

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NICOLAS BAILLEUL

Appeal No. 2004-0515
Application No. 09/400,960

ON BRIEF

Before RUGGIERO, DIXON, and GROSS, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1 and 2, which are all of the claims pending in the present application.

The claimed invention relates to a method and apparatus for modifying coded data which is coded to include a set of parameters for decoding the coded data. The coded data is

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decoded, modified, and coded to obtain coded modified data. A determination is made as to whether a satisfactory result will be obtained by re-using the set of parameters, which had been established for decoding the coded data, for decoding the coded modified data. If so, the established set of parameters is added to the coded modified data for decoding purposes. If a satisfactory result will not be obtained by re-using established parameters, a new set of parameters is added to the coded modified data for decoding.

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

1. A method of modifying coded data (CD) which is accompanied by a set of parameters (PAR) for decoding the coded data (CD), the method comprising the steps of:

decoding (DEC1), at least partially, the coded data (CD) so as to obtain decoded data (DD);

modifying (MOD) the decoded data (DD) so as to obtain modified data (MD);

coding (ENC2) the modified data (MD) so as to obtain coded modified data (CMD);

examining (EXAM) whether a satisfactory result will be obtained, if the set of parameters (PAR) for decoding the coded data (CD) is applied for decoding (DEC2) the coded modified data (CMD); and

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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 and 2. 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, 1073, 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 Hosp. Sys., Inc. v.

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Montefiore Hosp., 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 claims 1 and 2, Appellant asserts 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 prior art reference. In particular, Appellant contends (Brief, pages 3-5) that the applied Rasky reference does not teach or suggest the claimed feature of "examining whether a satisfactory result will be obtained, if the set of parameters for decoding the coded data is applied for decoding the coded modified data."

After reviewing the arguments of record from Appellant and the Examiner, we are in general agreement with Appellant's position as stated in the Brief. Although the Examiner asserts (Answer, page 3) that, in Rasky, a decision is made in soft

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decision block 107 whether to continue decoding or to re-encode the incoming data, we find no support in Rasky for such a conclusion.

Rasky does indeed suggest (column 6, lines 33-40) that after a number of iterations there will no longer be any errors left to correct. There is no indication, however, as to how or where a determination is made whether a satisfactory result will be obtained if the original set of parameters used for decoding is also used for decoding the coded modified data. In our view, even assuming, arguendo, the Examiner's summarization of the operation of Rasky is correct, we fail to see how this would satisfy the language of the claims on appeal. The Examiner must not only make requisite findings, based on the evidence of record, but must also explain the reasoning by which the findings are deemed to support the asserted conclusion. See In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002).

In view of the above discussion, in order for us to sustain the Examiner's rejection, we would need to resort to impermissible speculation or unfounded assumptions or rationales to supply deficiencies in the factual basis of the rejection before us. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968), reh'g denied,

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390 U.S. 1000 (1968). Accordingly, since all of the claim limitations are not taught or suggested by the disclosure of Rasky, we do not sustain the Examiner's 35 U.S.C. § 103(a) rejection of appealed claims 1 and 2. Therefore, the decision of the Examiner rejecting claims 1 and 2 is reversed.

REVERSED

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JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH L. DIXON)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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ANITA PELLMAN GROSS)	
Administrative Patent Judge)	

JFR:hh

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