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

Paper No. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN E. CRANE, LEEANN HERRINGER,
MICHAEL SHINSKY, GERALD A. RAITZER,
MICHAEL A. OGRINC, and STEVEN T. MAYER

Appeal No. 1998-1397
Application No. 08/482,905

ON BRIEF

Before KRASS, FLEMING, and BARRY, Administrative Patent Judges.
BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the rejection of claims 21-42. We reverse.

BACKGROUND

The invention at issue in this appeal relates to video editing. Various methods of video editing are well known. For tape-based editing, an editor cycles source tapes back and

forth on a source video cassette recorder (VCR) or a source video tape

recorder (VTR) to find a scene to be edited. He positions a destination tape on a destination VCR to receive the scene from the source tape. The scene from the source tape is then recorded on the destination tape; this process is repeated for each successive scene. Because it requires constant cycling of physical tapes having slow access times, however, tape-based editing is slow and cumbersome.

For disk-based editing, all video material is stored on a disk drive of a computer. The computer can find any frame in the stored video material quickly; it also keeps track of all edit and record frames for the entire production. After creating an edit decision list for a program, an editor inserts source tapes in one or more VTRs and a destination tape into a destination VCR. The computer executes the edit decision list to record the entire edited program onto the

destination tape. Because it requires enormous storage capacities, however, disk-based editing is expensive.

The invention employs a computer with a disk drive for interactive editing of video material. At any given time, only a
small portion of video taped material is stored as video frames on the computer's disk. By software control, video material is cached back and forth between the disk and source video tapes. By this means editing is accomplished and an edit decision list is constructed for compilation of a final video production. The invention offers the advantage of fast access time for editing the material on the disk while allowing actual physical editing at the end of the project of the actual video tape material. Furthermore, the logging of the material onto the disk and the editing of the final tape are done automatically.

Claim 21, which is representative for our purposes, follows:

21. A method for editing video material using a video source device storing video source material, a storage device having faster access speed than the video source device, and a display coupled to the storage device, comprising the steps of:

transferring only a portion of a first video scene from the video source device to the storage device, the portion being a plurality of sequential video frames of the first video scene;

displaying on the display at least a part of the transferred video scene, the displayed part thereby representing all of the video scene; automatically transferring only a portion of a second video scene from the video source device to the storage device when needed, the portion being a plurality of sequential video frames of the second video scene;

automatically deleting at least a part of the portion of the first video scene from the storage device when needed, thereby to provide additional storage capacity on the storage device; and

creating an edit decision list of edit decisions for the video material.

The references relied on in rejecting the claims follow:

Westland	4,685,003	Aug. 4, 1987
Izeki et al. (Izeki)	4,974,178	Nov. 27, 1990 (filed Nov. 20, 1987)
Mita et al. (Mita)	5,060,280	Oct. 22, 1991 (filed Mar. 22, 1990).

Claims 21-22, 26-27, 29-30, and 37-42 stand rejected under 35 U.S.C. § 103(a) as obvious over Westland. Claims 23-25 and 31-34 stand rejected under 35 U.S.C. § 103(a) as obvious over Westland in view of Izeki. Claim 28 stands rejected under 35 U.S.C. § 103(a) as obvious over Westland in view of Mita. Claims 35 and 36 stand rejected under 35 U.S.C. § 103(a) as obvious over Westland in view of Izeki further in view of Mita. Rather than repeat the arguments of the appellants or examiner

in toto, we refer the reader to the briefs and answer for the respective details thereof.

OPINION

In reaching our decision in this appeal, we considered the subject matter on appeal and the rejection advanced by the examiner. Furthermore, we duly considered the arguments and evidence of the appellant and examiner. After considering the totality of the record, we are persuaded that the examiner erred in rejecting claims 21-42. Accordingly, we reverse.

We begin by noting the following principles from In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

> In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).... "A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

With these principles in mind, we consider the appellants' argument and the examiner's reply.

The appellants' argument follows.

> [A]lthough Westland does disclose providing a "snapshot" (still picture) of one or two frames of each video scene, and also recognizes that a fast access storage devices e.g. [sic] the disk drive, could not store the entire scene economically, he did not recognize or suggest that storage and display of e.g. [sic] several seconds of video for each scene was useful. (Appeal Br. at 6.)

The examiner replies, “it merely [sic] an obvious engineering choice in selecting the labels for the video scenes because the number of the ‘labels’ for identifying the particular video scene can be selected by the editor.” (Examiner’s Answer at 11.)

Claims 21-28 and 41 each specify in pertinent part the following limitations:

> transferring only a portion of a first video scene from the video source device to the storage device, the portion being a plurality of sequential video frames of the first video scene;
>
> ...
>
> automatically transferring only a portion of a second video scene from the video source device to the storage device when needed, the portion being a plurality of sequential video frames of the second video scene ....

Similarly, claims 29-40 and 42 each specify in pertinent part the following limitations:

> means for transferring only a portion of a first video scene from the video source device to the storage device, the portion being a plurality of sequential video frames of the first video scene;
>
> ...
>
> means for automatically transferring only a portion of a second video scene from the video source device to the storage device when needed by the processing unit, the portion being a plurality of sequential video frames of the second video scene ....

Accordingly, claims 21-42 each require transferring sequential video frames of a video scene from a video source device to a storage device.

The examiner fails to show a suggestion of the limitations in the prior art. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995)(citing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551-53, 220 USPQ 303, 311-13 (Fed. Cir. 1983)). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." Id. at 1266, 23 USPQ2d at 1784,

(citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)).

Here, the examiner admits, “Westland does not specifically discloses [sic] the newly added limitations wherein the portion of the first video scene is a plurality of sequential video frames of the first video scene as recited in claims 21 and 29 ....” (Examiner’s Answer at 6.) He further admits, “the use of several second [sic] of video for identifying the particular scene is not suggested in Westland.” (Id. at 10.) For its part, although the reference’s controller 22 collects an “image pair” of frames of a video segment from a video source to a magnetic disk, col. 21, ll. 6-10, the frames are not sequential. To the contrary, the image pair “includes a digitized snapshot of the frames, typically the first and last frames of the segment, which are employed as the label pair for the segment.” Id. at 10-12.

Faced with this difference, the examiner fails to identify a suggestion in Izeki, in Mita, or anywhere else in the prior art to modify Westland’s controller to collect video

frames that are sequential. Rather than providing a line of reasoning that explains why such a modification would have been desirable, he asserts that such a modification would have been undesirable. Specifically, the examiner asserts, "selecting more than two
labels for the video scene as claimed has a disadvantage over Westland because more than two labels for the video scene will fill the storage 146 faster than two labels for the video scene as disclosed in Westland." (Examiner's Answer at 6.) Furthermore, his opinion that "it merely an obvious engineering choice in selecting the labels for the video scenes because the number of the 'labels' for identifying the particular video scene can be selected by the editor," (id. at 11), is conclusory and unsupported by facts.

In view of the examiner's conclusory opinion and his assertion of undesirability, we are not persuaded that teachings from the prior art would appear to have suggested the limitations of "transferring only a portion of a first video scene from the video source device to the storage device, the portion being a plurality of sequential video

frames of the first video scene;" "automatically transferring only a portion of a second video scene from the video source device to the storage device when needed, the portion being a plurality of sequential video frames of the second video scene;" "means for transferring only a portion of a first video scene from the video source device to the storage device, the portion being a plurality of sequential video frames of the first video scene;" and "means for automatically transferring only a portion of a second video scene from the video source device to the storage device when needed by processing unit, the portion being a plurality of sequential video frames of the second video scene ...." The examiner impermissibly relies on the appellants' teachings or suggestions. He fails to establish a prima facie case of obviousness. Therefore, we reverse the rejection of claims 21-22, 26-27, 29-30, and 37-42 under 35 U.S.C. § 103(a) as obvious over Westland; the rejection of claims 23-25 and 31-34 under 35 U.S.C. § 103(a) as obvious over Westland in view of Izeki; the rejection of claim 28 under 35 U.S.C. § 103(a) as obvious over Westland in view of Mita; and the rejection of claims 35 and 36 under 35 U.S.C.

§ 103(a) as obvious over Westland in view of Izeki further in view of Mita.

CONCLUSION

In summary, the rejection of claims 21-22, 26-27, 29-30, and 37-42 under 35 U.S.C. § 103(a) as obvious over Westland; the rejection of claims 23-25 and 31-34 under 35 U.S.C. § 103(a) as obvious over Westland in view of Izeki; the rejection of claim 28 under 35 U.S.C. § 103(a) as obvious over Westland in view of Mita; and the rejection of claims 35 and 36 under 35 U.S.C.
§ 103(a) as obvious over Westland in view of Izeki further in view of Mita are reversed.

REVERSED

ERROL A. KRASS Administrative Patent Judge	)	
MICHAEL R. FLEMING Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
LANCE LEONARD BARRY Administrative Patent Judge	)	

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