

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN ABT and
JAMES A. DELWICHE

Appeal No. 95-0840
Application 08/029,343¹

ON BRIEF

Before THOMAS, JERRY SMITH and FLEMING, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed March 10, 1993. According to the appellants, this application is a continuation of Application 07/715,287, filed June 14, 1991, now abandoned.

Appeal No. 95-0840
Application 08/029,343

Appellants have appealed to the Board from the examiner's final rejection of claims 27 to 32, 34 to 40 and 42 to 51, which constitute all the claims remaining in the application.

Representative independent claim 27 is reproduced below:

27. A non-additive mixer for video signals, comprising:

a first chrominance filter for receiving a first video input and producing a first luminance signal;

a second chrominance filter for receiving a second video input and producing a second luminance signal;

summation means coupled to receive the first luminance signal and the second luminance signal and producing a mixer control signal that is a linear function of the difference between the first luminance signal and the second luminance signal; and

a mixer coupled to receive the first video input and the second video input and producing a video output representative of the product of the first video input and the mixer control signal plus the product of the second video input and the complement of the mixer control signal.

There are no references relied on by the examiner.

All pending claims stand rejected under the first paragraph of 35 U.S.C. § 112 as being based upon a non-enabling disclosure, as well as the second paragraph of 35 U.S.C. § 112 since, in the examiner's view, the claims fail to particularly point out and distinctly claim the subject matter which appellants regard as their invention.

Appeal No. 95-0840
Application 08/029,343

Rather than repeat the positions of the appellants and the examiner, reference is made to the brief and the answer for the respective details thereof.

OPINION

Turning first to the rejection of the claims under the second paragraph of 35 U.S.C. § 112, it is to be noted that to comply with the requirements of the cited paragraph, a claim must set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure and the teachings of the prior art as it would be by the artisan. Note In re Johnson, 558 F.2d 1008, 1016, 194 USPQ 187, 194 (CCPA 1977); In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

Generally speaking, "[t]he test of enablement is whether one reasonably skilled in the art could make or [sic and] use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), citing Hybritech, Inc. V. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986).

Appeal No. 95-0840
Application 08/029,343

Under both tests the claimed invention must be viewed from the artisan's perspective, the one reasonably skilled in the art. As to the enablement issue, we are in agreement with appellants' position briefly stated at the middle of page 3 of the brief on appeal that each of the recited elements in the claims on appeal have corresponding structural and/or functional correlation to the structural elements shown in Figs. 2 and 3 of the specification's drawing figures. Each of the respectively shown elements is well known in the video signal processing art anyway. Irrespective of the label attached to the claimed invention, we are not persuaded by any of the examiner's reasoning that the artisan would have required undue experimentation to make and use the presently claimed invention.

The real position apparently advocated by the examiner is some form of misdescriptive labeling of the claimed invention in the preamble as a non-additive video mixer. Initially, we note that no such corresponding language appears in the body of each independent claim on appeal. Therefore, the label of a non-additive mixer in the preamble of each of these independent claims appears to us to be a mere end use limitation that has no real significant meaning in the body of the claim. Even if it did, the examiner's reasoning, even if it were correct, does not

Appeal No. 95-0840
Application 08/029,343

lead us to conclude that the artisan would have been in any way deceived as to or find indefinite or vague the subject matter and scope of the claimed invention.

Again, consistent with our enablement discussion, the claims are clearly consistent with the written description and drawing figures associated therewith. If the artisan were to agree with the examiner's view that in some manner the body of the claims does not recite structure consistent with conventional meanings in the art of a non-additive mixer, the artisan would have clearly recognized this from the disclosure, the drawing figures and the claims. Therefore, in this sense, the artisan clearly would not have been deceived or otherwise view the presently claimed subject matter as being unclear or indefinite in some manner since the artisan clearly would have recognized the misdescriptive nature of the invention as departing significantly from prior art conventional understandings of non-additive mixers.

We are also not convinced that the artisan would have been convinced of such misdescriptive nature of each independent claim on appeal since each in some form recites language to the effect that the output of a mixer circuit is representative of the product of the first video input and a mixer control signal plus

the product of a second video input signal and the complement of the same mixer control signal. This feature is recited in some manner at least once in each independent claim on appeal. This language corresponds to appellants' implementation of the art-recognized non-additive mixer equation introduced at the bottom of page 4 of appellants' specification.

At page 7 of the answer, the examiner considers this equation to represent non-additive mixing as conventionally defined in the art when the modifying values are exclusively "1" or "0." Page 5 of appellants' specification at lines 9 through 13 indicate that appellants' version of a non-additive video mixer is functionally equivalent to what is known in the prior art when, in rare instances, both offset signals of representative Fig. 2 are zero and the gain control signal is at a maximum or infinity. The so-called "softening" the transition feature between the input video signals discussed at the bottom of page 5 of the invention is clearly consistent with the aim of the disclosure set forth in the first sentence of page 1 of the written description where appellants indicate that the invention is an improved video non-additive mixer circuit that provides control over the point and rate of transition of video signals.

Appeal No. 95-0840
Application 08/029,343

The end result of appellants' invention is a mixer control signal that varies from 0.0 to 1.0 which the artisan would have well recognized by definition is some form of modified version of a conventionally defined non-additive mixer which traditionally provides only variations of zero or one as modifying elements to the conventional equation represented at the bottom of page 4 of appellants' written description. Accordingly, we find that appellants' claimed invention is definite within the second paragraph and adequately disclosed within the first paragraph of 35 U.S.C. § 112.

In view of the foregoing, the decision of the examiner rejecting claims 27 to 32, 34 to 40 and 42 to 51 under the first and second paragraphs of 35 U.S.C. § 112 is reversed.

REVERSED

JAMES D. THOMAS
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT

Appeal No. 95-0840
Application 08/029,343

JERRY SMITH)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
MICHAEL R. FLEMING)	
Administrative Patent Judge)	

TEKTRONIX, INC.
P. O. Box 1000 (63-LAW)
Wilsonville, OR 97070-1000