

Art Unit 2602

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Appeal No. 93-4110

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ON BRIEF

PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Tokumichi Murakami,
Kohtaro Asai, Koh Kamizawa,
Masami Nishida, Eizo Yamazaki
Atsushi Itoh and Naoto Kinjoh

Application for Patent filed January 8, 1992, Serial
No. 07/818,277, for the Reissue of Patent No. 5,010,401, granted
April 23, 1991, based on application Serial No. 07/340,009, filed
April 7, 1989. Picture Coding And Decoding Apparatus Using
Vector Quantization.

Lawrence G. Norris et al. for appellants.

Primary Examiner - John K. Peng

Before Craig, Lynch and Thomas, Administrative Patent Judges.¹

Thomas, Administrative Patent Judge.

This is a decision by Examiners-in-Chief designated in
accordance with 35 U.S.C. 7 on an appeal taken under 35 U.S.C.
134 to the Board of Patent Appeals and Interferences. Appellants
have appealed to the Board from the examiner's final rejection of

¹ The Commissioner of Patents and Trademarks has authorized the
Examiners-in-Chief of the Board of Patent Appeals and
Interferences to use the title of Administrative Patent Judge.
See 1156 OG 32, November 9, 1993.

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claims 1 to 12, which constitute all the claims in this reissue application.

Representative claim 9 is reproduced below:

9. A picture encoding transmission apparatus, comprising: an encoding section including

a blocking circuit for blocking video signal series inputted in raster direction scanning order into blocks of $m \times n$ pixels (m, n : integers) as encoding units to be made input vectors;

a field memory for storing at least one field of picture information corresponding to one or more previous frames;

a dynamic vector quantizer for blocking the signal series at the position of the encoding object and periphery in the field memory, constituting a set of output vectors to read out, determining one of the output vectors being most similar to each input vector as a dynamic vector quantization (DVO) output vector, and making an index (label) of the DVO output vector as an encoded output; and

a digital filter for applying a smoothing process to the DVO output vectors, said digital filter being provided with an adaptive filter in which a weighting factor α thereof is varied in accordance with the amount of motion shown by the DVO index, and a sum of α times an object pixel value and a weighted sum of peripheral pixel values of pixels peripheral to said object pixel, the weights of which peripheral pixels add up to $(1-\alpha)$, is made a filter output of the object pixel in order to strengthen the degree of smoothing of the DVO output vectors in accordance with said amount of motion.

There are no references relied on by the examiner.

Claims 1 to 12 stand rejected under 35 U.S.C. 251 as being based upon a defective reissue declaration, the examiner noting the particulars of implementing rule 37 CFR 1.175. The examiner has taken the position that the language in the reissue declaration that certain "above-noted errors were recently discovered in the last several months" is not sufficiently

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specific to determine the "when" issue within 37 CFR 1.175(a)(5). Additionally, the examiner raises two additional issues with respect to this rejection. The oath fails to discuss the correction of the two errors noted with respect to original patent claim 7 and the declaration does not concern itself with the labeling of Figures 1 to 20 and 53 to 55 as prior art where the original issued patent figures fail to indicate such status for these figures. The examiner has set forth a separate rejection of claims 9 to 12 under 35 U.S.C. 251 in that these newly added claims in this reissue application constitute new matter.

Rather than reiterate the arguments of the appellants and the examiner, reference is made to the briefs and the answer for the respective details thereof.

OPINION

We will sustain the rejection of claims 1 to 12 under 35 U.S.C. 251 as being based upon a defective reissue declaration.

The following language at the bottom of page 3 of the declaration accompanying this reissue application questioned by the examiner in this rejection is:

The above-noted errors were recently discovered in the last several months upon a careful review of the claims by the assignee of the patent;....

This language is deficient for two reasons, in our view, to meet the requirements of 35 U.S.C. 251 and the

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implementing rule, 37 CFR 1.175. Initially, the assignee is not an in personam entity but merely a corporate entity. As such, it is not possible from the terms expressed in the declaration what person or persons actually made the determination of the errors since the declaration indicates that the errors were recently discovered "by the assignee of the patent."

Secondly, we agree with the examiner's basic premise that there is a lack of specificity under the statute and implementing rule as to the timeframe in which the errors were discovered.

Our reviewing court has stated the following:

The statutory provision has been implemented and expanded by the PTO regulations of 37 C.F.R. §175, which require an oath or declaration with respect to both aspects of error under section 251 and further require an explanation as to how and when the error in conduct arose and how and when it was discovered.

Hewlett-Packard Co. v. Bausch & Lomb Inc, 882 F.2d 1556, 11 USPQ2d 1750, 1758 (Fed. Cir. 1989), cert. den., 110 Sup. Ct. 112 (1990). See also Alcon Laboratories v. Allergan Inc., 17 USPQ2d, 1365, 1375 (DC N. Texas, 1990), relying on Hewlett-Packard.

Although we recognize that the requirement of the so-called "when" issue is not particularly set forth within the four corners of 37 CFR 1.175(a)(5), it is clear from the above-quoted portion of Hewlett-Packard that the court regards such as a part of the rule. The court thus gives great deference to the requirement of explanation as to how and when any error in conduct arose and how and when it was discovered.

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This language is more specifically set forth in M.P.E.P. 1414 and M.P.E.P. 1414.03 as noted by the examiner at page 5 of the answer. The second paragraph of M.P.E.P. 1414, revision 14, November 1992, page 1400-5, states "Reissue oaths or declarations must point out very specifically what the defects are and how and when the errors arose, and how and when the errors were discovered." Similar language is found in the third paragraph of M.P.E.P. 1414.03, revision 14, November 1992, page 1400-8. There it states that "'How' includes when and under what circumstances the errors arose or occurred." This is further explained in the remaining portions of that paragraph. It is apparent that the policy consideration behind the more specific requirements of how and when is such as to permit the examiner to make an independent determination that the errors arose without any deceptive intention on the part of appellants.

Since our reviewing court has given great deference to the referenced language in M.P.E.P. 1414 and M.P.E.P. 1414.03 as being imputed to be part of implementing rule 37 CFR 1.175 as to how and when the noted errors occurred and how and when they were discovered, we agree with the examiner's requirement that the quoted language in the present declaration that the noted errors were only "recently discovered in the last several months" is not sufficiently specific to meet the requirements of the rule, and thus the statute. This analysis is believed to directly address

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appellants' arguments in the principal brief with respect to this issue.

We now turn our attention to the additional bases of the rejection which relate to the two changes in original patent claim 7 and the labelling of certain figures as prior art. To make a determination of these issues we turn attention to a review of the patented file. Patented claim 7 is identical to amended original claim 7 in the parent application. Page 18 of the amendment filed on October 12, 1990 in the parent application indicates that appellants' reproduction of claim 7 at this page contained in part the following language, "an adder for adding the decoded the interframe...." It is apparent, then, that the present attempt in this reissue application to delete the second occurrence of the word "the" in the above-quoted portion in the patented claim in this reissue application is a result of an error of appellants rather than as alleged an error of the Patent and Trademark Office which the prosecution history in this reissue application seems to indicate. Under such circumstances, it is incumbent upon appellants to so specify in their reissue declaration that the language "the" in claim 7 to be deleted is their own error. The present reissue declaration contains no such reference as noted by the examiner.

We make an additional reference to the bottom portion of page 18 of that amendment filed on October 12, 1990 in the parent application. The pertinent language "every other pixel

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and every other line of both...." clearly indicates that there was an original correct spelling of the word "line". The printed version of this word was spelled "lien", which appellants attempt to correct in this reissue application. This is clearly an Office printing error in the printing of the actual patent. Even though there is no error that may be fairly attributed to appellants within 35 U.S.C. 251 with respect to the spelling of the word "line", we see no reason why appellants should not be permitted to make such a correction in a reissue application since 35 U.S.C. 251 is remedial in nature.

We make a similar determination with respect to the issue raised by the examiner as to the labeling of Figures 1 to 20 and 53 to 55 as being prior art. The original printed version of these figures in the patent does not contain such a designation. The present figures in this reissue application do contain such a designation. Turning again to the file of the parent application, as a part of the October 12, 1990 amendment, appellants submitted various drawing corrections including the labeling of Figures 1 to 20 and 53 to 55 as prior art and certain additional changes to Figure 45. Such changes were approved by the examiner in the Notice of Allowability mailed November 13, 1990; see therein part II, sub-paragraph 2b. The lead-in language of part II indicates that a shortened statutory period for response to comply with the requirements so noted is set to expire three months from the date of mailing of the form. Since

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the formal drawings incorporating the examiner approved changes were filed on February 12, 1991, this filing was in compliance with the requirements so stated on the form. Thus, again we face the situation were the error was an Office printing error rather than one attributed to appellants within 251. However, we reach a similar conclusion as noted earlier that we know of no reason why appellants should not be permitted to correct the drawings in this reissue application even though the error cannot be fairly attributed to them within 35 U.S.C. 251 since 35 U.S.C. 251 is remedial in nature. The changes include certain changes to Figure 45 as well since they too were not made in the patent drawings.

Lastly, we turn to the separate rejection of claims 9 to 12 within 35 U.S.C. 251 as being based upon new matter. We reverse this rejection. There appears to be no dispute in the record as a whole that the subject matter of claims 9 to 12 read on an embodiment set forth in Figures 56 to 59 which is discussed at the bottom of column 36 to the end of the patent. We conclude that the examiner's characterization that it is new matter to effectively delete subject matter from the originally presented patented claims 1 to 8 and thus present the apparent broadened reissue claims as new claims 9 to 12 is misplaced. The subject matter of these claims clearly reads upon the structure set forth in Figures 56 and 57. The examiner's position is not well-taken. Page 3 of the final rejection indicates that the examiner has

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effectively agreed that the determination of new matter within 35 U.S.C. 251 may be simply determined by deciding if the original specification supports the reissue-claims under 35 U.S.C. 112. The examiner then goes on to indicate that it is clear that the newly added claims 9 to 12 directly recite the embodiment disclosed in Figures 56 to 59 (columns 36 to 39). The examiner also admits at the top of page 7 of the answer that if the present claims 9 to 12 were presented in the original application there would not be any new matter situation presented. In view of such statements, the examiner's position cannot be sustained. Note also the reasoning in In re Amos, 953 F.2d 613, 21 USPQ2d 1271 (Fed. Cir. 1991).

There is clearly an adequate basis within the referenced figures and column locations in the original patent for the subject matter of claims 9 to 12 within 35 U.S.C. 112. Since this reissue application was filed approximately nine months after the patent date of the patent in question, it clearly complies with the requirements at the end of 35 U.S.C. 251 that any broadening of any reissue claims must be presented within 2 years of the patent date. Even though we fairly characterize, as well as the examiner characterizing the subject matter of claims 9 to 12, as being directed to a different embodiment of the same invention claimed in the original patent, to the extent they may be interpreted to be broader than the original patent claims 1 to 8, they are clearly permitted to be

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filed within the provisions of 35 U.S.C. 251 permitting broadened reissue claims to be filed within two years of the patent date.

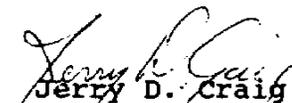
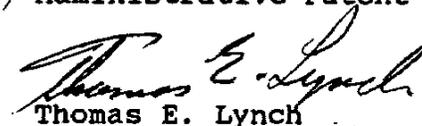
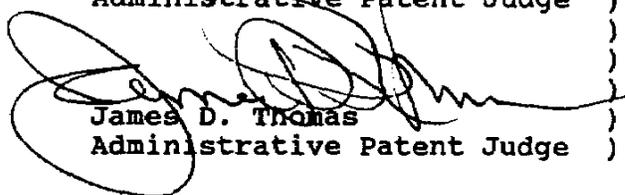
SUMMARY

In view of the foregoing, we have reversed the examiner's rejection of claims 9 to 12 under 35 U.S.C. 251 as being based upon new matter. Notwithstanding this, we sustain a separate rejection of claims 1 to 12 under 35 U.S.C. 251 as being based upon a defective reissue declaration. Accordingly, the decision of the examiner is affirmed. More specifically, in any succeeding declaration filed in this or any continuing application, appellants must be more specific as to how and when the errors were discovered to include an indication of which natural persons of the assignee discovered the errors. The declaration must also include a reference to the correction of the minor error noted in claim 7 with respect to the superfluous "the" sought to be deleted in this claim. Applicants should also be permitted to correct the other noted error, a misspelling error caused by the Office printing process, in claim 7 as well as the labeling of certain figures as prior art and the changes to Figure 45 without being required to set forth such as errors attributed to them within 35 U.S.C. 251.

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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). See the final rule notice, 54 F.R. 29548 (July 13, 1989), 1105 O.G. 5 (August 1, 1989).

AFFIRMED

 Jerry D. Craig Administrative Patent Judge)	
 Thomas E. Lynch Administrative Patent Judge)	BOARD OF PATENT APPEALS AND INTERFERENCES
 James D. Thomas Administrative Patent Judge)	

Lawrence G. Norris
Rothwell, Figg, Ernst & Kurz, P.C.
555 Thirteenth Street, N.W.
Suite 701 East
Washington, D.C. 20004