

EXHIBIT 8

Inventor: Qiang Huang

Patent No.: 7,009,655 B2

Reexamination Control No.: 95/001,284

Filed: December 18, 2009

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

Confirmation No.: 1850

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:

**AMPACC Law Group, PLLC
6100 219th Street SW, Suite 580
Mountlake Terrace, WA 98043**

Dated: May 31, 2011

Respectfully submitted,

/Lance A. Smith/

Lance A. Smith
Novak, Druce and Quigg LLP
Phone: (415) 814-6161

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Qiang Huang

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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.

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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 §120 benefit of U.S. Patent No. 7,009,655 (the ‘655 patent, which is the subject of the *inter partes* reexamination control no. 95/001,284 the present *inter partes* reexamination proceeding (“the ‘1284 proceeding”). The ‘172 patent is the subject of control no. 95/001,283, 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 to the extent that no claim amendment has been entered in this proceeding, but notes that Appellant proposed to amend independent claim 1 after the Action Closing Prosecution.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Respondent rejects Appellant/Owner’s summary of the subject matter of claims 1-18 as being inaccurate. Respondent notes that the claims do not limit the desired output media format to being one of a *plurality* of standard video formats. Further, at least the independent claims do not limit the desired output media format to optical disk media. Finally, at least the independent claims do not specify that the presentation format is 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 '655 patent are limited to low cost systems for converting video to DVD optical disks. Only claim 6 is limited to DVD as a particular output media format. The claims of the '655 patent are not limited to capturing, converting, editing and authoring videos in inexpensive or technologically simple ways. Parameters such as cost or simplicity of technology are not found in the '655 claims. The '655 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 and specific claim rejections. Respondent will thereafter show that the prior art clearly anticipates claims 1-18 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 '655 specification and claims under the broadest reasonable construction.

B. The Examiner Correctly Rejected Claims 1-4, 9 and 12-18 as Anticipated Under 35 U.S.C. §102(b) because the Cleaner 5 User Manual ("C5M") Teaches All of the Argued Limitations of Claim 1

1. Introduction

¹ *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)); *In re Suitco Surface, Inc.*, 603 F.3d 1255, 161 (Fed. Cir. 2010).

The '655 patent includes only one independent claim. Appellant has not provided separate arguments for the patentability of dependent claims 2-4, 9, 10 and 12-18. Therefore, claims 1, 2-4, 9, 10 and 12-18 stand or fall as a group pursuant to the fourth and sixth sentences of §41.67(c)(1)(vii). Appellant argues only dependent claims 5-8, 10 and 11 separately from claim 1.

Many of the arguments that a reference lacks certain 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 software, 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 operates to receive a video file and output the video file in a converted format based on a variety of user supplied characteristics such as media format information, television standard information, aspect ratio, frame rate and frequency. (Id., pp. 5, 8, 204, 205, 207, 209, and 212) Incoming video files are first converted into an uncompressed raw video format, such as YUV. (Id., p. 138) Additional 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 these functions 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 functions provided by the codes in Cleaner and in Adaptec Toast, C5M also discusses the use of MPEG Charger software together with Cleaner. As C5M describes, when installed together on a computer system, Cleaner, MPEG Charger and Adaptec Toast are

integrated and they include codes that perform all functions recited in claims 1-18 of the '655 patent. One of ordinary skill in the art would understand how to draft the code to perform the functions described in the C5M and Charger manuals.

3. C5M discloses “an integrated computer software application.”

Appellant/Owner contends that C5M does not anticipate claim 1 because it does not disclose “an integrated computer software application,” as recited in the preamble of independent claim 1. Appellant contends that Cleaner requires a second software application that is “non-integrated” to provide optical disk authoring for writing processed video/audio. (Brief, pp. 5-9) Appellant also contends that the Examiner has ignored his own claim constructions in erroneously maintaining this rejection. Respondent disputes these contentions, because Appellant's contentions are premised on an overly narrow construction of “an integrated computer software application” and on reading a limitation into claim 1 that simply is not there. Appellant contends that “an integrated computer software application” means “software designed to operate or function as a single application, unit or system for handling multiple functions previously found in different software products, usually under the control of one common program.” (Brief, p. 8, emphasis added.) Respondent disputes this contention because the newly proposed construction is not the broadest reasonable interpretation, and because even if so construed, the claim is anticipated.

In litigation, Appellant/Owner proposed “computer codes or instructions that are compatible and interoperate” as the proper construction for “integrated computer software application.” The court did not adopt this construction, because it was deemed to be overly broad, and could be misunderstood by a jury. (Brief, Exhibit 43, page 9) The Examiner, who is required to adopt the broadest reasonable construction of claim limitations, and who is experienced enough in the relevant technology to avoid “confusion,” adopted that claim construction in this reexamination proceeding. (ACP, pp. 6-7) The Examiner also cited a dictionary definition furnished by Appellant as a basis for the Examiner's adopting the proposed claim construction. (Id.) Ultimately, the Examiner concluded that “based on the Patent Owner definition so long as the computer program (*sic*, programs) ‘work as a unit’ and/or ‘work together to handle an application,’ then it meets the ‘integrated application’ definition.” (RAN, pp. 6 and 7)

Although Appellant argues that the Examiner has ignored that claim construction after having adopted it, (Brief, pp. 8-9), this is not the case. As pointed out in the paragraph immediately above, the Examiner has not ignored the adopted construction of “integrated computer software application.” Instead, under the broadest reasonable interpretation, the Examiner has properly construed that phrase and applied that construction. Properly construed, “integrated computer software application” encompasses multiple software programs on a computer system that work in concert. Therefore, even if claim 1 required writing the processed video information to disk media, which it does not, C5M in fact teaches writing to optical disk media as a component in an integrated software application.

C5M specifically discloses that the Cleaner program “integrates seamlessly” with Cleaner MPEG Charger, (“Charger”). (C5M, p. 209) C5M also discloses that Cleaner includes a check box that will add certain non-standard information to an MPEG-1 file intended for processing by Adaptec Toast, (*i.e.*, to integrate Cleaner with Adaptec Toast for writing a Video CD). (Id.) The internal references to Charger and Adaptec Toast in C5M are not mere mentions of other software that perform functions that Cleaner does not. (Brief, p. 6) Those references instead inform the user of the availability of additional software that will function together with the Cleaner 5 software when loaded on a computer system. Accordingly these software programs, when installed together on a computer system, together constitute “an integrated software application” because they comprise “computer codes or instructions that are compatible and interoperate.”

When Appellant argues that “integrated computer software application” means “software designed to operate or function as a single application, unit or system for handling multiple functions previously found in different software products, usually under the control of one common program,” (Brief, p. 8; emphasis added.), Appellant cites Microsoft Office, a suite of programs, as an alleged example. (Id.) However, as C5M describes, Cleaner, Charger and Adaptec Toast software programs, when loaded on the same computer system, work together as a unit to handle processing video and/or audio data. They comprise “an integrated software application” under the broadest reasonable definition of that phrase, even if there is no single program under which they are all controlled, because Appellant’s definition does not require such control. It should also be noted that when loaded on a computer system, all programs are “commonly controlled” by that computer’s operating

system software, i.e., a common program, even though control by one common program is not a requirement of this claim construction proposed by Appellant.

For the reasons set forth above, the teaching in C5M that Cleaner, Charger and Adaptec Toast work together when loaded on a computer system clearly satisfies Appellant's unduly restrictive construction of "integrated computer software application," and also satisfies the Examiner's broadest reasonable construction of that limitation.

4. C5M discloses "a code directed to receiving 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 "desired output media format" to mean "standard video format for optical disk media." (Brief, p. 9) Appellant further contends that "The specification acknowledges and describes many ways of distributing video in any output format. However, the claims are narrowly drawn to preparing video for output to 'disk media (e.g. DVD, CD-ROM).'" (Brief, p. 10) Respondent disputes each of these contentions. Appellant is not according "a code directed to receiving a desired output media format based upon a first input" the broadest reasonable interpretation. The majority of the claims, including independent claim 1, and all dependent claims except claims 5-7, and 11, are not limited to an output to "disk media."

The Examiner correctly determined that because the '655 patent specification repeatedly mentions "desired" "output media format" and "any" "output media format" without requiring that it be a format for an optical disk, the limitation "output media format" is not limited to an optical disk. This is especially true since the '655 specification states, in reference to CDs or DVDs, that these formats are "examples" rather than requirements for "output media format." (RAN, pp. 8-13) Therefore, the Examiner correctly determined the broadest reasonable interpretation of "desired output media format" does not require that the output media format be a format for optical disc media. (Id., p. 8)

Respondent agrees with the Examiner's finding because that finding is clearly supported by the '655 patent specification. The '655 specification states, for example, that "As can be seen, the media format can be DVD, VCD, or Super VCD, among others." (8:49-50; emphasis added.) Nevertheless, Cleaner clearly allows a user to select a desired output media format based upon a first input. For example the user can produce MPEG-1 files for

Video CD by selecting the Video CD pre-set in the Advanced Settings window. (C5M, p. 209) The user can also create an MPEG-2 stream. (C5M, p. 206) Cleaner 5 clearly includes “a code directed to receiving a desired output media format based upon a first input,” in accordance with the teachings in C5M.

Respondent also disagrees with Appellant that “desired” necessarily requires a plurality of output media formats under the broadest reasonable interpretation. “Desired²” does not necessarily connote a plurality. Nothing in the specification suggests the common term “desired” has any special meaning in this patent.

Even if the Appellant’s argument was accepted, C5M discloses that a user can select different MPEG outputs. (C5M, pp. 206, 209)

5. C5M discloses “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.”

Appellant contends that the claimed invention requires code that resizes the video automatically to a size associated with both the desired media format and desired TV standard as received inputs. (Brief, p. 13) 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 code associates the desired media format and TV standard with a size for the video. (Id.) Appellant also contends that C5M neither discloses code for 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 size based on such association. Appellant additionally alleges that C5M does not disclose code for resizing raw video information according to desired output media format and desired TV standard received as input. Respondent disputes each of these contentions.

The teaching at p. 204 of C5M, which mentions Video CDs, clearly satisfies the limitations of a desired output media format. As to “automatically” resizing the video, claim 1 does not require that the resizing be done “automatically.” Therefore, the disclosed image sizes that Cleaner associates with an MPEG2 output media for an NTSC TV standard (720 x 480) and for a PAL TV standard (720 x 576) clearly teach that Cleaner contains code for

² 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.

resizing video information associated with a desired output media and desired TV standard. Further, the limitation clearly states that a "desired" output media format and "desired" TV standard are targeted by the claimed code. This limitation does not preclude a user selecting those parameters as desired by the user; again, the claim does not require "automatically" resizing.

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

6. C5M discloses "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."

Appellant contends that "instead of code automatically adjusting the frame rate with a TV Standard input, the user of Cleaner 5 must select a frame rate from many possible rates between 23 and 60 frames per second." Respondent disputes this contention.

Appellant has again construed a claim limitation to include the word "automatically" when that word simply does not appear in the claim. Appellant complains that the user must adjust the frame rate, because there is no code for doing that "automatically" based on receiving NTSC or PAL as an input. However, the word "automatically" is simply not in the claim either expressly or under any fair reading. Therefore, it is immaterial that a user may adjust the frame rate manually, using information provided by C5M regarding the 29.97 and 25 fps frame rates for the NTSC and PAL standards. (C5M, p. 207) C5M clearly describes that Cleaner includes a code that functions as claimed.

7. C5M discloses "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."

Appellant 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.³ Respondent disputes the contention that as used in claim 1, "presentation format" is limited to an

³ The Patent Owner identifies other patents to support these arguments, but the relevance of those other patents is not established. As just one example, U.S. Patent No, 5,608,909 has nothing to do with video processing or DVD.

allegedly 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. 18) However, 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. However, 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.” (RAN, p. 32; C5M, p. 62).

The Examiner was correct in holding that an MPEG-1 VCD file is an example of a presentation format taught by C5M, and that C5M teaches multiplexing the audio information with the elementary video data stream, as recited by claim 1. With respect to this claim limitation, C5M describes the presentation format file is authored by Cleaner and then written to disk media in a second software program, Adaptec Toast. However, when Cleaner and Adaptec Toast are both loaded on a computer system, they together form an integrated computer software application in accordance with the Patent Owner’s own proposed definition. (RAN, pp. 6-7)

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 contends that 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. 7-8 and 19-20, 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 5 is not a quality setting. (Brief, p. 25). Appellant further contends that Cleaner 5 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 the only mention occurs in claim 6 itself. 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 5 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.21; citing C5M, p. 144)⁴ Appellant is simply incorrect in arguing otherwise. Appellant again argues that Cleaner 5 cannot write a video in a presentation format onto disk media without another application. That argument again

⁴ This disclosure appears in the 6th paragraph of p. 144.

ignores that “an integrated software application” is satisfied by two applications residing on a computer system that are compatible and interoperate, that “work as a unit” and/or “work together to handle an application.” (RAN, pp. 6 and 7)

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.

In the RAN, the Examiner addressed the argument that C5M allegedly does not create a presentation format, 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 5 discloses that a special MPEG-1 file can 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. 27, quoting RAN, p. 22). 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 '655 patent.” (Brief, p. 27) Respondent disputes these contentions, because neither claim 10, nor its parent claim 1, defines what that video format is and because claim 10 is directed to an audio format, not to a video format.

Claim 1 requires “a code directed to receiving a desired output media format based upon a first input,” but does not specify whether the code is directed to audio or video, or any particular format for audio or video. Indeed claim1 describes a second input as being a desired TV standard and includes a limitation that is directed to “processing the elementary video stream with audio information in the desired output media format.” Again, no specific type of format for the audio information is specified. Claim 10 is directed only to audio information broadly, again without specifying the 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, pp 22-23) 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. (RAN, pp 22-23, citing C5M, p. 212)

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

Appellant/Owner contends that the Examiner erred in 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. 27, quoting RAN, p. 22), because Appellant alleges that “The desired output media is defined as a specific standard video format for optical disk media in the claims.” 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) It should be noted that 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.

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 38 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 contains a single page section explaining why Charger allegedly does not teach the limitations relied on. Beginning at page 29, Appellant's Brief then provides a separate section of 16 pages that asserts a smorgasbord of legal arguments that begins with alleging that the Examiner failed to apply statutory and common law, delves into infringement issues, detours 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 '655 patent is not expired, and Appellant's arguments are contrary to every holding by the Federal Circuit for reexamination proceedings directed to an unexpired patent. Respondent does not have the available pages or words to 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. For example, Appellant argues that the examiner should have presumed that the patents were valid and should have applied the same test to claim construction that district courts apply. (Brief, 39-40). These are both arguments that the Federal Circuit has explicitly rejected. 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). See also footnote 1, *supra*.

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, and MPEG-2 files for DVD. MPEG Charger is a software application 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. 39; 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, p. 40)

Appellant/Owner contends that the Examiner erred in adopting the obvious 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 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. 40)

E. Conclusion

For the reasons above, Respondent/Patent Owner requests that the Board maintain the Examiner's rejections of claims 1-18, i.e., all of the ‘655 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 Swanson et al*, 540 F.3d 1368 (Fed. Cir. 2008)

B. *Ex Parte Jorgen J. Moller, Jr.*, 2011 WL 289299

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 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,

/Tracy W. Druce/
Novak Druce + Quigg, LLP
Tracy W. Druce
Reg. No. 35,493
James P. Murphy
Reg. No. 55,474
Brian McKnight
Reg. No. 59,914

NOVAK DRUCE + QUIGG, LLP
1000 Louisiana St.
Wells Fargo Plaza
53rd Floor
Houston, Texas 77002
P: 713-571-3400
F: 713-456-2836