The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID H. HANES

Appeal No. 2005-2559
Application No. 09/911,017

ON BRIEF

Before HAIRSTON, KRASS, and BLANKENSHIP, 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 1-20, which are all the claims in the application.

We reverse.

BACKGROUND

The invention relates to scene or shot boundary detection in video data for storage on optical storage media (e.g., DVD), for allowing a user to access the appropriate place in the video data. Representative claim 1 is reproduced below.

1. A method for storing scene detection information, comprising:

identifying scene candidates from received video data;

formatting the scene candidates for storage on optical storage media, the optical storage media having a recordable capacity; and

storing the formatted scene candidates on the optical storage media in a media structure without reducing the recordable capacity.

The examiner relies on the following reference:

Dimitrova et al. (Dimitrova)	6,137,544	Oct. 24, 2000 (filed Jun. 2, 1997)

Claims 1-20 stand rejected under 35 U.S.C. § 102 as being anticipated by Dimitrova.

We refer to the Final Rejection (mailed Sep. 24, 2004) and the Examiner's Answer (mailed Jun. 1, 2005) for a statement of the examiner's position and to the Brief (filed Mar. 17, 2005) and the Reply Brief (filed Jul. 5, 2005) for appellant's position with respect to the claims which stand rejected.

OPINION

Dimitrova is directed to a video indexing system whereby a visual index, that may consist of visual images, audio, or text, is created on a pre-existing or new video tape. Col. 2, ll. 36-49. The invention may also be applied to storage media such as files or DVD, to ease access to particular points in the video program. Col. 1, ll. 61-63. Dimitrova's detailed embodiment relates in the main to video tape (e.g., Fig. 1). The reference, however, also makes clear that MPEG files or disks may benefit from the indexing. E.g., col. 12, l. 65 - col. 13, l. 4. Appellant submits that Dimitrova fails to show, as recited in instant claim 1, storing the formatted scene candidates on the optical storage media in a media structure "without reducing the recordable capacity." Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). The first inquiry must be into exactly what the claims define. In re Wilder, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970). The independent claims all relate to storage, or at least formatting for storage, on optical storage media. While Dimitrova describes an optical storage medium (i.e., DVD), the disclosure relating to details of formatting and storage on video tape would not necessarily be applicable to a file, or to an optical storage medium.

The examiner seems to suggest that the "tape" described by Dimitrova is some sort of optical storage medium. On this record, however, the video tape described by

Dimitrova appears to be no more than a conventional magnetic storage medium. See, e.g., col. 3, ll. 13-22. The discussion between the examiner and appellant with respect to whether or not reserving a portion of a tape for the visual index (col. 2, ll. 36-42) reduces the recordable capacity of the tape is essentially irrelevant to what is claimed.

More specific to optical storage media, the examiner relies (Answer at 4), in particular, on a sentence at column 2, lines 42 through 44 of the reference: "For a file, the selected area for the visual index may occur anywhere in the file, and may be reserved by a system automatically or manually selected by a user." The examiner relates this teaching to appellant's specification, which reveals that the optical storage medium includes an area allocated to store additional information that may be used for data interchange, which does not reduce the recordable capacity of the medium. (Answer at 5.) Appellant's specification (at 10, ll. 9-30) does seem to say that the scene detection information may be stored on a data portion of DVDs, using existing DVD format specifications, such that the available storage capacity of the medium is not reduced.

However, the instant rejection is for anticipation. The examiner has not used appellant's teachings in the specification as an admission of prior art, nor supplied a teaching reference that might show the artisan's knowledge with respect to use of various storage portions of optical storage media,[1] in a rejection over combined

[1] See, e.g., Ralph Labarge, "A Cure For Insomnia And Other Uses Of The DVD-Video Specification," Interactivity, pp. 61-63 (Sept. 1998).

teachings from the prior art under 35 U.S.C. § 103. The column 2 portion of Dimitrova relied upon by the examiner is, at best, a suggestion, but not a disclosure having the specificity required by the instant claims.

Further, we cannot substitute our own knowledge for evidence that is lacking in the record. See In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (in a determination of patentability "the Board must point to some concrete evidence in the record in support of...[the]...findings"). "With respect to core factual findings in a determination of patentability . . . the Board cannot simply reach conclusions based on its own understanding or experience -- or on its assessment of what would be basic knowledge or common sense." Id.

We thus cannot sustain the rejection of claims 1-20 under 35 U.S.C. § 102 as being anticipated by Dimitrova.

CONCLUSION

The rejection of claims 1-20 under 35 U.S.C. § 102 as being anticipated by Dimitrova is reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)	
ERROL A. KRASS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
HOWARD B. BLANKENSHIP Administrative Patent Judge	)	

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