

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DENNIS M. O'CONNOR and MARK P. CHUANG

Appeal 2008-4041
Application 11/174,906
Technology Center 2600

Decided: December 23, 2008

Before KENNETH W. HAIRSTON, JOSEPH L. DIXON, and
LANCE LEONARD BARRY, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims. The Appellant appeals therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

The invention at issue on appeal relates to time shifting by simultaneously recording and playing a data stream. (Spec. 1.)

B. ILLUSTRATIVE CLAIM

Claim 26, which further illustrates the invention, follows.

26. A method comprising:

selectively displaying a video stream from storage or without storing said video stream, depending on a time delay.

C. REFERENCES

The Examiner relies on the following references as evidence:

| | | |
|-----------|--------------|----------------|
| Yonemitsu | US 5,040,061 | Aug. 13, 1999. |
| Camhi | US 5,930,444 | Jul. 27, 1999 |

D. REJECTIONS

The Examiner makes the following rejections.

Claims 26-27, 29-33, 35-40, and 42-44 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Camhi.

Claims 28, 34, and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Camhi in view of Yonemitsu.

II. ISSUE

Has the Examiner set forth a proper showing of anticipation and specifically, whether the teachings of the originally filed application of the Camhi reference support the relied upon portions in the issued patent?

III. PRINCIPLES OF LAW

35 U.S.C. § 102

"[A]nticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim" *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1457 (Fed. Cir. 1984)). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). 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.

Appellants have the opportunity on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a

claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

35 U.S.C. § 103(a)

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).

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," and discussed circumstances in which a patent might be determined to be obvious. *KSR*, 127 S. Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court 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 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.* at 1740.

The Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR*, 127 S. Ct. at 1739).

The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was “uniquely challenging or difficult for one of ordinary skill in the art” or “represented an unobvious step over the prior art.” *Id.* at 1162 (citing *KSR*, 127 S. Ct. at 1741).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

IV. ANALYSIS

35 U.S.C. § 102

Appellants' contention as set forth in the Reply Brief at page 2 is that the originally filed subject matter in the original specification of Camhi, prior to any amendments thereto, cannot and does not support the Examiner's reliance thereon for the rejection of the presently claimed subject matter "selectively displaying a video stream from storage or without storing said video stream depending on the time delay." We disagree with Appellants' contention and find that the originally filed subject matter in Camhi supports the Examiner's position as set forth in the statement of the rejection.

First, from our review of the originally filed specification of Camhi, we find that there is adequate and enabling support in the originally filed subject matter at pages 10-11 which discusses the bypass lines 34 to prevent the inputs 22 from interfering with the information retrieved from memory 12 and coupled to the outputs 24, for the portions of Camhi, relied upon in the rejection. At pages 10-11 of originally filed Camhi, we find that there is

adequate and enabling support for the language of dependent claim 9, as amended during prosecution of Camhi, to support "when said key means for controlling the sequence and rate is subsequently used to advance the playback of the stored information to a point where the interval of time delay becomes negligible." From our reasoned analysis, we find that in the switchover from playback to live viewing, there would not necessarily be a delay of zero at switchover due to the latency of the switching circuitry. Once there is a zero delay, by the time the switching circuitry switches sources of input, there would be some additional delay and some missed data during that additional delay. Therefore, the language of dependent claim 9 of Camhi takes into account this fact.

Furthermore, we find that the Examiner's reliance upon page 15, third paragraph, of the originally filed specification of Camhi (Answer 7) to additionally support the Examiner's rejection of independent claim 26. We agree with the Examiner that figure 5 of Camhi teaches the further recordation of the input stream when a user has viewed the recorded input, a recorder reverts to a passive state with information present at the input 22 coupled directly to the output. Hence, there is selectively displaying of the video stream from storage when data is recorded or without storing said video stream depending on a time delay. For one stream of video there is a delay and for the other stream of video there is no delay. Therefore, the output depends on a time delay being present or not. Therefore, we will sustain the Examiner's rejection of independent claim 26 and dependent claims 27-30 grouped therewith.

Since Appellants have not separately argued the patentability of independent claims 32 and independent claim 38, we will sustain the

rejections of those claims and their respective dependent claims 33-36 and 39-44 for the same reasons discussed above with respect to independent claim 26.

With respect to the Examiner's position that the originally filed specification of Camhi does not have to support the relied upon subject matter under 35 U.S.C. § 102(e), we disagree with the Examiners' position and find that the Appellants' contention and reliance upon Ex Parte D to be correct. Applying that principle here, we find original support in the originally filed disclosure of Camhi, as discussed above. Therefore, there is no material issue in this respect. Therefore, Appellants' argument is not persuasive of error in the Examiner's initial showing of anticipation.

35 U.S.C. § 103(a)

Appellant relies on the same arguments advanced above with respect to anticipation. Since we did not find those arguments persuasive of error in the Examiner's initial showing, we do not find that Appellants have shown error in the Examiner's initial showing of obviousness.

V. CONCLUSION

For the aforementioned reasons, we conclude that the teachings of the originally filed application of the Camhi reference supports the relied upon portions of the issued patent. Hence, the Examiner has set forth initial showings of anticipation and obviousness, and Appellants have not shown error therein.

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VI. ORDER

We affirm the anticipation rejection of claims 26-27, 29-33, 35-40, and 42-44, and the obviousness rejections of claims 28, 34, and 41.

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

AFFIRMED

BARRY, *Administrative Patent Judge, concurring.*

I concur with my colleagues' analysis and finding "that the originally filed subject matter in Camhi supports the Examiner's position as set forth in statement of the rejection." I also write separately to explain an alternative reason for affirming the outstanding rejections.

ISSUE

The Examiner finds "that the original specification of Camhi does disclose the limitations recited in the instant claimed invention." (Answer 7.) The Appellants argue that they "*know* that the application does not support the patent" (Appeal Br. 10 (emphasis added)) and that they "ha[ve] carried the burden of showing that subject matter relied upon in the issued patent was improperly added in an amendment during prosecution. Nothing within the application as filed supported the added subject matter" (*id.*). Therefore, the issue is whether the Appellants have met their burden to rebut the presumption of operability of Camhi.

LAW

"A patent shall be presumed valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim." 35 U.S.C. § 282 (2007)¹. "[W]hen the PTO cited a

¹ I cite to the version of the United States Code in effect at the time of the Appeal Brief. The current version includes the same law.

disclosure which expressly anticipated the present invention . . . , the burden was shifted to the applicant. He had to rebut the presumption of the operability of [the reference] by a preponderance of the evidence." *In re Sasse*, 629 F.2d 675, 681 (CCPA 1980) (citing *In re Jacobs*, 318 F.2d 743 (1963)). *See also Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1355 (Fed. Cir. 2003) ("In patent prosecution the examiner is entitled to reject application claims as anticipated by a prior art patent without conducting an inquiry into whether or not that patent is enabled or whether or not it is the claimed material (as opposed to the unclaimed disclosures) in that patent that are at issue.") "Argument in the brief does not take the place of evidence in the record." *In re Schulze*, 346 F.2d 600, 602 (CCPA 1965) (citing *In re Cole*, 326 F.2d 769, 773 (CCPA 1964)).

FINDING OF FACT

Camhi is a U.S. Patent.

ANALYSIS

Because Camhil is a domestic patent it is presumed valid under 35 U.S.C. § 282. The Examiner's citation and reliance upon the patent "shifted the burden of going forward to [the A]ppellants, who, to overcome the rejection, were required to rebut the presumption of operability of the cited patent by a preponderance of the evidence." *Ex parte D*, 27 USPQ2d 1067, 1069 (BPAI 1993).²

² *Ex parte D*, 27 USPQ2d 1067 (BPAI 1993) is the case cited by the Appellants. (Appeal Br. 10.)

The "Appellants have not apprised us of any objective evidence tending to establish that the [patent's] disclosure, as filed, was non-enabling, i.e., that the patent specification was insufficient to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation." *Id.* Their argument does not take the place of evidence in the record.; nor does their personal knowledge, i.e., what they "know" (Appeal Br. 10)

CONCLUSION

Based on the aforementioned facts and analysis, I conclude that the Appellants did not meet their burden to rebut the presumption of operability of the Camhi. For that reason alone, I would affirm the rejections on that failure alone. Agreeing with my colleagues' analysis, however, I would alternatively affirm for their reasons.

msc

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