

EXHIBIT 16

Inventor: Qiang Huang

Patent No.: 7,283,172 B2

Reexamination Control No.: 95/001,283

Filed: March 23, 2010

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

Confirmation No.: 1757

Group Art Unit: 3992

Examiner: Ovidio Escalante

Docket No.: (8157.019.000000)

CERTIFICATE OF SERVICE

The undersigned hereby certifies that pursuant to 37 CFR § 1.903(b)(5) and MPEP § 2666.06, a copy of the document entitled RESPONDENT'S BRIEF OF REQUESTER has been served via first class mail on May 31, 2011 upon the Patent Owner at the following correspondence address of record:

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Dated: May 31, 2011

Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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

Mail Stop Inter Partes Reexam
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER

Dear Sir:

The following documents, together with this Transmittal Letter, are filed in response to the Appellant Brief filed by Patent Owner on May 2, 2011 (37 C.F.R. §1.8 certificate dated April 28, 2011), in the above-captioned *inter partes* reexamination proceeding:

RESPONDENT'S BRIEF OF REQUESTER

CERTIFICATE OF SERVICE

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Registration No. 35,493

CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8(a)(1)(i)(C) & (a)(1)(ii): The undersigned hereby certifies that this transmittal letter and the papers listed thereon are being filed using the USPTO's electronic filing system EFS-Web, and are addressed to: Mail Stop Inter Partes Reexam, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 31st day of May, 2011.

/Lance A. Smith/
Lance A. Smith

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Qiang Huang

Examiner: Ovidio Escalante

Patent No.: 7,283,172 B2

Group Art Unit: 3992

Reexamination Control No.: 95/001,283

Confirmation No.: 1757

Filed: March 23, 2010

Docket No.: (8157.019.000000)

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

RESPONDENT'S BRIEF (REQUESTER)

Mail Stop *Inter Partes* Reexamination
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Respondent/Requester submits this Respondent's Brief in response to the Appellant Brief filed on May 2, 2011(37 C.F.R. §1.8 certification dated April 28, 2011).

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I. REAL PARTY IN INTEREST

The real party in interest is the Requester, Apple, Inc.

II. RELATED APPEALS AND INTERFERENCES

U.S. Patent No. 7,843,508 (“the ‘508 patent”) claims benefit under 35 USC §120 as a continuation of U.S. Patent No. 7,283,172 (“the ‘172 patent”), which in turn claims Section §120 benefit as a continuation of U.S. Patent No. 7,009,655 (“the ‘655 patent”). The ‘172 patent is the subject of the present *inter partes* reexamination control no. 95/001,283. The ‘655 patent is the subject of control no. 95/001,284, an *inter partes* reexamination proceeding that is currently on appeal before the USPTO Board of Patent Appeals and Interferences (“Board”). The ‘172 and the ‘655 patents are currently the subject of Civil Action No. 11-cv-2525 (HRL), which is now pending before the US District Court for the Northern District of California after a recent transfer from the Eastern District of Texas. The ‘508 patent is the subject of *inter partes* reexamination controls nos. 95/000,617, 95/001,534, and 95/001,521. The ‘508 patent is the subject of Civil Action No. 3:10-cv-05410 (RS) and Civil Action No. 3:10-cv-05762 (RS), each pending before the US District Court for the Northern District of California, San Francisco Division. Respondent knows of no other litigation, appeals or interferences that either directly affect, or have an indirect bearing on the decision of the Board in the present appeal.

III. STATUS OF CLAIMS

Respondent accepts Appellant/Owner’s statement on the status of the pending claims.

IV. STATUS OF AMENDMENTS

Respondent accepts Appellant/Owner’s statement on the status of amendments.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Respondent disputes Appellant/Owner’s summary of the subject matter of claims 1-15 and 19. Respondent notes that claims 1 and 19, the independent claims, and dependent claims 2-6, and 8-15 are not limited to recording video information onto a disk medium. The independent claims also do not limit the desired output media format to being one of a *plurality* of standard video formats. Further, the independent claims do not limit the desired output media format to optical disk media or limit the presentation format to a specific format for video information on an optical disk media.

VI. ISSUES TO BE REVIEWED ON APPEAL

Respondent accepts Appellant/Owner's statement of the issues to be reviewed on appeal. Respondent notes, however, that Appellant's first stated issue requires separate treatment of claims 1-4, 9 and 12-18 and claims 5-8, 10 and 11. Only dependent claims 5-8, 10 and 11 have been separately argued. Dependent claims 2-4, 9 and 12-18 do not require separate treatment because they have not been separately argued from claim 1.

VII. ARGUMENT

A. Introduction

Respondent notes that none of the claims of the '172 patent are limited to low cost systems performing methods for converting video to DVD optical disks. Only claims 16-18 are limited to a system, and those claims are cancelled. The rest of the claims are directed to a method for converting video information from an incoming format to an outgoing format. The method recited in '172 patent claims 1-15 and 19 is not required to be practiced using inexpensive, non-specialized equipment. Parameters such as cost or simplicity of technology are not found in the '172 patent claims. The '172 patent claims do not require only "a few" inputs, and do not recite the names of people of note who have allegedly evaluated the invention embodied in the claims.

Respondent will address claim construction issues and specific claim rejections. Respondent will thereafter show that the prior art clearly anticipates claims 1-15 and 19 when those claims are given their broadest reasonable interpretation, as is required in a reexamination proceeding by a number of cases.¹ As will be shown below, Appellant's claims are far less limited than Appellant argues them to be, and the Examiner's claim construction is both broad, and reasonable in light of the '172 specification and claims.

B. The Examiner Correctly Rejected Claims 1-4, 9 and 12-15 as Anticipated Under 35 U.S.C. §102(b) because the Cleaner 5 User Manual Teaches All of The Argued Limitations of Claim 1

1. Introduction

¹ *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1259 (Fed. Cir. 2010); See also: *In re Swanson*, 540 F.3d 1368, 1377-78 (Fed. Cir. 2008) (And unlike in the district courts, in reexamination, proceedings, "[c]laims are given 'their broadest reasonable interpretation, consistent with the specification....'" (citing *In re Trans Texas Holdings Corp.*, 498 F.3d1290, 1998 (Fed. Cir. 2007) (quoting *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984))

The '172 patent includes two independent claims. Appellant has not provided separate arguments for the patentability of dependent claims 2-4, 9 and 12-15, and only argues dependent claims 5-8, 10 and 11 and independent claim 19 separately from claim 1. Therefore, claims 1, 2-4, 9 and 12-15 stand or fall as a group pursuant to the fourth and sixth sentences of §41.67(c)(1)(vii).

Certain of the Appellant's arguments that a reference does not teach particular claim limitations are predicated on claim construction issues, and will therefore be addressed by Respondent on that basis. With respect to claim 1, Appellant argues a limitation in the preamble of claim 1 and only four of the eight limitations in the body of claim 1. Therefore, Respondent's position will address only those arguments, since Appellant apparently does not contest that the applied prior art teaches the claim limitations that Appellant did not argue.

2. The Cleaner 5 User Manual ("C5M") and MPEG Charger Manual ("Charger")

C5M is a user manual for the Cleaner 5 software program, and explains to a user the various functionalities of the Cleaner software. Charger is a user manual that describes the functions performed by the MPEG Charger software. It is C5M and Charger that are applied as prior art publications. As disclosed by C5M, Cleaner is software stored in a memory for converting incoming digital video (DV) to an outgoing MPEG-1 or MPEG-2 stream. (C5M, pp. 141, 206) Per C5M, Cleaner performs a conversion method that receives a video file and outputs 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. (Id., pp. 5, 8, 204, 205, 207, 209, and 212) Incoming video files are initially converted into an uncompressed raw video format, such as YUV. (Id., p. 138) Additional continuous processing is used to resize the video to the desired output media format, frame rate, aspect ratio, frequency, and television standard. (Id., at pp. 5, 8, 204, 205, 207, 209 and 212) The output file can further be authored and then written to a disk media such as Video CD or DVD. (Id., pp. 206, 209) Importantly, C5M describes Cleaner performing the method steps in this process together with other integrated software loaded on a computer system with Cleaner.

C5M discusses the use of Adaptec Toast (an authoring application) together with Cleaner. C5M describes methods implemented in Cleaner and in Adaptec Toast. C5M also discusses the use of MPEG Charger software together with Cleaner. When installed together on

a computer system, Cleaner, MPEG Charger and Adaptec Toast form a continuous conversion process that includes method steps performed as recited in claims 1-15 and 19 of the '172 patent.

3. C5M discloses “a continuous pass conversion process free from one or more intermediary files.”

Appellant/Owner contends that C5M does not anticipate claim 1 because it does not disclose a process “free from one or more intermediary files,” as recited in the preamble of independent claim 1. Appellant also contends that the preamble and the various “directly” method steps limits the method to be a “non-stop” method (Brief, p.6) Appellant also contends that C5M does not anticipate claim 1 because Cleaner allegedly starts and stops and outputs an MPEG-1 or MPEG-2 file, and that these files are intermediary files because they are not presentation files. (Brief, at p.7) Respondent disputes these contentions.

In litigation, Appellant had asserted that the construction of the limitation “free from one or more intermediary files” is “without writing video to disk while processing the input video into the presentation format.” (RAN, p.14) The court adopted that construction,² but then noted at footnote 14 of its Memorandum Order that:

“... as it relates to this limitation ... the source compressed video is never saved as an uncompressed or ‘raw’ video file during the conversion process. Doing so would require inordinate amounts of storage space, so the source is uncompressed and converted in small chunks that are then converted into the destination format. The Court adopts Plaintiff’s construction with the understanding that the final presentation format may be written to disk as a file during the conversion process. While this file is written to disk, it is not an intermediary file.”

Respondent disagrees that the preamble should be considered a limitation. The claim should be given its broadest reasonable interpretation. However the Examiner concluded that the claims are anticipated by C5M even if the preamble is a limitation. (RAN, p. 5) Although Appellant asserts that the preamble limitation distinguishes over the prior art, the Examiner determined that even if that limitation were interpreted congruently with the specification’s discussion of the term, the element is taught by Cleaner 5. The Examiner concluded that “‘free from one or more intermediary files’ describes a process in which an intermediary file, which is stored, is not used during the encoding process. This step however, ends after

² See: *Mediostream, Inc. vs. Microsoft Corporation, et al.* U.S. District Court, Eastern District of Texas, No. 2:08-CV-369(CE), Memorandum Opinion and Order, p. 17 (August 27, 2010).

encoding has been completed and does not include the actual writing of this file to disk.” In arriving at this conclusion, the Examiner correctly noted that the specification states that temporary files are often stored in memory. (RAN, p. 14, citing the ‘172 patent³) The Examiner also correctly found that the claim language permits files to be stored in memory and then used without being written to disk, until the encoding has been completed and the final file is written to disk. (RAN, p.14) Respondent agrees with the Examiner on each point, except to note that the specification consistently supports that the process is free from one or more intermediary files through the processing of the raw video files, but that intermediary files are explicitly passed once the audio and video are to be processed in the audio/video output. *See* the ‘172 patent 5:55, 6:11, 11:4.

The Examiner also correctly determined that “directly” does not entail or exempt the use of intermediary files as claimed, so that the claims do not require a conversion process that is “non-stop.” (RAN, p. 8)

Further, the Examiner correctly determined that C5M discloses converting incoming digital video to an outgoing MPEG-1 or MPEG-2 stream in a single pass conversion process that encodes movies into a single file without intermediary files. (RAN, pp. 15-16, citing C5M at pp. 64, 206)

For at least these reasons, the Examiner’s RAN position correctly finds that C5M teaches this limitation.

4. C5M discloses "inputting a desired output media format based upon a first input"

Appellant/Owner contends that C5M does not anticipate claim 1 because the examiner failed to properly construe the language “output media format” to mean “a standard video format for optical disk media” as construed in the concurrent litigation (Brief, pp. 7-8), Appellant also contends that C5M does not teach inputting a “desired” output media format based upon a first input, and that C5M does not teach inputting multiple output formats. Appellant argues that Cleaner 5 does not disclose inputting a DVD or SVCD media format. Respondent disputes these contentions.

The Examiner correctly applied the broadest reasonable interpretation of the limitation “desired output media format” and found that C5M teaches that Cleaner allows a

³ The Examiner did not supply a specific citation into the ‘172 patent, but *see* ‘172 patent, 5:9-20.

user to select MPEG-1 for Video CD projects and MPEG-2 for DVD output media format, whichever is desired. (RAN, p. 16, citing C5M, pp. 209 and 62) Respondent further notes that “desired⁴” does not necessarily connote a plurality. Nothing in the specification suggests that the common term “desired” has any special meaning in this patent. Cleaner in fact does have an input for MPEG-2 that is for use with DVD-Video (C5M at page 62) and an input for Video CD (C5M at p. 209). That these inputs depend on processing by a second software program that is integrated with Cleaner does not mean that there is no input for DVD format. Finally, claim 1 is not limited to DVD format.

5. C5M discloses “ directly resizing the raw video information in the uncompressed format into a size associated with the desired output media format and the desired video presentation standard.”

Appellant/Owner contends that the claimed invention requires directly resizing the video automatically to a size associated with both the desired media format and desired TV standard as received inputs. (Brief, p. 11) Appellant further contends that the claims do not read on the user selecting the video size based on the user’s knowledge of the media formats or TV standards; instead the method associates the desired media format and TV standard with a size for the video. (Id.) Appellant also contends that C5M does not disclose associating video sizes with media formats (e.g. VCD, SVCD or DVD) or TV standards (e.g. NTSC or PAL) or resizing raw video to any sized based on such association. Appellant additionally alleges that C5M does not disclose resizing raw video information according to desired output media format and desired TV standard received as input. Respondent disputes each of these contentions.

The Examiner has correctly found that C5M teaches converting uncompressed raw video information to the selected image size through a resizing operation, (C5M 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 (i.e. an NTSC DVD); (C5M 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 (i.e. a PAL DVD), (C5M at p. 204). The Examiner noted that by selecting the desired output format the raw video information would be resized in accordance with the

⁴ Desire – adjective – means: 1. To wish for the possession and enjoyment of, with earnestness. 2. **to express a wish to obtain; to ask for.** Synonym: request, wish covet, solicit, **want**, long for. Webster’s New Universal Unabridged Dictionary – latest copyright date 1983.

selected desired output format. Nothing in the claimed method limitation requires a selection that may not be based on the user's prior knowledge of these parameters.

For at least these reasons, the Examiner's RAN position correctly finds that C5M teaches this limitation.

6. C5M discloses "directly adjusting the uncompressed format in the size associated with the desired output media format and the desired video presentation standard to a frame rate associated with the desired video presentation standard."

Appellant/Owner contends that one can select any frame rate in Cleaner, but cannot directly adjust uncompressed video to a frame rate associated with an inputted desired video presentation. Respondent disputes this contention.

The Examiner has held that C5M discloses the standard frame rate of 29.97 frames per second associated with MPEG-1 and MPEG-2 output media formats for the NTSC TV standard and the standard frame rate of 25 frames per second associated with MPEG-1 and MPEG-2 output media formats for the PAL TV standard. (C5M, p. 207) The cited portion of C5M clearly states that while one can select a number of different non-standard frame rates, there is a specific standard frame rate for the two MPEG output formats and specific presentation format frame rates. That disclosure satisfies the language of this claim limitation.

7. C5M discloses "directly processing the elementary video stream with audio information in the desired output media format and the desired video presentation standard to form video and audio information in a presentation format based upon the desired output media format and the desired video standard."

Appellant/Owner contends that presentation format is a "term of art" in the DVD optical disk art, and Patent Owner used the term as it is ordinarily used in that field. Respondent disputes the contention that as used in claim 1, "presentation format" is limited to an art recognized definition in the DVD optical disk art, because claim 1 does not recite writing to a DVD optical disk. Respondent also disputes that contention because C5M teaches authoring into a presentation format and then writing to a DVD, as well as to a CD.

Claim 1 is not limited to DVD optical disk media, because the claim nowhere recites that limitation. If it did, dependent claims 5, 6, 8 and 10 would make no sense because they are specifically not limited to DVD optical disk media.

Further, Appellant admits that the VCD and SVCD specifications pre-date the terms “presentation format” and “presentation data,” and that it was “well known” in the art that corresponding audio/video information and structure are described in the VCD and SVCD standards for writing video and audio information to disk media. (Brief, p. 17) Not only is it well known in the art, C5M clearly teaches that “The Video CD format is a standard that plays in most DVD players. It requires MPEG-1 video and special Video CD formatting. You can easily produce MPEG-1 files for your Video CD projects in Cleaner by selecting the Video CD preset in the Advanced Settings window. To author Video CDs, you’ll also need a CD-mastering application, such as Adaptec Toast or Easy-CD Creator.” (C5M, p. 209, emphasis added) As claim 1 is not limited to processing to produce the VOB format for authored audio/video information, Appellant’s argument regarding the VOB format is irrelevant. Moreover, C5M clearly teaches that “Cleaner now encodes MPEG-2 which is the format used for DVD-Video. DVD-Video is another form of DVD that is used for the commercial distribution of prerecorded movies. The discs can be played back on standard set-top and portable DVD players or on computers with DVD-ROM drives. DVD-Video’s rate is 5.7 Mbits/sec and is used by Cleaner’s default MPEG-2 setting.” (C5M, p. 62)

The Examiner was correct in holding 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/video standard based on the desired MPEG-1 or VCD output media format, (Cleaner 5 at p. 7, 206).

8. Additional Limitations in Claim 1

There are additional limitations in claim 1 that Appellant has not argued as distinguishing the claim over the C5M publication. Appellant has therefore conceded that C5M teaches those limitations pursuant to the second sentence of (37 CFR 41.67(c)(1)(vii)).

C. The Examiner Correctly Rejected Claims 5-8, 10 and 11 as Anticipated Under 35 U.S.C. §102(b) because C5M Teaches All of the Limitations of Each Claim

1. Introduction

Each of claims 5-8, 10 and 11 have been argued by Appellant as being patentable over the C5M publication separately from independent claim 1 from which they depend. As demonstrated in Sections B(3)-B(8) above, claim 1 is anticipated by C5M because it teaches

every limitation argued by Appellant. In fact C5M teaches every limitation of claim 1 for the reasons set forth by the Examiner. (RAN, pp. 17-20)

2. The Examiner Correctly Rejected Claim 5 as Anticipated Under 35 U.S. C. §102(b) by C5M

Appellant/Owner contends that the Examiner incorrectly held claim 5 to be anticipated by C5M because C5M fails to teach the limitation that “the desired output media format is selected from a group consisting of: DVD, VCD, and SVCD.” Respondent disputes this contention.

This contention is clearly erroneous, because parent claim 1 is anticipated by the C5M disclosure that a Video CD can be created. As previously discussed in Section B(7), the Examiner has correctly held that C5M clearly teaches that Cleaner includes a preset for creating a Video CD. (RAN, pp. 16 and 19, citing C5M, p. 209) As noted by the Examiner, C5M teaches a desired output media as recited in claim 1, because C5M has a VCD preset and a user can have DVD projects. (RAN, p.32) The Examiner further recognized that C5M teaches that Cleaner will output video and audio files for creating video CDs that will play on most DVD players. (Id.) The Examiner also recognized Cleaner “encodes MPEG-2, which is the format used for DVD-Video.” (RAN, p. 10, citing C5M, p. 62)

3. The Examiner Correctly Rejected Claim 6 as Anticipated Under 35 U.S. C. §102(b) by C5M

Appellant/Owner contends that the Examiner has erred in rejecting claim 6 by finding a quality setting based on a third input is taught by C5M, because the Examiner relies on selection of data rate and frame rate (RAN p.21, citing C5M, p. 59.) and the data rate discussed in Cleaner is not a quality setting. (Brief, p. 25) Appellant further contends that Cleaner cannot accept an input specifying DVD as the media format, and therefore the user cannot select a quality setting when the desired output media is DVD. Respondent disputes both contentions.

Initially, it should be noted that the term “quality setting” is not described or defined in the specification, and is only mentioned in claim 6. As C5M clearly states:

“One of the most important decisions you must make when preparing movies is choosing the data rate. More than any other factor, the data rate affects the final image and sound quality of your movie. It also affects how big the final file will be,

as well as what playback methods will be able to effectively deliver the movie.”
(C5M, p. 59, emphasis added)

It is clear that C5M teaches a quality setting. Furthermore, C5M also teaches frame size as being a factor that controls quality. (C5M, p. 64) As “data rate” and “frame size” are inputs differing from the first and second inputs recited in parent claim 1, either is clearly “a third input” as required by claim 6. Furthermore, not only can the user of Cleaner select DVD as the media format, as recognized by the Examiner, (RAN, p. 10, citing C5M, p. 62), C5M also teaches that MPEG-2 is the format for DVD-Video. (C5M, p. 62) For all of these reasons, Examiner properly rejected claim 6 as being anticipated by C5M.

4. The Examiner Correctly Rejected Claim 7 as Anticipated under 35 U.S.C. §102(b) by C5M.

Appellant/Owner contends that C5M does not teach writing video and audio information onto disk media such as CD-ROM or DVD-ROM as alleged by the Examiner, but teaches only writing data to a CD disk or a DVD disk and not to an output media format (DVD, VCD or SVCD specification). Respondent disputes this contention.

Appellant alleges that page 141 of C5M lists all of the output formats supported by Cleaner. Although it is noted that Claim 7 does not specify any particular type of disk media, it is clear that C5M teaches that movies can be written to CD-ROMs and DVD-ROMs as stated by the Examiner. (RAN, p.20; citing C5M, p. 144)⁵ Appellant is simply incorrect in arguing otherwise. Appellant again argues that Cleaner cannot write a video in a presentation format onto disk media without other software. That argument again ignores that Cleaner is “integrated” with two other software programs when those programs reside on a computer system with Cleaner. The three programs are compatible and interoperate, i.e., “work as a unit” and/or “work together to handle an application” (RAN, p. 52)

5. The Examiner Correctly Rejected Claim 8 as Anticipated under 35 U.S.C. §102(b)

Appellant/Owner contends that C5M does not teach writing video and audio information in the presentation format onto disk media such as CD-ROM or DVD-ROM. Respondent disputes this contention.

⁵ This disclosure appears in the 6th paragraph of p. 144.

The Examiner addressed the argument that C5M does not create a presentation format in the RAN, and the reasons why the Examiner's position is correct are discussed above in Section B(7), 3rd paragraph. Cleaner, residing on a computer system with Adaptec Toast, clearly can, and does, create presentation formats, and C5M describes this. Those presentation formats are created for at least VCD and DVD disk media, by "an integrated computer software application" that resides on a computer system in accordance with the Patent Owner's construction of "an integrated computer software application," (presented in litigation), that the limitation means "computer codes or instructions that are compatible and interoperate." Specifically, Cleaner allows a special MPEG-1 file to be created and written to VCD using Adaptec Toast. (C5M, p. 206)

6. The Examiner Correctly Rejected Claim 10 as Anticipated under 35 U.S.C. § 102(b)

Appellant/Owner contends that the Examiner erred in rejecting claim 10 based on a finding that C5M discloses that audio information is adjusted to a desired frequency based upon the desired output media format because 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." (Brief, p. 25) Appellant contends that the rejection is erroneous because "The desired output media is defined as a specific standard video format for optical disk media in the claims. MP3 is not a desired output media format as described and claimed in the '172 patent." (Brief, p. 27) Respondent disputes these contentions, because neither claim 10, nor its parent claim 1, defines what the desired video format is and because claim 10 is directed to an audio format, not to a video format.

The Examiner cited C5M as disclosing audio information tuned to a desired (i.e., particular) frequency, wherein the audio information may be in the form of MP3 audio files. (RAN, p. 21, citing C5M, p. 212) The Examiner was correct in doing so and in rejecting claim 10 as anticipated for the reasons that claim 1 was so rejected together with the additional showing that the limitation added by claim 10, which is limited to audio information is clearly taught in C5M.

7. The Examiner Correctly Rejected Claim 11 as Anticipated under 35 U.S.C. § 102(b)

Appellant/Owner contends that the Examiner erred in arguing that “C5M discloses various desired frequencies including 44.1 kHz for use with VCD.” (Brief, p. 26, quoting RAN, p. 21) Appellant alleges that the Examiner cited the wrong pages of C5M. Respondent disputes this contention.

Claim 11, like parent claim 10, is directed to audio information, and presents a group of media formats for which a desired frequency may be selected. The Examiner cited and applied the teachings of C5M, which includes a disclosure of various desired audio frequencies including 44.1 kHz for use with VCD. (RAN, p. 23, citing C5M, pp. 212-213 and 209) Those pages are correct, since C5M also states that: “Unlike consumer MP3 encoders/rippers, Cleaner includes a professional MP3 encoder created by Fraunhofer, the inventors of the MP3 format. Cleaner allows you to use MP3s in the audio tracks of your QuickTime movies by selecting MP3 in the Codec pop-up menu in the Audio tab.” (C5M, p. 153) For these reasons, the Examiner’s rejection of claim 11 is clearly correct.

8. C5M discloses the limitations in claim 19.

Appellant argues only that C5M does not disclose “a process free from one or more intermediary files,” or “multiplexing the elementary video stream with audio information in the desired output media format and the desired video presentation standard to form video and audio information in a presentation format based upon the desired output media format and the desired video presentation standard.” (Brief, p. 26) Respondent disputes this contention.

C5M clearly discloses “a process free from one or more intermediary files” for the reasons discussed in Section B(3). The limitation “multiplexing the elementary video stream with audio information in the desired output media format and the desired video presentation standard to form video and audio information in a presentation format based upon the desired output media format and the desired video presentation standard” was not previously discussed by Appellant, although it is similar to the last limitation in claim 1. The “multiplexing” limitation is disclosed in C5M for the reasons discussed in Section B(7).

D. The Examiner Correctly Rejected Claims 5, 6 and 8 as Obvious Under 35 U.S.C. §103 Over C5M in view of Charger

1. Introduction

Beginning at page 29 of the RAN, the examiner addresses a second ground of rejection for claims 5, 6 and 8 based on obviousness under 35 U.S.C § 103. These rejections are in addition to the §102 anticipation position taken by the Examiner. (RAN, p. 38)

The Appellant's Brief discusses these rejections at pages 26 and 27, explaining why Charger allegedly does not teach the limitations relied on.

2. The Examiner's Obviousness Rejections of Claims 5, 6, and 8 are correct

Appellant/Owner contends that the Examiner erred in adopting the obviousness rejection of claim 5 based on C5M in view of Charger. Respondent disputes this contention, because C5M anticipates parent claim 1, Charger can produce MPEG-1 files for Video CD, MPEG Charger is a software program explicitly for use with Cleaner, and turns video and audio files into MPEG-2 streams for DVD and MPEG-1 streams for Video CD. It clearly would have been obvious to a person of ordinary skill in the art to combine the teachings of Charger with those of C5M, to produce the invention of claim 5. Their use together on a computer would constitute an integrated computer software application. (RAN, P. 30; C5M at p. 209)

Appellant/Owner contends that the Examiner erred in adopting the obviousness rejection of claim 6 based on C5M in view of Charger. Respondent disputes this contention, because claim 5 is obvious over C5M in view of Charger, and Charger teaches that the user is allowed "to turn all popular video, audio and animation file formats into MPEG streams for DVD, Video CD" and other formats. (Charger, p. 9) Therefore, a person of ordinary skill in the art would have found it obvious to use MPEG Charger with Cleaner because of the higher data rate to create an MPEG stream suitable for a DVD, and the teaching that Cleaner and MPEG Charger are integrated applications. (RAN, pp. 30-31)

Appellant/Owner contends that the Examiner erred in adopting the obviousness rejection of claim 8 based on C5M in view of Charger. Respondent disputes this contention, because claim 1 is anticipated by C5M and the teachings of Charger discussed above with respect to the obviousness rejection of claim 5 would have rendered applying those facets of

the MPEG Charger software with the Cleaner software obvious to a person of ordinary skill in the art. (RAN, p. 41)

E. The Examiner Correctly Rejected Claims 1-12, 15 and 19 as Anticipated Under 35 U.S.C. §102(a) because Washino Teaches All of The Argued Limitations of Claim 1

1. Introduction

U.S. Patent No. 6,370,198 to Washino issued on April 9, 2007 from an application filed on May 6, 1999. The Examiner has rejected claims as being anticipated under 35 U.S.C. § 102(e). However, Washino also qualifies as prior art under 35 U.S.C. § 102(a) because Washino issued prior to the July 23, 2002 effective filing date of the '172 patent. This does not, of course, affect the Examiner's finding that Washino teaches claims 1-12, 15 and 19.

Washino was used to reject and cause cancelation of claims that are not patentably distinct from claims 1-12, 15 and 19 during the prosecution of the '655 patent, which is the parent patent of the '172 patent. Since the claims in the '655 patent were rejected and eventually canceled by the Patent Owner because they were anticipated, the same result should be given effect to the claims of the '172 patent.⁶

2. Claims 2-12 and 15 Should Stand or Fall With Claim 1

Respondent respectfully points out that for Washino, Appellant has not specifically directed arguments to any claims other than claims 1 and 19. Claims 2-12 and 15 depend from claim 1, and have not been separately argued. Pursuant to 37 C.F.R. §41.67(c)(1)(vii), claims 2-12 and 15 should stand or fall with claim 1. However, the reasons why Washino anticipates claims 2-12 and 15 is briefly discussed below.

3. Washino Does Not Teach Away from Claims 1 and 19.

Appellant/Owner contends that Washino teaches using an intermediary storage format (allegedly also called preferred/internal/production format in Washino's specification) so that Washino teaches away from the invention of claims 1 and 19 because those claims are directed to "a process free from one or more intermediary files." Appellant/Owner further contends that Washino does not teach disk authoring of the converted video file and outputting of a presentation format. Respondent disputes these contentions.

⁶ The entirety of this argument was previously presented in the Request for Reexamination at p. 47, and can be referred to for more detail.

Washino does mentions “preferred internal or ‘production’ frame rate” at 6:37-40 and “preferred internal format” at 20:14-17. However, these phrases describe a preferred frame rate, not an “intermediary file.” Washino also uses the term “internal storage format,” (not “intermediary storage format”), at 19:61-65 to describe selection of a frame rate of 24 fps as being preferred. Appellant’s contention that Washino teaches an “intermediary file” is apparently based on the word “internal.” As the Examiner has properly pointed out, Appellant has argued that a file that is “free from one or more intermediary files” is a file that is output after the continuous pass conversion process without writing onto disk, but if Washino stores a file during the conversion process, the stored file is after the conversion process but before writing to disk. (RAN, p. 59) Claims 1 and 19 do not require writing to disk media of any kind.

4. The Examiner Correctly Rejected Claims 2-12 and 15 as Anticipated under 35 U.S.C. §102 by Washino

To the extent that the patentability of any of claims 2-12 and 15, is deemed to have been separately argued by Appellant/Patent Owner, Respondent disputes the contention of Appellant that any of claims 2-12 and 15 are patentable.

Appellant appears to argue that Washino does not disclose any output media formats (e.g. DVD, VCD AND SVCD) for writing video to an optical disk. Only claims 5, 6, 8 and 11 even mention a particular optical disk media, which is DVD, and Washino clearly teaches the use of DVD optical disks for storage of processed audio/video productions. (Washino, 16:5-11).

F. Appellant/Owner’s Additional Arguments

Beginning at page 27, Appellant’s Brief then provides a separate section of 16 pages that assert a smorgasbord of general legal arguments that are not directed to any particular claim of the ‘172 patent. The arguments begin by alleging that the Examiner failed to apply statutory and common law, delve into infringement issues, detour into an allegation that the Examiner erred by failing to apply the statutory presumption that all patents are correctly issued, cites and discusses irrelevant claim construction cases and alleges that, in this reexamination proceeding, the Examiner erred by failing to construe the claims narrowly in favor of validity. The ‘172 patent is not expired, and Appellant’s claim construction arguments are contrary to every holding by the Federal Circuit for reexamination proceedings

directed to an unexpired patent. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1316–17 (Fed. Cir. 2005) (en banc) (observing that PTO gives claims their “broadest reasonable construction”); *In re Morris*, 127 F.3d 1048, 1053–54 (Fed. Cir. 1997) (observing that the PTO gives claims their “broadest reasonable interpretation,” unlike courts hearing patent litigation, and declining invitation to overrule “decades old case law” that examiners should apply the broader standard); *In re Etter*, 756 F.2d 852, 855–56 (Fed. Cir. 1985) (holding that the presumption of validity does not apply in reexamination proceedings). Respondent does not have the available pages or words to further address these arguments. Respondent simply states that all of the contentions on pages 29-44 are disputed and that the Board will find them baseless even if not argued by Respondent.

G. Conclusion

For the reasons above, Respondent/Patent Owner requests that the Board maintain the Examiner's rejections of claims 1-15 and 19, i.e., all remaining ‘172 claims.

VIII. EVIDENCE APPENDIX

None

IX. RELATED PROCEEDINGS APPENDIX

None

X. CERTIFICATE OF SERVICE

A certificate of service of all papers on the attorney of record for the patent owner is attached.

XI. TABLE OF CASES CITED

A. *In re Suitco Surface, Inc.*, 603 F.3d 1255 (Fed. Cir. 2010)

B. *In re Swanson*, 540 F.3d 1368 (Fed. Cir. 2008)

C. *Mediostream, Inc. vs. Microsoft Corporation, et al.* No. 2:08-CV-369(CE), (E.D. Tex. August 27, 2010) Memorandum Opinion and Order

D. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316–17 (Fed. Cir. 2005)

E. *In re Morris*, 127 F.3d 1048, 1053–54 (Fed. Cir. 1997)

F. *In re Etter*, 756 F.2d 852, 855–56 (Fed. Cir. 1985)

XII. PAGE/WORD COUNT STATEMENT

Respondent/Requester certifies that this Respondent's Brief, including the separately filed certificate of service contains fewer than 7,000 words, as calculated using Microsoft Word's word count feature.

XIII. FEES

The fee of \$540.00 is paid by credit card. The Director is authorized to charge any deficiency in fee payments due for this paper, and to credit any overpayment in connection with this paper to the Novak Druce Deposit Account 14-1437.

Respectfully submitted,

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