

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOSHIYUKI ODA,
TAMOTSU ITO and TAKASHI TAKEUCHI

Appeal No. 95-4645
Application 07/678,441¹

HEARD: February 4, 1998

Before THOMAS, HAIRSTON and LEE, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 10 to 14 and 19. As distinguished from

¹ Application for patent filed April 1, 1991.

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the final rejection, the initial answer rejected only claims 10 and 19 under 35 U.S.C. § 102(b), which rejection remains. This answer instituted a rejection of dependent claims 11 to 14 under 35 U.S.C. § 103. The supplemental answer reduced this latter rejection such that only claim 11 is included. Thus, only claims 10, 11 and 19 remain on appeal.

The pertinent portion of representative independent claim 10 on appeal is "means for modifying the reproduced image data and the reproduced voice data in accordance with the executed control program." Corresponding language appears in independent claim 19 in slightly more specific form.

The following references are relied on by the examiner:

Kageyama et al. (Kageyama)	4,791,496	Dec. 13, 1988
Hirano et al. (Hirano)	4,845,571	Jul. 04, 1989

Rather than repeat the positions of the appellants and the examiner, reference is made to the various briefs and answers for the respective details thereof.

OPINION

We reverse the rejection of claims 10 and 19 under 35 U.S.C. § 102 as being anticipated by Hirano and, because Kageyama does not cure the defects of Hirano as applied in the rejection of claim 11 under 35 U.S.C. § 103, this latter rejection of dependent claim 11 is also reversed.

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Page 9 of the Principal brief on appeal begins a series of arguments that the above noted means for modifying of independent claims 10 and 19 is not taught within 35 U.S.C. § 102 in Hirano. More specifically, the arguments beginning at the bottom of page 10 through page 11 of the Principal brief on appeal take the position that in accordance with the sixth paragraph of 35 U.S.C. § 112, the reference does not teach the process table of Figure 9 and thus, the process of modifying the image data by diffussing one pixel of data into data of surrounding pixels as described at page 17, lines 9 to 12 of the specification as filed.

To expand upon this correlation it appears that the subject matter of Figure 9 is discussed beginning at line 3 of page 17 through the end of the specification. A specific manner of modifying is, as urged by appellants, discussed at page 17 in the manner argued. The succeeding pages discuss Figure 10 and Figure 11 of the specification as filed. Even though the discussion in the specification relating to Figure 11 does not discuss in detail the process table of Figure 9, it is shown in Figure 11 as a part of the application program. As noted by the examiner in the responsive arguments portion at page 6 of the initial examiner's answer, the referenced portion of the specification at page 17 makes reference only to modifying image data whereas the

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subject matter of the means for modifying clause of each independent claim on appeal relates to doing so for

reproduced image data and reproduced voice data. The examiner's reference to the bottom of page 21 of the specification as filed correlates to the Figure 12 showing of the system of the invention which concerns modifying both image and voice data as set forth at lines 22 through 26 at this page. It is noted further that the subject matter of the original but now canceled claim 1 recited this same feature of means for modifying the voice data and the image data in accordance with the claimed controlled program.

In light of this understanding, it is apparent that there is, as disclosed and originally claimed, a means for modifying the reproduced image data and the reproduced voice data as presently claimed in independent claims 10 and 19 on appeal. Although the original claims in the specification as filed do not detail the manner in which the means for modifying of voice data would occur, the corresponding teachings and showings associated with Figure 9, as urged by appellants, do detail the specifics of

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the modification of the reproduced image data in such a manner as to diffuse one pixel of data into data of surrounding pixels.

The examiner's correlation of the claimed modifying feature to the error correcting capability of the error correction

circuit 53 in Figure 2 of Hirano is misplaced. Even though the discussion of Figure 2 of Hirano beginning at column 4, line 30, indicates that with respect to read operation the error correcting code generator 53 does in fact correct or modify data to the extent broadly claimed, it does not do so in a program manner such as to diffuse a pixel into surrounding pixels in accordance with the arguments presented by appellants linking the claimed means for modifying to the Figure 9 representation of the disclosed invention. Thus, we conclude that there can be no structural equivalence in accordance with 35 U.S.C. § 112, sixth paragraph, for this claimed feature. As such, we do not agree with the examiner's expanded arguments as to this modifying feature in the supplemental answer at pages 2 and 3 thereof.

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In view of the foregoing, the decision of the examiner rejecting claims 10 and 19 under 35 U.S.C. § 102 is reversed as well as the rejection of dependent claim 11 under 35 U.S.C. § 103.

REVERSED

JAMES D. THOMAS
Administrative Patent Judge

KENNETH W. HAIRSTON
Administrative Patent Judge

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