

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GOPAL K. SRIVASTAVA and PETER C. SKERLOS

Appeal No. 95-4131
Application No. 08/089,320¹

ON BRIEF

Before HAIRSTON, BARRETT and TORCZON, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 8.

The disclosed invention relates to a method and apparatus for operating an interactive video communications system.

Claim 1 is illustrative of the claimed invention, and it reads as follows:

¹ Application for patent filed July 9, 1993.

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1. A method of operating a video communication system comprising:

repetitively transmitting sequential video data defining a video program organized into equal duration segments, each segment comprising a fixed number of fields, in a fifo memory having individual segment taps corresponding to said segments, said video data including information identifying the beginning and ending segments of said video program;

selecting a segment tap corresponding to the beginning of said video program responsive to a viewer request;

supplying said video program from the selected segment tap to a one segment-long resettable fifo memory having field taps corresponding to said fields; and

supplying said video program to said viewer from one of said field taps.

No references were relied on by the examiner.

Claims 1 through 8 stand rejected under the first paragraph of 35 U.S.C. § 112 as being based upon a non-enabling disclosure.

Reference is made to the brief and the answer for the respective positions of the appellants and the examiner.

OPINION

According to the examiner (Answer, pages 3 and 4), the lack of enablement rejection was instituted because:

Applicant has failed to adequately describe the memory means (segment memory (12)) as shown in the Figure which is a FIFO memory having the capability of storing at all times an entire video program as stated within the specification on page 2, lines 16-21. Examiner is unaware of any presently available single

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FIFO memory device having sufficient storage capabilities to store an entire video program at all times.

In addition, as previously mentioned above, Applicant has disclosed within the specification on page 2, lines 16-17, that the segment memory (12) is a first-in-first-out memory (FIFO). However, the segment memory (12) is disclosed as being divided into segment taps each of which can be individually accessed by a program request from the viewer to be a starting point. Therefore, the first segment tap need not be selected as the starting point. This would lead one of ordinary skill in the art to the conclusion that the segment memory is not a single FIFO memory device as disclosed by applicant but instead must comprise several segment taps each representing a FIFO memory device. If the memory was a FIFO memory device as disclosed by the specification, drawing, and claims then the data first stored in the first segment tap would have to be read out first, as is inherent of a FIFO memory device. However, Applicant discloses in the specification that such is not the case because the user may make a selection such that the data stored within the first segment tap is not accessed first. This once again reinforces the conclusion that the device as disclosed in the specification, drawing, and claim[s] fails to provide enabling disclosure.

Appellants response (Brief, pages 3 and 4) to the examiner's position is that:

The Examiner is arbitrarily defining a fifo memory as a single device. Presumably this means that the memory must be available in a single package. It is respectfully submitted that there is absolutely no justification for this position. While it seems clear that those skilled in the art would recognize that no currently available single memory device could contain an hour or so of video program, they would certainly know to cascade a plurality of memories or delay lines.

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Since the disclosed and claimed invention never mentions a "single" FIFO, we are of the opinion that the examiner is reading the claimed invention in a much too restrictive light. During patent examination, claims must be interpreted as broadly as their terms reasonably allow. See In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). The examiner has astutely recognized that a single FIFO does not possess sufficient storage capability to store a whole program, and that a FIFO does not have taps. The examiner has likewise recognized that a FIFO type memory with taps would have to be implemented using a FIFO memory at each tap. The program data from each tap would then be read out in a first-in-first-out manner. Thus, we agree with appellants (Brief, page 4) that the skilled artisan "would certainly know to cascade a plurality of memories" to properly implement a FIFO type memory with taps. The skilled artisan would not have to resort to undue experimentation to arrive at such an implementation. As indicated in Genentech, Inc. v. Novo Nordisk A/S, 108 F.3d 1361, 1364, 42 USPQ2d 1001, 1004 (Fed. Cir.), cert. denied, 118 S.Ct. 397 (1997), the enablement clause of the first paragraph of 35 U.S.C. § 112 only requires that the disclosure adequately describe the claimed invention so that the artisan could practice it without undue

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experimentation. The lack of enablement rejection of claims 1 through 8 is reversed.

DECISION

The decision of the examiner rejecting claims 1 through 8 under the first paragraph of 35 U.S.C. § 112 is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
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RICHARD TORCZON)	
Administrative Patent Judge)	

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APPLICATION NO. 08/089,320

APJ HAIRSTON

APJ TORCZON

APJ BARRETT

DECISION: REVERSED

Typed By: Jenine Gillis

DRAFT TYPED: 12 Jan 99

FINAL TYPED:

3 MEMBER CONF. Yes No