UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHU LIN and DONALD HENRY WILLIS

Appeal 2008-2605
Application 10/121,089[1]
Technology Center 2600

Decided: September 24, 2008

Before JOSEPH F. RUGGIERO, ROBERT E. NAPPI, and MARC S. HOFF, *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a Final Rejection of claims 1-18. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' invention relates to a method for trick mode playback of an MPEG video presentation recorded on a storage medium. Upon receiving a command requesting a trick mode playback for a portion of the MPEG

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[1] Application filed April 11, 2002. The real party in interest is Thomson Licensing.

video presentation, an information file for the MPEG video presentation can be accessed. The information file can contain selected data about the MPEG video presentation, which can be used to facilitate the trick mode playback (Spec. 3).

Claim 1 is exemplary:

1 A method for trick mode playback of an MPEG video presentation recorded on a storage medium, comprising:

responsive to a command for trick mode playback of a portion of the MPEG video presentation, accessing an information file for the MPEG video presentation, said information file containing selected data about the MPEG video presentation for facilitating said trick mode;

retrieving from said information file, information for performing said trick mode playback indicated by said command.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Toebes, VIII	US 5,959,690	Sep. 28, 1999
Senoh	US 2003/0007780 A1	Jan. 9, 2003
Nakazawa	US 6,674,480 B2	Jan. 6, 2004

Claims 1-4, 6-13, and 15-18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Toebes.

Claims 5 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Toebes in view of Senoh and Nakazawa.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Appeal Brief (filed August 2, 2007) and the Answer (mailed October 5, 2007) for their respective details.

ISSUE

The principal issue in the appeal before us is whether Toebes teaches "trick mode playback" within the meaning ascribed to the phrase in Appellants' Specification.

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

The Invention

1. According to Appellants, they have invented a method for trick mode playback of an MPEG video presentation recorded on a storage medium. Upon receiving a command requesting a trick mode playback for a portion of the MPEG video presentation, an information file for the MPEG video presentation can be accessed. The information file can contain selected data about the MPEG video presentation, which can be used to facilitate the trick mode playback (Spec. 3).

2. Appellants' Specification states that users will expect DVDs using MPEG compression protocols to offer,

> at minimum, features similar to those of predecessor devices such as an analog video cassette recorder (VCR). For example, a DVD can be expected to provide playback in either forward or reverse directions at speeds other than a normal playback speed, designated 1X by convention. Such non-standard speed playback features are known as trick modes.

Spec. 1:17-23.

3. When describing "forward trick modes," Appellants indicate that playback speed can range between 2X (i.e., two times regular speed) and 15X (Spec. 14:12-23).

4. When describing reverse trick mode, Appellants do not exclude 1X playback (i.e., playback in reverse at the same speed as regular forward playback) from possible choices (Spec. 11:16, 12:6, 12:12-13, 15:16, 15:25).

5. Appellants teach that pause is one of the trick modes (Spec. 12).

Toebes

6. Toebes teaches a method and apparatus for random, frame accurate access to an MPEG video stream at any frame, and to provide high quality reverse play of MPEG video streams using computing resources approximately the same as those required for forward MPEG play (col. 6, ll. 25-32).

7. Toebes teaches reverse playback of MPEG video (col. 7, ll. 34-48).

8. Toebes facilitates reverse play (a form of trick play) by creating B frames from the MPEG data. This includes accessing frames from the MPEG file. See col. 16, ll. 55- 67, and col . 17, ll. 7-15.

9. Toebes teaches an information file containing selected data about the MPEG video presentation (col. 9, l. 64 – col. 10, l. 26).

Senoh

10. Senoh teaches providing trick playback of compressed digital audio and video data including random access, fast forward, and fast reverse playback modes (para. 0001, 0009).

Nakazawa

11. Nakazawa teaches a frame-rate converting device for a moving picture decoder which makes it possible to perform a smooth display of

pictures even when a display is made on a monitor of 30 Hz or 60 Hz based on stream data whose input frame rate is 24 Hz (col. 1, ll. 52-56).

PRINCIPLES OF LAW

Anticipation of a claim requires a finding that the claim at issue reads on a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) (quoting *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 781 (Fed. Cir. 1985)).

Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

In an appeal from a rejection for anticipation, the Appellants must explain which limitations are not found in the reference. *See Gechter v. Davidson*, 116 F.3d 1454, 1460 (Fed. Cir. 1997) ("[W]e expect that the Board's anticipation analysis be conducted on a limitation by limitation basis, with specific fact findings for each *contested* limitation and satisfactory explanations for such findings.")(emphasis added). *See also In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case

with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.")

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that "the principles laid down in *Graham* reaffirmed the 'functional approach' of *Hotchkiss*, 11 How. 248." *KSR*, 127 S.Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966) (emphasis added)), and reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The Court explained:

> When a work is available in one form of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740. The operative question in this "functional approach" is thus, "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.*

The claim terms should be given their broadest reasonable meaning in their ordinary usage as such claim terms would be understood by one skilled in the art by way of definitions and the written description. *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

> The claims, of course, do not stand alone. Rather, they are part of a 'fully integrated written instrument' . . . consisting principally of a specification that concludes with the claims. For that reason, claims 'must be read in view of the specification, of which they are a part.' . . . . [T]he specification 'is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.'

Phillips v. AWH Corp., 415 F.3d 1303, 1315 (Fed. Cir. 2005).

Our reviewing court states that "claims must be interpreted as broadly as their terms reasonably allow." *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989). Our reviewing court further states that "the words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc)(internal citations

omitted). The "ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id*. at 1313. The description in the specification can limit the apparent breadth of a claim in two instances: (1) where the specification reveals a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess; and (2), where the specification reveals an intentional disclaimer, or disavowal, of claim scope by the inventor. *Id*. at 1316.

ANALYSIS

Claims 1-4, 6-13, and 15-18

We note at the outset that Appellants urge the separate patentability of each claim (Br. 17). Upon inspection of Appellants' Brief, it is clear that Appellants present arguments in favor of the patentability of claim 1. For the other pending claims, however, Appellants merely state that each claim is patentable for the reasons given for claim 1, and then recite the bare text of the claim as a 'reason' why it is separately patentable. 37 C.F.R. § 41.37 (c)(1)(vii) states that "A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim." Because Appellants have provided mere statements as to what the claims recite, rather than a separate argument directed to the separate patentability of the claims, Appellants' arguments have grouped claims 1-4, 6-13, and 15-18 together. We select claim 1 as representative of the group.

Appellants argue that Toebes "absolutely fails to teach … accessing an information file in response to a command for trick mode playback" (Br.

21) and fails to teach "retrieving information from a file for performing a trick mode playback" (Br. 21). In contrast to Appellants' invention, Appellants argue, "Toebes teaches referring to an index to perform a seek operation, which is not at all equivalent to a trick mode playback as taught and claimed by the Appellant. In fact, there is absolutely no mention of a trick mode playback in Toebes at all" (Br. 21).

In order to decide the subject appeal, it is necessary to determine the meaning of the phrase "trick mode playback." To do so, we look first to the Specification, "the single best guide to the meaning of a disputed term." *Phillips*, 415 F.3d at 1315. Appellants state that users will expect DVDs using MPEG compression protocols to offer,

> at minimum, features similar to those of predecessor devices such as an analog video cassette recorder (VCR). *For example*, a DVD can be expected to provide playback in either forward or reverse directions at speeds other than a normal playback speed, designated 1X by convention. Such non-standard speed playback features are known as trick modes.

FF 2 (emphasis added).

Appellants thus indicate that trick mode playback encompasses features similar to those offered in a VCR, and gives a *non-exhaustive* example of possible such features.

Appellants' invention is entitled "Fast Forward Trick Mode and Reverse Trick Mode Using An Information File," which suggests that reverse playback need not be "fast" (i.e., faster than regular playback) to be considered "trick" play. When describing "forward trick modes," Appellant indicates that playback speed can range between 2X (i.e., two times regular speed) and 15X (FF 3); when mentioning reverse trick mode, however,

Appellant does not exclude 1X playback (i.e., playback in reverse at the same speed as regular forward playback) from possible choices (FF 4).

Appellants teach that pause is one of the trick modes (FF 5).

The Examiner finds, and Appellants do not rebut, that "[a]s recognized by those having ordinary skill in the art, trick mode playback must be understood as any playback mode other than normal playback" (Final Rej. 2; Ans. 9).

Taking together Appellants' teaching that trick modes should be similar to those available on VCRs, Appellants' failure to exclude 1X reverse playback from the possible reverse speeds constituting "trick play," and the Examiner's unrebutted finding that trick mode constitutes any playback mode other than normal playback, we construe Appellants' phrase "trick mode playback" as encompassing, at minimum, 1X reverse playback as one possible trick mode.

Because we construe "trick mode playback" as encompassing 1X reverse playback, we find Appellants' arguments with respect to Toebes unpersuasive. Toebes teaches reverse playback of MPEG video (FF 7). Further, we agree with the Examiner's findings that Toebes teaches accessing an information file for an MPEG video presentation in response to a command for trick mode playback, e.g., reverse playback (FF 8), said information file containing selected data about the MPEG video presentation (FF 9), and retrieving information for performing the trick mode playback indicated by said command (FF 8), as claim 1 requires. Ans. 3.

Because we find that Toebes teaches all the limitations of independent claims 1 and 10, we do not find error in the Examiner's rejection of claims 1-4, 6-13, and 15-18 under 35 U.S.C. § 102(b).

Claims 5 and 14

We select claim 5 as representative of this group, pursuant to our authority under 37 CFR § 41.37(c)(1)(vii).

Appellants do not present separate argument in favor of the patentability of claims 5 and 14. Instead, Appellants assert that the claims are patentable for the same reasons advanced for the patentability of parent claims 1 and 10 respectively, and that Senoh and Nakazawa fail to remedy the asserted deficiencies of Toebes (Br. 34-35). Because we find *supra* that Toebes teaches all the limitations of claims 1 and 10, we therefore sustain the rejections of claims 5 and 14 under 35 U.S.C. § 103(a), for the same reasons.

CONCLUSION OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1-18. Claims 1-18 are not patentable.

DECISION

The Examiner's decision rejecting claims 1-18 is affirmed.

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).

AFFIRMED

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