

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES D. GREENFIELD, DIANE M. MAUERSBERG
and AGNES Y. NGAI

Appeal No. 1997-2707
Application No. 08/411,127

ON BRIEF

Before THOMAS, KRASS, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 1, which is the sole claim pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to an apparatus for color component compression. An understanding of the invention can be derived from a reading of sole claim 1, which is reproduced below.

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1. In a method of encoding interlaced, full motion digital video image data having two interlaced fields per frame with luminance and chrominance components, where the chrominance components are uncorrelated between adjacent fields, the improvement comprising applying one field of chrominance information to both luminance fields of a frame, thereby encoding chrominance components at one quarter the spatial resolution of the luminance components.

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

Guede	5,436,663	Jul. 25, 1995 (Filed Dec. 16, 1993)
Auld	5,502,494	Mar. 26, 1996 (Eff. filing date Oct. 25, 1993)

Claim 1 stands rejected under 35 U.S.C. § 103 as being unpatentable over Guede in view of Auld.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 13, mailed Feb. 19, 1997) for the examiner's reasoning in support of the rejections, and to the appellants' brief (Paper No. 12, filed Jan. 27, 1997) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the

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respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Appellants sole argument is that the examiner's rejection is based upon improper hindsight reconstruction of the claimed invention. (See brief at page 4.) We agree with appellants. The examiner has set forth two separate teachings in the prior art and asserted that neither of the two references teach or fairly suggest that one field of chrominance information is applied to both luminance fields. (See answer at page 4.) The examiner then concludes that it would have been obvious with the two teaching and the general knowledge of chrominance and luminance field processing to devise the claimed invention based upon the rationale that it was well known to desire more pleasant viewing. Appellants argue that the examiner has relied upon improper hindsight reconstruction to reject claim 1. We agree with appellants. Absent some teaching or suggestion in the prior art references or some convincing line of reasoning derived from that knowledge in the relevant art, we find no motivation to modify the prior art teaching to arrive at the claimed invention. Therefore, the examiner has not set forth a *prima facie* case of obviousness.

When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the

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prior art to make the selection made by the appellants. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The extent to which such suggestion must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the appellants' invention. As in all determinations under 35 U.S.C.

§ 103, the decision maker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the appellants' structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the appellants' combination would have been obvious. **In re Gorman**, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. **See In re Beattie**, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); **Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.**, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984). In determining obviousness/nonobviousness, an invention must be considered "as a whole," 35 U.S.C. § 103, and claims must be considered in their entirety. **Medtronic, Inc. v. Cardiac Pacemakers, Inc.**, 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983). Since the

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limitation that “applying one field of chrominance information to both luminance fields of a frame, thereby encoding chrominance components at one quarter the spatial resolution of the luminance components” is not taught or suggested by the applied prior art, we will not sustain the 35 U.S.C. § 103 rejection of sole claim 1.

CONCLUSION

To summarize, the decision of the examiner to reject claim 1 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ERROL A. KRASS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
JOSEPH L. DIXON)	
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