

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUHIRO SUZUKI, TOSHIMASA MIZUNASHI,
YASUO NOMURA, YASUHIKO TERASHITA, TAKEHIRO YOKOYAMA

Appeal No. 2000-0723
Application 08/852,415

HEARD: JANUARY 23, 2002

Before JERRY SMITH, LALL 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 1-3, 5, 6 and 8-27, which constitute all the claims remaining in the application.

The disclosed invention pertains to a method and

apparatus for producing video compact discs from which video and audio data is selectively reproduced in response to input from a user. More specifically, the invention is intended to produce such video compact discs accurately while requiring a minimum of human over-sight and operator input.

Representative claim 1 is reproduced as follows:

1. A data processing method for converting data to be recorded on a digital video disc into a record format thereof, comprising the steps of:

(a) generating source data including at least a picture signal;

(b) encoding the source data into encoded data using an encoding method;

(c) generating a script, said script including at least information regarding said encoded data content, and information identifying said encoding method in a tabular format;

(d) generating format information of the disc corresponding to at least the script and the encoded data; and

(e) generating record format data composed of the encoded data corresponding to the format information.

The examiner relies on the following references:

Duffield	4,996,597	Feb. 26, 1991
Shinbo et al. (Shinbo)	5,027,222	June 25, 1991
Hatakenaka et al. (Hatakenaka)	5,239,382	Aug. 24, 1993
Yamauchi et al. (Yamauchi)	5,245,600	Sep. 14, 1993
Allen	5,418,713	May 23, 1995

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Yoshio et al. (Yoshio)	5,446,714	Aug. 29, 1995
Lee et al. (Lee)	5,561,649	Oct. 01, 1996

The following rejections are on appeal before us:

1. Claims 1-3 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Hatakenaka and Yamauchi.

2. Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Hatakenaka, Yamauchi and Yoshio.

3. Claims 8-14, 16-24, 26 and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Allen and Lee.

4. Claims 15 and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Allen, Lee, Duffield and Shinbo.

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

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We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of 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 evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-3, 5, 6 and 8-27. Accordingly, we reverse.

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 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

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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 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

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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)].

We consider first the rejection of claims 1-3 and 5 based on Hatakenaka and Yamauchi and the rejection of claim 6 based on Hatakenaka, Yamauchi and Yoshio. These claims stand or fall together as a single group [brief, page 6]. With respect to representative, independent claim 1, the examiner finds that Hatakenaka teaches all the features of claim 1 except for the script information identifying the encoding method in a tabular format. The examiner cites Yamauchi as teaching this feature. The examiner finds that it would have been obvious to the artisan to provide script information as taught by Yamauchi in the system of Hatakenaka [answer, pages 4-6].

Appellants argue that the portion of Yamauchi relied on by the examiner fails to support the examiner's findings.

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Thus, appellants argue that Yamauchi does not teach or suggest the script including information identifying an encoding method as claimed. Appellants also argue that the script of Yamauchi does not include playback control information as claimed. Appellants argue, therefore, that the applied prior art does not teach or suggest the "script" as recited in claim 1 [brief, pages 6-10].

The examiner responds that although appellants' argument regarding the teachings of Yamauchi is correct, Yamauchi nevertheless teaches that the data stored therein is digitally encoded. The examiner asserts that Yamauchi contains additional teachings which support the rejection. The examiner also notes that the "playback control information" limitation does not appear in representative claim 1. The examiner argues, nevertheless, that the disclosed control or playback control information is necessary and taught by Hatakenaka [answer, pages 12-15].

Appellants respond that although the examiner has attempted to change the teachings of the prior art being relied on, the applied prior art still fails to teach or suggest the script as recited in claim 1. Appellants also

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respond that playback control information, as used in the specification and claims, is not contemplated by the "script" of Hatakenaka [reply brief, pages 1-5].

We do not sustain the examiner's rejection of claim 1 for the reasons essentially argued by appellants in the briefs. First, we agree with appellants that the "script" allegedly generated by Yamauchi does not contain information identifying said encoding method in a tabular format. The examiner's authority to interpret the claims broadly does not support his position in support of the rejection. The fact that different encoding techniques were known does not support the examiner's contention that the data stored in Yamauchi includes information identifying the encoding method in a tabular format. Yamauchi only teaches that data which may have been encoded is stored. Second, we fail to see the motivation for combining the teachings of Hatakenaka with the teachings of Yamauchi. In our view, the only basis for combining the teachings of Hatakenaka and Yamauchi as proposed by the examiner is to improperly attempt to reconstruct appellants' invention in hindsight. Therefore, we do not sustain the examiner's rejection of claims 1-3, 5 and 6.

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We now consider the rejection of claims 8-14, 16-24, 26 and 27 based on Allen and Lee and the rejection of claims 15 and 25 based on Allen, Lee, Duffield and Shinbo. Claims 8, 10, 12, 13 and 17-27 stand or fall together as a first group, and dependent claims 9, 11 and 14-16 stand or fall together as a second group [brief, page 6]. With respect to representative, independent claim 8, the examiner finds that Allen teaches all the features of claim 8 except for the second signal providing the encoding method. The examiner cites Lee as teaching this feature. The examiner finds that it would have been obvious to the artisan to modify Allen by incorporating information of the encoding method as taught by Lee [answer, pages 7-8].

Appellants argue that although Lee does mention a record of the data signal coding method, this record is not a second signal being used to generate disc format information as claimed. Specifically, appellants argue that Lee teaches how information is physically laid out on a disc once it has already been generated, but that Lee is silent as to a method of generating the format information in the first place. Appellants argue that the examiner appears to be relying on an

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inherency argument to support the rejection [brief, pages 10-14].

The examiner responds that appellants are improperly attacking the references individually. The examiner notes that Allen, by teaching mastering, must format and record all signals from one medium to another including the encoding method, format information, video/image and sound in a specified format meeting the limitations of first, second, third, etc. signals. The examiner notes that Lee has been cited to teach that the second signal can correspond to the encoding method [answer, pages 15-18].

Appellants respond that the examiner has changed his findings on what the references teach, and that the examiner is now relying on some type of inherency argument. Specifically, appellants argue that the examiner has simply speculated what is required when a mastering process as taught by Allen takes place. Appellants argue that the examiner's speculative assumptions with respect to the applied prior art do not establish a prima facie case of obviousness [reply brief, pages 5-8].

We again agree with the position argued by appellants.

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The examiner's rejection relies on the examiner's speculation as to what probably happens when the device of Allen is used for the mastering process. As argued by appellants, obviousness cannot be established based on speculation and conjecture by the examiner. Therefore, we agree with appellants that the examiner has failed to establish a prima facie case of the obviousness of these claims. Therefore, we do not sustain the examiner's rejection of claims 8-27.

In summary, we have not sustained any of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-3, 5, 6 and 8-27 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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PARSHOTAM S. LALL)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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HOWARD B. BLANKENSHIP)
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