

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HONG-KEE KIM and SUNG-PIL CHOI

Appeal 2008-2623
Application 09/796,691
Technology Center 2600

Decided: September 2, 2008

Before KENNETH W. HAIRSTON, SCOTT R. BOALICK,
and JOHN A. JEFFERY, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 39-68, 71-74, 77, 78, and 82-84.¹ We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part.

¹ Although the Brief indicates that claims 75 and 76 are on appeal (Br. 2), these claims have been cancelled (Ans. 2).

STATEMENT OF THE CASE

Appellants invented a digital audio player that enables editing digital audio data to a particular size thus enhancing the efficiency of storage. A controller displays a menu that enables selection of a bitrate and target extraction data size.² Claim 39 is illustrative with the key limitations in dispute emphasized:

39. A digital audio player for storing digital audio data in a memory portion, comprising:

a key input portion having a predetermined key for enabling adjustment of a data extraction rate with respect to an audio signal input through an input portion; and

a controller for encoding said audio signal received through the input portion according to an adjusted data extraction rate, and storing the encoded audio data in the memory portion;

said predetermined key providing, when activated by a user, a predetermined key signal to the controller and said controller displaying a menu on a display, in response to said predetermined key signal, said menu including a *bitrate adjustment tool* for selecting a bitrate at predetermined kilobyte per second intervals and a *target data size tool* for selecting a target data size at predetermined kilobyte intervals, said data extraction rate being adjusted according to a selected one of the bitrate adjustment tool and the target data size tool.

The Examiner relies on the following prior art references to show unpatentability:

Terui	US 5,903,871	May 11, 1999
Downs	US 6,226,618 B1	May 1, 2001 (filed Aug. 13, 1998)

² See generally Spec. ¶¶ 0012-23.

Appeal 2008-2623
Application 09/796,691

Chaddha	US 6,233,017 B1	May 15, 2001 (filed Jun. 30, 1997)
Hinderks	US 2001/0010040 A1	Jul. 26, 2001 (filed Nov. 30, 2000)
Nakazawa	US 2001/0010663 A1	Aug. 2, 2001 (filed Jan. 24, 2001)

Information Technology - Coding of Audiovisual Objects, Part 3: Audio, Subpart 4: Time/Frequency Coding, ISO/IEC CD 14496-3 Subpart 4, ISO/JTC 1/SC 29/WG11, May 15, 1998 (“ISO/IEC”).

Screenshots of RealJukebox 1.0.0.439, 1999³ (“RealJukebox”).

Screenshots of MusicMatch JukeBox, Version 5.10.0149 (undated)⁴ (“MusicMatch”).

Creative NOMAD II User Guide, Version 1.1, Apr. 2000 (“Creative”).

Texas Instruments and Fraunhofer to Develop First On-Board AAC and MP3 Encoding Solution for Portable Digital Audio Devices, PR Newswire, New York, Jan. 6, 2000, at 1 (“TI”).

1. Claims 39, 40, 48, 49, 51, and 53 stand rejected under 35 U.S.C. § 102(b) as being anticipated by RealJukebox.
2. Claims 41, 46, 47, 60-63, 66-68, 72-74, 78, and 84 stand rejected under 35 U.S.C. § 103(a) as unpatentable over RealJukebox and ISO/IEC.⁵

³ Although the publication year of 1999 does not clearly appear on this reference, the Examiner nonetheless indicates that the subject matter of the screenshots was available to the public in 1999 (Ans. 3)—a factual finding that is undisputed.

⁴ Although no date appears on this publication, the qualification of this reference as prior art is undisputed.

⁵ Although the Examiner includes claims 69 and 79-81 in this rejection (Ans. 5; Final Rej. 18), these claims have been cancelled (Ans. 2). We deem this

3. Claim 42 stands rejected under 35 U.S.C. § 103(a) as unpatentable over RealJukebox, Hinderks, and Terui.
4. Claim 43 stands rejected under 35 U.S.C. § 103(a) as unpatentable over RealJukebox, Hinderks, Terui, and ISO/IEC.
5. Claims 44, 45, 64, and 82 stand rejected under 35 U.S.C. § 103(a) as unpatentable over RealJukebox, ISO/IEC, and Chaddha.⁶
6. Claims 50 and 57 stand rejected under 35 U.S.C. § 103(a) as unpatentable over RealJukebox and TI.
7. Claims 65, 71, 77, and 83 stand rejected under 35 U.S.C. § 103(a) as unpatentable over RealJukebox, ISO/IEC, and TI.
8. Claim 52 stands rejected under 35 U.S.C. § 103(a) as unpatentable over RealJukebox, Nakazawa, and Creative.
9. Claims 54-56 stand rejected under 35 U.S.C. § 103(a) as unpatentable over RealJukebox, Downs, and ISO/IEC.
10. Claim 58 stands rejected under 35 U.S.C. § 103(a) as unpatentable over MusicMatch and ISO/IEC.
11. Claim 59 stands rejected under 35 U.S.C. § 103(a) as unpatentable over MusicMatch, ISO/IEC, and Downs.

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Brief and the Answer⁷ for their respective details. In this decision, we have considered only those arguments actually made by

error harmless as it does not affect our decision regarding the merits of this rejection.

⁶ In this rejection, the Examiner likewise erroneously includes cancelled claim 70 (Ans. 6; Final Rej. 29, 32). *See* Ans. 2. Nevertheless, we deem this error harmless.

⁷ We refer to the most recent Appeal Brief filed November 20, 2006 and the Examiner's Answer mailed December 12, 2007 throughout this opinion.

Appellants. Arguments which Appellants could have made but did not make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

FINDINGS OF FACT

The following findings of fact (FF) are supported by substantial evidence on the record before us:

1. RealJukebox is a collection of screenshots from a software application entitled “RealJukebox 1.0.0.439” depicting various features of the program.
2. The “Preferences” menu is available from the “Options” menu on the main screen of RealJukebox (RealJukebox, at 2 (“First Screenshot”)).
3. The “Encoding Options” tab on the “Preferences” menu contains a table containing various audio encoding parameters: (1) “Bitrate” (identified as column “F”); (2) “Limit” (column “I”); (3) “Quality Level”; and (4) “Disk Space” (column “H”) (RealJukebox, at 3 (“Second screenshot”)).
4. The “Bitrate” options include various bitrates including (1) “96 Kbps Stereo”; (2) “64 Kbps Stereo”; (3) “44 Kbps Stereo”; and (4) “32 Kbps Mono” (RealJukebox, at 3 (“Second screenshot”)).
5. The “Disk Space” options include (1) “44 MB per CD”; (2) “29 MB per CD”; (3) “20 MB per CD”; and (4) “14 MB per CD” (RealJukebox, at 3 (“Second screenshot”)).
6. A horizontal bar highlights an entire row of the table such that each data item in every column in that row of the table is likewise highlighted (RealJukebox, at 3 (“Second screenshot”)). In this screenshot, the last row is

highlighted thus selecting (1) a “Bitrate” of 32 Kbps Mono, (2) a “Limit” of 4967 CDs; and (3) a “Disk Space” of 14 MB per CD (*Id.*).

7. MusicMatch is a collection of screenshots from a software application entitled “MusicMatch JukeBox, Version 5.10.0149” depicting various features of the program.

8. After selecting the “Options” menu (labelled “F”), the user can select the “Send to Device | “Download Playlist to Nike psa[128max Player” option (MusicMatch, at 2 (“First Screenshot”)).

9. Upon selecting this option, the “Download Playlist to Nike psa[128max Player” is displayed. On this screen, there is a menu listing various bitrates (33kbs, 64kbs, 96kbs, 128kbs, “None”) (MusicMatch, at 2 (“Second Screenshot”)).

10. The “Download Playlist to Nike psa[128max Player” display also contains a list of MP3 files underneath a column (“File Name”) and another column (“Size (MB)”) with numbers underneath indicating the file size of each associated file (MusicMatch, at 2 (“Second Screenshot”)). This listing is labelled “G” in the Final Rejection reproduction of this screenshot (Final Rej. 43).

PRINCIPLES OF LAW

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. *RCA Corp. v. Appl. Dig. Data Sys., Inc.*, 730 F.2d 1440, 1444 (Fed. Cir. 1984); *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554 (Fed. Cir. 1983).

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 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

If the Examiner's burden is met, the burden then shifts to the Appellants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

THE ANTICIPATION REJECTION

We first consider the Examiner's anticipation rejection of claims 39, 40, 48, 49, 51, and 53 over RealJukebox (Ans. 4; Final Rej. 12-17).⁸

Claims 39, 40, and 48

Representative independent claim 39⁹ calls for, in pertinent part, the displayed menu to include (1) a bitrate adjustment tool for selecting a bitrate, and (2) a target data size tool for selecting a target data size. The claim

⁸ We note that the Examiner's Answer does not expressly state the Examiner's grounds of rejection, but instead refers us to a previous office action, namely the Final Rejection. Such incorporations by reference, however, are improper under current practice. *See* MPEP § 1207.02 ("An examiner's answer should not refer, either directly or indirectly, to any prior Office action without fully restating the point relied on in the answer.").

⁹ Since Appellants' initial arguments pertaining to this rejection are limited to independent claim 39, Appellants effectively argue claims 39, 40, and 48 together as a group. *See* Br. 21-23. Accordingly, we select claim 39 as representative. *See* 37 C.F.R. § 41.37(c)(1)(vii).

further specifies that the data extraction rate is adjusted according to a selected one of the bitrate adjustment tool and the target data size tool.

Appellants argue that RealJukebox does not disclose a separately selectable “target data size tool”—a tool that must be a separate and distinct selectable item from the “bitrate adjustment tool.” According to Appellants, the columns F, I, and H identified by the Examiner in the screenshot of RealJukebox are not separately selectable, but only the bitrate is selected in this display (i.e., Item F). Appellants emphasize that Item H (the column that is said to correspond to the recited “target data size tool”) is not directly selected, but is merely a reference item that the user uses to select a bitrate (Br. 21-23).

The Examiner responds that the user in RealJukebox can make selections according to either (1) the left column (F) (a “bitrate adjustment tool”), or (2) the right column (H) (a “target data size tool”). These distinct selection options, the Examiner contends, fully meet the disputed limitations (Ans. 8-11).

ISSUE

The issue before us, then, is whether Appellants have shown that the Examiner erred in finding that RealJukebox anticipates the disputed limitations of representative claim 39. The issue turns on whether (1) the left column (F) of RealJukebox reasonably corresponds to a “bitrate adjustment tool”, and (2) the right column (H) reasonably corresponds to a “target data size tool” as claimed. For the following reasons, we find that Appellants have not shown such error.

ANALYSIS

Based on the depictions of the screenshots of RealJukebox as indicated in the Findings of Fact section above (FF 1-6), we find no error in the Examiner's interpretation of the selection according to the "Bitrate" column options in RealJukebox as corresponding to a "bitrate adjustment tool." Nor do we find error in the Examiner's findings that selection according to the "Disk Space" column options in RealJukebox corresponds to a "target data size tool."

We recognize that the encoding options in RealJukebox are presented as a table such that the user, in effect, selects a row of that table (and the corresponding data items in each column) by highlighting that particular row (FF 6). In so doing, the user would effectively select both a particular bitrate (32 Kbps Mono) and disk space (14 MB per CD) as shown in the screenshot (FF 6). And we further recognize that the "Disk Space" column, in effect, provides information to the user regarding a particular encoding bitrate indicated in the "Bitrate" column as Appellants point out (Br. 21-22).

But nothing in the claim precludes these respective columns as corresponding to the recited "tools," namely the "bitrate adjustment tool" and "target data size tool." That is, the user can select a row based on the information presented in the "Bitrate column" (FF 4). Likewise, the user can select a row based on the information presented in the "Disk Space" column (FF 5)—information that would represent a "target data size" in terms of disk space required. In that sense, these different selection options constitute distinct "tools" for selection. Although the data in these columns may be related, the user can nonetheless select the row on the basis of information presented in either "tool."

For the foregoing reasons, Appellants have not persuaded us of error in the Examiner's rejection of representative claim 39. Therefore, we will sustain the Examiner's rejection of that claim, and claims 40 and 48 which fall with claim 39.

Claims 49 and 51

Regarding representative independent claim 49, Appellants essentially reiterate the arguments presented with respect to claim 39 regarding the alleged failure of RealJukebox to disclose a target data size in the adjustment of a data extraction rate (Br. 23). We are unpersuaded by these arguments, however, for the reasons previously discussed.

For the foregoing reasons, Appellants have not persuaded us of error in the Examiner's rejection of representative claim 49. Therefore, we will sustain the Examiner's rejection of that claim, and claim 51 which falls with claim 49.

Claim 53

Regarding claim 53, Appellants' contention that the Examiner "overlooked" the rejection of claim 53 (Br. 23) is unavailing. First, the Grounds of Rejection in the Answer unambiguously include claim 53 in the anticipation rejection (Ans. 4). Second, although the Examiner did omit claim 53 in the first sentence of the anticipation rejection on page 12 of the Final Rejection, the Examiner nonetheless included an analysis pertaining to claim 53 in the body of the rejection (Final Rej. 17). At best, this inconsistency is an apparent typographical error which is deemed to be

harmless. In any event, the rejection of claim 53 is clearly stated in the Answer as we noted above.

We are also not persuaded by Appellants' argument that the arrow keys of a keyboard do not correspond to the recited bitrate and target data size scroll means (Br. 24). As the Examiner indicates (Ans. 12), it was not the arrow keys, but the movable highlighted bar in RealJukebox that is said to correspond to the recited scroll means.

We find no error in this interpretation. While this highlighted bar effectively selects both the bitrate and the target data size for that particular row (FF 6), it effectively functions as both a "bitrate scroll means" and a "target data size scroll means" with respect to the information contained in the corresponding "Bitrate" and "Data Size" columns. As we indicated previously, although the data in these columns may be related, the user can nonetheless select the row on the basis of information presented in either "tool." As such, moving the highlighted bar with respect to these distinct bases for selection in effect provides scroll means associated with these selection options.

For the foregoing reasons, Appellants have not persuaded us of error in the Examiner's rejection of representative claim 53. Therefore, we will sustain the Examiner's rejection of that claim.¹⁰

¹⁰ Although Appellants present additional arguments pertaining to claim 58 with respect to the Examiner's anticipation rejection (Br. 24-25), the Examiner did not reject this claim over the disclosure of RealJukebox at all, let alone include this claim in the anticipation rejection. *See* Ans. 4; *see also* Final Rej. 12-17. Accordingly, we need not address these additional arguments.

THE OBVIOUSNESS REJECTION OVER REALJUKEBOX AND ISO/IEC

We now consider the Examiner's obviousness rejection of claims 41, 46, 47, 60-63, 66-68, 72-74, 78, and 84 over RealJukebox and ISO/IEC (Ans. 5; Final Rej. 18-24).

Claims 41, 46, and 47

Regarding claims 41, 46, and 47, Appellants essentially reiterate the arguments presented with respect to claim 39 pertaining to the alleged failure of RealJukebox to disclose a target data size tool (Br. 25). We are unpersuaded by these arguments, however, for the reasons previously discussed. Nor have Appellants particularly pointed out errors in the Examiner's reasoning to persuasively rebut the Examiner's prima facie case of obviousness based on the collective teachings of the cited references.

For the foregoing reasons, Appellants have not persuaded us of error in the Examiner's rejection of claims 41, 46, and 47. Therefore, we will sustain the Examiner's rejection of those claims.

Claims 60-63, 66-68, 72-74, 78, and 84

Regarding claims 60-63, 66-68, 72-74, 78, and 84, Appellants contend that since these claims do not depend from claim 39, it was improper to reject the claims on the same grounds as applied to claim 39 (Br. 26). The Examiner, however, referred to the previously articulated grounds of rejection to merely show how the disclosure of RealJukebox meets the limitations found to be commensurate with those recited in independent claims 60, 66, 72, 78, and 84 (Final Rej. 22-24). We find no reversible error in this approach.

As to Appellants other arguments pertaining to claims 60, 66, 72, 78, and 84 (Br. 26), Appellants essentially reiterate the arguments presented with respect to claim 39 pertaining to the alleged failure of RealJukebox to disclose a target data size tool (Br. 26). We are unpersuaded by these arguments, however, for the reasons previously discussed. Nor have Appellants particularly pointed out errors in the Examiner's reasoning to persuasively rebut the Examiner's prima facie case of obviousness based on the collective teachings of the cited references.

For the foregoing reasons, Appellants have not persuaded us of error in the Examiner's rejection of claims 60-63, 66-68, 72-74, 78, and 84. Therefore, we will sustain the Examiner's rejection of those claims.

THE OBVIOUSNESS REJECTIONS OF CLAIMS 42 AND 43

Regarding the Examiner's obviousness rejections of (1) claim 42 over RealJukebox, Hinderks, and Terui (Ans. 5; Final Rej. 24-26), and (2) claim 43 over RealJukebox, Hinderks, Terui, and ISO/IEC (Ans. 5-6; Final Rej. 26-28), Appellants essentially reiterate the arguments presented with respect to claim 39 pertaining to the alleged failure of RealJukebox to disclose a target data size tool (Br. 26-27). We are unpersuaded by these arguments, however, for the reasons previously discussed. Nor have Appellants particularly pointed out errors in the Examiner's reasoning to persuasively rebut the Examiner's prima facie case of obviousness based on the collective teachings of the cited references.

For the foregoing reasons, Appellants have not persuaded us of error in the Examiner's rejection of claims 42 and 43. Therefore, we will sustain the Examiner's rejections of those claims.

THE OBVIOUSNESS REJECTION OVER REALJUKEBOX, ISO/IEC, AND
CHADDHA

We now consider the Examiner's obviousness rejection of claims 44, 45, 64, and 82 over RealJukebox, ISO/IEC, and Chaddha (Ans. 6; Final Rej. 29-32). Regarding Appellants' argument pertaining to cancelled claims 70 and 76 (Br. 28), we find the Examiner's including cancelled claim 70 in the statement of the rejection, at best, harmless error as we indicated previously. *See* n.6, *supra*, of this opinion. As to claim 76, while the obviousness rejection in the Final Rejection did include that claim (Final Rej. 29, 32), the grounds of rejection for this obviousness rejection as stated in the Answer did not (Ans. 6). We are therefore unpersuaded of error based on this argument.

Appellants also essentially reiterate the arguments presented with respect to claim 39 pertaining to the alleged failure of RealJukebox to disclose a target data size tool (Br. 28). We are unpersuaded by these arguments, however, for the reasons previously discussed. Nor have Appellants particularly pointed out errors in the Examiner's reasoning to persuasively rebut the Examiner's *prima facie* case of obviousness based on the collective teachings of RealJukebox, ISO/IEC, and Chaddha.

For the foregoing reasons, Appellants have not persuaded us of error in the Examiner's rejection of claims 64 and 82. Therefore, we will sustain the Examiner's rejections of those claims.

Claim 44

Although we are not persuaded of error in the Examiner's rejection of claim 44 for the reasons indicated above, Appellants nevertheless do raise

some problematic issues regarding the rejection of claim 44. Specifically, Appellants argue that it is unclear why the Examiner refers to three references in the body of the rejection (Nakazawa, Creative, and Downs) that were not cited in the rejection (Br. 28). We, too, are puzzled by the Examiner's reliance on these references in this rejection.

Nevertheless, we deem this inconsistency harmless error. In connection with the rejection of claim 44, the Examiner identifies the perceived differences between RealJukebox and the claimed invention. The Examiner then relies on ISO/IEC for disclosing particular coding details which the Examiner concludes would have been obvious to incorporate into the encoder and playback programs of RealJukebox "in view of Nakazawa, Creative, and Downs." It is unclear why the Examiner referred to Nakazawa, Creative, and Downs in this context, as the RealJukebox reference alone teaches an encoder and playback program. Notably, the remainder of the rejection does not refer to Nakazawa, Creative, and Downs, but rather adds the disclosure of Chaddha for teaching other features that were combined with RealJukebox and ISO/IEC.

When considering the Examiner's rejection as a whole, and noting that the statement of the rejection did not include Nakazawa, Creative, and Downs (Ans. 6; Fin. Rej. 29), we conclude that the Examiner did not intend to reject the claims based on these references and their inclusion in the body of the rejection was a mere typographical error. This error is therefore harmless.

For the foregoing reasons, Appellants have not persuaded us of error in the Examiner's rejection of claim 44. Therefore, we will sustain the Examiner's rejection of that claim.

Claim 45

Claim 45, however, is a different matter entirely. In rejecting this claim, the Examiner repeatedly refers to the disclosure of Hinderks for various features that are combined with the disclosure of Chaddha (Ans. 6, Final Rej. 31-32). Unlike the rejection of claim 44, however, the Examiner's inexplicable reliance on this superfluous reference to Hinderks is substantial and cannot be, in our view, the result of an inadvertent oversight tantamount to a typographical error. Simply put, this error is harmful, and indeed compels us to reverse the rejection of claim 45 on that ground alone.¹¹

For the foregoing reasons, we find the Examiner's rejection of claim 45 erroneous. Therefore, we will not sustain the Examiner's rejection of that claim.

THE OBVIOUSNESS REJECTION OVER REALJUKEBOX AND TI

We will, however, sustain the Examiner's obviousness rejection of claims 50 and 57 over RealJukebox and TI (Ans. 6; Final Rej. 32-33). Although Appellants contend that claim 57 depends from claim 53 which was purportedly not previously rejected over RealJukebox (Br. 28), we find ample basis for the Examiner's rejection of claim 57 on this record. First, our previous discussion pertaining to the Examiner's rejection of claim 53 applies equally here and we incorporate that discussion by reference.¹² As

¹¹ See *In re Hoch*, 428 F.2d 1341, 1342 n.3 (CCPA 1970) ("Where a reference is relied upon to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of the rejection.").

¹² See p. 10-11, *supra*, of this opinion.

we indicated in that discussion, we find ample basis for the Examiner's rejection of claim 53 based on the disclosure of RealJukebox. As such, we find no error in the Examiner's rejection of dependent claim 57 based on the collective teachings of RealJukebox and TI.

Furthermore, Appellants essentially reiterate the arguments presented with respect to claim 39 pertaining to the alleged failure of the cited prior art to disclose a target data size tool (Br. 28-29). We are unpersuaded by these arguments, however, for the reasons previously discussed. Nor have Appellants particularly pointed out errors in the Examiner's reasoning to persuasively rebut the Examiner's prima facie case of obviousness based on the collective teachings of the cited references.

For the foregoing reasons, Appellants have not persuaded us of error in the Examiner's rejection of claims 50 and 57. Therefore, we will sustain the Examiner's rejection of those claims.

THE OBVIOUSNESS REJECTIONS OF CLAIMS 52, 54-56, 65, 71, 77, AND 83

Regarding the Examiner's obviousness rejections of (1) claims 65, 71, 77, and 83 over RealJukebox, ISO/IEC, and TI (Ans. 7; Final Rej. 34-35); (2) claim 52 over RealJukebox, Nakazawa, and Creative (Ans. 7; Final Rej. 35-38); and (3) claims 54-56 over RealJukebox, Downs, and ISO/IEC (Ans. 7; Final Rej. 38-42), Appellants essentially reiterate the arguments presented with respect to claim 39 with respect to the alleged failure of the cited prior art to disclose a target data size tool or using a target data size for the adjustment of a data extraction rate (Br. 29-30). We are unpersuaded by these arguments, however, for the reasons previously discussed. Nor have Appellants particularly pointed out errors in the Examiner's reasoning to

persuasively rebut the Examiner's prima facie case of obviousness based on the collective teachings of the cited references.

For the foregoing reasons, Appellants have not persuaded us of error in the Examiner's rejection of claims 52, 54-56, 65, 71, 77, and 83. Therefore, we will sustain the Examiner's rejections of those claims.

THE OBVIOUSNESS REJECTION OVER MUSICMATCH AND ISO/IEC

We now consider the Examiner's obviousness rejection of claim 58 over MusicMatch and ISO/IEC (Ans. 7-8; Final Rej. 42-47). In the rejection, the Examiner takes the position that (1) the bitrate adjustment extraction rate in MusicMatch is selected through the display "B," and (2) the target data size extraction rate is selected via the bitrate selected via display "B" in combination with the selected file(s) and requisite memory via display "G" (Final Rej. 45).

Appellants argue that MusicMatch fails to disclose a key input portion that includes an edit key for enabling adjustment of a data extraction rate as claimed (Br. 30-31). In addition, although Appellants acknowledge that MusicMatch teaches a selectable bitrate adjustment data extraction rate, Appellants contend that the reference nonetheless fails to disclose a selectable target data size extraction rate, let alone determining which one is selected (Br. 31-32).

The Examiner responds that the options key corresponds to recited edit key. The Examiner also takes the position that, similar to the RealJukebox reference, since the user can make selections based on the size and bitrate of the encodings based on the displayed information, then it will determine which one is selected (Ans. 14-16).

The issue before us, then, is whether Appellants have shown that the Examiner erred in finding that the collective teachings of the cited prior art teach or suggest the limitations of claim 58. The issue turns on whether the disclosure of MusicMatch reasonably teaches or suggests a main menu which includes a menu bar with a key edit portion that includes an edit key for enabling adjustment of a data extraction rate as claimed. The issue also turns on whether MusicMatch teaches or suggests determining which one of the bitrate adjustment data extraction rate and target data size data extraction rates has been selected. For the following reasons, we find that Appellants have not shown such error.

Based on the description of MusicMatch in the Findings of Fact section (FF 7-10) above, we find no error in the Examiner's interpretation of this reference as teaching or suggesting the disputed limitations of claim 58. First, nothing in the claim precludes a "main menu" of MusicMatch to be considered a menu of functions on a screen, such as the menu bar and associated Options menu depicted in the First Screenshot (FF 8).

Second, nothing in the claim precludes the selectable "Send to Device" | "Download Playlist to Nike psa[128max Player" option (FF 8) as corresponding to the recited edit key. As shown in the "Second Screenshot," selecting this option results in the display of the Download Playlist to Nike psa[128max Player" screen that contains, among other things, a menu listing various bitrates (33kbs, 64kbs, 96kbs, 128kbs, "None") (FF 9).

Lastly, we find no error in the Examiner's reasoning with respect to determining which one of (1) the bitrate adjustment extraction rate in MusicMatch is selected through the display "B," and (2) the target data size extraction rate is selected via the bitrate selected via display "B" in

combination with the selected file(s) and requisite memory via display “G” (Final Rej. 45). As the Examiner indicates (Ans. 15), the user can select the particular extraction rate based on the particular size of the files as shown in display “G” (FF 10) or via a particular rate via display “B” (FF 9). As with the functionality of RealJukebox, even though the respective pieces of information presented to the user in making this selection may be related (bitrate and file size), the fact that the user can make extraction rate selections based on either piece of information would result in the determination of such a selection.

For the foregoing reasons, Appellants have not persuaded us of error in the Examiner’s rejection of claim 58. Therefore, we will sustain the Examiner’s rejection of that claim.

THE OBVIOUSNESS REJECTION OF CLAIM 59

Regarding the Examiner’s obviousness rejections of claim 59 over MusicMatch, ISO/IEC, and Downs (Ans. 8; Final Rej. 47-49), Appellants essentially reiterate the arguments presented with respect to claim 58 (Br. 32-33). We are unpersuaded by these arguments, however, for the reasons previously discussed. Nor have Appellants particularly pointed out errors in the Examiner’s reasoning to persuasively rebut the Examiner’s prima facie case of obviousness based on the collective teachings of the cited references.

For the foregoing reasons, Appellants have not persuaded us of error in the Examiner’s rejection of claim 59. Therefore, we will sustain the Examiner’s rejection of this claim.

CONCLUSIONS OF LAW

Appellants have not shown that the Examiner erred in rejecting claims 39-44, 46-68, 71-74, 77, 78, and 82-84. Appellants have, however, shown that the Examiner erred in rejecting claim 45.

DECISION

We have sustained the Examiner's rejections with respect 39-44, 46-68, 71-74, 77, 78, and 82-84, but have not sustained the Examiner's rejection with respect to claim 45. Therefore, the Examiner's decision rejecting claims 39-68, 71-74, 77, 78, and 82-84 is affirmed-in-part.

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-IN-PART

KIS

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