

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 RICHARD JOSEPH PAULS and MICHAEL CHARLES RECCHIONE

Appeal No. 2004-0913
Application No. 08/940,760

ON BRIEF

Before JERRY SMITH, BLANKENSHIP, and NAPPI, Administrative Patent Judges.
BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-3 and 5-36, which are all the claims remaining in the application.

We reverse.

BACKGROUND

The invention relates to improving data transfer performance over communications networks. The invention uses a set of transcoding techniques to encode (or compress) the data and a set of error control schemes to correct errors occurring during transmission. The selection of particular sets of transcoding and error control schemes may be based on the data type (e.g., voice, video, or text) of the data being transmitted. Representative claim 1 is reproduced below.

1. A method for transmitting data over a communications network, the method comprising the steps of:
 - determining a data type for the data;
 - selecting a transcoding technique and an error control scheme to format the data based on the data type;
 - encoding the data using the selected transcoding technique; and
 - applying the selected error control scheme to the encoded data, the selected error control scheme adding error control information to the encoded data.

The examiner relies on the following references:

Bresalier et al. (Bresalier)	5,513,181	Apr. 30, 1996
Suzuki et al. (Suzuki)	6,202,188 B1	Mar. 13, 2001 (filed Jul. 2, 1997)

Claims 1-3 and 5-36 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bresalier and Suzuki.

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We refer to the Final Rejection (Paper No. 23) and the Examiner's Answer (Paper No. 30) for a statement of the examiner's position and to the Brief (Paper No. 29) for appellants' position with respect to the claims which stand rejected.

OPINION

Bresalier uses the term "transcoding," as the examiner notes, to include processes such as encoding, decoding, error detection, and error correction. See Bresalier col. 1, ll. 16-24; col. 4, ll. 51-57. The rejection relies on Suzuki, at least for purposes of the instant independent claims, solely for the teaching of adding error control information to transmitted data.

Appellants argue that an examiner's finding with respect to Bresalier is in error. In appellants' view, Bresalier does not teach selecting a transcoding technique and an error control scheme to format the data based on the data type, as required in substance by all the claims on appeal. In the examiner's reading of the reference, Bresalier teaches that each of a variety of different data types requires a different transcoding technique, relying on column 4, lines 48 through 52 of the reference. (Answer at 3.) Elsewhere in the Answer (at 8), the examiner contends that Bresalier "inherently" discloses selecting the transcoding and error control scheme based on the determined type of data.

We find that Bresalier discloses:

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In the exemplary embodiment, input lead 211 [Fig. 6] is preferably capable of transporting a plurality of communication signals (e.g., half-duplex audio, video or data signals), each of which is to be transcoded in accordance with a particular coding technique....

Either the source or destination device (e.g., the mobile switching center or base station controller) communicates to the illustrative embodiment which communication signals are to be transcoded with which coding technique with either: (1) in-band signaling that is carried by input lead 211 is a component of the various communication signals, or (2) by out-of-band signaling that can be carried to the exemplary embodiment by input lead 211 or by an alternative route.

Bresalier col. 4, l. 47 - col. 5, l. 6.

We agree with appellants that, according to Bresalier's objective teaching, the source or destination determines the transcoding technique (which may include error detection and correction), but the reference does not disclose, expressly or inherently, how the determination is made by the source or destination. Bresalier discloses that a plurality of communication signals are to be transcoded in accordance with selected techniques, and that the signals may comprise, for example, audio, video, or data. We find no disclosure or suggestion of determining a transcoding technique and an error control scheme based on the data type. Moreover, the only example that Bresalier appears to provide of different transcoding and error control techniques as related to data type is that of applying different techniques to a single data type; i.e., audio. See col. 1, ll. 36-51.

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What the examiner may deem to be an “inherent” teaching of Bresalier has not been established on this record. Our reviewing court has set out clear standards for establishing inherency.

To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)
(citations omitted).

Appellants’ specification teaches that certain transcoding techniques and error control schemes are more effective when used to format particular data types. (Spec. at 7, final ¶ et seq.) Appellants contend (Brief at 6) that it is not known -- and thus was not known at the time of invention -- to select a transcoding technique and an error control scheme to format data based on the data type. We must accept appellants’ contention as correct, to the extent that it reflects the artisan’s knowledge at the time of invention, because the contention is effectively uncontroverted. We presume that had a contradictory teaching in the prior art been available, the examiner would have provided it.

Therefore, since the evidence relied upon by the examiner is not sufficient to establish a case for prima facie obviousness, we cannot sustain the § 103 rejection of claims 1-3 and 5-36.

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CONCLUSION

The rejection of claims 1-3 and 5-36 under 35 U.S.C. § 103 as being unpatentable over Bresalier and Suzuki is reversed.

REVERSED

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

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