates to a system for generating electronic and printed reports of medical treatments and procedures wherein captured images are combined with dictated text into integrated medical records (col. 1, lines 5-10). Shipp discloses that during or after the surgical procedure, the surgeon dictates pertinent information describing the medical procedure related to the video image observed on a monitor from which still images are selected for storage (col. 3, lines 12-17). Additionally, Shipp discloses that the voice recognition includes features for recognizing certain words as commands for operating the system such as one for frame grab command which captures a frame from the video string and delivers to the storage device (col. 3, lines 46-59). Therefore, the still images are merely captured and stored as the surgeon commands without being detected for the change over from one still image to another.

As discussed above, what the Examiner characterizes in Shipp as detecting the change over from one still image to another when a voice command is received (answer, page 11), is actually a voice recognition feature of the system that helps the surgeon to operate the system by speaking the commands. In fact, the surgeon decides which frame from the video image should be stored

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as a still image and provides the command for capturing that still image. Thus, Shipp does not disclose or suggest the recited features of claim 51, nor of claims 55 and 57-59, which are dependent therefrom. Accordingly, the 35 U.S.C. § 103 rejection of claims 51, 55 and 57-59 over Shipp cannot be sustained.

Turning to the 35 U.S.C. § 103 rejection of claims 56 and 60-68, we note that the Examiner has relied on Qureshi for disclosing receiving video images from an overhead transparency and on Ellozy for teaching the transcription of text using optical character recognition software. However, by relying on these references, the Examiner has not provided additional evidence to overcome the deficiencies of Shipp as discussed above with respect to the rejection of claims 51, 55 and 57-59, and therefore, has failed to establish a prima facie case of obviousness. Accordingly, we do not sustain the 35 U.S.C. § 103 rejection of claims 56, 60, 61 and 66-68 over Shipp and Qureshi and of claims 62-65 over Shipp, Qureshi and Ellozy.

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CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 51 and 55-68 under 35 U.S.C. § 103 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LANCE LEONARD BARRY)	APPEALS
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)	INTERFERENCES
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