

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

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JURGEN KAADEN and KLAUS OLDERMANN

Appeal No. 1998-2565
Application 08/481,455

ON BRIEF

Before JERRY SMITH, BARRETT and HECKER, **Administrative Patent Judges**.

HECKER, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 12, all claims pending in this application.

The invention relates to time compressed video recording and reproducing. In particular,

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known digital video signals are time compressed by, for example, a factor of 20. This would allow a film lasting 100 minutes to be transmitted in 5 minutes. At a location where this signal is received in such time compressed form, the invention would record the signal at a tape speed increased by 4 times a nominal tape speed with a corresponding increase in head drum speed. Reproduction of the signal would take place at a tape speed of 1/5 the nominal tape speed at approximately the same head drum speed as used in recording. Thus, a factor of 4 in recording combined with a factor of 5 in reproduction would result in an overall factor of 20. Accordingly, the invention would allow the 5 minute transmitted signal to be recorded, and then reproduced at a real time of 100 minutes. An electronic memory is used to convert the overscanned track signals to the time base and frequency position for real time reproduction.

Representative independent claim 1 is reproduced as follows:

1. Time-compressed signal recording and reproducing process by a video recorder with helical track recording at a nominal tape longitudinal speed and a nominal head drum speed of rotation, comprising the steps of:

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will not sustain the rejection of claims 1 through 12 under 35 U.S.C. § 103.

The Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." *Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.*, 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, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

The Examiner reasons that Higuchi teaches the claimed invention, with tape speed increased over nominal tape speed and appropriate head drum speed, but fails to particularly disclose that reproduction takes place at a tape

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speed reduced with respect to the recording by a factor, but at an increased head drum speed. However, the Examiner notes, Amada teaches the concept of such reproduction at a tape speed reduced, LP mode for example, but still at the same head drum speed. (Answer-pages 4 and 5.) The Examiner states:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, having both the references of Higuchi et al and Amada et al before him/her, to increase the efficiency of the time-compressed signal reproducing apparatus of Higuchi et al by varying the tape speed of the recording medium while keeping the head drum speed of rotation at the same speed, as taught in Amada et al. in order to provide a higher information transfer rate when handling multiple kinds of signals containing different amounts of information such as digital picture signal and the HD digital picture signal at a fixed number of drum revolutions that is compatible with the long-time play mode of any of the multiple signals. [Answer-page 5.]

Both of Appellants' independent claims 1 and 7 require a combination of **recording** a time compressed signal (at increased tape speed and increased head drum speed) and **reproducing** (at reduced tape speed and increased head drum speed). We have reviewed Higuchi and found no mention of **recording** a time compressed signal, and thus no mention of

what the tape and drum speeds would be in the recording process. Higuchi is directed to data compression (and expansion) "at the time of **reproduction**" (emphasis added), (column 1, line 14), and refers to itself as a "digital video signal reproducing apparatus" (column 4, lines 20-21, and in all claims).

The Examiner indicates a teaching of recording in Higuchi (answer-page 4, line 5), but has not shown where this teaching can be found. The Examiner relies on Amada for **reproduction** at reduced tape speed, LP mode, but still at the same head drum speed (answer-page 5). Thus we find the Examiner has failed to set forth a *prima facie* case for the claimed combination of **recording** and **reproduction** at the respective tape and head drum speeds.

Appellants argue the differences between their invention and the applied references on pages 3 and 4 of their brief.¹ In response the Examiner dismisses the differences as

¹ Appellants contend their claims do not stand or fall together (brief-page 2). However, pages 4-7 of the brief merely recite the differences in what the claims cover, which is not considered an argument for separate patentability, 37

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merely an intended use (answer-pages 5 and 6). We disagree and find that Appellants' claims positively recite structure and method steps that are not met by the Examiner's rejection.

The Federal Circuit states that "[t]he 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 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), **citing In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Since there is no evidence in the record that the prior art suggested the claimed combination

of claims 1 and 7, we will not sustain the Examiner's rejection of these claims.

The remaining claims on appeal also contain the above limitations discussed in regard to claims 1 and 7 and thereby, we will not sustain the rejection as to these claims.

CFR
§ 1.192(c)(7), 60 FR 14518, Mar. 17, 1995.

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We have not sustained the rejection of claims 1 through 12 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

REVERSED

	JERRY SMITH)	
	Administrative Patent Judge)	
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)	
	LEE E. BARRETT)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	STUART N. HECKER)	
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