

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOSHIKAZU AKAMA, KOJI ARIMURA, JUN IKEDA
and YUKIKO INOUE

Appeal No. 2004-0422
Application No. 09/046,315

ON BRIEF

Before THOMAS, BARRETT, and MACDONALD, ***Administrative Patent Judges.***

MACDONALD, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 5-13. Claims 1-4 have been canceled.

Invention

Appellants' invention relates to an apparatus for detecting a frame accompanied by a scene change or cut in compressed motion picture data. A cut is the beginning of a video clip and is a representative image. Appellants' specification at page 1, lines 4-6 and 13-14.

Appeal No. 2004-0422
Application No. 09/046,315

Claim 5 is representative of the claimed invention and is reproduced as follows:

5. An apparatus for detection of a cut in compressed motion picture data, the apparatus comprising:

extracting means for extracting data from said compressed motion picture data which is received as a data stream partitioned into a plurality of intra frames each having an equal number of bits;

data comparing means for comparing said compressed motion picture data at corresponding locations of adjacent ones of said frames of the stream; and

cut judging means for judging the presence or absence of a cut by the result of the comparison by said comparing means.

References

The references relied on by the Examiner are as follows:

Saito	5,204,706	Apr. 20, 1993
Liou et al. (Liou)	5,835,163	Nov. 10, 1998
		(Filed Dec. 21, 1995)

Rejections At Issue

Claim 5 stands rejected under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 5-13 stand rejected under 35 U.S.C. § 102 as being anticipated by Liou.

Appeal No. 2004-0422
Application No. 09/046,315

Claims 5-13 stand rejected under 35 U.S.C. § 102 as being anticipated by Saito.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.¹

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claim 5 under 35 U.S.C. § 112; we affirm the Examiner's rejection of claims 5-12 under 35 U.S.C. § 102; and we reverse the Examiner's rejection of claim 13 under 35 U.S.C. § 102.

Appellants have indicated that for purposes of this appeal, the claims stand or fall together in five groupings:

Claim 5 as Group I, with respect to the rejection under 35 U.S.C. § 112;

Claims 5-12 as Group II, with respect to the rejection under 35 U.S.C. § 102 over Liou;

¹Appellants filed an appeal brief on April 8, 2003. Appellants filed a reply brief on August 25, 2003. The Examiner mailed out an Examiner's Answer on June 18, 2003.

Appeal No. 2004-0422
Application No. 09/046,315

Claims 13 as Group III, with respect to the rejection under
35 U.S.C. § 102 over Liou;

Claims 5-12 as Group IV, with respect to the rejection under
35 U.S.C. § 102 over Saito; and

Claim 13 as Group V, with respect to the rejection under
35 U.S.C. § 102 over Saito.

See page 3 of the brief. Furthermore, Appellants argue each group of claims separately and explain why the claims of each group are believed to be separately patentable. See pages 3-6 of the brief and pages 1-3 of the reply brief. Appellants have fully met the requirements of 37 CFR § 1.192 (c) (7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellants' filing of the brief.

37 CFR § 1.192 (c) (7) states:

Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c) (8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

Appeal No. 2004-0422
Application No. 09/046,315

We will, thereby, consider Appellants' claims as standing or falling together in the five groups noted above, and we will treat:

Claim 5 as a representative claim of Group I;
Claim 5 as a representative claim of Group II;
Claim 13 as a representative claim of Group III;
Claim 5 as a representative claim of Group IV; and
Claim 13 as a representative claim of Group V.

If the brief fails to meet either requirement, the Board is free to select a single claim from each group and to decide the appeal of that rejection based solely on the selected representative claim. *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). *See also In re Watts*, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004).

I. *Whether the Rejection of Claim 5 Under 35 U.S.C. § 112 is proper?*

It is our view, after consideration of the record before us, that claim 5 does not contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Accordingly, we reverse.

Appeal No. 2004-0422
Application No. 09/046,315

With respect to independent claim 5, the Examiner bears the initial burden of establishing a **prima facie** case that the claimed subject matter is not enabled. Our review of the rejection at page 3 of the brief and at page 4 of the final rejection (paper number 27) finds no attempt by the Examiner to establish a **prima facie** case. The Examiner has identified the claimed subject matter for which the specification is not enabling. However, the Examiner has failed to include any explanation in their rejection as to why the specification is not enabling. Office policy requires that the Examiner apply the factors set forth in **In re Wands**, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1998) as appropriate. See also MPEP § 2164.01(a) and § 2164.04. The explanation should include any questions the Examiner may have asked which were not satisfactorily resolved and consequently raise doubt as to enablement.

Therefore, Appellants' argument at page 3 of the brief is persuasive on its face and we will not sustain the Examiner's rejection under 35 U.S.C. § 112.

We also note that the Examiner's lack of explanation left both Appellants and this Board a little confused as to whether the Examiner intended to give an enablement rejection or a written description rejection. However, we have reviewed

Appeal No. 2004-0422
Application No. 09/046,315

Appellants' specification and can find no basis to give either rejection. Finally, we point out that if such a basis existed for rejecting claim 5, then it would be equally applicable to all the claims that depend from claim 5.

**II. Whether the Rejection of Claims 5-12 Under
35 U.S.C. § 102 is proper?**

It is our view, after consideration of the record before us, that the disclosure of Liou does fully meet the invention as recited in claims 5-12. Accordingly, we affirm.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

With respect to independent claim 5, Appellants argue at page 4 of the brief, "Liou's intra-coded video is different than Appellants' compressed DV intra frames. The official Action failed to identify any suggestion in Liou of DV intra frames. Thus, the rejection is improper and should be withdrawn." Appellants also argue at page 2 of the reply brief, that the Examiner has ignored Appellants' argument as to DV intra frames.

Appeal No. 2004-0422
Application No. 09/046,315

We agree with Appellants that DV is a specific standard in the art, and while extension of the process of Liou to the DV standard may be obvious in the extreme (given Liou's columns 5 and 6 listing of standards to which his process is applicable), we agree with Appellants that Liou does not teach the DV standard.

However, Appellants' argument as to DV intra frames is not persuasive as claim 5 fails to recite this feature. Claim 5, at line 4, only requires "intra frames" not "DV intra frames" as argued. We find that Liou teaches "intra frames." See for example, Liou's column 19, line 60.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 102.

III. *Whether the Rejection of Claim 13 Under 35 U.S.C. § 102 is proper?*

It is our view, after consideration of the record before us, that the disclosure of Liou does not fully meet the invention as recited in claim 13. Accordingly, we reverse.

With respect to independent claim 13, Appellants present the same argument as above with respect to claim 5. Here we find that the argument is fully persuasive as claim 13 does recite "DV data" and as we have stated above, "we agree with Appellants that

Appeal No. 2004-0422
Application No. 09/046,315

DV is a specific standard in the art and that Liou does not teach this standard."

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 102.

IV. *Whether the Rejection of Claims 5-12 Under 35 U.S.C. § 102 is proper?*

It is our view, after consideration of the record before us, that the disclosure of Saito does not fully meet the invention as recited in claims 5-12. Accordingly, we reverse.

With respect to independent claim 5, Appellants argue at page 4 of the brief, that Saito fails to teach "intra frames." Appellants also argue, that Saito fails to teach "compressed" intra frames.

Our reading of Saito shows that "intra frames" are taught. See for example, Saito's column 3 at line 45. However, we agree with Appellants that Saito does not teach "compressed" intra frames. We note that Saito teaches an "encoder" at figure 3, and artisans would read an encoder as usually (but not always) including compression. However, "usually" is not sufficient for a rejection under 35 U.S.C. § 102.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 102.

Appeal No. 2004-0422
Application No. 09/046,315

V. *Whether the Rejection of Claim 13 Under 35 U.S.C. § 102 is proper?*

It is our view, after consideration of the record before us, that the disclosure of Saito does not fully meet the invention as recited in claim 13. Accordingly, we reverse.

With respect to independent claim 13, Appellants present the same argument as above with respect to claim 5 and the Liou reference. Here we find the argument fully persuasive as claim 13 does recite "DV data." We agree with Appellants that DV is a specific standard in the art and that Saito does not teach this standard.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 102.

Conclusion

In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. § 112 of claim 5; we have sustained the rejection under 35 U.S.C. § 102 of claims 5-12; and we have not sustained the rejection under 35 U.S.C. § 102 of claim 13.

Appeal No. 2004-0422
Application No. 09/046,315

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

AFFIRMED-IN-PART

JAMES D. THOMAS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
ALLEN R. MACDONALD)	
Administrative Patent Judge)	

ARM/lbg

Appeal No. 2004-0422
Application No. 09/046,315

LAWRENCE E ASHERY
RATNER & PRESTIA
ONE WESTLAKES SUITE 301 BERWYN
P O BOX 980
VALLEY FORGE, PA 19482-0980