

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOHN G. POSA and BARRY H. SCHWAB

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Appeal No. 1999-1096  
Application No. 08/556,746

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ON BRIEF

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Before JERRY SMITH, DIXON, and GROSS, Administrative Patent Judges.  
GROSS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 5, 10, 11, 16 through 24, 27 through 30, and 35 through 50. In the Examiner's Answer (page 2), the examiner indicates that claims 42 through 47 are allowed and claims 19, 27 through 30, and 50 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form. Accordingly, only claims 1, 5, 10, 11, 16 through 18, 20 through 24, 35 through 41, 48, and 49 remain before us on appeal.

Appeal No. 1999-1096  
Application No. 08/556,746

Appellants' invention relates to a video indexing method which includes separately storing segments of a video program and displaying them in separate windows to identify program contents, with at least one of the segments including motion imagery.

Claim 1 illustrates the claimed invention and reads as follows:

1. A video indexing method, comprising the steps of:

recording a video program having a sequence of images;

separately storing information representative of a subset of the images, the image subset representing segments of the program which are separated in time; and

displaying images from the subset in separate windows on a display device as a way of identifying the contents of the video program, at least one of the windows displaying a segment including motion imagery.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Yoshimura et al. (Yoshimura)	5,126,851	Jun. 30, 1992
Kano	5,142,302	Aug. 25, 1992
Henmi et al. (Henmi)	5,390,027	Feb. 14, 1995
Takahashi	5,459,582	Oct. 17, 1995
Mankovitz	5,541,738	Jul. 30, 1996

(filed Apr. 12, 1994)

Claims 1, 5, 10, 11, 16 through 18, 21, 24, 48, and 49 stand rejected under 35 U.S.C. § 103 as being unpatentable over Takahashi in view of Mankovitz.

Claims 20, 22, 23, and 35 through 41 also stand rejected under 35 U.S.C. § 103 as being unpatentable over Takahashi in

Appeal No. 1999-1096  
Application No. 08/556,746

view of Mankovitz, but further in view of Kano for claim 22, Yoshimura for claim 23, or Henmi for claims 20 and 35 through 41.

Reference is made to the Examiner's Answer (Paper No. 15, mailed January 5, 1999) for the examiner's complete reasoning in support of the rejections, and to appellants' Brief (Paper No. 14, filed October 13, 1998) and Reply Brief (Paper No. 17, filed January 28, 1999) for appellants' arguments thereagainst.

#### OPINION

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellants and the examiner. As a consequence of our review, we will reverse the obviousness rejections of claims 1, 5, 10, 11, 16 through 18, and 20 through 24 and affirm the obviousness rejection of claims 35 through 41, 48, and 49.

Claim 1 recites a video indexing method including the steps of "separately storing information representative of a subset of the images [of a video program being recorded], the image subset representing segments of the program which are separated in time," and "displaying images from the subset in separate windows . . . at least one of the windows displaying a segment including motion imagery." Claim 17 recites means for accomplishing essentially the steps of claim 1. Thus, both claims 1 and 17 require storing and displaying in separate windows time separated

Appeal No. 1999-1096  
Application No. 08/556,746

segments of a program being recorded, with at least one segment containing motion imagery.

The examiner asserts (Answer, page 5) that Takahashi discloses displaying images as a way of identifying the contents of a video program, but fails to disclose that the displayed images are motion images. To remedy this deficiency, the examiner turns to Mankovitz, stating that "Mankovitz discloses a video apparatus including the capability of displaying guide information having video clips comprising moving pictures as menu data indicating the content of the video program." The examiner continues that:

It would have been obvious . . . to modify the Takahashi's video system wherein the displaying means provided thereof . . . would incorporate the capability of displaying motion images as menu for identifying the contents of the video program in the same conventional manner as shown by Mankovitz. The motivation being to increase the quality of the displayed images by providing a more comprehensive imagery to the user as suggested by Mankovitz.

Appellants argue (Brief, page 7) that Takahashi is limited to storage of a single still picture subdivided into multiple images. As support for their assertion, appellants point to column 8, lines 17-23, of Takahashi wherein Takahashi indicates that for a fixed image memory capacity, as the number of images written into the image memory is increased, the picture quality is degraded. This portion of the disclosure seems to suggest

Appeal No. 1999-1096  
Application No. 08/556,746

that Takahashi is concerned with limiting the amount of information written into the image memory, whereas substituting motion pictures would require increasing the amount of information written into memory.

Mankovitz discloses a program guide for use in future recordings and not recording new indexing information as part of a user recording. Thus, Mankovitz alone does not teach the claimed invention. As to the examiner's motivation for incorporating Mankovitz's motion images in Takahashi's indexing system, i.e., "to increase the quality of the displayed images by providing a more comprehensive imagery to the user," we find no suggestion in either reference that more comprehensive imagery would result from the combination nor that such would even be desirable. The Court has held that:

With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience -- or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.

*In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus, we cannot accept bald assertions with no evidence to support them as motivation for modifying Takahashi. Accordingly, the examiner has failed to establish a *prima facie* of obviousness for claims 1 and 17. Therefore, we cannot sustain

Appeal No. 1999-1096  
Application No. 08/556,746

the rejection of claims 1, 17, and their dependents, claims 5, 10, 11, 16, 18, 21, and 24.

As to independent claim 48 and its dependent claim, 49, appellants assert (Brief, page 13) that:

According to paragraph 2 of the final Office Action, these claims are rejected only over Takahashi in view of Mankovitz though, in the previous Office Action, Yoshimura was added under §103. Since it is unclear to Appellants precisely which references are being used to reject these claims, argument will be made with respect to Yoshimura in the event that the Examiner intended its use.

However, we find nothing in the Answer, the Final Rejection, or the Office Action just prior to the Final Rejection indicating the addition of Yoshimura for rejecting claims 48 and 49. The rejection was and continues to be over Takahashi and Mankovitz. As appellants' sole argument is directed to Yoshimura, they have failed to point out any deficiency in the applied combination. Accordingly, we will affirm the rejection of claims 48 and 49. Furthermore, appellants state (Brief, page 5) that claims 35 through 41 are to stand or fall with, claims 48 and 49. Consistent therewith, appellants have presented no arguments as to the separate patentability of claims 35 through 41. Since we have affirmed the rejection of claims 48 and 49, we will likewise affirm the rejection of claims 35 through 41.

Regarding claim 20, Henmi teaches identifying portions of a tape by program information and index numbers, not by images or

Appeal No. 1999-1096  
Application No. 08/556,746

pictures. Therefore, Henmi fails to add any teachings to the primary combination of Takahashi and Mankovitz which would cure the deficiencies thereof. Consequently, we cannot sustain the rejection of claim 20.

For claim 22, the examiner adds Kano to Takahashi and Mankovitz for a suggestion to include a means for printing the stored pictures. However, Kano is directed to a printer, not to a video indexing method, and, therefore, fails to cure the deficiency of the primary combination. Accordingly, we cannot sustain the rejection of claim 22.

As to claim 23, the examiner applies Yoshimura for a suggestion to display the pictures in an array of windows. However, as Yoshimura discloses extracting and displaying still pictures similar to Takahashi, Yoshimura fails to provide the missing motivation for substituting moving images for still pictures. Therefore, Yoshimura fails to remedy the primary combination, and we cannot sustain the rejection of claim 23.

#### CONCLUSION

The decision of the examiner rejecting claims 1, 5, 10, 11, 16 through 18, 20 through 24, 35 through 41, 48, and 49 under 35 U.S.C. § 103 is affirmed as to claims 35 through 41, 48, and 49 and reversed as to claims 1, 5, 10, 11, 16 through 18, and 20 through 24.

Appeal No. 1999-1096  
Application No. 08/556,746

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	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
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	)	
ANITA PELLMAN GROSS	)	
Administrative Patent Judge	)	

Appeal No. 1999-1096  
Application No. 08/556,746

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