

EXHIBIT 5



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AMPACC Law Group, PLLC 6100 219th Street SW, Suite 580 Mountlake Terrace, WA 98043			EXAMINER ESCALANTE, OVIDIO	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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FEB 14 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester *Inter Partes* Reexamination

REEXAMINATION CONTROL NUMBER 95/001,284.

PATENT NUMBER 7,009,655.

TECHNOLOGY CENTER 3900.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Right of Appeal Notice
(37 CFR 1.953)**

Control No.

95/001,284

Examiner

OVIDIO ESCALANTE

Patent Under Reexamination

7009655

Art Unit

3992

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --

Responsive to the communication(s) filed by:

Patent Owner on 16 July 2010

Third Party(ies) on 13 August 2010

Patent owner and/or third party requester(s) may file a notice of appeal with respect to any adverse decision with payment of the fee set forth in 37 CFR 41.20(b)(1) within **one-month or thirty-days (whichever is longer)**. See MPEP 2671. In addition, a party may file a notice of **cross** appeal and pay the 37 CFR 41.20(b)(1) fee within **fourteen days of service** of an opposing party's timely filed notice of appeal. See MPEP 2672.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

If no party timely files a notice of appeal, prosecution on the merits of this reexamination proceeding will be concluded, and the Director of the USPTO will proceed to issue and publish a certificate under 37 CFR 1.997 in accordance with this Office action.

The proposed amendment filed 16 July 2010

☐ will be entered

☒ will not be entered*

*Reasons for non-entry are given in the body of this notice.

1a. ☒ Claims 1-18 are subject to reexamination.

1b. ☐ Claims _____ are not subject to reexamination.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are confirmed. [Unamended patent claims].

4. ☐ Claims _____ are patentable. [Amended or new claims].

5. ☒ Claims 1-18 are rejected.

6. ☐ Claims _____ are objected to.

7. ☐ The drawings filed on _____ ☐ are acceptable. ☐ are not acceptable.

8. ☐ The drawing correction request filed on _____ is ☐ approved. ☐ disapproved.

9. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d) or (f). The certified copy has:

☐ been received.

☐ not been received.

☐ been filed in Application/Control No. _____.

10. ☐ Other _____

Attachments

1. ☐ Notice of References Cited by Examiner, PTO-892

2. ☒ Information Disclosure Citation, PTO/SB/08

3. ☐ _____

RIGHT OF APPEAL NOTICE

1. This Office action addresses claims 1-18 of United States Patent No. 7,009,655 and is in response to the Patent Owner's response filed on July 16, 2010 and the Requester's response filed on August 13, 2010.

Status of the Claims

2. Original claims 1-18 are rejected.

Rejections Proposed by the Requester

3. The following 3 issues for rejection were proposed in the Request for *inter partes* reexamination (95/001,284):

Issue 1: Cleaner 5 User Manual is asserted as rendering claims 1-18 anticipated.

Issue 2: Cleaner 5 User Manual in view of Cleaner MPEG Charger is asserted as rendering claims 5, 6 and 8 obvious.

Issue 3: Avid Xpress in view of Avid Xpress DV is asserted as rendering claims 1-3, 5, 7, 9 and 13-18 obvious.

Information Disclosure Statement

4. With respect to the Information Disclosure Statement filed on July 19, 2010, July 26, 2010, August 30, 2010 and December 10, 2010 the information cited has been considered as described in the MPEP. Note that MPEP 2256 and 2656 indicate that degree of consideration to be given to such information will be normally limited by the degree to which the party filing the information citation has explained the content and relevance of the information. Information that does not appear to be "patents or printed publications" as identified in 35 U.S.C. 301 have been considered to the same extent (unless otherwise noted), but have been lined through and will not

be printed on any resulting reexamination certificate. In addition, information without a date has likewise been lined through.

Amendment After ACP

5. The Patent Owner's Amendment filed on July 16, 2010 is not entered. As noted by the Requester, the amendments should not be entered because they do not comply with the "strict" standards of 37 C.F.R. 1.116 governing after final amendments. MPEP 2672. 37 C.F.R. 1.116 sets forth that amendments to the claims after an Action Closing Prosecution may only be entered if they meet one of three criteria:

- (1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
- (2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
- (3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

The present amendment does not cancel claims; does not put the claims in better condition for consideration on appeal since it raises new issues; and does not come with a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

The Examiner agrees with the Requester and thus the proposed amendment is not entered.

Claimed Invention Arguments

The Patent Owner maintains that claim 1 requires processing the elementary video stream and audio information to form video and audio information in a "presentation format." The Patent Owner further maintains that their definitions do not require "authoring" however, the Patent Owner notes that the cited prior art references admit that authoring is required for authoring a presentation format for DVD, VCD or Super VCD. The Patent Owner emphasizes that claim 1 does not require writing the presentation format to disk media, since dependent claim 7 requires "writing the video and audio information in the presentation format onto a disk media."

The Examiner first notes that the patent specification describes disk authoring as a method which adds audio information to the elementary video stream in a multiplexing process. The Examiner acknowledges that the specification discloses that disc authoring is "often" used to perform the multiplexing process. In this scenario a prior art reference which discloses of multiplexing audio and video information is maintained to support disk authoring. In view of this embodiment, the Patent Owner's argument that the cited prior arts admit that authoring is required for authoring a presentation format for DVD, VCD or Super VCD is not persuasive since the Patent Owner cites to the prior art use of disk authoring for writing to disk and not to the prior art use of disk authoring for multiplexing audio and video information.

The Examiner also notes that in light of the patent specification disk authoring is required for a presentation format. The Patent Owner argues against the prior art since they "requires" authoring; however, as set forth in for example, in col. 5, lines 32-34, the patent describes a step

in the conventional method. This step notes that disc authoring can be used to perform the multiplexing process; i.e. adding audio information to the elementary video stream".

The specification does not disclose any other requirements for "disc authoring"; however as known in the art disc authoring further includes (in a separate step) the writing of the encoded file to disc (i.e. burning). The Patent Owner's arguments are based on this step since the prior art specifically discloses that disk authoring is needed to "create" a VCD/DVD. This step, as noted in the previous office action, is not required by the independent claims.

As shown in claim 1, the claim requires "a code directed to processing the elementary video stream with audio information in the desired output media format". This claim is further narrowed by claim 9 which discloses that this is performed using a multiplexing process. It is clear from the Patent Owner's comments that "preparation of a presentation for writing to DVD or CD disc media for later playback on TV is part of disc authoring." (page 5 of Patent Owner's response to the Examiner's Non-Final Rejection).

Thus, in the context of the claims and patent specification, the Examiner maintains that "disc authoring" includes many steps include those that are part of the encoding process (preparing the presentation format) and those that are not (writing to an actual disc).

As set forth in the rejection, Cleaner 5 allows a user to select for example a VCD presentation for MPEG 1, as the presentation format. This presentation format is not written to disk during the conversional process but is instead written to disk afterward. Indeed, Cleaner 5 makes it clear that a separate application is used to write the files to disk.

The Examiner emphasizes that the MPEG-1 VCD file is an example of a presentation format of Cleaner 5 and this is the file that is written. As disclosed by Cleaner 5, since the

reference discloses of at least multiplexing the audio information with the elementary data stream, then Cleaner 5 alone (i.e. without additional applications) performs disc authoring in the same way as described in the patent specification. It is only when the presentation format file is finished does Cleaner 5 rely upon a second application to write that file to disc.

The Patent Owner further notes that claim 1 requires multiple applications (for video conversion and creating the presentation format) on a computer system; however these applications must be integrated on the computer system to meet the requirement of claim 1. The Patent Owner notes that preparing a file on one computer using one application and further processing that file using another application whether on the same or a different computer does not satisfy the claimed invention where the two applications are not integrated computer software applications.

The Examiner notes that under the Patent Owner's definition, as set forth in the ACP an integrated applications is "a collection of computer programs designed to work together to handle an application either by passing data from one to another or as components of a single system" or as "a collection of computer programs that work as a unit with a unified command structure to handle several applications, such as work processing, spread sheets, data-base management, graphics, and data communications."

The Examiner notes that it is still unclear what the Patent Owner means by "these applications must be integrated on the computer system". The Patent Owner maintains that in scenario which prepares a file on one computer using one application and further processing the file using another application on the same computer does not satisfy the claimed invention where

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the two applications are not integrated computer software applications. However based on the Patent Owner definition so long as the computer program "work as a unit" and/or "work together to handle an application", then it meets the "integrated application" definition.

IN this case the Examiner relied upon for example, Cleaner 5 which discloses of have a presentation format of VCD MPEG-1. Cleaner 5, in this example, is considered to be the first application. In a second step, Cleaner 5 discloses that if a user desire to create a Video CD they must select a specific option. As set forth on page 209 of Cleaner 5, it is disclosed "In order for MPEG streams to be accepted by Adaptec Toast to create a Video CD....check the Compatible with Toast Video CD option in the Output tab of the Advanced Settings window.

While the Examiner agrees that Adaptec Toast is a second application, both of these application "work as a unit" and/or "work together to handle an application". Cleaner 5 specification integrates specific code for handling the Adaptec Toast software and thus the two different applications are integral with each other and work together. If they did not work together, Cleaner 5 would not have provided an option to create a disc that specifies what application needs to be used.

Construction of the '655 Patent Claims Argument

The Patent Owner contends their construction is based according to their ordinary meaning and their usage in the claims and the specification. The Patent Owner further contends that the Requester ignores the manner in which the term (e.g. "output media format" and

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"presentation format") are used in the specification and simply reduce both terms to "any format" under the pretext of given them their broadest reasonable construction.

The Examiner maintains that as cited in MPEP § 2258 (I.) (G.) (During reexamination, claims are given the broadest reasonable interpretation consistent with the specification and limitations in the specification are not read into the claims (*In re Yamamoto*, 740 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984)).

As will be further described below, the Examiner maintains that the '655 patent repeatedly states "desired" or "any" output media format without any requirement that it be a specific type of format. For example, the '655 specification discloses "Preferably, the video information can be in almost any format or any format. The output video information can also be in any desired format," (col. 6, lines 18-20). This citation does not specify that it must be an optical disc format but instead that the output video information can also be "in any desired format".

In addition, the '655 specification, when referencing CD or DVD, states that these formats are "examples" and never discloses that output media format must or is required to be an optical disc format.

Construction of Output Media Format Argument

The Patent Owner contends their construction requires that an output media format is a standard video format for optical disk. The Patent Owner maintains that their construction does

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not incorporate limitations from the claims but instead is the broadest reasonable construction that includes other optical disk formats.

The Examiner maintains that the Patent Owner reads limitations from the specification into the claims. The specification never defines output media format as being an optical disc format. As can be seen from the below citations from the patent specification each recitation of DVD, VCD or SuperVCD was only cited as being exemplary.

The Examiner's interpretation of "output media format" is not limited to optical disc formats because the patent specification imposes no such limit.

As noted in the patent specification:

Many different types of video outputs also exist. Such video output types include DVD, VCD, SuperVCD, and others. (col. 2, lines 24-38).

In other embodiments, the invention allows a user to take any video information in any format and convert such video information into an outgoing format for writing onto a disk media, **e.g., CD, DVD.** (emphasis added), (col. 4, lines 14-18).

Preferably, the video information can be in almost any format or any format. The output video information can also be in any desired format, depending upon the embodiment. (col. 6, lines 18-20)

The encoding process **can** form a desired output **such as** DVD, VCD, and others. (emphasis added) (col. 6, lines 59-60).

As can be seen, the media format **can be** DVD, VCD, or Super VCD, among others. (col. 8, lines 49-50).

The Examiner notes that the specification uses terms such as "among others", "desired", such as, and for example when used in conjunction with DVD, VCD or Super VCD. The specification, contrary to the Patent Owner's assertion does not define nor show that output media format must be narrowly constructed to only include optical disc formats unless such a requirement is specifically claimed.

These statements clearly show that the optical disc formats are exemplary only and are not limited. In addition, the specification and claims broadly recite “desired” output media format. Nonetheless, as noted in the rejection of the claims, the Examiner has shown that the prior art supports both VCD and DVD formats.

The Patent Owner maintains that the construction incorporates the plain ordinary meaning of “output media format” as used in the context of the claims and specification, which discloses optical disks as the only type of media format converted by the invention.

The Patent Owner contends that “only optical disk media formats are disclosed and claimed, because the player for this media format are connected to television around the world. The patent Owner notes that no other “type” of media format has a player connected to televisions, nor does any other type of media format required identification of a TV standard for playback.

The Examiner notes first notes that other types of media formats can be played on television contrary to the Patent Owner’s erred assumption. For example, the Examiner notes that on page 205 of Cleaner 5, it is discloses of playing a DVD title based on the **MPEG-2 format**. In addition, Cleaner 5 discloses several options in which a user can select—including options for a CD or DVD (see pages 207-208).

The Examiner notes that as set forth on page 62 of Cleaner 5, it is discloses that “Cleaner 5 now encodes **MPEG-2**, which is the format used for DVD-Video. The discs can be played back on standard set-top and portable DVD players or on computers with DVD-ROM drivers.

Thus, Cleaner 5 fully discloses that its MPEG-2 format for DVD is playable on DVD players which are a format that playable on a television.

As further noted on page 209 of Cleaner, the Video CD format is a standard that plays in most DVD players. "It requires **MPEG-1 video** and special Video CD formatting."

The Patent Owner discounts MPEG-1 or MPEG-2 as an output media format, however, the Examiner maintains that the prior art shows that these formats are based on either VCD or DVD formats and in addition those formats are formatted to conform to a TV standard as set forth in the rejection and as taught by Cleaner 5.

The Examiner further notes that the Patent Owner maintains that the Examiner's construction that includes any media type renders the requirement for processing the video based on the "media format" and "TV Standard" meaningless.

The Examiner first notes that as recited in the rejection, each of the formats relied upon are disclosed to conform to a TV Standard, thus the Examiner has not relied upon a format that did not conform to a TV Standard. In addition, with respect to the Examiner's interpretation of the term which includes any media type, the Examiner notes that this is based on the specific language of the specification which in addition to using optical disc formats as possible formats, the specification leaves open the use of "any desired format". While it may be consider that the specification is narrow in one aspect, it is clearly broad in other aspects. In this case, the specification sets forth that "any desired format" can be used.

Preferably, the video information can be in almost any format or any format. The output video information can also be in any desired format, depending upon the embodiment. (col. 6, lines 18-20)

The Patent Owner further contends that a "desired" output media format requires code for potentially receiving more than one output media format connoting a choice from a plurality of output media formats

The Examiner first notes that the Patent Owner uses the word "potentially" for maintaining that desired requires more than one output media format. These term clearly sets forth that the term "desired" does not require more than one.

The Examiner agrees that the specification describes a plurality of output formats, however, the Examiner notes that it is the claims that define the invention. In this case, the claims simply do not require more than one format. Indeed, the Examiner notes that related U.S. Patent 7,843,508, the Patent Owner has clearly set forth in the claims that a "desired" output media format is "one selected from a plurality of output media formats" (see claim 1 of the '508 patent). If the Patent Owner considered the "desired" term to be understood to have a plurality of formats then the Patent Owner would not have specifically required the additional limitations in the claim.

The Examiner further notes that despite the disagreement of the scope of the claimed output media format, the Examiner has applied prior art to shows an output format of MPEG-1

for VCD or MPEG-2 for DVD. Thus, the Examiner has clearly showed that the prior art supports both DVD and VCD formats which are optical disc formats as set forth by the Patent Owner.

The Examiner notes that the Patent Owner maintains that their construction is consistent with the specification because it is not limited to DVD, VCD and Super VCD but also includes other media formats such as HD DVD or Blu-ray¹ since these are consistent with the disclosure of the specification for wiring to disk mead and formatting consistent with a TV standard.

The Examiner notes that the Patent Owner implies that an output media format further requires that it be "written to disk media" and formatting consistent with a TV standard. The Examiner maintains that the Patent Owner is clearly requiring further limitations from the specification which are not required by the claimed "output media format". While the specification describes various TV standards and having files written to disk, this is not a requirement for the term "output media format".

Construction of the Presentation Format Argument

The Patent Owner contends that the Examiner's construction literally removes "presentation" from the claim and rewrites the claim language to mean "any format based upon a desired output media format and desired TV standard.

¹ The Examiner notes that as acknowledged by the Patent Owner on page 6 of their response. HD DVD and Blu-ray are not recited in their specification. The Examiner notes that while these are optical disk formats, they are not the same type of format as VCD or DVD since HD-DVD and Blu-ray would not be playable on the same type of players as a DVD player. The '655 patent specification does not provide written description support for these types of formats. Nonetheless, these formats are not claimed and thus are not germane to any pending issue.

The Examiner disagrees and maintains that the phrase "presentation" format is not read out of the claim. Instead the presentation format is a format that is based upon a desired output media format and desired TV standard. The Examiner maintains that the claim defines the requirements for a presentation format as being based on those at least these requirements. The Examiner disputed the Patent Owner argument that presentation format required a format for writing video and audio information to an optical disc since the claim does not have this requirement.

Indeed, the Patent Owner is fully aware of how to specifically claim a presentation format that is based on an optical disk format. As noted in related U.S. Patent 7,843,508, the Patent Owner has set forth a claim in which it was clear that the presentation format is based on a specific format for writing video and audio information to an optical disk (see claim 1). The current patent under reexamination does not share the same requirement and thus cannot be interpreted as narrow but instead must be interpreted under the broadest reasonable interpretation.

The Patent Owner contends "presentation format" is "a format in which data can be easily displayed on an output device...Data stored according to a presentation format is sometimes referred to as presentation format."

The examiner agrees with this citation and notes that this citation says nothing about a requirement of "optical disk" While the Examiner agrees that with certain teachings of the specification, for example that presentation format can be played on a player for the desired media format, the claims plainly do not have this requirement. The Patent Owner has shown that

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a presentation format under the broadest reasonable interpretation is defined as a format in which data can be easily displayed on an output device. There is no other requirement under the broadest reasonable interpretation standard.

The Patent Owner notes that dependent claim 8 requires the presentation format to be selected from the group consisting of VOB (video object for DVD), VCD MPEG1 and Super VCD MPEG2. The Patent Owner notes that their construction of presentation format is the same format written to disk media in claim 7.

The Examiner agrees. Indeed, as noted in the rejection of the claim, the Examiner has likewise shown that the prior art anticipates this limitation by showing that VCD MPEG1 is written to disk using disk authoring software.

The Examiner also agrees that the Patent Owner's construction of presentation format makes logical sense, however, the Patent Owner is not considering that the claims must be interpreted under the broadest reasonable interpretation. While the specification describes presentation format in accordance with DVD, VCD and SVCD and the NTSC and PAP standards, this is not a requirement in claim 1. The Examiner agrees that the dependent claims specify these requirements and the Examiner has treated those claims accordingly, however, the Examiner maintains that the broadest reasonable interpretation of "presentation format" does not require those formats unless they are specifically claimed.

The Patent Owner argues that the presentation format for writing audio and video prepared in a presentation format corresponds to the .vob, .dat and .mpg files for DVD, VCD and SVCD respectively. The Patent Owner notes that these files are written to disk media in the appropriate directories of DVD, VCD and SVCD and are the same files that are played back in players for the desired media format using the desired TV standard.

The Examiner notes that the claim does not recite any requirement of a ".dat" file. Nonetheless, assuming *arguendo* that ".dat" files, ".vob" files and ".mpg" files are the formats for VCD, DVD and SVCD respectively, the Examiner notes that since this is the known standard then since Cleaner 5 discloses of at least VCD and DVD standards and the using a CD-mastering application to at least write VCDs to disc, then Cleaner 5 supports ".dat" files for VCD since this would have been required as noted by the Patent Owner.

The Examiner maintains that the proper interpretation of "presentation format" must be considered in view of the actual claim language. As set forth above, the claim merely requires that a presentation format be based on at least the desired output media format and TV standard. The Patent Owner interpretation goes beyond what is claimed by reading limitations from the specification into the claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Issue 1 (Adopted and Maintained)

7. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Cleaner 5.

Regarding claim 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 (Digital Video) to an outgoing MPEG-1 or MPEG-2 stream, (Cleaner 5 at pp. 141,206). As shown on page 141, Cleaner 5 lists the supported formats that can be read and written. Page 206 discloses how one would select the outgoing format using a software based pop-up menu.

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. Capturing Video pg. 5; Capturing with MotoDV pg. 8 and 141).

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 and 205). In addition, as stated on page 206, while pertaining to images, Cleaner clearly discloses that "You can choose whether you want to make an NTSC-compatible or a PAL-compatible stream". Thus, Cleaner 5 discloses that a user can be an input (second input) to select a destined TV standard.

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 YUV², (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). The Examiner notes that by selecting the desired output format the raw video information would be resized in accordance with the selected desired output format.

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 - Stream Type).

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

² The Examiner notes that the '655 Huang Patent discloses that YUV is a known raw video information in

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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).

Regarding claim 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 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). Page 141 lists the supported formats.

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

Regarding claim 4:

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

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

Regarding claim 5:

an uncompressed format, (col. 3, lines 2-5).

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 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 project," (Cleaner 5 at p. 209).

Regarding claim 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 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).

Regarding claim 7:

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

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

Regarding claim 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 writing the video and audio information in the presentation format onto a disc 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 and 209).

Regarding claim 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 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).

Regarding claim 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 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).

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

Regarding claim 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 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).

Regarding claim 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 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).

Regarding claim 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 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).

Regarding claim 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 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

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the Preferences dialog that allow you to choose between higher quality or faster decoding," (Cleaner 5 at p. 138).

Regarding claim 16:

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

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).

Regarding claim 17:

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

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).

Regarding claim 18:

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

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).

Response to Arguments

The Patent Owner contends that Cleaner 5 does not disclose an integrated computer software application for converting and processing audio and video information to form a presentation format.

The Examiner notes that the Patent Owner disputes the teaching of Cleaner 5 because it does not "integrate" the all of the programs, however, the Examiner notes that the Cleaner 5 software alone is able to take an input format and converted that format to MPEG1 for VCD. It is only when a user wishes to write that VCD files onto disk is a separate application needed. In the context of claim 1, however, the writing of files to disk is not claimed. In addition, as set forth above, Cleaner 5 specifically discloses of code which specifically list what application it will work with and thus under the Patent Owner's definition of "integrated"; the Examiner maintains that Cleaner 5 is an integrated computer software application since it has several applications that integrally work together to form a presentation format.

A code directed to receiving a desired output media format based upon a first input
Argument

The Patent Owner notes that the Examiner states that Cleaner 5 discloses a user "can easily produce MPEG-1 file for Video CD projects by selecting the Video CD present in the Advanced Settings window."

The Patent Owner maintains that Cleaner 5 can only receive one output media format at best, which can't be a "desired" output media format since it is required as the only available output media format Cleaner 5 could possible input.

The Examiner first notes that the term "desired" does not require more than one choice since a user's desire may be limited to only one choice.

The Patent Owner further contends that an MPEG-1 or MPEG-2 file is not a "desired output media format".

The Examiner notes that this argument is based on the fact that the Patent Owner is improperly reading limitation into the claim which is not claimed. Specifically the Patent Owner does not agree that MPEG-1 or MPEG-2 is not an output media format because it is not an optical disc format. However, this is not required by the claim language.

Nonetheless, as noted by Cleaner, a user "can easily produce MPEG-1 files for Video CD projects by selecting the Video CD preset in the Advanced Settings window." In addition, Cleaner 5 also discloses that MPEG-2 files are for the DVD output media format.

Cleaner 5 discloses that a user can select at least the VCD option. The VCD format is an optical disc format as acknowledged by the Patent Owner.

The Examiner notes that assuming *arguendo* that an optical disk format must be selected, the Examiner has shown that Cleaner 5 allows a user to select MPEG-1 for VCD. In addition, as disclosed by Cleaner MPEG-2 is for DVD format. Thus, selecting MPEG-1 or MPEG-2 reads on

the Patent Owner construction of output media format. The Examiner again points out that dependent claim 8 specifically notes that the presentation format includes MPEG-2 and MPEG-1. The presentation format as claimed is based on the desired output media format. In Examiner rejection of the claims, it was considered that MPEG-1 is based on the desired output media format of VCD.

The Requester agrees and notes that “desired” does not connote a plurality. The Requester notes that by definition “desire” means “yearned or wished for; coveted or deemed correct or proper; selected; required”.

In addition, the Requester maintains that even if the claim were to require that the output media format be an optical disk, it would not require that the output media format be an optical disk. It would only require that the output media format be a standard video format for optical disk.

In addition, as the Examiner noted above, the Requester also notes that Cleaner 5 teaches (page 209) that a standard video format for an optical disk can be selected and provides at least two (a plurality) options: MPEG-1 and MPEG-2. Accordingly, even if the claim were to require that an output media format be one of a plurality of standard video formats for optical disk, the claim cannot be considered patentable over the teachings of Cleaner 5 since Cleaner 5 teaches that MPEG-1 or MPEG-2 can be selected.

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 Argument

The Patent Owner maintains that this limitations is not met since MPEG-2 is not a desired output media format and Cleaner 5 does not have code direct to resizing video based on “a desired output media format and desired TV standard.”

The Examiner disagrees and notes that MPEG-2 is a desired output media format since in Cleaner 5 MPEG-2 is based on DVD. Indeed, even claim 8 recites that the presentation format which is based on the output media format can be SVCD MPEG2.

In addition, the Examiner points out that MPEG-1 as disclosed by Cleaner 5 is directly related to a VCD format (since a user can select MPEG-1 file for Video CD - page 209 of Cleaner 5).

In addition, as per the “desired TV standard” the Examiner notes that Cleaner 5 allows a user to select between NTSC and PAL. The Examiner finds the Patent Owner’s arguments confusing since Cleaner 5 specifically discloses of having a user make this selection.

As further noted in Cleaner 5, the reference discloses how MPEG-2 (which is the format for DVD-Video) is stored at a resolution of 720x480 pixels (NTSC) or 720x576 (PAL), (page 204 of Cleaner). Thus, Cleaner 5 would resize the raw video into the size e.g. 720x480 associated with the desired media output (which in this case is DVD-video) and the desired TV standard (e.g. NTSC).

With respect to MPEG-1, as noted above, Cleaner 5 discloses that the standard MPEG-1 size image is 352x240, NTSC, (page 203). Thus, Cleaner 5 will resize the raw video into the size of 352x240 associated with the desired media output of VCD and the desired TV standard NTSC.

Likewise the Requester maintains that an MPEG file does fall within the broadest reasonable interpretation of the term output media format. Even under a narrower interpretation of output media wherein the output media must be an optical disk, an MPEG file is a format associated with VCD and DVD.

Code directed to processing the elementary stream with audio information in the desired output media format and the desired TV standard to from video and audio information in a presentation format based upon the desired output media format and the desired TV standard.

The Patent Owner contends that Cleaner 5 does not process audio and video information “to form a presentation format based on a desired output media format and desired TV standard” The Patent Owner notes that MPEG-1 streams or files, even with video and audio in the size and frame rate associated with an output media format and TV standard, are not in a “presentation format” because they are not in the format written to disk media.

The Examiner finds this statement confusing since claim 8 states that the presentation format is VCD MPEG-1. This format is the same format as disclosed on page 209 of Cleaner 5 which discloses that a user can select the VCD MPEG-1 option to encode the input file as a VCD files. This same file is the file that is used in conjunction with disk authoring software to write the file to disk. The examiner has repeatedly explained that as noted in the prior art and in the patent under reexamination that MPEG-1 is the presentation format for the output media of

VCD. The claims support the Examiner's interpretation because claim 8 recites that the presentation format is VCD MPEG-1 which is indeed based on the output media format of VCD.

The Examiner thus finds the Patent Owner's argument to be contrary to the claims at issue and further in contrast to their parent specification which supports MPEG-1 for VCD as a presentation format.

In addition, the Examiner notes that in the creation of the VCD file in Cleaner 5, additional programs are not needed as asserted by the Patent Owner. Cleaner 5 is able to encode the file as a VCD file. It is only when a user want to actually desires to write this file to disc is an additional application needed. However, at this point the presentation format is already made by Cleaner 5 prior to any secondary application being used.

In addition, the Requester maintains the '655 patent never defines the presentation format as the format written to an optical disk such that an optical disk player would be able to play the video. Rather the presentation format is based on the output media format and the desired TV standard. Accordingly, at best, the '655 patent discloses a relationship between the output media format and the presentation format.

In addition, Cleaner 5 discloses that it can output an MPEG-1 file modified for Video CD. Such a modified MPEG file is the "presentation format" as interpreted by the Patent Owner because in the instance of VCD, the modified MPEG file is written to the VCD and is recognized by a player.

Regarding claim 5:

The Patent Owner contends that VCD is the only alleged preset, and therefore cannot be a “desired output media format” since “desired” requires a plurality of media formats.

The Examiner disagrees and notes that Cleaner 5 disclose of by VCD and DVD formats. While DVD is not described with respect to the preset option, the DVD option would be supported since Cleaner 5 specifically discloses that a user can have DVD projects.

In addition, even considering only the VCD preset option, the Examiner maintains that “desired” does not entail a plurality of media formats since a user may have only one desire. There is no requirement for multiple desires in the independent claim.

The Examiner maintains that Cleaner 5 discloses at least DVD and VCD output media formats that may be pre-selected. . In addition, the Examiner, as noted below and in the rejection, as provided an alternative rejection in which including additional output media was known in the art.

The Requester likewise notes that Cleaner 5 discloses that video and audio files can be output for use in creating DVD's as well as Video CDs. Cleaner 5 discloses that a user can select to output an MPEG-2 file for the purpose of creating a DVD. The MPEG-2 output can further be formatted so that it can easily be authored onto a DVD by a DVD authoring program. As claim 1 does not require authoring to a DVD, Cleaner 5 discloses selecting a output media format, either MPEG-1 specially formatted for Video CD or MPEG-2 formatted with a DVD specifically considered. Cleaner 5 continues to anticipate even under the Patent Owner's interpretation of the claim that improperly requires reading limitations from the specification into the claim.

Claim 6 Arguments

The Patent Owner contends the Examiner has not pointed out a DVD output media format. The Examiner disagrees.

Cleaner 5 specifically discloses that a user can create DVD projects. For example, on page 205, Cleaner 5 discloses of using the MPEG-2 format for DVD for playing a movie. In addition, as further disclosed on page 205 of Cleaner, a user can choose an MPEG setting and can specifically use the Output tab which allows a user to select between MPEG-1 and MPEG-2 streams.

In addition, as noted by the Requester, the claims do not specify the program must accept a selection of a menu items specifically reciting "DVD." Rather the claim language will allow for selection of an MPEG-2 output, which is related to DVD, and accordingly the output media format could be DVD.

Claim 7 Arguments:

The Patent Owner contends the Examiner does not point to any disclosure showing Cleaner 5 can write the format for VCD or any other format for presenting video and audio based on a desired output media format or TV standard standard.

The Examiner notes that the Patent Owner contradicts themselves since the Patent Owner acknowledges that Cleaner 5 discloses a CD-mastering application (page 22 of the Patent Owner's response).

The Examiner further maintains that the Cleaner 5 reference specifically discloses of writing the MPEG-1 for VCD format to disc and specifically disclosed on page 209 of Cleaner 5.

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Cleaner 5 discloses that the MPEG-1 for VCD files can be authored (i.e. written) onto disc using the Easy-CD Creator or Adaptec Toast application.

In addition, as noted by the Requester, 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). Additionally, the Cleaner 5 manual states "To author Video CDs, you'll also need a CD- mastering application, such as Adaptec Toast or Easy-CD creator," (Cleaner 5 at p. 209). While Cleaner 5 (the software application) alone cannot create VCDs that are playable on a media player that reads VCD formatted optical discs, Cleaner 5 (the reference) very clearly discloses that Cleaner 5 can write the video and audio information to a disc media or Cleaner 5 can be used in conjunction with another program to write the information to an optical disc playable by a media player.

Claim 8 Arguments:

The Patent Owner notes that construing presentation format to include MPEG-1 files is unreasonable and contrary to the ordinary meaning of the term since MPEG-1 file cannot be played on a TV.

The Examiner first notes that claim 8 specifically recites that the presentation format can be VCD MPEG-1, thus, the Patent Owner's argument are contrary to their patent disclosure and the current claims which note that MPEG-1 for VCD can be displayed on a television.

In addition, the Examiner notes that as set forth on page 62 of Cleaner 5, it discloses that "Cleaner 5 now encodes MPEG-2, which is the format used for DVD-Video. The discs can be played back on standard set-top and portable DVD players or on computers with DVD-ROM

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drivers. Thus, Cleaner 5 fully discloses that its MPEG-2 format for DVD is playable on DVD players which are a format that playable on a television. As is known, DVD players as a standard set-top box are connected to television sets.

The Patent Owner argues that the presentation format for writing audio and video presentation data to a VCD is described as a ".dat" file that contains MPEG-1 audio and video. The Examiner notes that the claim does not recite any requirement of a ".dat" file. Nonetheless, assuming *arguendo* that ".dat" files, ".vob" files and ".mpg" files are the formats for VCD, DVD and SVCD respectively, the Examiner notes that since this is the known standard then since Cleaner 5 discloses of at least VCD and DVD standards and the using a CD-mastering application to at least write VCDs to disc, then Cleaner 5 supports ".dat" files for VCD since this would have been required as noted by the Patent Owner.

Likewise, the Requester emphasizes that Cleaner 5 states that one can "produce MPEG-1 files for your Video CD projects in Cleaner by selecting the Video CD preset in the Advance Settings Window," (Cleaner 5 at p. 209). The Patent Owner argues Cleaner 5 does not cover claim 8 because MPEG-1 streams are not presentation formats. However, as discussed with reference to claim 1 above, the claims do not recite authoring as a requirement and thus, under the broadest reasonable interpretation, the presentation format is not required to be in a format for an optical disk. Further, also discussed above, MPEG-1 files modified for Video CD, as disclosed in Cleaner 5 are the presentation format for VCD, which is a format for an optical disk, and accordingly Cleaner 5 meets even this improper construction of the claim

Regarding claim 10:

The Patent Owner contends that Cleaner 4 does not have code for receiving a desired output media format.

The Examiner notes that is statement is based on the Patent Owner same flawed argument that MPEG-1 is not an output media format. However, as noted above Cleaner 5 discloses that MPEG-1 is for VCD and specifically encodes the files to be in MPEG1 VCD format. This is the same format that is disclosed in the '655 patents specification and further specification claimed in claim 8.

In addition as noted by the Requester and Cleaner 5 at pg. 95, Cleaner's audio optimization applies to "all the supported output formats".

Regarding claim 18:

The Patent Owner contends that Cleaner 5 does not disclose all of the elements of claim 1 in multiple integrated applications or in a single integrated application.

The Examiner disagrees and notes that Cleaner 5 shows a single integrated application for encoding the input file in at least MPEG1 for VCD. Cleaner 5 only discusses using a secondary application for writing the MPEG1 for VCD file to disk. This step, however, is not required in claim 1 or claim 18.

In addition, assuming *arguendo* that such a step was required, as set forth above, the Examiner notes that under the Patent Owner's definition, as set forth in the ACP an integrated applications is "a collection of computer programs designed to work together to handle an application either by passing data from one to another or as components of a single system" or as "a collection of computer programs that work as a unit with a unified command structure to

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handle several applications, such as work processing, spread sheets, data-base management, graphics, and data communications.”

In this case the Examiner relied upon for example, Cleaner 5 which discloses of have a presentation format of VCD MPEG-1. Cleaner 5, in this example, is considered to be the first application. In a second step, Cleaner 5 discloses that if a user desire to create a Video CD they must select a specific option. As set forth on page 209 of Cleaner 5, it is disclosed “In order for MPEG streams to be accepted by Adaptec Toast to create a Video CD....check the Compatible with Toast Video CD option in the Output tab of the Advanced Settings window.

While the Examiner agrees that Adaptec Toast is a second application, both of these application “work as a unit” and/or “work together to handle an application”. Cleaner 5 specification integrates specific code for handling the Adaptec Toast software and thus the two different applications are integral with each other and work together. If they did not work together, Cleaner 5 would not have provided an option to create a disc that specifies what application needs to be used.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Issue 2 (Adopted)

9. Claims 5, 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cleaner 5 in view of MPEG Charger.

The Examiner notes that this rejection was proposed in addition to the rejection to claims 5, 6 and 8 to Cleaner 5 alone.

The Examiner acknowledges that as per MPEP 2660, III, "it is to be noted that the examiner is not to refuse to adopt a rejection properly proposed by the requester as being cumulative to other rejections applied. Rather, any such proposed rejection must be adopted to preserve parties' appeal rights as to such proposed rejections."

The Examiner maintains that Cleaner 5 anticipates the claims, however in addition, the Examiner acknowledges the below teachings with respect to MPEG Charger. As noted in the Request, 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. 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.

The Examiner notes 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

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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.

Regarding claim 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 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.

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.

Regarding claim 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 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

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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.

Regarding claim 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 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).

Response to Arguments

Claim 5 Arguments

The Patent Owner contends MPEG Charger does not disclose a DVD output media format. The Patent Owner notes that the only preset cited by Examiner is for VCD and MPEG Charger does not disclose what Cleaner 5 is missing.

The Examiner first notes that MPEG Charger (like Cleaner 5) specifically discloses of DVD as an output. As noted under the MPEG Charger section (under Overview), MPEG Charger "gives you comprehensive control over both MPEG-1 and MPEG-2 encoding. Because it integrates seamlessly with Cleaner 5, you can easily customize your MPEG settings".

In addition, the Examiner acknowledges that Cleaner 5 only specifically discloses a preset for VCD; however, as explained above, Cleaner 5 also discloses that a user can create DVD movies that are playable on a player, thus, Cleaner 5 supports a preset for DVD. MPEG Charger supplements Cleaner 5 since MPEG Charger provides further support for DVD. IN addition, as noted by MPEG Charger, Cleaner 5 allows a user to select the VCD format and the conversion process would provided "special Video CD formatting" so that the MPEG file can be written to disk (page 12 of MPEG Charger).

In addition, as noted by the Requester citing to MPEG Charger at page. 10, MPEG Charger discloses the ability to create MPEG-2 files which is the format used for DVD playback. It was noted that MPEG-2 is used for commercial DVDs (DVD-Video). In addition, MPEG-2 is full frame rate (24-30fps) and full-screen resolution (720x480, NTSC).

In addition, it was noted that MPEG Charger discloses a variety of quality settings for DVD.

MPEG Charger offers feature enhancements not included in Cleaner 5, including support for:

- Both 1-pass and 2-pass variable bitrate encoding for both MPEG-1 and MPEG-2.
- Custom video buffer verifier sizes.
- Custom Group of Pictures (GOP) sizes.
- Open or closed GOPs.
- All standard MPEG frame sizes and frame rates
- Both 4:2:2 and 4:2:0 chromas for MPEG-2 streams

Claim 6 Arguments

The Patent Owner repeats that MPEG Charger does not provide DVD as a desired output media format.

The Examiner disagrees and notes, as stated by the Requester, that the claims do not specify that the program must accept a selection of a menu item specifically reciting "DVD." Rather the claim language will allow for selection of an MPEG-2 output, which is related to DVD, and accordingly the output media format could be DVD.

Additionally, the Cleaner 5 reference specifically states that MPEG Charger can be combined with Cleaner 5, rendering this claim obvious. MPEG Charger is a companion application specifically for use with Cleaner 5. MPEG Charger discloses the ability to create MPEG-2 files, which is the format used for DVD playback and accordingly, selecting MPEG-2 output meets the claim limitations related to DVD. See MPEG Charger at p. 10.

Claim 8 Arguments

The Patent Owner contends that Cleaner 5 with MPEG Charger still can't process video and audio information to form video and audio information in a presentation format, and that MPEG Charger does not disclose preparing a .vob files, .dat files or .mpg file as specified by the DVD, VCD and SVCD standards.

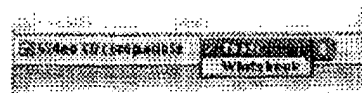
The Examiner disagrees and notes that MPEG Charger is a companion application specifically for use with Cleaner 5. MPEG Charger provides additional disclosure regarding the use of the Adaptec Toast Application, which is used to author video CDs:

Making Video CDs

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.

Adaptec Toast support for Video CD (Mac OS only)

In order for MPEG streams to be accepted by Adaptec Toast to create a Video CD, certain non-standard information must be added to the MPEG file. To make files intended for inclusion on a Video CD being authored with Toast, check the **Video CD compatible** option in the Output tab of the Advanced Settings window and choose Toast in the pop-up menu. See the Toast documentation for authoring instructions.



Making MPEG streams for use with Adaptec Toast.

In addition, under the MPEG Charger Options section of MPEG Charger, it is disclosed that MPEG files usually use a file suffix of ".mpg". thus, Cleaner 5 along with MPEG Charger meet the claim language. As noted above, The Examiner notes that assuming *arguendo* that ".dat" files, ".vob" files and ".mpg" files are the formats for VCD, DVD and SVCD respectively, the Examiner notes that since this is the known standard then since Cleaner 5 discloses of at least VCD and DVD standards and the using a CD-mastering application to at least write VCDs to

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disk, then Cleaner 5 supports “.dat” files for VCD since this would have been required as noted by the Patent Owner.

Issue 3 (Not Adopted)

10. The rejection of claims 1-3, 5, 7, 9 and 13-18 as being rejected under 35 U.S.C. 103(a) as being unpatentable over AVID Xpress in view of AVID Xpress DV is not adopted.

As set forth in the previous Non-Final Rejection and Action Closing Prosecution Office

Actions:

As stated in the Request **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).

In addition, as stated in the Request **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.

The **Examiner** maintains that while Avid Xpress discloses of providing software for converting and editing video and audio files, Avid Xpress does not disclose in detail any of the

steps or code for performing at least the recited converting steps. Thus, neither Avid Xpress nor Avid Express DV either alone or in combination meet all of the claimed limitations.

The Examiner agrees that Avid Xpress is a software system for converting and editing video and multimedia content quickly, (Avid Xpress at p. 1). Additionally, as noted above, the Examiner agrees that 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).

The Examiner agrees that both references disclose of code to receive video in many different formats and for outputting video into broadcast digital formats, (Avid Xpress at p. 1).

The Examiner notes that the Request fails to specifically point out where in the references does it show that the video information in the first format is converted to "raw video information [in] an uncompressed format using a decoding process".

The Request merely states:

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.

There is no support for converting the video information to raw video information.

The Examiner acknowledges that the Request further points to the following in Avid Xpress:

"Truest Online Image Quality Avid Xpress supports ITU R-601 broadcast industry standards for the truest online image quality. For the first time in its category, uncompressed video is available as an option for Avid Xpress Deluxe and Elite systems for the best possible video quality. All Avid Xpress systems using Avid's state-of-the-art Meridien video subsystem deliver broadcast quality 2:1 image compression, as well as a range of other resolutions in either 4:3 or 16:9 wide screen. No other digital video system in its class combines unmatched speed and productivity features with the highest image standards." Avid Xpress at p. 1.

"Single-Stream Uncompressed Video Option (Deluxe and Elite Bundle only) A single stream of uncompressed video allows the best possible image quality for high-end projects." Avid Xpress at p. 2.

The Examiner acknowledges that Avid Xpress uses uncompressed video, however no relationship between this uncompressed video and the received video information has been made. The claim requires a code directed to converting the video information in the first format to a raw video information [in] an uncompressed format using a decoding process.

The next limitation pertains to resizing the raw video information (i.e. the raw video information that resulted from the previous converting step) into a size associated with the desired output media format.

The Request merely shows that Avid Xpress is able to output video with various sizes, however, the Request's statements are conclusory and are not specific as to how Avid Xpress resizes or converts the received data.

The claim also outlines specific step that recites code for resizing the raw information in the uncompressed format into a size associated with the desired output media format and the desire TV standard.

The Examiner agrees that Avid Xpress discloses of various TV Standards and different output media with various 'sizes', however, the Avid Xpress reference does not disclose what video is being output or whether what is being output was a result of a converting step which converted video information in a first format to raw video information in an uncompressed format.

The claims further recited limitations directed to process the uncompressed format into "an elementary video stream". The Request discloses that since Avid Xpress DV includes code directed to exporting files in the MPEG format, then Avid Xpress DV inherently processes the uncompressed format into an elementary stream".

The Request relies upon MPEG Standard to support the processing of video into an elementary video stream; however, the Examiner first notes that the Request does not show how Avid Xpress discloses of creating the uncompressed video stream from the received video information and while elementary stream were known in the art, the Request did not point out how MPEG Standard contemplates the converting of video information to raw video information

in an uncompressed format and the processing of that same video information in the raw uncompressed format into an elementary video stream.

The Examiner does not agree that Avid Xpress in view of Avid Xpress DV renders obvious any of the claims under reexamination and thus the proposed rejection will not be adopted by the Examiner.

Response to Argument

No Arguments were presented thus the Examiner's position is maintained.

Conclusion

This is a RIGHT OF APPEAL NOTICE (RAN); see MPEP § 2673.02 and § 2674. The decision in this Office action as to the patentability or unpatentability of any original patent claim, any proposed amended claim and any new claim in this proceeding is a FINAL DECISION.

No amendment can be made in response to the Right of Appeal Notice in an *inter partes* reexamination. 37 CFR 1.953(c). Further, no affidavit or other evidence can be submitted in an *inter partes* reexamination proceeding after the right of appeal notice, except as provided in 37 CFR 1.981 or as permitted by 37 CFR 41.77(b)(1). 37 CFR 1.116(f).

Each party has a **thirty-day or one-month time period, whichever is longer**, to file a notice of appeal. The patent owner may appeal to the Board of Patent Appeals and Interferences with respect to any decision adverse to the patentability of any original or proposed amended or new

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claim of the patent by filing a notice of appeal and paying the fee set forth in 37 CFR 41.20(b)(1). The third party requester may appeal to the Board of Patent Appeals and Interferences with respect to any decision favorable to the patentability of any original or proposed amended or new claim of the patent by filing a notice of appeal and paying the fee set forth in 37 CFR 41.20(b)(1).

In addition, a patent owner who has not filed a notice of appeal may file a notice of cross appeal within **fourteen days of service** of a third party requester's timely filed notice of appeal and pay the fee set forth in 37 CFR 41.20(b)(1). A third party requester who has not filed a notice of appeal may file a **notice of cross appeal within fourteen days of service** of a patent owner's timely filed notice of appeal and pay the fee set forth in 37 CFR 41.20(b)(1).

Any appeal in this proceeding must identify the claim(s) appealed, and must be signed by the patent owner (for a patent owner appeal) or the third party requester (for a third party requester appeal), or their duly authorized attorney or agent.

Any party that does not file a timely notice of appeal or a timely notice of cross appeal will lose the right to appeal from any decision adverse to that party, but will not lose the right to file a respondent brief and fee where it is appropriate for that party to do so. If no party files a timely appeal, the reexamination prosecution will be terminated, and the Director will proceed to issue and publish a certificate under 37 CFR 1.997 in accordance with this Office action.

11. All correspondence relating to this *inter partes* reexamination proceeding should be directed:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

By Mail to: Mail Stop Inter Partes Reexam

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Attn: Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the data of transmission, which is prior to the expiration of the set period of time in the Office action.

Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

/Ovidio Escalante/
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Conferee: /r.g.f./

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