

# **EXHIBIT 1**

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(Also referred to as FORM PTO-1465)

**REQUEST FOR *INTER PARTES* REEXAMINATION TRANSMITTAL FORM**

Address to:

**Mail Stop *Inter Partes* Reexam  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450**Attorney Docket No.: 8157.019.655Date: December 18, 2009

1.  This is a request for *inter partes* reexamination pursuant to 37 CFR 1.913 of patent number 7,009,655 issued 03-07-2006. The request is made by a third party requester, identified herein below.
2.  a. The name and address of the person requesting reexamination is:  
Apple Inc.  
1 Infinite Loop  
Cupertino, CA 95014
- b. The real party in interest (37 CFR 1.915(b)(8)) is: Apple Inc.
3.  a. A check in the amount of \$ \_\_\_\_\_ is enclosed to cover the reexamination fee, 37 CFR 1.20(c)(2);
- b. The Director is hereby authorized to charge the fee as set forth in 37 CFR 1.20(c)(2) to Deposit Account No. \_\_\_\_\_ ; **or**
- c. Payment by credit card. Form PTO-2038 is attached.
4.  Any refund should be made by  check or  credit to Deposit Account No. 141437 37 CFR 1.26(c). If payment is made by credit card, refund must be to credit card account.
5.  A copy of the patent to be reexamined having a double column format on one side of a separate paper is enclosed. 37 CFR 1.915(b)(5)
6.  CD-ROM or CD-R in duplicate, Computer Program (Appendix) or large table  
 Landscape Table on CD
7.  Nucleotide and/or Amino Acid Sequence Submission  
*If applicable, items a. – c. are required.*
- a.  Computer Readable Form (CRF)
- b. Specification Sequence Listing on:
- i.  CD-ROM (2 copies) or CD-R (2 copies); **or**
- ii.  paper
- c.  Statements verifying identity of above copies
8.  A copy of any disclaimer, certificate of correction or reexamination certificate issued in the patent is included.
9.  Reexamination of claim(s) 1-18 is requested.
10.  A copy of every patent or printed publication relied upon is submitted herewith including a listing thereof on Form PTO/SB/08, PTO-1449, or equivalent.
11.  An English language translation of all necessary and pertinent non-English language patents and/or printed publications is included.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.915. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop *Inter Partes* Reexam, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

12.  The attached detailed request includes at least the following items:
- A statement identifying each substantial new question of patentability based on prior patents and printed publications. 37 CFR 1.915(b)(3)
  - An identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited art to every claim for which reexamination is requested. 37 CFR 1.915(b)(1) & (3).
13.  It is certified that the estoppel provisions of 37 CFR 1.907 do not prohibit this reexamination. 37 CFR 1.915(b)(7)
14.  a. It is certified that a copy of this request has been served in its entirety on the patent owner as provided in 37 CFR 1.33(c).  
The name and address of the party served and the date of service are:
- Kai-ching Chu
- MedioStream, Inc.
- Suite 201 4962 El Camino Real Los Altos CA 94022
- Date of Service: December 18, 2009; or
- b. A duplicate copy is enclosed because service on patent owner was not possible. An explanation of the efforts made to serve patent owner is **attached**. See MPEP 2620.

15. Third Party Requester Correspondence Address: Direct all communications about the reexamination to:

 The address associated with Customer Number:

37086

**OR** Firm or  
Individual Name \_\_\_\_\_

Address

City

State

Zip

Country

Telephone

Email

16.  The patent is currently the subject of the following concurrent proceeding(s):

- a. Copending reissue Application No. \_\_\_\_\_
- b. Copending reexamination Control No. \_\_\_\_\_
- c. Copending Interference No. \_\_\_\_\_
- d. Copending litigation styled:  
MedioStream, Inc. v. Acer American Corporation, Apple Comput  
Civil Action No. 2:07-CV-376 (CE) January 9, 2009.

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**/Tracy W. Druce/

Authorized Signature

12-18-2009

Date

Tracy W. Druce

Typed/Printed Name

35,493

Registration No., if applicable

## CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this *REQUEST FOR INTER PARTES REEXAMINATION OF U.S. PATENT 7,009,655*, together with all exhibits and attachments and supporting documentation, has been served via USPS priority mail on December 18, 2009, upon the following:

Kai-ching Chu  
MedioStream, Inc.  
4962 El Camino Real  
Suite 201  
Los Altos, CA 94022

/Johanna Weir/

Johanna Weir

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Inventors: HUANG, Qiang

Patent No.: 7,009,655

Filed: July 23, 2002

For: METHOD AND SYSTEM FOR DIRECT  
RECORDING OF VIDEO  
INFORMATION ONTO A DISK  
MEDIUM

REQUEST FOR INTER PARTES REEXAMINATION OF  
U.S. PATENT NO. 7,009,655 UNDER 35 U.S.C. §  
311 AND 37 C.F.R. §§ 1.913 AND 1.915

Mail Stop Inter Partes Reexamination  
ATTN: Central Reexamination Unit  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 25003-1450

**REQUEST FOR *INTER PARTES* REEXAMINATION  
OF U.S. PATENT NO. 7,009,655**

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### LIST OF EXHIBITS

The exhibits to the present Request are arranged in four groups: prior art (“PA”), relevant patent prosecution file history and patents (“PAT”), claim charts (“CC”), and other (“OTH”).

#### A. PRIOR ART (PA)

PA-SB08A USPTO Form SB/08A

PA-A Cleaner 5 User Manual

PA-B Cleaner MPEG Charger User Manual

PA-C Avid Xpress

- <http://web.archive.org/web/20000815061831/www.avid.com/products/pdf/xpress.pdf>

PA-D Avid Xpress DV consisting of:

- <http://web.archive.org/web/20010331173804/www.avid.com/products/avidxpressdv/index.html>
- <http://web.archive.org/web/20010410220406/www.avid.com/products/avidxpressdv/features.html>
- <http://web.archive.org/web/20010410224816/www.avid.com/products/avidxpressdv/specs.html>
- [http://web.archive.org/web/20010414031420/www.avid.com/products/avidxpressdv/press\\_quotes.html](http://web.archive.org/web/20010414031420/www.avid.com/products/avidxpressdv/press_quotes.html)

PA-E MPEG Standard

#### B. RELEVANT PATENT MATERIALS (PAT)

PAT-A U.S. Patent No. 7,009,655 (“the ‘655 patent”)

PAT-B File History for ‘655 patent

#### C. CLAIM CHARTS (CC)

CC-A Claim Chart for Cleaner 5

CC-B Claim Chart for Cleaner 5 in view of MPEG Charger



CC-C Claim Chart for Avid Xpress in view of Avid Xpress DV

**D. OTHER DOCUMENTS (OTH)**

OTH-A Fourth Amended Complaint filed in *MedioStream, Inc. v. Acer American Corporation, Apple Computer, Inc., Dell, Inc. and Gateway, Inc.*, Civil Action No. 2:07-CV-376 (CE), United States District Court for the Eastern District of Texas, January 9, 2009.

OTH-B Complaint filed in *MedioStream, Inc. v. Microsoft Corporation*, Civil Action No. 2:08-CV-369 (CE), United States District Court for the Eastern District of Texas, September 30, 2008.

OTH-C Avid Xpress DV 2.0, <http://web.archive.org/web/20010603091715/www.avid.com/products/avidxpressdv/>

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Inventors: HUANG, Qiang

Patent No.: 7,009,655

Filed: July 23, 2002

For: METHOD AND SYSTEM FOR DIRECT  
RECORDING OF VIDEO  
INFORMATION ONTO A DISK  
MEDIUM

REQUEST FOR INTER PARTES REEXAMINATION OF  
U.S. PATENT NO. 7,009,655 UNDER 35 U.S.C. §  
311 AND 37 C.F.R. §§ 1.913 AND 1.915

Mail Stop Inter Partes Reexamination  
ATTN: Central Reexamination Unit  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 25003-1450

**REQUEST FOR *INTER PARTES* REEXAMINATION  
OF U.S. PATENT NO. 7,009,655**

Dear Sir:

Pursuant to 35 U.S.C. §§ 311 et seq. and 37 C.F.R. §§ 1.902 et seq., Third Party Requester and Real Party in Interest, Apple Inc, (hereinafter "Requester") hereby requests inter partes reexamination of patented claims 1-18 of U.S. Patent No. 7,009,655, entitled "Method and System For Direct Recording of Video Information Onto a Disk Medium" (hereinafter "the '655 patent") filed July 23, 2002 and issued March 7, 2006 to Qiang Huang (Exhibit PAT-A). Reexamination is requested in view of the Substantial New Questions of Patentability ("SNQ") presented below. Requester reserves all rights and defenses available including, without limitation, defenses as to invalidity and unenforceability. By simply filing this Request in compliance with the Patent Rules, Requester does not represent, agree or concur that the '655 patent is enforceable, and by asserting the SNQs herein, Requester specifically asserts that original claims 1-18 of the

'655 patent are, in fact, not patentable; as such, the U.S. Patent and Trademark Office (the "Office") should reexamine and find all claims unpatentable and cancel claims 1-18 of the '655 patent, rendering them null, void and otherwise unenforceable.

Requester submits that this request not only raises SNQs with respect to claims 1-18 of the '655 patent but also sets forth a sufficient basis to reject and cancel each of the requested claims. Specifically, the cited prior art discloses a system for converting video information in an incoming format into an outgoing format, which is one of a plurality of formats using computer software and then writing the video information on a medium as is recited by the claims.

Notably, during the original prosecution the Examiner rejected and Applicant canceled original claim 1 which differs from the allowed claim 1 in that allowed claim 1 performs the method of the invention using software. Every other limitation of the claims was taught by U.S. Patent 6,370,198 to Washino, cited by the Examiner, and Applicant has never suggested otherwise. In view of the fact that the references cited herein not only teach the recited elements of the invention, but are additionally a software system, the current claims of the '655 patent should be found unpatentable and a certificate of reexamination to the same effect is requested.

Requester also notes that the '655 patent, for which reexamination is requested, was asserted in *Mediostream, Inc. v. Acer American Corporation, Apple Computer, Inc., Dell, Inc. and Gateway, Inc.*, Civil Action No. 2:07-CV-376 (CE), United States District Court for the Eastern District of Texas, originally filed on August 27, 2007 and last amended on January 9, 2009, and *Mediostream, Inc. v. Microsoft Corporation*, Civil Action No. 2:08-CV-369 (CE), United States District Court for the Eastern District of Texas, filed on September 30, 2008 ("the Pending Litigations"). The Pending Litigations are consolidated under Case Number 2:08-CV-369 (CE).

## **I. REQUIREMENTS FOR INTER PARTES REEXAMINATION UNDER 37 C.F.R. § 1.915**

Pursuant to 37 C.F.R. § 1.915, Requester satisfies each requirement for *inter partes* Reexamination of the '655 patent. The '655 patent issued from Application No.

10/202,999 filed on July 23, 2002. Because the '655 patent was filed after November 29, 1999 and issued from an "original filed application" in accordance with Manual of Patent Examining Procedure § 2611 (hereinafter, "MPEP"), the '655 patent qualifies for *inter partes* reexamination. See 37 C.F.R. § 1.913; MPEP § 2610.

**A. PAYMENT OF FEES**

Requester authorizes the Office to charge the credit card number submitted with the Request on form PTO-2038 for the \$8,800 filing fee for *inter partes* reexamination as set forth in 37 C.F.R. § 1.20(c) and 37 C.F.R. § 1.915(a). Any additional fees may be charged to Deposit Account No. 14-1437.

**B. IDENTIFICATION OF CLAIMS FOR REEXAMINATION;  
37 C.F.R. § 1.915(B)(1)**

Requester requests reexamination of claims 1-18 of United States Pat. No. 7,009,655.

**C. CITATION OF PRIOR ART PRESENTED; 37 C.F.R. § 1.915(B)(2)**

Form SB/08A presents the patents and printed publications upon which this Request is based. A complete copy of each listed patent and printed publication is included herewith. For reasons set forth in detail below, and in the accompanying claim charts, SNQs as to claims 1-18 are raised with respect to anticipation under 35 U.S.C. §§ 102 (a), (b) or (e), and with respect to obviousness under 35 U.S.C. § 103(a) in view of various combinations of prior art addressed in greater detail below. This request for reexamination is based on the patents and printed publications included in Exhibits PA-A through PA-E.

**D. STATEMENT OF EACH SUBSTANTIAL NEW QUESTION OF  
PATENTABILITY; 37 C.F.R. §1.915(B)(3)**

A statement of each substantial new question of patentability can be found *infra* and in accompanying claim charts at Exhibit CC-A through Exhibit CC-C. Each claim chart fully sets forth the SNQs sought against claims 1-18.

Requester has presented each prior art reference against claims 1-18, element by element, as a detailed example of how each reference renders claims 1-18 unpatentable, in compliance with relevant statutes, rules and procedures. In addition, Requester has submitted herewith claim charts at Exhibits CC-A through CC-C that show how each

piece of prior art renders each of the limitations of the issued and pending claims of the '655 patent unpatentable.

1. Claims 1-18 of the '655 patent are anticipated under 35 U.S.C. 102(b) by the Cleaner 5 User Manual.

Requestor respectfully submits that claims 1-18 of the '655 patent are anticipated by the Cleaner 5 User Manual ("Cleaner 5"). The reference was not discussed or applied either by the Examiner or the Applicant during the original prosecution and raises a substantial new question of patentability with respect to the claims of the '655 patent because it is not cumulative of any art previously of record and its teachings are such that a reasonable examiner would have considered Cleaner 5 pertinent to deciding the question of patentability of the requested claims. Specifically, Cleaner 5 discloses a software system for carrying out the steps of the claim. As the claims of the '655 patent were only deemed patentable because the Examiner was not aware of a software system for carrying out the steps of the invention, Cleaner 5 cannot be considered cumulative because it teaches this limitation. A claim chart setting forth the pertinency and manner of applying Cleaner 5 to these claims is submitted herewith as Exhibit CC-A.

2. Claims 5, 6 and 8 are rendered obvious under 35 U.S.C. § 103 by the Cleaner 5 User Manual in view of Cleaner MPEG Charger.

Requestor respectfully submits that claims 5, 6 and 8 of the '655 patent are rendered obvious by the Cleaner 5 User Manual ("Cleaner 5") in view of Cleaner MPEG Charger ("MPEG Charger"). Neither Cleaner 5 nor MPEG Charger was discussed or applied by the Examiner or the Applicant during the original prosecution and the combination raises a substantial new question of patentability with respect to the claims of the '655 patent because it is not cumulative of any art previously of record and its teachings are such that a reasonable examiner would have considered Cleaner 5 in view of MPEG Charger pertinent to deciding the question of patentability of the requested claims. In addition to the non-cumulative nature of Cleaner 5, this combination is further not cumulative in view of MPEG Charger's additional teachings related to enhanced MPEG output options. A claim chart setting forth the pertinency and manner of applying Cleaner 5 to these claims is submitted herewith as Exhibit CC-B.

3. Claims 1-3, 5, 7, 9, and 13-18 are rendered obvious under 35 U.S.C. § 103 by Avid Xpress in view of Avid Xpress DV.

Requestor respectfully submits that claims 1-3, 5, 7, 9, and 13-18 of the '655 patent are rendered obvious by Avid Xpress in view of Avid Xpress DV. Neither the Examiner nor the Applicant discussed or applied Avid Xpress in view of Avid Xpress DV during the original prosecution, and the combination raises a substantial new question of patentability with respect to the claims of the '655 patent because it is not cumulative of any art previously of record and its teachings are such that a reasonable examiner would have considered Avid Xpress in view of Avid Xpress DV pertinent to deciding the question of patentability of the requested claims. A claim chart setting forth the pertinency and manner of applying Avid Xpress in view of Avid Xpress DV to these claims is submitted herewith as Exhibit CC-C.

**E. COPIES OF PRIOR ART; 37 C.F.R. §1.915(B)(4)**

Copies of every patent and printed publication relied upon in this Request are attached as Exhibits PA-A through PA-E.

**F. COPY OF U.S. PATENT NO. 7,009,655; 37 C.F.R. § 1.915(B)(5)**

Attached as Exhibit PAT-A is a copy of the '655 patent. 37 C.F.R. § 1.915(b)(5); MPEP § 2614. A copy of the prosecution history of the '655 patent is attached at PAT-B.

**G. CERTIFICATION OF SERVICE; 37 C.F.R. § 1.915(B)(6)**

A copy of the Certificate of Service can be found at the conclusion of this request. Pursuant to 37 C.F.R. § 1.915(b)(6), this request is being served on the Patent Owner at:

KAI-CHING CHU  
MEDIOSTREAM, INC.  
SUITE 201  
4962 EL CAMINO REAL  
LOS ALTOS CA 94022

**H. CERTIFICATE THAT ESTOPPEL PROVISIONS DO NOT PROHIBIT INTER PARTES REEXAMINATION; 37 C.F.R. § 1.915(B)(7)**

Requester hereby certifies that it is not prohibited under the provisions of 35 U.S.C. § 317 or 37 C.F.R. § 1.907 from filing this Request for inter partes reexamination. Requester may request inter partes reexamination because neither it nor those in privity

with it have previously requested inter partes reexamination of the '655 patent. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 1.907; and, MPEP § 2612.

**I. STATEMENT IDENTIFYING REAL PARTY IN INTEREST;  
37 C.F.R. § 1.915(B)(8)**

Apple Inc. (“Requestor”) is the real party in interest and requests reexamination of the '655 patent in view of the SNQs presented below. Requester reserves all rights and defenses available including, without limitation, defenses as to invalidity and unenforceability. By filing this Request in compliance with the Patent Rules, Requester does not represent, agree or concur that the '655 patent is enforceable. Requester specifically asserts that all claims of the '655 patent are in fact not patentable and as such the Office should reexamine and find claims 1-18 unpatentable and cancel claims 1-18 of the '655 patent, rendering these claims of the '655 patent null, void, and otherwise unenforceable.

Further, pursuant to the policy of the Office concerning revised reexamination procedures to provide for a scheduling-type order of expected substantive action dates in Requests ordered after the Office’s 2005 fiscal year, Requester respectfully seeks such a scheduling order upon the granting of this Request.

**II. CONCURRENT LITIGATION**

The '655 patent is presently the subject of two pending litigations. In *Mediostream, Inc. v. Acer American Corporation, Apple Computer, Inc., Dell, Inc. and Gateway, Inc.*, Civil Action No. 2:07-CV-376 (CE), United States District Court for the Eastern District of Texas, August 28, 2007, Patent Owner alleges that the Requester and several other parties infringe claims of the '655 patent. (*see* OTH-A Forth Amended Complaint filed January 9, 2009 at ¶ 37.)

Additionally, Patent Owner also alleges infringement of the '655 patent by Microsoft, Inc. in the litigation captioned: *Mediostream, Inc. v. Microsoft Corporation*, Civil Action No. 2:08-CV-369 (CE), United States District Court for the Eastern District of Texas, September 30, 2008. (*see* Complaint at OTH-B.) These two cases have been consolidated under the latter case before Magistrate Judge Charles Everingham.

Accordingly, Requester respectfully argues that this Request be granted and reexamination conducted not only with “special dispatch,” but also with “priority over all other cases” due to the ongoing nature of the underlying litigation. *See* 35 U.S.C. § 314, MPEP § 2661.

### III. SUMMARY OF THE ‘655 PATENT AND THE PROSECUTION HISTORY

#### J. SUMMARY OF THE ‘655 PATENT

The ‘655 patent issued from Application No. 10/202,999 filed on July 23, 2002 (hereinafter the ‘999 application).

The ‘655 patent is directed to a system for performing steps directed by computer software code for converting video from an incoming format to an outgoing format, and then writing the video onto a disk (e.g., CD or DVD). ‘655 at Col. 2, lines 52-56. The system receives video from a video source, and output parameters such as output format and desired TV standard information. ‘655 at Abstract. The video is decoded to an uncompressed format and resized according to the output parameters. ‘655 at Col. 6, lines 39-41 and 51-54. The uncompressed format is further adjusted to a frame rate associated with the TV standard and then encoded into an elementary video stream. ‘655 at Col. 6, lines 54-56. Lastly, the elementary video stream is multiplexed with audio to produce a presentation format. ‘655 at Col. 6, lines 63-66. Fig. 2, below, illustrates the above-described steps.

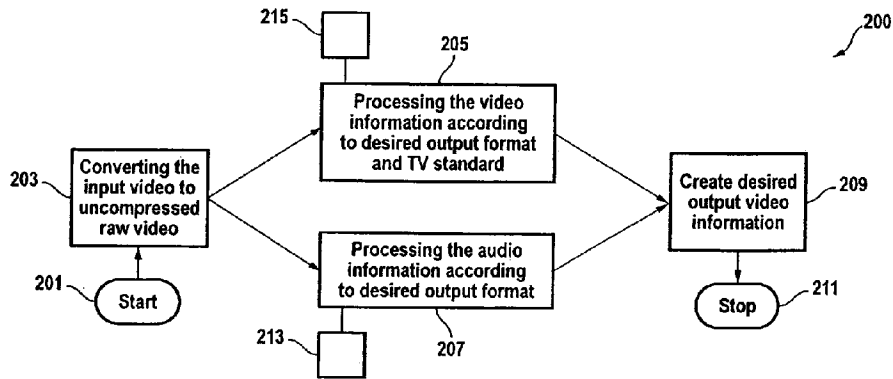


FIG. 2

FIGURE 2 OF THE ‘655 PATENT



**K. THE '999 APPLICATION**

In the first and only Office Action, the Examiner rejected claims 1-15 and 20 but allowed claims 16-19. PAT-B, Office Action mailed March 22, 2005.

The Examiner deemed claims 16-19 allowable because the prior art failed to disclose a system that uses computer software to convert video from an incoming format to an outgoing format. PAT-B, Office Action mailed March 22, 2005, p. 5 (emphasis added). Claims 1-15 and 20 recited a similar system, but did not require that the system perform the steps using computer code as in claims 16-19. See, for example, a comparison of rejected and canceled claim 1 with allowed claim 16:

Original Claim 1 (canceled) <sup>1</sup>	Original Claim 16 (now claim 1)
1. A <u>method</u> for converting video information from an incoming format to an outgoing format using a <u>continuous pass conversion process free from one or more intermediary files</u> , the method comprising:	16. A <u>system</u> for converting video information from an incoming format to an outgoing format using <u>an integrated computer software application, the integrated computer software application being provided on one or more memories, the one or more memories including:</u>
<u>inputting</u> video information in a first format;	a) <u>a code directed to receiving</u> video information in a first format;
	b) <u>a code directed to receiving</u> a desired output media format based upon a first input;
	c) <u>a code directed to receiving</u> a desired TV standard based upon a second input;
<u>directly</u> converting the video information in the first format to raw video information in an uncompressed format;	d) <u>a code directed to</u> converting the video information in the first format to raw video information [in] an uncompressed format <u>using a decoding process</u> ;
<u>inputting</u> a desired output media format based upon a first input;	

---

<sup>1</sup> Underlining is provided to highlight differences between the language of the claims; spacing is provided to align the claim language and emphasize the similarities between the claims. Two of the claim elements are in a different locations in the claims, but the language otherwise corresponds.

<u>inputting</u> a desired TV standard based upon a second input;	
<u>directly</u> resizing the raw video information in the uncompressed format into a size associated with the desired output media format and the desired TV standard;	e) <u>a code directed to</u> resizing the raw video information in the uncompressed format into a size associated with the desired output media format and the desired TV standard;
<u>directly</u> adjusting the uncompressed format in the size associated with the desired output media format and the desired TV standard to a frame rate associated with the desired TV standard;	f) <u>a code directed to</u> adjusting the uncompressed format in the size associated with the desired output media format and the desired TV standard to a frame rate associated with the desired TV standard;
<u>directly</u> processing the uncompressed format in the size and the frame rate into an elementary video stream; and	g) <u>a code directed to</u> processing the uncompressed format in the size and the frame rate into an elementary video stream; and
<u>directly</u> processing the elementary video stream with audio information in the desired output media format and the desired TV standard to form video and audio information in a presentation format based upon the desired output media format and the desired TV standard.	h) <u>a code directed to</u> processing the elementary video stream with audio information in the desired output media format and the desired TV standard to form video and audio information in a presentation format based upon the desired output media format and the desired TV standard.

As the table above plainly shows, the only potentially patentable distinction between allowed claim 16 and rejected claim 1 is that claim 16 requires software to perform the steps of the method.

Claims 1-15 and 20 were rejected under 35 U.S.C § 102 by U.S. Patent 6,370,198 to Washino, which discloses the recited method, but apparently did not recite software for accomplishing the method. PAT-B, Office Action mailed March 22, 2005, pp. 3-4.

Additionally, the Examiner rejected claims 13 and 14 under 35 U.S.C. § 112 as being indefinite for reciting editing information based upon an unclear fourth and an unclear fifth input; thus, rendering the claims indefinite. PAT-B, Office Action mailed March 22, 2005, p. 2.

In response to the Office Action, Applicant canceled claims 1 and 20 and amended claims 2-15 to be dependent upon claim 16, which had been allowed. PAT-B, Amendment dated August 18, 2005, p. 5. Thus, all other dependent claims were similarly allowable, and the Examiner promptly issued a notice indicating the same. PAT-B, Notice of Allowance mailed September 12, 2005.

#### L. CLAIM CONSTRUCTION

Requester notes that for purposes of this Request, the claim terms are presented by the Requester in accordance with 37 C.F.R § 1.555(b) and MPEP § 2111. Specifically, each term of the claims is to be given its “broadest reasonable construction” consistent with the specification. MPEP § 2111; *In re Trans Texas Holding Corp.*, No. 2006-1599, -1600, p.14 (Fed. Cir. August 22, 2007) (citing *In re Yamamoto*, 670 F.2d 1569, 1571 (Fed. Cir. 1984)). As the Federal Circuit noted in *Trans Texas*, the Office has traditionally applied this standard during reexamination and does not interpret claims as a court would interpret claims. MPEP § 2111. The Office is not bound by any prior district court claim construction. *Trans Texas*, No.2006-1599 at 14, 19. Rather:

the PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.

*In re Morris*, 127 F.3d 1048, 1054-55, 44 U.S.P.Q.2d 1023, 1027-28 (Fed. Cir. 1997). The rationale underlying the “broadest reasonable construction” standard is that it reduces the possibility that a claim, after issue or certificate of reexamination, will be interpreted more broadly than is justified. 37 C.F.R § 1.555(b), MPEP § 2111.

Because the standards of claim interpretation used in the courts in patent litigation are different from the claim interpretation standards used in the Office in claim examination proceedings (including reexamination), any claim interpretations submitted herein for the purpose of demonstrating an SNQ are neither binding upon litigants in any litigation related to the ‘655 patent, nor do such claim interpretations correspond to the construction of claims under the legal standards that are mandated to be used by the Courts in litigation. *See* 35 U.S.C. § 314; *see also* MPEP § 2286 II (determination of an SNQ is

made independently of a court's decision on validity because of different standards of proof and claim interpretation employed by the District Courts and the Office); *see also In re Trans Texas Holding Corp.*, No. 2006-1599, -1600, p.14 (Fed. Cir. August 22, 2007); *In re Zletz*, 893 F.2d 319, 322, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

The interpretation and/or construction of the claims in the '655 patent presented either implicitly or explicitly herein should not be viewed as constituting, in whole or in part, Requester's own interpretation and/or construction of such claims. In fact, Requester expressly reserves the right to present its own interpretation of such claims at a later time, which interpretation may differ, in whole or in part, from that presented herein.

#### **IV. STATEMENT UNDER 37 C.F.R. § 1.915(B) OF EACH SUBSTANTIAL NEW QUESTION OF PATENTABILITY**

This Request is based on the cited prior art documents listed above and on the accompanying Form PTO-SB/08A. Exhibit PA-SB/08A. All of these cited prior art publications constitute effective prior art as to the claims of the '655 patent under 35 U.S.C. § 102.

##### **A. CLAIMS 1-18 ARE ANTICIPATED BY THE CLEANER 5 USER MANUAL ("CLEANER 5") UNDER 35 U.S.C. 102(B)**

##### **SUMMARY OF CLEANER 5**

Cleaner 5 was published at least one year before the filing date of the '655 patent and accordingly is prior art under 35 U.S.C. § 102(b). *See* Cleaner 5 copyright page (copyright 1995-2000).

Just as in the '655 patent, Cleaner 5 is a software application stored in a memory for converting incoming digital video (DV) to an outgoing MPEG-1 or MPEG-2 stream. Cleaner 5 at p. 141, 206. Cleaner 5 operates to receive a video file and output the video file in a converted format based on a variety of user supplied characteristics such as media format information, television standard information, aspect ratio, frame rate and frequency. Cleaner 5 at pp. 5, 8, 204, 205, 207, 209, and 212. Incoming video files are first converted into an uncompressed raw video format, such as YUV. Cleaner 5 at p. 138. Additional processing is used to resize the video to the desired output media format,

frame rate, aspect ratio, frequency, and television standard. Cleaner 5 at pp. 5, 8, 204, 205, 207, 209, and 212. The output file can further be stored on a disc such as Video CD or DVD. Cleaner 5 at pp. 206, 209. Importantly, Cleaner 5 performs these functions entirely using software run from a disc.

Requestor respectfully submits that the Cleaner 5 User Manual (“Cleaner 5”) anticipates claims 1-18 of the ‘655 patent. Neither the Examiner nor the Applicant applied or discussed the reference during the original prosecution. The reference raises a substantial new question of patentability with respect to the claims of the ‘655 because it is not cumulative of any art previously of record and its teachings are such that a reasonable examiner would have considered Cleaner 5 pertinent to deciding the question of patentability of the requested claims. A claim chart setting forth the pertinency and manner of applying Cleaner 5 to these claims is submitted herewith as Exhibit CC-A.

**1. A system for converting video information from an incoming format to an outgoing format using an integrated computer software application, the integrated computer software application being provided on one or more memories, the one or more memories including:**

Cleaner 5 discloses a system for converting incoming DV to an outgoing MPEG-1 or MPEG-2 stream. Cleaner 5 at pp. 141, 206. Additionally, Cleaner 5 is an integrated computer software application, which “offers a complete camera-to-web solution that makes it easy to put video and audio on a [user’s] site.” Cleaner 5 at p. 141. Additionally, Cleaner 5 is an application that is run on a computer running Windows or Mac OS, which includes one or more memories. Cleaner 5 at p. 2. Since programs running in a Windows or Mac OS environment are always run from one or more memories, Cleaner 5 too, is provided on one or more of those memories. Cleaner 5 at p. 141.

**a) a code directed to receiving video information in a first format;**

Cleaner 5 discloses a capture code directed to receiving source material in DV format (i.e., video information in a first format) from a DV camera. Cleaner 5 at pp. 5, 8.

**b) a code directed to receiving a desired output media format based upon a first input;**

Cleaner 5 discloses allowing a user to select a different output media format based upon a first input. For example, the user “can easily produce MPEG-1 files for Video CD

projects by selecting the Video CD preset in the Advanced Settings window.” Cleaner 5 at p. 209.

**c) a code directed to receiving a desired TV standard based upon a second input;**

Cleaner 5 discloses that a user may choose between NTSC or PAL (i.e., desired TV standard) based upon the preset (i.e., second input) the user selects. Cleaner 5 at pp. 204, 205.

**d) a code directed to converting the video information in the first format to raw video information [in] an uncompressed format using a decoding process;**

Cleaner 5 decodes and converts the DV stream format video information to an uncompressed raw video format, such as YUV. Cleaner 5 at p. 138.

**e) a code directed to resizing the raw video information in the uncompressed format into a size associated with the desired output media format and the desired TV standard;**

Cleaner 5 discloses converting the uncompressed raw video information to the selected image size through a resizing operation. Cleaner 5 at p. 204. In Cleaner 5, 720 x 480 pixels is the image size associated with an MPEG 2 output media format in an NTSC TV standard. Cleaner 5 at p. 204. Additionally, 720 x 576 pixels is the image size associated with an MPEG 2 output media format in a PAL TV standard. Cleaner 5 at p. 204.

**f) a code directed to adjusting the uncompressed format in the size associated with the desired output media format and the desired TV standard to a frame rate associated with the desired TV standard;**

Cleaner 5 discloses a frame rate of 29.97 frames per second is associated with MPEG 1 and MPEG 2 output media formats for the NTSC TV standard and a frame rate of 25 frames per second is associated with MPEG 1 and MPEG 2 output media formats for the PAL TV standard. Cleaner 5 at p. 207.

**g) a code directed to processing the uncompressed format in the size and the frame rate into an elementary video stream; and**

Cleaner 5 discloses that a user can select to process the video into an elementary video stream when outputting MPEG 1 and MPEG 2 files. Cleaner 5 at p. 206.

**h) a code directed to processing the elementary video stream with audio information in the desired output media format and the desired TV standard to form video and**

**audio information in a presentation format based upon the desired output media format and the desired TV standard.**

Cleaner 5 discloses that when an MPEG 1 system stream is selected, the elementary video stream is processed or multiplexed with the audio stream to form a single multiplexed stream of audio and video information in the desired NTSC or PAL TV standard based on the desired MPEG 1 output media format. Cleaner 5 at p. 7, 206.

**2. The system of claim 1 wherein the first format is selected from a group consisting of: a digital file, a digital captured video stream, an analog captured video stream, and an internet video stream.**

Cleaner 5 discloses the limitations of claim 1 as explained above.

Cleaner 5 discloses reading an input format (i.e., first format) in a number of formats, including digital video (DV), AVI files, MPEG1 and MPEG2. Cleaner 5 at p. 141.

**3. The system of claim 2 wherein the digital file is selected from a group consisting of: an AVI format an MPEG format, a DV format, a QuickTime format, Real Video format, Windows Media Player format.**

Cleaner 5 discloses the limitations of claim 2 as explained above.

Cleaner 5 discloses selecting from an AVI format, an MPEG format, a DV format, a QuickTime format, and other multimedia formats. Cleaner 5 at p. 141.

**4. The system of claim 1 wherein the uncompressed format is selected from a group consisting of: RGB, and YUV.**

Cleaner 5 discloses the limitations of claim 1 as explained above.

Cleaner 5 decodes and converts the DV stream format video information to an uncompressed format, such as YUV. Cleaner 5 at p. 138.

**5. The system of claim 1 wherein the desired output media format is selected from a group consisting of: DVD, VCD, and Super VCD.**

Cleaner 5 discloses the limitations of claim 1 as explained above.

Cleaner 5 discloses that a user may output media in VCD format. Cleaner 5 at p. 209. Specifically, Cleaner 5 states that a user can select the “Video CD preset in the Advanced Settings window” in Cleaner to “easily produce MPEG-1 files for Video CD projects.” Cleaner 5 at p. 209.

**6. The system of claim 5 further comprising a code directed to inputting a quality setting based upon a third input when the desired output media format is DVD.**

Cleaner 5 discloses the limitations of claim 5 as explained above.

Cleaner 5 discloses that a user may select a third input for specifying quality settings based on a variety of parameters. Cleaner 5 at p. 59. For example, Cleaner 5 discloses quality settings such as data rate, and frame rate. Cleaner 5 at pp. 59, 62, 64-65. Furthermore, Cleaner 5 discloses that when the output format is DVD, a data rate acceptable to DVD formats are required and Cleaner 5 uses a data rate of 5.7 Mbits/sec which is used by Cleaner's default MPEG-2 setting. Cleaner 5 at p. 62.

**7. The system of claim 1 further comprising writing the video and audio information in the presentation format onto a disk media.**

Cleaner 5 discloses the limitations of claim 1 as explained above.

Cleaner 5 discloses writing the video and audio information in the presentation format onto a disk media such as CD-ROM or DVD-ROM. Cleaner 5 at p. 144.

**8. The system of claim 1 wherein the presentation format is selected from a group consisting of: VOB(Video Object for DVD), VCD MPEG1, and SuperVCD MPEG2.**

Cleaner 5 discloses the limitations of claim 1 as explained above.

Cleaner 5 discloses writing the video and audio information in the presentation format onto a disk media. For example an MPEG 1 system stream for VCD. Cleaner 5 at p. 206. Specifically, Cleaner 5 allows the user to "choose between creating MPEG-1 or MPEG-2 streams" when MPEG 1 is used for VCD output. Cleaner 5 at p. 206, 209.

**9. The system of claim 1 wherein the code directed to processing of the elementary video stream with audio information comprises a code directed to perform a multiplexing process.**

Cleaner 5 discloses the limitations of claim 1 as explained above.

Cleaner 5 discloses a code directed to processing an elementary video stream with audio information, for example, Cleaner 5 lets the "[user] select between System or Elementary streams for MPEG-1 files and Program or Elementary streams for MPEG-2." Cleaner 5 at p. 206. Additionally, the user will "output to System (MPEG-1) or Program (MPEG-2) streams, in which both the video and audio are muxed (multiplexed) into a single file." Cleaner 5 at p. 206.



**10. The system of claim 1 wherein the audio information is tuned to a desired frequency based upon the desired output media format.**

Cleaner 5 discloses the limitations of claim 1 as explained above.

Cleaner 5 discloses audio information is tuned to a desired frequency based upon the desired output media format. Cleaner 5 at p. 212. In Cleaner 5, a user may use MP3 audio files and “the MP3 default sample rate is 44.1 kHz, which is also the sample rate of audio CDs.” Cleaner 5 at p. 212.

**11. The system of claim 10 wherein the desired frequency is selected from a group consisting of: 48 kHz for DVD, 44.1 kHz for VCD and SVCD.**

Cleaner 5 discloses the limitations of claim 10 as explained above.

Cleaner 5 discloses various desired frequencies including 44.1 kHz for use with VCD. Cleaner 5 at pp. 212-213, 209.

**12. The system of claim 1 wherein the codes directed to converting, resizing, and adjusting, and processing are codes directed to be performed free from one or more intermediary files.**

Cleaner 5 discloses the limitations of claim 1 as explained above.

Cleaner 5 discloses direct converting, direct adjusting and directly processing are performed free from one or more intermediary files. Cleaner 5 at p. 206. Specifically, the user will “output to System (MPEG-1) or Program (MPEG-2) streams, in which both the video and audio are muxed (multiplexed) into a single file.” Cleaner 5 at p. 206.

**13. The system of claim 1 further comprising a code directed to processing the raw video information based upon video editing information based upon user input.**

Cleaner 5 discloses the limitations of claim 1 as explained above.

Cleaner 5 is directed at processing raw video information based upon video editing information from a user. For example, Cleaner 5 is a software application for cropping or trimming video based on In/Out points selected by the user. Cleaner 5 at p. 25. Moreover, cropping allows the user to specify the part of the image they want to keep and trimming allows the user to set in and out points, designating the points to start and end. Cleaner 5 at p. 25.

**14. The system of claim 1 further comprising a code directed to processing the audio information based upon audio editing information based upon user input.**

Cleaner 5 discloses the limitations of claim 1 as explained above.

Cleaner 5 can be directed to processing audio information based upon Noise Removal (i.e., audio editing information) after the user selects the clean-up filter. Cleaner 5 at p. 95. Specifically, “Cleaner offers professional-quality resampling, as well as a range of clean-up filters, such as Noise Removal, Noise Gate and High/Low Pass, to optimize your audio.” Cleaner 5 at p. 95.

**15. The system of claim 1 wherein the code directed to processing into the elementary video stream is provided in code directed to an encoding process and the code directed to converting into the raw video information is provided in code directed to a decoding process.**

Cleaner 5 discloses the limitations of claim 1 as explained above.

Cleaner 5 is directed to converting raw video information to the elementary video stream is performed through encoding. Cleaner 5 at p. 206. Additionally, Cleaner 5 discloses converting to YUV raw video information is performed through decoding. Cleaner at p. 138. Specifically, “Cleaner 5 decodes files significantly faster by using a combination of native YUV processing and Digital Origin’s DV codec. Cleaner also offers several decoding options through the Preferences dialog that allow you to choose between higher quality or faster decoding.” Cleaner 5 at p. 138.

**16. The system of claim 1 further comprising a code directed to receiving video editing information based upon a third input.**

Cleaner 5 discloses the limitations of claim 1 as explained above.

Cleaner 5 discloses that a user may select a third input for specifying quality settings based on a variety of parameters. Cleaner 5 at p. 59. For example, Cleaner 5 discloses quality settings for video editing such as data rate, and frame rate. Cleaner 5 at pp. 59, 62, 64-65.

**17. The system of claim 16 further comprising a code directed to receiving audio editing information based upon a fourth input.**

Cleaner 5 discloses the limitations of claim 16 as explained above.

Cleaner 5 discloses receiving audio information that can be edited using a number of different filters (i.e., fourth input). Cleaner 5 at p. 95. For example, these filters include noise removal filters, noise gate filters, high/low pass filters, dynamic range compression filters and reverb filters. Cleaner 5 at p. 95.

**18. The system of claim 16 wherein the integrated computer software application is a single integrated application.**

Cleaner 5 discloses the limitations of claim 16 as explained above.

Cleaner 5 is a single integrated computer software application which “offers a complete camera-to-web solution that makes it easy to put video and audio on your site.” Cleaner 5 at p. 1.

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In view of the analysis presented above, Requester submits that Cleaner 5 not only presents a substantial new question of patentability with respect to the requested claims, but also anticipates each of the requested claims. Therefore, the claims of the ‘655 patent should be found null, void, unenforceable and otherwise unpatentable and a Certificate of Reexamination should issue with the same effect.

**B. CLAIMS 5, 6 AND 8 ARE RENDERED OBVIOUS BY THE CLEANER 5 USER MANUAL (“CLEANER 5”) IN VIEW OF CLEANER MPEG CHARGER (“MPEG CHARGER”) UNDER 35 U.S.C. 103(A)**

**SUMMARY OF MPEG CHARGER**

MPEG Charger was published at least one year before the filing date of the ‘655 patent and accordingly is prior art under 35 U.S.C. § 102(b). *See* MPEG Charger copyright page (copyright 1995-2001).

Just as in the ‘655 patent, MPEG Charger is a software application for converting a video file into a MPEG video file based on certain parameters. MPEG Charger at pp. 9, 14. MPEG Charger is explicitly configured to work with Cleaner 5 in the process of converting video files for recording onto a disc. *See generally* MPEG Charger. Specifically, MPEG Charger can produce MPEG-1 files for Video CD projects and MPEG-2 files for “producing high-data rate, full broadcast-quality files that require

DVD, fast CD-ROM or hard drives for playback.” MPEG Charger at p. 10. Importantly, MPEG Charger performs the method entirely using software run from a disc.

Requestor respectfully submits that claims 5, 6 and 8 of the ‘655 patent are rendered obvious by the Cleaner 5 User Manual (“Cleaner 5”) in view of Cleaner MPEG Charger (“MPEG Charger”). Neither the Examiner nor the Applicant discussed or applied either Cleaner 5 or MPEG Charger during the original prosecution. The combination of Cleaner 5 and MPEG Charger raises a substantial new question of patentability with respect to the claims of the ‘655 patent because it is not cumulative of any art previously of record and its teachings are such that a reasonable examiner would have considered Cleaner 5 in view of MPEG Charger pertinent to deciding the question of patentability of the requested claims. A claim chart setting forth the pertinency and manner of applying Cleaner 5 to these claims is submitted herewith as Exhibit CC-B.

Each of claims 5, 6 and 8 ultimately depend from claim 1. Cleaner 5 discloses the elements of claim 1 as demonstrated above. Additionally, MPEG Charger also discloses many of the limitations of claim 1. MPEG Charger is a software application for explicit use with Cleaner 5 and provides additional functionality in MPEG-1 and MPEG-2 encoding. MPEG Charger at p. 9. Additionally, MPEG Charger explicitly discloses the ability to “turn all popular video, audio and animation file formats into MPEG streams for DVD, Video CD, CD-ROM, digital broadcasting and broadband webcasting.” MPEG Charger at p. 9.

**5. The system of claim 1 wherein the desired output media format is selected from a group consisting of: DVD, VCD, and Super VCD.**

Cleaner 5 discloses the limitations of claim 1 as explained above.

Cleaner 5 discloses that a user may output media in VCD format. Cleaner 5 at p. 209. Specifically, Cleaner 5 states that a user can select the “Video CD preset in the Advanced Settings window” in Cleaner to “easily produce MPEG-1 files for Video CD projects.” Cleaner 5 at p. 209.

Additionally, MPEG Charger discloses DVD output media formats. MPEG Charger at p. 9.

**6. The system of claim 5 further comprising a code directed to inputting a quality setting based upon a third input when the desired output media format is DVD.**

Cleaner 5 in view of MPEG Charger discloses the limitations of claim 5 as explained above.

Cleaner 5 discloses that a user may select a third input for specifying quality settings based on a variety of parameters. Cleaner 5 at p. 59. For example, Cleaner 5 discloses quality settings such as data rate, and frame rate. Cleaner 5 at pp. 59, 62, 64-65. Furthermore, Cleaner 5 discloses that when the output format is DVD a data rate acceptable to DVD formats are required and Cleaner 5 uses a data rate of 5.7 Mbits/sec and is used by Cleaner's default MPEG-2 setting. Cleaner 5 at p. 62. Moreover, MPEG Charger discloses that the user is allowed "to turn all popular video, audio and animation file formats into MPEG streams for DVD, Video CD, CD-ROM, digital broadcasting and broadband webcasting." MPEG Charger at p. 9. Thus, the user may input a higher data rate to create an MPEG stream suitable for a DVD.

**8. The system of claim 1 wherein the presentation format is selected from a group consisting of: VOB(Video Object for DVD), VCD MPEG1, and SuperVCD MPEG2.**

Cleaner 5 discloses the limitations of claim 1 as explained above.

Cleaner 5 discloses writing the video and audio information in the presentation format such as an MPEG 1 system stream for VCD. Cleaner 5 at p. 206. Specifically, Cleaner 5 allows the user to "choose between creating MPEG-1 or MPEG-2 streams" for VCD output. Cleaner 5 at p. 206, 209. Furthermore, MPEG Charger discloses that the user is allowed "to turn all popular video, audio and animation file formats into MPEG streams for DVD, Video CD, CD-ROM, digital broadcasting and broadband webcasting." MPEG Charger at p. 9.

### **REASONS TO COMBINE**

A person of ordinary skill in the art would have been motivated to combine Cleaner 5 with MPEG Charger in view of the explicit motivation found within the MPEG Charger Reference: "MPEG Charger is a software-only MPEG option for Cleaner 5 that gives you comprehensive control over both MPEG-1 and MPEG-2 encoding," and reference within Cleaner 5: "Cleaner MPEG Charger integrates seamlessly with

Cleaner.” MPEG Charger at p. 9; Cleaner 5 at p. 209. The hypothetical person of ordinary skill in the art would have been aware of both of these references since they were publically available before the filing date of the ‘655 patent and would have known to combine the teachings of the two references in view of the explicit instruction within each of these references to do so. Accordingly, the references are properly combinable.

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In view of the analysis presented above, Requester submits that Cleaner 5 in view of MPEG Charger not only presents a substantial new question of patentability with respect to the requested claims, but also renders obvious each of the requested claims. Therefore, the claims of the ‘655 patent should be found null, void, unenforceable and otherwise unpatentable and a Certificate of Reexamination should issue with the same effect.

**C. CLAIMS 1-3, 5, 7, 9, AND 13-18 ARE RENDERED OBVIOUS BY AVID XPRESS IN VIEW OF AVID XPRESS DV UNDER 35 U.S.C. 103(A)**

**SUMMARY OF AVID XPRESS**

AVID Xpress was published at least one year before the filing date of the ‘655 patent and accordingly is prior art under 35 U.S.C. § 102(b). *See* Avid Xpress p. 4 (copyright 2000).

Avid Xpress is an advertising document promoting a software application for converting and editing video and audio files based on user input parameters. Avid Xpress at p. 1. The Avid Xpress system can receive video in many different input formats including popular animation file formats on Windows, Macintosh and SGI, including QuickTime formats. Avid Xpress at pp. 1, 3. The Avid Xpress software is designed to accept these file types (and more) for editing and output. Among Avid Xpress’ output features are the ability to output to files into NTSC and PAL TV formats and further outputting video in compliance with the ITU R-601 standard for broadcast television. Avid Xpress at p. 3.

## SUMMARY OF AVID XPRESS DV

Avid Xpress DV was publically available at least one year earlier than the filing date of the '655 patent as evidenced by the retrieval of this document from the "Way Back Machine" indexed at [www.archive.org](http://www.archive.org). Archive.org catalogues archived versions of websites and presents them on [www.archive.org](http://www.archive.org) for visitors to browse as those sites existed on the date "crawled." The crawled date is included within the URL of each page. The crawled date of this reference, which includes several different linked web pages<sup>2</sup> is no later than April 14, 2001, and therefore this reference qualifies as prior art under 35 U.S.C. 102(b).

Further, the Way Back Machine is a proper source for dating a reference. *See* [www.uspto.gov/web/menu/pbmethod/aiplafall02paper.htm](http://www.uspto.gov/web/menu/pbmethod/aiplafall02paper.htm); (paper authored by Wynn W. Coggins, Group Director of Technology Center 3600, supporting the use of the Way Back Machine by Examiners for dating references). *See also* [www.uspto.gov/web/menu/pbmethod/partnership.pps](http://www.uspto.gov/web/menu/pbmethod/partnership.pps) (slide show authored by Wynn W. Coggins, Group Director of Technology Center 3600, supporting the use of the Way Back Machine by Examiners for dating references).

Avid Xpress DV discloses a software system that is related to Avid Xpress, which includes additional capabilities such as supporting MPEG output formats and writing outputs to DVD. Avid Xpress DV at 1. By supporting MPEG outputs Avid Xpress DV inherently includes the teachings of the MPEG standard, which require elementary video streams and multiplexing audio and video into one output file. MPEG Standard at p. x. Furthermore, the MPEG standard inherently includes code to change the frame rate in the output file based on the desired television format standard. MPEG Standard at p. 121.

When combined, Avid Xpress and Avid Xpress DV teach each and every element of the claims of the '655 patent as discussed below. A detailed application of these references can be found below and at Exhibit CC-C.

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<sup>2</sup> Avid Xpress DV: Overview page, dated March 31, 2001; Avid Xpress DV: Features page, dated April 10, 2001; Avid Xpress DV: Specifications page: dated April 10, 2001; Avid Xpress DV: Press Quotes page: dated April 14, 2001.

**1. A system for converting video information from an incoming format to an outgoing format using an integrated computer software application, the integrated computer software application being provided on one or more memories, the one or more memories including:**

The Avid Xpress system is a software system for converting and editing video and multimedia content quickly. Avid Xpress at p. 1. Additionally, Avid Xpress DV is a software product that is related to Avid Xpress that has a variety of exporting options including MPEG output abilities. Avid Xpress DV Features at p. 1.

**a) a code directed to receiving video information in a first format;**

Avid Xpress is a software application having code to receive video in many different formats including popular animation files on Windows, Macintosh and SGI, and QuickTime formats. Avid Xpress at pp. 1, 3. Additionally, Avid Xpress supports the ITU R-601 standard for converting video into broadcast digital formats. Avid Xpress at p. 1. Furthermore, Avid Xpress DV, which is a related application to Avid Xpress, also receives RealMedia, Windows Media/ASF, IWMV, AVI and OMF/JFIF files input formats. Avid Xpress DV at p. 1 and FEATURES, p. 1

**b) a code directed to receiving a desired output media format based upon a first input;**

Avid Xpress is a software application having code directed to receiving a desired output media format including popular animation files on Windows, Macintosh and SGI, and QuickTime format. Avid Xpress at pp. 1, 3. Further, Avid Xpress supports the ITU R-601 standard for converting video into broadcast digital formats. Avid Xpress at p. 1. Therefore, Avid Express has code to output video in a compliant ITU-R601 format. Furthermore, Avid Xpress DV also supports output formats such as MPEG-1, MPEG-2 and OMF/JFIF formats. Avid Xpress DV at FEATURES, p. 1.

**c) a code directed to receiving a desired TV standard based upon a second input;**

Avid Xpress software utilizes the ITU R-601 standard for outputting broadcast quality outputs in both the NTSC and PAL TV standards. Avid Xpress at p. 3.

**d) a code directed to converting the video information in the first format to raw video information [in] an uncompressed format using a decoding process;**

The Avid Xpress software includes code for converting video information into uncompressed video using its uncompressed video option. Avid Xpress at pp. 1-2.



Furthermore, since the Avid Xpress system receives compressed, encoded formats and outputs uncompressed formats it inherently uses a decoding process.

**e) a code directed to resizing the raw video information in the uncompressed format into a size associated with the desired output media format and the desired TV standard;**

The Avid Xpress software system includes code directed to resizing input video information in a size associated with the desired output media format and TV standard (720 x 486 NTSC; 720 x 576 PAL). Avid Xpress at p. 3. Furthermore, the Avid Xpress software system can output projects as uncompressed video for the best possible image quality. Avid Xpress at p. 2. Therefore, Avid Xpress can resize the input video and output an uncompressed video file in the desired size for the output media format and TV standard. Avid Xpress at pp. 2-3.

**f) a code directed to adjusting the uncompressed format in the size associated with the desired output media format and the desired TV standard to a frame rate associated with the desired TV standard;**

The Avid Xpress software conforms to the ITU R-601 broadcast industry standard output for PAL and NTSC TV standards. Avid Xpress at p. 3. Therefore, Avid Xpress inherently can adjust the output frame rate.

Furthermore, Avid Xpress DV exports files to MPEG format and therefore must conform the output to the MPEG standard. Avid Xpress DV at FEATURES, p. 1. The MPEG standard includes fields for specifying the frame rate as seen in Table 2-40. MPEG Standard at pp. 57, 58, 62, 121.

Table 2-40 – Video stream descriptor

Syntax	No. of bits	Mnemonic
video_stream_descriptor(){		
descriptor_tag	8	uimsbf
descriptor_length	8	uimsbf
multiple_frame_rate_flag	1	bsbf
frame_rate_code	4	uimsbf
MPEG_1_only_flag	1	bsbf
constrained_parameter_flag	1	bsbf
still_picture_flag	1	bsbf
if (MPEG_1_only_flag == 0){		
profile_and_level_indication	8	uimsbf
chroma_format	2	uimsbf
frame_rate_extension_flag	1	bsbf
reserved	5	bsbf
}		
}		

MPEG Standard at p. 62.

**g) a code directed to processing the uncompressed format in the size and the frame rate into an elementary video stream; and**

Avid Xpress DV includes code directed to exporting files in the MPEG format. Avid Xpress DV at FEATURES, p. 1. As seen in Figure 1 below, the MPEG standard requires that the input file be processed into an elementary video stream before creating an MPEG file. MPEG Standard at pp. x, xi. Therefore, Avid Xpress DV inherently processes the uncompressed format into an elementary stream.

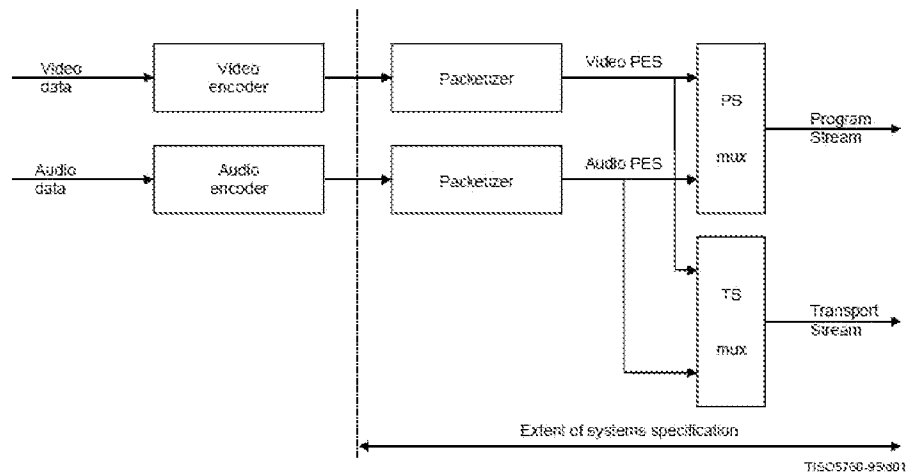


Figure Intro. 1 – Simplified overview of the scope of this Recommendation | International Standard

**h) a code directed to processing the elementary video stream with audio information in the desired output media format and the desired TV standard to form video and audio information in a presentation format based upon the desired output media format and the desired TV standard.**

Avid Xpress and Avid Xpress DV include code for processing the elementary video stream into an output audio-visual file having the characteristics required based upon the output media format and desired TV standard. Specifically, Avid Xpress discloses processing the output audio-visual file based on broadcast industry standards and the output media format (storage for online broadcasting). Avid Xpress at p. 1. Avid Xpress also discloses many other output formats such as Quicktime, and other Windows and Macintosh platform files. Avid Xpress at p. 1.

Avid Xpress DV enhances Avid Xpress capabilities providing MPEG outputs and media formats including Web, DVD, and tape. Avid Xpress DV at p. 1 and FEATURES, p. 1.

**2. The system of claim 1 wherein the first format is selected from a group consisting of: a digital file, a digital captured video stream, an analog captured video stream, and an internet video stream.**

Avid Xpress in view of Avid Xpress DV disclose the limitations of claim 1 as explained above.

Both Avid Xpress and Avid Xpress DV support several different first formats including popular animation files on Windows, Macintosh and SGI, QuickTime, RealMedia, Windows Media/ASF, IWMV, AVI and OMF/JFIF formats. Avid Xpress at pp. 1, 3 and Avid Xpress DV at FEATURES, p. 1.

**3. The system of claim 2 wherein the digital file is selected from a group consisting of: an AVI format an MPEG format, a DV format, a QuickTime format, Real Video format, Windows Media Player format.**

Avid Xpress in view of Avid Xpress DV disclose the limitations of claim 2 as explained above.

Both Avid Xpress and Avid Xpress DV support several different first formats including QuickTime, RealMedia, Windows Media, AVI formats. Avid Xpress at pp. 1, 3 and Avid Xpress DV at FEATURES, p. 1.

**5. The system of claim 1 wherein the desired output media format is selected from a group consisting of: DVD, VCD, and Super VCD.**

Avid Xpress in view of Avid Xpress DV disclose the limitations of claim 1 as explained above.

Avid Xpress DV discloses DVD as an output media format. Avid Xpress DV at p. 1.

**7. The system of claim 1 further comprising writing the video and audio information in the presentation format onto a disk media.**

Avid Xpress in view of Avid Xpress DV disclose the limitations of claim 1 as explained above.

Avid Xpress DV discloses seamlessly delivering the audio-visual output file to DVD. Avid Xpress DV at p. 1.

**9. The system of claim 1 wherein the code directed to processing of the elementary video stream with audio information comprises a code directed to perform a multiplexing process.**

Avid Xpress in view of Avid Xpress DV disclose the limitations of claim 1 as explained above.

Avid Xpress DV discloses exporting files to MPEG format. Avid Xpress DV at FEATURES, p. 1. As is illustrated in Fig. Intro 1, the MPEG standard requires that the elementary video stream be multiplexed with audio information. MPEG Standard at p. x.

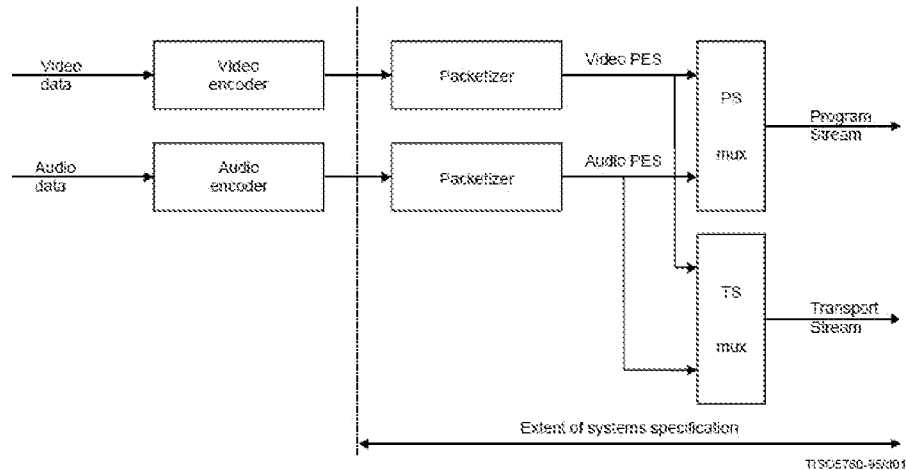


Figure Intro. 1 – Simplified overview of the scope of this Recommendation | International Standard

**13. The system of claim 1 further comprising a code directed to processing the raw video information based upon video editing information based upon user input.**

Avid Xpress in view of Avid Xpress DV disclose the limitations of claim 1 as explained above.

The Avid Xpress system includes many different editing options. Avid Xpress at pp. 1, 3. Specifically, the Avid Xpress system processes raw video information based upon video editing information such as applying Avid’s One Step Technology to perform editing functions. Avid Xpress at pp. 1, 3.

**14. The system of claim 1 further comprising a code directed to processing the audio information based upon audio editing information based upon user input.**

Avid Xpress in view of Avid Xpress DV disclose the limitations of claim 1 as explained above.

Both Avid Xpress and Avid Xpress DV comprise code directed to editing the audio information. Avid Xpress at p. 1 and Avid Xpress DV at FEATURES, p. 1.

**15. The system of claim 1 wherein the code directed to processing into the elementary video stream is provided in code directed to an encoding process and the code directed to converting into the raw video information is provided in code directed to a decoding process.**

Avid Xpress in view of Avid Xpress DV disclose the limitations of claim 1 as explained above.

As explained with respect to claim 1, many of the input formats that Avid Xpress accepts are compressed formats that inherently require a decoding process to convert into raw video information. Furthermore, to create many of the output formats an encoding process is inherently required. Since Avid Xpress can perform these functions, the elements of this claim are inherently present.

**16. The system of claim 1 further comprising a code directed to receiving video editing information based upon a third input.**

Avid Xpress in view of Avid Xpress DV disclose the limitations of claim 1 as explained above.

The Avid Xpress system is software that includes many different video editing options based on user input. Avid Xpress at pp. 1, 3. Specifically, the Avid Xpress system applies Avid's One Step Technology to perform editing functions. Avid Xpress at pp. 1, 3.

**17. The system of claim 16 further comprising a code directed to receiving audio editing information based upon a fourth input.**

Avid Xpress in view of Avid Xpress DV disclose the limitations of claim 1 as explained above.

Both Avid Xpress and Avid Xpress DV comprise code directed to audio editing information based upon user input. Avid Xpress at p. 1 and Avid Xpress DV at FEATURES, p. 1.

**18. The system of claim 16 wherein the integrated computer software application is a single integrated application.**

Avid Xpress in view of Avid Xpress DV disclose the limitations of claim 1 as explained above.

The Avid Xpress system is an integrated computer software application for

performing all video editing in one application. Avid Xpress at p. 1.

### **REASONS TO COMBINE**

A person of ordinary skill in the art would have been motivated to combine the Avid Xpress reference with the Avid Xpress DV reference since Avid Xpress DV is a related software product made by the same entity. Their features significantly overlap and perform substantially the same functions. Furthermore, Avid Xpress DV 2.0, was explicitly designed to work with Avid Xpress. *See* OTH-C, Avid Xpress 2.0 (“Avid Xpress DV version 2 is simple to learn, yet hard to outgrow. It’s the personal Avid solution you’ve been waiting for: an easy-to-use, portable companion to Media Composer, Symphony and Avid Xpress systems.”). Therefore a person of ordinary skill in the art would have been explicitly motivated to combine the two references.

Furthermore, both of these systems reference various file formats that encompass well-known standards, which a person of ordinary skill would have similarly been motivated to apply the teachings of these standards to achieve the claimed embodiments. For example, Avid Xpress DV discloses the MPEG file format, which is covered by the MPEG standard and Avid Xpress disclose the ITU R-601 standard. A person of ordinary skill would have considered that which is disclosed by these standards well within their skill and combinable with the additional teachings of Avid Xpress and Avid Xpress DV.

Accordingly, the references are properly combinable.

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In view of the analysis presented above, Requester submits that Avid Xpress in view of Avid Xpress DV not only presents a substantial new question of patentability with respect to the requested claims, but also renders obvious each of the requested claims. Therefore, the claims of the ‘655 patent should be found null, void, unenforceable and otherwise unpatentable and a Certificate of Reexamination should issue with the same effect.

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## V. CONCLUSION

The claims of the '655 patent discussed herein are unpatentable in light of the prior art documents presented in the Request above. These prior art documents were either not previously considered by the Office or are now being presented in a new light pursuant to MPEP § 2242(II)(A). These prior art documents teach the subject matter of the '655 patent in a manner such that Substantial New Questions of patentability for all claims are raised by this Request.

In view of the foregoing, it is respectfully submitted that substantial new questions of patentability of claims 1-18 of U.S. Patent No. 7,009,655 have been raised by this Request. Accordingly, Requestor respectfully asks that the Office grant this Request and initiate reexamination with special dispatch.

As an aid to the application of the presented prior art to claims of the '655 patent, corresponding claim charts are provided at Exhibit CC-A through CC-C attached hereto.

Enclosed is a credit card authorization to cover the fee for reexamination. If this authorization is missing or defective, please charge the fee to the Novak Druce Deposit Account No. 14-1437.

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