

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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex Parte JEFFERSON EUGENE OWEN, RAUL ZEGERS DIAZ  
and OSVALDO COLAVIN

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Appeal No. 2006-0889  
Application No. 10/174,918

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ON BRIEF

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Before KRASS, JERRY SMITH and MACDONALD, Administrative Patent Judges.

MACDONALD, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of claims 1-22.

**Invention**

The present application discloses an electronic system that contains a first device and video and/or audio decompression and/or compression device capable of operating in real time. Both the first device and the video and/or audio decompression and/or compression device require access to a memory. The video and/or audio decompression and/or compression device shares the memory with the first device. The two devices are coupled to the memory through a fast bus having a bandwidth of at least the minimum bandwidth

needed for the video and/or audio decompression and/or compression device to operate in real time.

In one preferred embodiment of the invention the two devices share an arbiter. The arbiter and Direct Memory Access (DMA) engines of the video and/or audio decompression and/or compression device and of the first device are configured to arbitrate between the two devices when one of them is requesting access to the memory. This allows both the video and/or audio decompression and/or compression device and the first device to share the memory. Appellants' specification at page 7, lines 15-28.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. An electronic system comprising:

a main memory having stored therein data corresponding to images to be decoded and also decoded data corresponding to images that have previously been decoded;

a bus coupled to the memory; and

a decoder coupled to the bus for receiving compressed images and for outputting a data for displaying the decoded images on a display device, the decoder receiving data from the main memory corresponding to at least one previously decoded image and to a current image to be decoded and outputting decoded data corresponding to a current image to be displayed, the current image being stored in the main memory.

a microprocessor system coupled to the main memory, the microprocessor system storing non-image data in and retrieving data from the main memory; and

an arbiter circuit coupled to both the microprocessor system and the decoder for controlling the access to said main memory by the decoder and the microprocessor.

### **References**

The references relied on by the Examiner are as follows:

Appeal No. 2006-0889  
Application No. 10/174,918

Cheney et al. (Cheney)	5,576,765	November 19, 1996
Wasserman et al. (Wasserman)	5,774,206	June 30, 1998

### **Rejections At Issue**

Claims 1-22 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Cheney and Wasserman.

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

### **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 claims 1-22 under 35 U.S.C. § 103.

We also use our authority under 37 C.F.R. § 41.50(b) to enter a new grounds of rejection of claims 1-4. The basis for this is set forth in detail below.

#### **I. Whether the Rejection of Claims 1-22 Under 35 U.S.C. § 103 is proper?**

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 invention as set forth in claims 1-22. Accordingly, we reverse.

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<sup>1</sup> Appellants filed an appeal brief on July 11, 2005. The Examiner mailed an Examiner's Answer on September 16, 2005.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. “In reviewing the [E]xaminer’s decision on appeal, the Board must necessarily weigh all of the evidence and argument.” **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. “[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion.” **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 1, Appellants argue at page 7 of the brief, “the prior art fails to show ‘an arbiter circuit coupled to both the microprocessor system and the decoded for controlling the access to said main memory by the decoder and the microprocessor.’” We agree. The Examiner takes the position in the rejection (page 4 of the

answer) that item 600 of Cheney is an arbiter circuit. We see no basis in Cheney for this finding.

The Examiner then argues at page 7 of the answer “a memory arbiter would have been obvious in view of the memory management unit [600] of Cheney.” However, the Examiner fails to explain how this (without more) would then result in the arbiter functionality recited in the claim. Ultimately, this and other alternative theories of the rejection, not on appeal before this Board, set forth in the Examiner’s response all fail for the same reason. If the Examiner wishes to introduce any new grounds of rejection based on the same references, then the new rejection must be formally stated as set forth in 37 C.F.R. § 41.39. Alternatively, the Examiner may reopen prosecution.

For the reasons above, we will not sustain the Examiner’s rejection under 35 U.S.C. § 103.

## **II. Rejection of Claims 1-4 Under 37 C.F.R. § 41.50(b).**

We make the following new grounds of rejection using our authority under 37 C.F.R. § 41.50(b).

Claims 1-4 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claim 1 contains a period in the middle of the claim. It is unclear whether claim 1 ends at the first or second period in the claim.

### **Conclusion**

In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. § 103 of claims 1-22, and we have entered a new grounds of rejection against claims 1-4 under 37 C.F.R. § 41.50(b).

As indicated **supra**, this decision contains a new grounds of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004).

37 C.F.R. § 41.50(b) provides that, “[a] new grounds of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 C.F.R. § 1.197 (b) (amended effective September 13, 2004)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner ...
- (2) Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record ...

**REVERSED**

**37 C.F.R. § 41.50(b)**

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

**Comment [COMMENT1]:** The year should be entered here.

ERROL A. KRASS	)
Administrative Patent Judge	)
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JERRY SMITH	) <b>BOARD OF PATENT</b>
Administrative Patent Judge	) <b>APPEALS AND</b>
	) <b>INTERFERENCES</b>
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ALLEN R. MACDONALD	)
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ARM/rwk

Appeal No. 2006-0889  
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