

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DAVID C. GIBBON  
and BEHZAD SHAHRARAY

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Appeal No. 1998-1323  
Application 08/252,861

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ON BRIEF

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Before JERRY SMITH, DIXON and BLANKENSHIP, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-25, which constitute all the claims in the application. An amendment after final rejection was filed on October 17, 1996, and was entered by the examiner.

The disclosed invention pertains to a method and apparatus for representing a sequence of frames having at least first and second information-bearing media components. More particularly, the invention forms a correspondence between representative frames based on the first information-bearing media component and segments of the second information-bearing media component.

Representative claims 1 and 25 are reproduced as follows:

1. A method of representing a sequence of frames having at least first and second information-bearing media components, in which the first and second information-bearing media components are different from one another, said method comprising the steps of:

selecting a plurality of representative frames representing information contained in the first information-bearing media component;

forming a correspondence between each of the representative frames and a segment of the second information-bearing media component; and

recording said representative frames, said segment of the second information-bearing media component and the correspondence therebetween.

25. A method of displaying a compressed rendition of a sequence of frames having at least different first and second information-bearing media components, said method comprising the steps of

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receiving a plurality of representative frames representing information contained in the first information-bearing component;

receiving a signal having information that forms a correspondence between each of the representative frames and a segment of the second information-bearing media component; and

displaying said representative frames and said segment of the second information-bearing media component in a manner determined by said correspondence therebetween.

The examiner relies on the following references:

Takahashi et al. (Takahashi)	5,428,774	June 27, 1995 (filed Mar. 16, 1993)
Buhro et al. (Buhro)	5,440,336	Aug. 08, 1995 (filed July 23, 1993)
Cragun et al. (Cragun)	5,481,296	Jan. 02, 1996 (filed Aug. 06, 1993)

Claims 1-24 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Takahashi in view of Buhro and Cragun. Claim 25 stands rejected under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Cragun.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on

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appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the examiner has failed to establish a prima facie case of the obviousness of the invention as set forth in claims 1-24. We are also of the view that the disclosure of Cragun does fully meet the invention as recited in claim 25. Accordingly, we affirm-in-part.

We consider first the rejection of claims 1-24 under 35 U.S.C. § 103 based on the teachings of Takahashi, Buhro and Cragun. 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, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual

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determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant 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

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the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

Although the examiner cites three references in the statement of the rejection, it appears that all three references are not being relied on to reject all the indicated claims. The examiner notes that claims 1-24 substantially read on Takahashi [answer, page 4]. Cragun is cited only in connection with claims 5, 6, 10-13 and 24, and Buhro is cited only in connection with claims 14 and 18 [id., pages 5 and 6]. Therefore, it appears that the examiner bases this rejection primarily on Takahashi with Cragun and Buhro used to meet specific additional limitations. In fact, the examiner's comments make it appear that claim 1 is essentially rejected on Takahashi taken alone.

The examiner's explanation of this rejection is

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critical because appellants argue that Takahashi does not process a frame having first and second media components. The examiner has improperly redefined the invention as nothing more than associating video information with non-video information. Based on this redefinition, the examiner finds that the keywords entered by input unit 15 of Takahashi associate non-video information (the keywords) with video information (the frames from block 11). Appellants argue that the keywords of Takahashi are not information-bearing media components as recited in claim 1 [brief, page 6].

We agree with the position argued by appellants. Claim 1, for example, recites a correspondence formed between representative frames based on first information-bearing media components and a segment of second information-bearing media components. An information-bearing media component refers to the video, audio or text which carries the information on the medium. The keywords added by the user in Takahashi do not represent an information-bearing media component. They are simply locators for the information. The examiner's assertion that it would have been obvious to modify the input unit of Takahashi to input closed caption data or audio data is

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completely unsupported by this record. The mere fact that multimedia existed would not have suggested the examiner's proposed modification of Takahashi.

In summary, the examiner's reliance on Takahashi as the primary reference or only reference in rejecting claim 1, for example, fails to address all the differences between the claimed invention and the prior art. This results in a failure to establish a prima facie case of obviousness. Since Takahashi appears to be the primary reference in rejecting claims 1-24 under 35 U.S.C. § 103, we do not sustain the rejection of claims 1-24 as formulated by the examiner.

We now consider the rejection of claim 25 under 35 U.S.C.

§ 102(e) as anticipated by the disclosure of Cragun.

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. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L.

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Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner indicates how he reads claim 25 on the disclosure of Cragun [answer, pages 6-7]. We note that Cragun receives frames of data having a first information-bearing component (video) and a second information-bearing component (closed captioned text). Cragun uses search requests to associate desired closed captioned text information with its accompanying video. Thus, the technique of Cragun results in an association of video information and closed captioned information. This associated information is displayed to the user. We agree with the examiner that the invention as broadly recited in claim 25 appears to be fully met by Cragun.

Appellants argue that Cragun forms a correspondence between a user's entry and closed captioned text whereas the claimed invention forms a correspondence between each of the representative frames and a segment of the second information-bearing component [brief, page 9]. Appellants ignore the fact that Cragun forms a correspondence between a user's entry and

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closed captioned text and then forms a further association between the closed captioned text and the video corresponding thereto. Thus, Cragun ends up storing specific closed captioned text along with corresponding video. Claim 25 does not exclude the user as the source of the correspondence information. We agree with the examiner that claim 25 is broad enough to read on the disclosure of Cragun. Therefore, we sustain the rejection of claim 25 as anticipated by Cragun.

We note that there are certain similarities between the invention of claim 25 and the invention of claim 1. We have reversed the rejection of claim 1 because it is based on Takahashi while we have affirmed the rejection of claim 25 based on Cragun. As noted above, we do not view Cragun as actually applied against claim 1. We leave it to the examiner to determine whether Cragun and/or any other prior art suggests the obviousness of any of claims 1-24.

In conclusion, we have sustained the examiner's rejection of claim 25, but we have not sustained the examiner's rejection of claims 1-24. Accordingly, the decision of the examiner rejecting claims 1-25 is affirmed-in-part.

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

AFFIRMED-IN-PART

	)	
JERRY SMITH	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
JOSEPH L. DIXON	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
HOWARD B. BLANKENSHIP	)	
Administrative Patent Judge	)	

S. H. DWORETSKY  
AT&T BELL LABORATORIES  
600 MOUNTAIN AVENUE  
P.O. BOX 636  
MURRAY HILL, NJ 07974-0636

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