

The opinion in support of the decision being entered today (1) was not written for publication and (2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KATSUJI IGARASHI, JUN YONEMITSU,
YOICHI YAGASAKI, YASUSHI FUJINAMI,
TOMOYUKI SATO, MOTOKI KATO,
and TERUHIKO SUZUKI

Appeal No. 1999-0089
Application No. 08/454,076

ON BRIEF¹

Before BARRETT, RUGGIERO, and BARRY, Administrative Patent Judges.

BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the final rejection of claims 18 and 38-42. We affirm-in-part.

BACKGROUND

¹A scheduled oral hearing was waived. (Paper No. 24.)

The invention at issue in this appeal relates to predictive encoding of a television picture. By reducing temporal redundance between successive television pictures, predictive encoding avoids the need to transmit a picture in its entirety. More specifically, corrections are applied to a previously encoded picture to obtain a current picture.

In the invention, a television picture is treated as a mosaic of areas. Two structure modes for encoding are used; the particular mode used depends on the motion in a video picture to be encoded. The first mode encodes the picture with intra-frame prediction and field-based orthogonal transformation. The second mode encodes the picture with inter-frame prediction and frame-based orthogonal transformation

Claim 38, which is representative for our purposes, follows:

38. A picture signal encoding method comprising the steps of:

receiving an interlaced signal having frames each containing an odd field and an even field, said

interlaced signal representing a current picture and at least one other picture;

selecting either a first or second mode of encoding, said first mode being carried out by an intra-frame prediction encoding technique and field-based orthogonal transformation and said second mode being carried out by an inter-frame prediction encoding technique and frame-based orthogonal transformation;

predictively encoding the current picture relative to said at least one other picture by the prediction encoding technique that is carried out by the selected mode of encoding; and

orthogonally transforming the predictively encoded current picture by the orthogonal transformation that is carried out by the selected mode of encoding.

The reference relied on in rejecting the claims follows:

Krause et al. (Krause)	5,091,782	Feb. 25,
		1992.

Claims 18 and 38-42 stand rejected under 35 U.S.C.

§ 103(a) as obvious over Krause. Rather than repeat the arguments of the appellants or examiner in toto, we refer the reader to the briefs and answer for the respective details thereof.

OPINION

In reaching our decision in this appeal, we considered the subject matter on appeal and the rejection advanced by the examiner. Furthermore, we duly considered the arguments and evidence of the appellants and examiner. After considering the totality of the record, we are persuaded that the examiner erred in rejecting claims 18, 38, 40, and 42 but not in rejecting claims 39 and 41. Accordingly, we affirm-in-part.

We begin by noting the following principles from In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).... "A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

With these principles in mind, we consider the appellants' argument and the examiner's reply.

The appellants argue, "[i]t is not enough for Krause simply to provide four possible modes, two of which correspond to Appellants' two modes. Rather, Krause must provide some teaching of selecting either the first mode or the second mode -- and this simply is not expressly or even impliedly disclosed." (Reply Br. at 7.) The examiner replies, "[w]hile it is true that Krause et al employs two other modes (i.e. intra-frame prediction encoding with frame-based orthogonal transformation and inter-frame prediction with field-based orthogonal transformation), the present claims do not exclude these other modes." (Examiner's Answer at 6.) We consider the argument and reply with respect to the following claims:

- claims 18, 38, 40, and 42
- claims 39 and 41.

Claims 18, 38, 40, and 42

"[W]hen interpreting a claim, words of the claim are generally given their ordinary and accustomed meaning"

In re Paulsen, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (citing Carroll Touch, Inc. v. Electro Mechanical Sys., Inc., 15 F.3d 1573, 1577, 27 USPQ2d 1836, 1840 (Fed. Cir. 1993)). Here, claims 18, 38, 40, and 42 specify in pertinent part the following limitations: "selecting either a first or second mode of encoding, said first mode being carried out by an intra-frame prediction encoding technique and field-based orthogonal transformation and said second mode being carried out by an inter-frame prediction encoding technique and frame-based orthogonal transformation" The expression "either ... or" means "an ... exclusive division between only two alternatives" Webster's Ninth New Collegiate Dictionary 399 (1990) (copy attached). In view of this understanding, the limitations require selecting between only a first or second mode of encoding, wherein the first mode is implemented by an intra-frame prediction encoding technique and field-based orthogonal transformation and the second mode is implemented by an inter-frame prediction encoding technique and frame-based orthogonal transformation.

The examiner fails to show a suggestion of the limitations in the prior art. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), cert. denied, 519 U.S. 822 (1996)(citing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." Id. at 1266, 23 USPQ2d at 1784 (citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).

Here, although Krause would have suggested selecting between modes, four modes are selected between. More specifically, the examiner admits, "Krause et al employs two other modes (i.e. intra-frame prediction encoding with frame-based orthogonal transformation and inter-frame prediction with field-based orthogonal transformation)" (Examiner's Answer at 6.) Because Krause requires selection between four modes, we are not persuaded that teachings from the applied prior art would appear to have suggested the limitations of "selecting either a first or second mode of encoding, said first mode being carried out by an intra-frame prediction encoding technique and field-based orthogonal transformation and said second mode being carried out by an inter-frame prediction encoding technique and frame-based orthogonal transformation" The examiner fails to establish a prima facie case of obviousness. Therefore, we reverse the rejection of claims 18, 38, 40, and 42 as obvious over Krause. Next, we consider the argument and reply with respect to claims 39 and 41.

Claims 39 and 41

"In the patentability context, claims are to be given their broadest reasonable interpretations. Moreover, limitations are not to be read into the claims from the specification." In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)). Here, in contrast to claims 18, 38, 40, and 42, claims 39 and 41 merely specify in pertinent part the following limitations: "an encoded signal ... encoded in a first or second mode, said first mode having been carried out by intra-frame predictive encoding and field-based orthogonal transformation and said second mode having been carried out inter-frame prediction encoding and frame-based orthogonal transformation" Giving the claims their broadest reasonable interpretations, the limitations require at least a first and second mode of encoding, wherein the first mode is implemented by an intra-frame prediction encoding technique and field-based orthogonal transformation and the second mode is implemented by an inter-frame prediction encoding technique and frame-based orthogonal transformation.

Krause would have suggested the limitations. The appellants admit, "Krause ... provide[s] four possible modes, two of which correspond to Appellants' two modes." (Reply Br. at 7.) More specifically, they make the following admission.

Krause's encoding operation may properly be described as providing four encoding modes: a "first mode" consisting of intra-frame prediction encoding and field-based orthogonal transformation (which, for the purpose of the present discussion, is assumed to be the same as Appellants' claimed "first mode"); a "second mode" consisting of inter-frame prediction encoding and frame-based orthogonal transformation (which, for the purpose of the present discussion, is assumed to be the same as Appellants' claimed "second mode"); a "third mode" consisting of intra-frame prediction encoding and frame-based orthogonal transformation; and a "fourth mode" consisting of inter-frame prediction encoding and field-based orthogonal transformation.

(Id. at 6.)

Because Krause teaches two modes that correspond to the appellants' two modes, we are persuaded that teachings from the applied prior art would appear to have suggested the limitations of "an encoded signal ... encoded in a first or second mode, said first mode having been carried out by intra-frame predictive encoding and field-based orthogonal transformation and said second mode having been carried out

inter-frame prediction encoding and frame-based orthogonal transformation" Therefore, we affirm the rejection of claims 39 and 41 as obvious over Krause.

CONCLUSION

To summarize, the rejection of claims 18, 38, 40, and 42 under 35 U.S.C. § 103(a) as obvious over Krause is reversed. The rejection of claims 39 and 41 under § 103(a) as obvious over Krause, however, is affirmed.

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

LEE E. BARRETT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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Administrative Patent Judge)

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