

# **EXHIBIT 9**

## CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this CORRECTED REQUEST FOR INTER PARTES REEXAMINATION OF U.S. PATENT NO. 7,283,172, together with all exhibits and attachments and supporting documentation, has been served via FedEx on March 23, 2010, upon the following:

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/Johanna Weir/

Johanna Weir

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Inventors: HUANG, Qiang

Patent No.: 7,283,172

Filed: January 27, 2006

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

CORRECTED REQUEST FOR INTER PARTES  
REEXAMINATION OF U.S. PATENT NO. 7,283,172  
UNDER 35 U.S.C. § 311 AND 37 C.F.R. §§ 1.913  
AND 1.915

Control No: 95/001,283

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

**CORRECTED REQUEST FOR *INTER PARTES* REEXAMINATION**  
**OF U.S. PATENT NO. 7,283,172**

This Corrected Request for *Inter Partes* Reexamination of U.S. Pat. No. 7,283,172 is being filed in response to the Office's March 4, 2010 communication, "Decision *Sua Sponte* Vacating *Inter Partes* Reexamination Filing Date." To remedy the defects cited in the Decision, Requester has further demonstrated that Washino is not cumulative of any art previously applied in the original prosecution of the '172 patent. Indeed, no art has ever been applied to these claims, thus, each SNQ presents a non-cumulative application of the prior art to the claims of the '172 patent. Additionally, the SNQ and proposed rejections relying on Avid Xpress in view of Avid Xpress DV have been modified to now also incorporate the MPEG Standard explicitly into the SNQ rather than relying on the MPEG Standard as evidence of what the Avid Xpress and Avid Xpress DV references inherently disclose. Requester submits that this Corrected Request meets all requirements for being granted a filing date.

Corresponding to the revisions made to the Original Request for Reexamination, this Corrected Request for Reexamination includes several revised exhibits. The MPEG Standard is being submitted herewith as PA-F, and a revised PA-SB08A - USPTO Form SB/08A is also being submitted including the MPEG Standard, which is now being relied upon as a prior art reference. Lastly, a revised OTH-D exhibit is also being filed. The reference, by LaBarge, Ralph, which is relied upon for support of inherent principles, was previously submitted as OTH-E, but is now submitted as OTH-D.

All other exhibits besides PA-SB08A, PA-F, and OTH-D are the same as previously filed, and accordingly, are not being submitted herewith. The previously filed versions are incorporated by reference and are available to the Examiner via the USPTO's electronic filing system.

Requester submits that this Correct Request for *Inter Partes* Reexamination of U.S. Pat. No. 7,283,172 meets all requirements for filing, raises several SNQ's that are sufficient to grant this Request and reject each of the claims requested for reexamination. Accordingly, Requester requests a filing date, Order Granting Reexamination, and an Office Action be issued by the Office as soon as reasonably possible.

<b>I. REQUIREMENTS FOR INTER PARTES REEXAMINATION UNDER 37 C.F.R. § 1.915</b>	<b>9</b>
A. PAYMENT OF FEES	9
B. IDENTIFICATION OF CLAIMS FOR REEXAMINATION; 37 C.F.R. § 1.915(B)(1)	9
C. CITATION OF PRIOR ART PRESENTED; 37 C.F.R. § 1.915(B)(2)	9
D. STATEMENT OF EACH SUBSTANTIAL NEW QUESTION OF PATENTABILITY; 37 C.F.R. §1.915(B)(3)	10
E. COPIES OF PRIOR ART; 37 C.F.R. §1.915(B)(4)	13
F. COPY OF U.S. PATENT NO. 7,283,172; 37 C.F.R. § 1.915(B)(5)	13
G. CERTIFICATION OF SERVICE; 37 C.F.R. § 1.915(B)(6)	13
H. CERTIFICATE THAT ESTOPPEL PROVISIONS DO NOT PROHIBIT INTER PARTES REEXAMINATION; 37 C.F.R. § 1.915(B)(7)	13
I. STATEMENT IDENTIFYING REAL PARTY IN INTEREST; 37 C.F.R. § 1.915(B)(8)	13
<b>II. CONCURRENT LITIGATION</b>	<b>14</b>
<b>III. SUMMARY OF THE ‘172 PATENT AND THE PROSECUTION HISTORY</b>	<b>15</b>
J. SUMMARY OF THE ‘172 PATENT	15
K. THE ‘280 APPLICATION	16
L. THE NEED FOR CONSISTENCY BETWEEN THE FILE HISTORIES OF THE PARENT APPLICATION AND THE ‘280 APPLICATION DEMAND THAT CLAIMS 1 AND 19 AND THEIR DEPENDENTS BE CANCELED.	17
M. CLAIM CONSTRUCTION	20
<b>IV. DETAILED DISCUSSION OF THE PERTINENCY AND MANNER OF APPLYING THE PRIOR ART</b>	<b>21</b>
A. CLAIMS 1-19 ARE ANTICIPATED BY THE CLEANER 5 USER MANUAL (“CLEANER 5”) UNDER 35 U.S.C. 102(B)	21
SUMMARY OF CLEANER 5	21
B. CLAIMS 5, 6 AND 8 ARE RENDERED OBVIOUS BY THE CLEANER 5 USER MANUAL (“CLEANER 5”) IN VIEW OF CLEANER MPEG CHARGER (“MPEG CHARGER”) UNDER 35 U.S.C. 103(A)	31

SUMMARY OF MPEG CHARGER	31
REASONS TO COMBINE	34
C. CLAIMS 1-3, 5, 7, 9 AND 13-19 ARE RENDERED OBVIOUS BY AVID XPRESS IN VIEW OF AVID XPRESS DV AND THE MPEG STANDARD UNDER 35 U.S.C. 103(A)	34
SUMMARY OF AVID XPRESS	34
SUMMARY OF AVID XPRESS DV	35
SUMMARY OF MPEG STANDARD	36
REASONS TO COMBINE	48
D. CLAIMS 1-12, 15 AND 19 ARE ANTICIPATED BY U.S. PATENT NO. 6,370,198 (“WASHINO”) UNDER 35 U.S.C. 102(E)	49
SUMMARY OF WASHINO	49
<b>V. CONCLUSION</b>	<b>57</b>

## TABLE OF EXHIBITS

### LIST OF EXHIBITS

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

#### A. PRIOR ART (PA)

- PA-SB08A USPTO Form SB/08A
- PA-A Cleaner 5 User Manual
- PA-B Cleaner MPEG Charger User Manual
- PA-C Avid Xpress
- <http://web.archive.org/web/20000815061831/www.avid.com/products/pdf/xpress.pdf>
- PA-D Avid Xpress DV consisting of:
- <http://web.archive.org/web/20010331173804/www.avid.com/products/avidxpressdv/index.html>
  - <http://web.archive.org/web/20010410220406/www.avid.com/products/avidxpressdv/features.html>
  - <http://web.archive.org/web/20010410224816/www.avid.com/products/avidxpressdv/specs.html>
  - [http://web.archive.org/web/20010414031420/www.avid.com/products/avidxpressdv/press\\_quotes.html](http://web.archive.org/web/20010414031420/www.avid.com/products/avidxpressdv/press_quotes.html)
- PA-E U.S. Patent No. 6,370,198 issued to Washino (“Washino”)
- PA-F MPEG Standard

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

- PAT-A U.S. Patent No. 7,283,172 (“the ‘172 patent”)
- PAT-B File History for ‘172 patent
- PAT-C File History for U.S. 7,009,655 (“the ‘655 patent”)

#### C. CLAIM CHARTS (CC)

- CC-A Claim Chart for Cleaner 5
- CC-B Claim Chart for Cleaner 5 in view of MPEG Charger
- CC-C Claim Chart for Avid Xpress in view of Avid Xpress DV and further in view of MPEG standard
- CC-D Claim Chart for Washino

**D. OTHER DOCUMENTS (OTH)**

- OTH-A Complaint filed in *Mediostream, Inc. v. Acer American Corporation, Apple Computer, Inc., Dell, Inc. and Gateway, Inc.*, Civil Action No. 2:07-CV-376 (CE), United States District Court for the Eastern District of Texas, January 9, 2009.
- OTH-B Complaint filed in *Mediostream, Inc. v. Microsoft Corporation*, Civil Action No. 2:08-CV-369 (CE), United States District Court for the Eastern District of Texas, September 30, 2008.
- OTH-C Avid Xpress 2.0
- OTH-D LaBarge, Ralph. "DVD Authoring & Production," CMP Books (2001), pp. 40-43.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Inventors: HUANG, Qiang

Patent No.: 7,283,172

Filed: January 27, 2006

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

REQUEST FOR INTER PARTES REEXAMINATION OF  
U.S. PATENT NO. 7,283,172 UNDER 35 U.S.C. §  
311 AND 37 C.F.R. §§ 1.913 AND 1.915

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

**REQUEST FOR *INTER PARTES* REEXAMINATION  
OF U.S. PATENT NO. 7,283,172**

Dear Sir:

Pursuant to 35 U.S.C. §§ 311 et seq. and 37 C.F.R. §§ 1.902 et seq., Third Party Requester and Real Party in Interest, Apple Inc, (hereinafter "Requester") hereby requests *inter partes* reexamination of patented claims 1-19 of U.S. Patent No. 7,283,172, entitled "Method and System For Direct Recording of Video Information Onto a Disk Medium" (hereinafter "the '172 patent") filed January 27, 2006 and issued October 16, 2007 to Qiang Huang (Exhibit PAT-A). Reexamination is requested in view of the Substantial New Questions of Patentability ("SNQ") presented below. Requester reserves all rights and defenses available including, without limitation, defenses as to invalidity and unenforceability. By simply filing this Request in compliance with the Patent Rules, Requester does not represent, agree or concur that the '172 patent is enforceable, and by asserting the SNQs herein, Requester specifically asserts that original

claims 1-19 of the '172 patent are, in fact, not patentable; as such, the U.S. Patent and Trademark Office (the "Office") should reexamine and find all claims unpatentable and cancel claims 1-19 of the '172 patent, rendering them null, void and otherwise unenforceable.

Requester submits that this request not only raises SNQs with respect to claims 1-19 of the '172 patent but also sets forth a sufficient basis to reject and cancel each of the requested claims. Specifically, the cited prior art discloses a system for converting video information in an incoming format into an outgoing format, which is one of a plurality of formats using computer software and then writing the video information on a medium as is recited by the claims.

Notably, during the prosecution of a parent patent the Examiner rejected claims that are nearly identical to claims 1 and 19 of the '172 patent, which resulted in the cancellation of those claims. The same rejection was not applied during the prosecution of the '172 patent allowing claims 1 and 19 to improperly issue. Every limitation of these claims were taught by U.S. Patent 6,370,198 to Washino (cited by the Examiner in the '655 patent's prosecution), and Applicant has never suggested otherwise. In view of this inconsistency between the prosecution of these two related patents, the effected claims should be rejected and ultimately canceled.

Also weighing in favor of the non-patentability of these claims is that many of the narrowest elements of the claims recite limitations required by the MPEG standard. Several of the prior art references relied upon below include MPEG creation capabilities including the Cleaner 5, MPEG Charger, and the Avid Xpress DV references.

In addition, the other references presented in this request teach the recited elements of the invention, as completed by a software system, which is a key limitation of claim 16 of the '172 patent. Accordingly, the current claims of the '172 patent should be found unpatentable and a certificate of reexamination to the same effect is requested.

Requester also notes that the '172 patent, for which reexamination is requested, was asserted in *MedioStream, Inc. v. Acer American Corporation, Apple Computer, Inc., Dell, Inc. and Gateway, Inc.*, Civil Action No. 2:07-CV-376 (CE), United States District Court for the Eastern District of Texas, originally filed on August 27, 2007 and last

amended on January 9, 2009, and *MedioStream, Inc. v. Microsoft Corporation*, Civil Action No. 2:08-CV-369 (CE), United States District Court for the Eastern District of Texas, filed on September 30, 2008 (“the Pending Litigations”). The court consolidated the Pending Litigations under Case Number 2:08-CV-369 (CE).

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

Pursuant to 37 C.F.R. § 1.915, Requester satisfies each requirement for *inter partes* Reexamination of the ‘172 patent. The ‘172 patent issued from Application No. 11/342,280 filed on January 27, 2006. Because the ‘172 patent was filed after November 29, 1999 and issued from an “original filed application” in accordance with Manual of Patent Examining Procedure § 2611 (hereinafter, “MPEP”), the ‘172 patent qualifies for *inter partes* reexamination. See 37 C.F.R. § 1.913; MPEP § 2610.

**A. PAYMENT OF FEES**

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

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

Requester requests reexamination of claims 1-19 of United States Pat. No. 7,283,172.

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

Form SB/08A presents the patents and printed publications upon which this Request is based. A complete copy of each listed patent and printed publication is included herewith. For reasons set forth in detail below, and in the accompanying claim charts, SNQs as to claims 1-19 are raised with respect to anticipation under 35 U.S.C. §§ 102 (a), (b) or (e), and with respect to obviousness under 35 U.S.C. § 103(a) in view of various combinations of prior art addressed in greater detail below. This request for reexamination is based on the patents and printed publications included in Exhibits PA-A through PA-F.

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

A statement of each substantial new question of patentability can be found *infra* and in accompanying claim charts at Exhibit CC-A through Exhibit CC-D. Each claim chart fully sets forth the SNQs sought against claims 1-19.

Requester has presented each prior art reference against claims 1-19, element by element, as a detailed example of how each reference renders claims 1-19 unpatentable, in compliance with relevant statutes, rules and procedures. In addition, Requester has submitted herewith claim charts at Exhibits CC-A through CC-D that show how each piece of prior art renders each of the limitations of the issued and pending claims of the ‘172 patent unpatentable.

1. Claims 1-19 of the ‘172 patent are anticipated under 35 U.S.C. 102(b) by the Cleaner 5 User Manual.

Requester respectfully submits that claims 1-19 of the ‘172 patent are anticipated by the Cleaner 5 User Manual (“Cleaner 5”). The reference was not discussed or applied either by the Examiner or the Applicant during the original prosecution. Indeed, no prior art has been considered and discussed on the record of the application that matured into the ‘172 patent; the claims were issued without any anticipation or obviousness rejections. Cleaner 5 raises a substantial new question of patentability with respect to the claims of the ‘172 patent because it is not cumulative of any art previously of record and its teachings are such that a reasonable examiner would have considered Cleaner 5 pertinent to deciding the question of patentability of the requested claims. Specifically, Cleaner 5 discloses a software system for carrying out the steps of the claim.<sup>1</sup> Therefore, Cleaner 5 cannot be considered cumulative because it teaches this limitation. A claim chart setting forth the pertinency and manner of applying Cleaner 5 to these claims is submitted herewith as Exhibit CC-A.

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<sup>1</sup> As discussed below, the parent patent, U.S. Patent 7,009,655, issued because it recited software reciting the method steps. According to its prosecution history, the art cited therein disclosed the method steps, but not performed by software. It is reasoned that a reference disclosing software for performing the claimed method steps must present a new technical teaching.

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

Requester respectfully submits that claims 5, 6 and 8 of the '172 patent are rendered obvious by the Cleaner 5 User Manual ("Cleaner 5") in view of Cleaner MPEG Charger ("MPEG Charger"). Neither Cleaner 5 nor MPEG Charger was discussed or applied by the Examiner or the Applicant during the original prosecution. Indeed, no prior art has been considered and discussed on the record of the application that matured into the '172 patent; the claims were issued without any anticipation or obviousness rejections. The combination raises a substantial new question of patentability with respect to the claims of the '172 patent because it is not cumulative of any art previously of record and its teachings are such that a reasonable examiner would have considered Cleaner 5 in view of MPEG Charger pertinent to deciding the question of patentability of the requested claims. In addition to the non-cumulative nature of Cleaner 5, this combination is further not cumulative in view of MPEG Charger's additional teachings related to software for enhanced MPEG output options.<sup>2</sup> A claim chart setting forth the pertinency and manner of applying Cleaner 5 to these claims is submitted herewith as Exhibit CC-B.

3. Claims 1-3, 5, 7, 9 and 13-19 are rendered obvious under 35 U.S.C. § 103 by Avid Xpress in view of Avid Xpress DV and further in view of MPEG standard.

Requester respectfully submits that claims 1-3, 5, 7, 9, and 13-19 of the '172 patent are rendered obvious by Avid Xpress in view of Avid Xpress DV and MPEG standard. Neither the Examiner nor the Applicant discussed or applied Avid Xpress in view of Avid Xpress DV and further in view of MPEG standard during the original prosecution. Indeed, no prior art has been considered and discussed on the record of the application that matured into the '172 patent; the claims were issued without any anticipation or obviousness rejections. The combination raises a substantial new question

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<sup>2</sup> As discussed below, the parent patent, U.S. Patent 7,009,655, issued because it recited software reciting the method steps. According to its prosecution history, the art cited therein disclosed the method steps, but not performed by software. It is reasoned that a

of patentability with respect to the claims of the '172 patent because it is not cumulative of any art previously of record and its teachings are such that a reasonable examiner would have considered Avid Xpress in view of Avid Xpress DV and MPEG standard pertinent to deciding the question of patentability of the requested claims. Specifically, Avid Xpress in view of Avid Xpress DV and MPEG standard discloses a software system for carrying out the steps of the claim.<sup>3</sup> A claim chart setting forth the pertinency and manner of applying Avid Xpress in view of Avid Xpress DV to these claims is submitted herewith as Exhibit CC-C.

4. Claims 1-12, 15 and 19 are anticipated under 35 U.S.C. § 102 by Washino.

Requester respectfully submits that claims 1-12, 15 and 19 of the '172 patent are anticipated by Washino. Washino was not discussed or applied by the Examiner or the Applicant during the original prosecution. Indeed, no prior art has been considered and discussed on the record of the application that matured into the '172 patent; the claims were issued without any anticipation or obviousness rejections. Washino raises a substantial new question of patentability with respect to the claims of the '172 patent because it is not cumulative of any art previously of record and its teachings are such that a reasonable examiner would have considered Washino pertinent to deciding the question of patentability of the requested claims. Specifically, the claims of the '172 patent are substantially similar to claims that were not allowed to issue over Washino during prosecution of the '172 patent's parent, U.S. Patent 7,009,655. A reasonable examiner would consider Washino important in deciding the patentability of these claims as demonstrated during the '655 patent's prosecution history (the '172 is a continuation of the '655 patent and recites substantially similar claims) wherein the examiner in that proceeding found that substantially similar claims could not be allowed in view of Washino's teachings. Further Washino cannot be considered cumulative because neither

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reference disclosing software for performing the claimed method steps must present a new technical teaching.

<sup>3</sup> As discussed below, the parent patent, U.S. Patent 7,009,655, issued because it recited software reciting the method steps. According to its prosecution history, the art cited therein disclosed the method steps, but not performed by software. It is reasoned that a

Washino nor any other reference has ever been considered with respect to the claims of the '172 patent. A claim chart setting forth the pertinency and manner of applying Washino to these claims is submitted herewith as Exhibit CC-D.

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

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

**F. COPY OF U.S. PATENT NO. 7,283,172; 37 C.F.R. § 1.915(B)(5)**

Attached as Exhibit PAT-A is a copy of the '172 patent. 37 C.F.R. § 1.915(b)(5); MPEP § 2614. A copy of the prosecution history of the '172 patent is attached at PAT-B.

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

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

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

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

Requester hereby certifies that it is not prohibited under the provisions of 35 U.S.C. § 317 or 37 C.F.R. § 1.907 from filing this Request for *inter partes* reexamination. Requester may request *inter partes* reexamination because neither it nor those in privity with it have previously requested *inter partes* reexamination of the '172 patent. See 35 U.S.C. § 317(b); 37 C.F.R. § 1.907; and, MPEP § 2612.

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

Apple Inc. ("Requester") is the real party in interest and requests reexamination of the '172 patent in view of the SNQs presented below. Requester reserves all rights and defenses available including, without limitation, defenses as to invalidity and

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reference disclosing software for performing the claimed method steps must present a

unenforceability. By filing this Request in compliance with the Patent Rules, Requester does not represent, agree or concur that the '172 patent is enforceable. Requester specifically asserts that all claims of the '172 patent are in fact not patentable and as such the Office should reexamine and find claims 1-19 unpatentable and cancel claims 1-19 of the '172 patent, rendering these claims of the '172 patent null, void, and otherwise unenforceable.

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

## II. CONCURRENT LITIGATION

The '172 patent is presently the subject of two pending litigations. In *MedioStream, Inc. v. Acer American Corporation, Apple Computer, Inc., Dell, Inc. and Gateway, Inc.*, Civil Action No. 2:07-CV-376 (CE), United States District Court for the Eastern District of Texas, August 28, 2007, Patent Owner alleges that the Requester and several other parties infringe claims of the '172 patent. (*see* OTH-A Forth Amended Complaint filed January 9, 2009 at ¶ 37.)

Additionally, Patent Owner also alleges infringement of the '172 patent by Microsoft, Inc. in the litigation captioned: *Mediostream, Inc. v. Microsoft Corporation*, Civil Action No. 2:08-CV-369 (CE), United States District Court for the Eastern District of Texas, September 30, 2008. (*See* Complaint at OTH-B.) These two cases have been consolidated under the latter case before Magistrate Judge Charles Everingham.

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

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new technical teaching.



### III. SUMMARY OF THE '172 PATENT AND THE PROSECUTION HISTORY

#### J. SUMMARY OF THE '172 PATENT

The '172 patent issued from Application No. 11/342,280 (hereinafter the '280 application), filed January 27, 2006 and continued from Application No. 10/202,999 (hereinafter the '999 application), filed July 23, 2002, now U.S. Patent 7,009,655 (hereinafter the '655 patent).

The '172 patent is directed to system for performing steps directed by computer software code for converting video from an incoming format to an outgoing format, and then writing the video onto a disk (e.g., CD or DVD). '172 patent at Col. 2, lines 52-56. The system receives video from a video source, and output parameters such as output format and desired TV standard information. '172 patent at Abstract. The video is decoded to an uncompressed format and resized according to the output parameters. '172 patent at Col. 6, lines 39-41 and 51-54. The uncompressed format is further adjusted to a frame rate associated with the TV standard and then encoded into an elementary video stream. '172 patent at Col. 6, lines 54-56. Lastly, the elementary video stream is multiplexed with audio to produce a presentation format. '172 patent at Col. 6, lines 63-66. Fig. 2, below, illustrates the above-described steps.

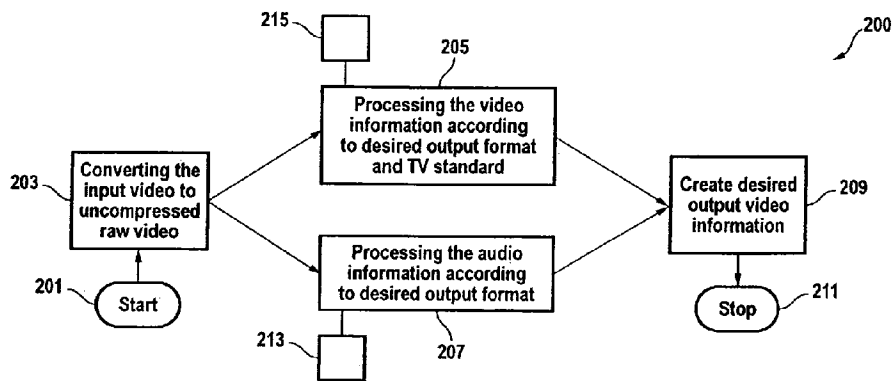


FIG. 2

FIGURE 2 OF THE '172 PATENT

## K. THE '280 APPLICATION

As originally filed, the '280 application contained claims 1-20, of which claims 1 and 20 were almost exactly the same as rejected and canceled claims 1 and 20 in the parent '999 application. See PAT-B, Claims filed on January 27, 2006; *see also* PAT-C Office Action mailed March 22, 2005, pp. 3-4.

In the Office Action dated February 5, 2007, the Examiner rejected claim 16 under 35 U.S.C. § 101 for statutory type double patenting because claim 16 of the '280 application was identical to issued claim 1 of U.S. 7,009,655 (issued from the '999 application). Claims 17-19 were objected to as being dependent on rejected claim 16, but were otherwise indicated as allowable. PAT-B, Non-Final Rejection mailed February 5, 2007.

The Examiner further rejected claims 1-15 and 20 on the ground of nonstatutory obviousness-type double patenting in view of the issued claims of U.S. 7,009,655. PAT-B, Non-Final Rejection mailed February 5, 2007. Notably, and inconsistent with the proceedings in the '999 application, the Examiner did not reject these claims over U.S. Patent 6,370,198 to Washino even though they are the exact same claims that were presented, rejected, and canceled because of the Washino reference in the '999 application. See PAT-C Office Action mailed March 22, 2005, pp. 3-4 and Amendment dated August 18, 2005.

In response to the Examiner's rejections, Applicant canceled claim 16 and amended claim 17 to be in independent form by including the limitations of claim 16 therewithin and modifying the language "TV standard" to read "video presentation standard." Additionally, Applicant filed a terminal disclaimer to overcome the obvious-type double patenting rejection.

Applicant also amended claims 1 and 20 to replace the language reciting "TV standard" to read "video presentation standard" as seen for example below:

inputting a desired ~~TV~~ video presentation standard based upon a second input;  
directly resizing the raw video information in the uncompressed format into a size associated with the desired output media format and the desired ~~TV~~ video presentation standard;

See PAT-B, Listing of Claims, July 31, 2007 Response to Office Action.

The application was subsequently allowed. PAT-B Notice of Allowability dated August 8, 2007. The Notice does not articulate any reason for the patentability of the claims of the '172 patent. However, it can be assumed that the claims were allowed because the Examiner believed that the claims recited the same subject matter as he already allowed as U.S. 7,009,655. Unfortunately, such rationale is faulty; many of the claims in the '172 patent fail to recite the limitations required for the patentability of the claims of U.S. 7,009,655 (code for carrying out the method).

**L. THE NEED FOR CONSISTENCY BETWEEN THE FILE HISTORIES OF THE PARENT APPLICATION AND THE '280 APPLICATION DEMAND THAT CLAIMS 1 AND 19 AND THEIR DEPENDENTS BE CANCELED.**

Several rejections were made by the Examiner in the parent '999 application that required the Applicant to either cancel or amend claims. However, the same Examiner failed to make those same rejections for extremely similar claims in the present '280 application.

As stated above, claims 1 and 20 (allowed as claims 1 and 19 of the '172 patent) of the '280 application are nearly identical to rejected and canceled claims 1 and 20 of the '999 application. See the chart below comparing these claims side-by-side.

Rejected Claims of the '999 Application (canceled) <sup>4</sup>	Claims of the '280 Application (Issued)
1. A method for converting video information from an incoming format to an outgoing format using a continuous pass conversion process free from one or more intermediary files, the method comprising:	1. A method for converting video information from an incoming format to an outgoing format using a continuous pass conversion process free from one or more intermediary files, the method comprising:
inputting video information in a first format;	inputting video information in a first format;
directly converting the video information in the first format to raw video information in an uncompressed format;	directly converting the video information in the first format to raw video information in an uncompressed format;

<sup>4</sup> Underlining is provided to highlight differences between the language of the claims; spacing is provided to align the claim language and emphasize the similarities between the claims.

inputting a desired output media format based upon a first input;	inputting a desired output media format based upon a first input;
inputting a desired <u>TV</u> standard based upon a second input;	inputting a desired <u>video presentation</u> standard based upon a second input;
directly resizing the raw video information in the uncompressed format into a size associated with the desired output media format and the desired <u>TV</u> standard;	directly resizing the raw video information in the uncompressed format into a size associated with the desired output media format and the desired <u>video presentation</u> standard;
directly adjusting the uncompressed format in the size associated with the desired output media format and the desired <u>TV</u> standard to a frame rate associated with the desired <u>TV</u> standard;	directly adjusting the uncompressed format in the size associated with the desired output media format and the desired <u>video presentation</u> standard to a frame rate associated with the desired <u>video presentation</u> standard;
directly processing the uncompressed format in the size and the frame rate into an elementary video stream; and	directly processing the uncompressed format in the size and the frame rate into an elementary video stream; and
directly processing the elementary video stream with audio information in the desired output media format and the desired <u>TV</u> standard to form video and audio information in a presentation format based upon the desired output media format and the desired <u>TV</u> standard.	directly processing the elementary video stream with audio information in the desired output media format and the desired <u>video presentation</u> standard to form video and audio information in a presentation format based upon the desired output media format and the desired <u>video presentation</u> standard.
20. A method for converting video information from an incoming format to an outgoing format using a process free from one or more intermediary files, the method comprising:	19. A method for converting video information from an incoming format to an outgoing format using a process free from one or more intermediary files, the method comprising:
receiving video information in a first format;	receiving video information in a first format;
receiving a desired output media format based upon a first input and a desired video presentation standard based upon a second input;	receiving a desired output media format based upon a first input and a desired video presentation standard based upon a second input;
decoding the video information in the first format to raw video information in an uncompressed format;	decoding the video information in the first format to raw video information in an uncompressed format;
directly resizing the raw video information in the uncompressed format into a size associated with the desired output media format and the desired <u>TV</u> standard and adjusting the uncompressed format in the size associated with the	directly resizing the raw video information in the uncompressed format into a size associated with the desired output media format and the desired <u>video presentation</u> standard and adjusting the uncompressed format in the size associated with the

desired output media format and the desired <u>TV</u> standard to a frame rate associated with the desired <u>TV</u> standard;	desired output media format and the desired <u>video presentation</u> standard to a frame rate associated with the desired <u>video presentation</u> standard;
encoding the uncompressed format in the size and the frame rate into an elementary video stream; and	encoding the uncompressed format in the size and the frame rate into an elementary video stream; and
multiplexing the elementary video stream with audio information in the desired output media format and the desired <u>TV</u> standard to form video and audio information in a presentation format based upon the desired output media format and the desired <u>TV</u> standard.	multiplexing the elementary video stream with audio information in the desired output media format and the desired <u>video presentation</u> standard to form video and audio information in a presentation format based upon the desired output media format and the desired <u>video presentation</u> standard.

Claims 1 and 20 of the '999 application were anticipated by U.S. Patent 6,370,198 to Washino and were promptly canceled. PAT-C, Office Action mailed March 22, 2005, pp. 3-4 and Amendment dated August 18, 2005. Claims 1 and 20 of the '999 application differed from the allowed and patented claims only in that they did not recite software code for carrying out the method. In view of the fact that presently patented claims 1 and 19 are nearly identical to the rejected and canceled claims of the '999 application and further that these claims do not recite the limitations required for patentability of the parent application, claims 1 and 19 of the '172 patent should never have issued. A need for consistency between these cases demands that claims 1 and 19 be canceled.

Further, the Examiner failed to repeat two rejections on the grounds of indefiniteness which are present in the exact same circumstances as in the '999 application. During the prosecution of the '999 the Examiner rejected claims 13 and 14 under 35 U.S.C. § 112 as being indefinite for reciting editing information based upon an unclear fourth and an unclear fifth input. PAT-C, Office Action mailed March 22, 2005, p. 2. In response, Applicant was forced to amend to make definite that the fourth and fifth inputs were user inputs by removing the objectionable language and replacing it with acceptable language.

Once again the Examiner failed to maintain consistency in the prosecution of the two applications. Claims 13 and 14 of the present patent were allowed to issue even

though they recite the offending language. *See* PAT-A, claims 13 and 14. A need for consistency between these cases demands that claims 13 and 14 be canceled or at least amended.

#### **M. CLAIM CONSTRUCTION**

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

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

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

Because the standards of claim interpretation used in the courts in patent litigation are different from the claim interpretation standards used in the Office in claim examination proceedings (including reexamination), any claim interpretations submitted herein for the purpose of demonstrating an SNQ are neither binding upon litigants in any litigation related to the ‘172 patent, nor do such claim interpretations correspond to the construction of claims under the legal standards that are mandated to be used by the Courts in litigation. *See* 35 U.S.C. § 314; *see also* MPEP § 2286 II (determination of an SNQ is made independently of a court’s decision on validity because of different standards of proof and claim interpretation employed by the District Courts and the Office); *see also In re*

*Trans Texas Holding Corp.*, No. 2006-1599, -1600, p.14 (Fed. Cir. August 22, 2007); *In re Zletz*, 893 F.2d 319, 322, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

The interpretation and/or construction of the claims in the '172 patent presented either implicitly or explicitly herein should not be viewed as constituting, in whole or in part, Requester's own interpretation and/or construction of such claims. In fact, Requester expressly reserves the right to present its own interpretation of such claims at a later time, which interpretation may differ, in whole or in part, from that presented herein.

#### **IV. DETAILED DISCUSSION OF THE PERTINENCY AND MANNER OF APPLYING THE PRIOR ART**

This Request is based on the cited prior art documents listed above and on the accompanying Form PTO-SB/08A. Exhibit PA-SB/08A. All of these cited prior art publications constitute effective prior art as to the claims of the '172 patent under 35 U.S.C. § 102.

##### **A. CLAIMS 1-19 ARE ANTICIPATED BY THE CLEANER 5 USER MANUAL ("CLEANER 5") UNDER 35 U.S.C. 102(B)**

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

Cleaner 5 was published at least one year before the priority date of the '172 patent and accordingly is prior art under 35 U.S.C. § 102(b). *See* Cleaner 5 copyright page (copyright 1995-2000).

Just as in the '172 patent Cleaner 5 is a software application stored in a memory for converting incoming digital video (DV) to an outgoing MPEG-1 or MPEG-2 stream. Cleaner 5 at p. 141, 206. Cleaner 5 operates to receive a video file and output the video file in a converted format based on a variety of user supplied characteristics such as media format information, television standard information, aspect ratio, frame rate and frequency. Cleaner 5 at pp. 5, 8, 204, 205, 207, 209, and 212. Incoming video files are first converted into an uncompressed raw video format, such as YUV. Cleaner 5 at p. 138. Additional processing is used to resize the video the desired output media format, frame rate, aspect ratio, frequency, and television standard. Cleaner 5 at pp. 5, 8, 204, 205, 207, 209, and 212. The output file can further be stored on a disc such as Video CD

or DVD. Cleaner 5 at pp. 206, 209. Importantly, Cleaner 5 performs these functions entirely using software run from a disc.

Requester respectfully submits that the Cleaner 5 User Manual (“Cleaner 5”) anticipates claims 1-19 of the ‘172 patent. Neither the Examiner nor the Applicant applied or discussed the reference during the original prosecution. The reference raises a substantial new question of patentability with respect to the claims of the ‘172 patent because it is not cumulative of any art previously of record and its teachings are such that a reasonable examiner would have considered Cleaner 5 pertinent to deciding the question of patentability of the requested claims. A claim chart setting forth the pertinency and manner of applying Cleaner 5 to these claims is submitted herewith as Exhibit CC-A.

**1. A method for converting video information from an incoming format to an outgoing format using a continuous pass conversion process free from one or more intermediary files, the method comprising:**

Cleaner 5 discloses a system for converting incoming DV to an outgoing MPEG-1 or MPEG-2 stream. Cleaner 5 at pp. 141, 206. Additionally, Cleaner 5 uses a continuous pass (e.g., single pass) conversion process to encode movies free from intermediary files into a single file. Cleaner 5 at pp. 64, 206.

**inputting video information in a first format;**

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

**directly converting the video information in the first format to raw video information in an uncompressed format;**

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

**inputting 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. Cleaner 5 also supports MPEG-2 files for the DVD output media format. Cleaner 5 at p. 62.



**inputting a desired video presentation standard based upon a second input;**

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

**directly resizing the raw video information in the uncompressed format into a size associated with the desired output media format and the desired video presentation standard;**

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 DVD output media format in an NTSC TV standard. Cleaner 5 at p. 62, 204, 209. Additionally, 720 x 576 pixels is the image size associated with an DVD output media format in a PAL TV standard. Cleaner 5 at p. 62, 204, 209.

**directly adjusting the uncompressed format in the size associated with the desired output media format and the desired video presentation standard to a frame rate associated with the desired video presentation standard;**

Cleaner 5 discloses a frame rate of 29.97 frames per second is associated with VCD and DVD output media formats for the NTSC TV standard and a frame rate of 25 frames per second is associated with VCD and DVD output media formats for the PAL TV standard. Cleaner 5 at p. 62, 207, 209.

**directly 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.

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

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

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

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

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

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

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

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

**4. The method of claim 1 wherein the uncompressed format is selected from RGB, and YUV.**

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

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

**5. The method of claim 1 wherein the desired output media format is selected from either DVD, VCD, and Super VCD.**

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

Cleaner 5 discloses that a user may output media in VCD format. Cleaner 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. Cleaner 5 also supports MPEG-2 files for the DVD output media format. Cleaner 5 at p. 62.

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

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

Cleaner 5 discloses that a user may select a third input for specifying quality settings based on a variety of parameters. Cleaner 5 at p. 59. For example, Cleaner 5

discloses quality settings such as data rate, and frame rate. Cleaner 5 at pp. 59, 62, 64-65. Furthermore, Cleaner 5 discloses that when the output format is DVD, a data rate acceptable to DVD formats are required and Cleaner 5 uses a data rate of 5.7 Mbits/sec which is used by Cleaner's default MPEG-2 setting. Cleaner 5 at p. 62.

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

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

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

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

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

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

**9. The method of claim 1 wherein the processing of the elementary video stream with audio information comprises a multiplexing process.**

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

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

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

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

Cleaner 5 discloses audio information is tuned to a desired frequency based upon the desired media output format. Cleaner 5 at p. 212. In Cleaner 5, a user may use MP3

audio files and the MP3 default sample rate is 44.1 kHz, which is also the sample rate of audio CDs. Cleaner 5 at p. 212.

**11. The method of claim 10 wherein the desired frequency is selected from 48 kHz for DVD, 44.1 kHz for VCD and SVCD.**

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

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

**12. The method of claim 1 wherein the directing converting, directly resizing, and directly adjusting, and directly processing are performed free from one or more intermediary files.**

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

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

**13. The method of claim 1 further comprising processing the raw video information based upon video editing information based upon a fourth input.**

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

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

**14. The method of claim 1 further comprising processing the audio information based upon audio editing information based upon a fifth input.**

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

Cleaner 5 can be directed to processing audio information based upon Noise Removal (i.e., audio editing information) after the user selects the clean-up filter, which constitutes a fifth input. Cleaner 5 at p. 95. Specifically, “Cleaner offers professional-

quality resampling, as well as a range of clean-up filters, such as Noise Removal, Noise Gate and High/Low Pass, to optimize your audio.” Cleaner 5 at p. 95.

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

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

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

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

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

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

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

**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. Cleaner 5 also supports MPEG-2 files for the DVD output media format. Cleaner 5 at p. 62.

**a code directed to receiving a desired video presentation standard based upon a second input;**

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

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

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

**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 video presentation 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 DVD output media format in an NTSC TV standard. Cleaner 5 at p. 62, 204, 209. Additionally, 720 x 576 pixels is the image size associated with an DVD output media format in a PAL TV standard. Cleaner 5 at p. 62, 204, 209.

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

Cleaner 5 discloses a frame rate of 29.97 frames per second is associated with VCD and DVD output media formats for the NTSC TV standard and a frame rate of 25 frames per second is associated with VCD and DVD output media formats for the PAL TV standard. Cleaner 5 at p.62, 207, 209.

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

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.

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

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

**a code directed to receiving video editing information based upon a third input.**

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

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

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

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

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

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

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

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

**19. A method for converting video information from an incoming format to an outgoing format using a process free from one or more intermediary files, the method comprising:**

Cleaner 5 discloses a software application for converting video information from an incoming format, such as a DV stream or QuickTime file to an outgoing format, such as MPEG 1 or MPEG 2, free from intermediary files. Cleaner 5 at pp. 141, 206.

**receiving video information in a first format;**

Cleaner 5 discloses receiving source material (i.e., video information in a first format) shot with a DV camera. Cleaner 5 at p. 5.

**receiving a desired output media format based upon a first input and a desired video presentation standard based upon a second input;**

Cleaner 5 discloses allowing a user to select an output media format, such as MPEG-1, based upon an input, such as the Video CD preset. Cleaner 5 at pp. 141, 209. Specifically, a user “can easily produce MPEG-1 file for [their] Video CD projects... by selecting the Video CD preset in the Advanced Settings window.” Cleaner 5 at p. 209. Cleaner 5 also supports MPEG-2 files for the DVD output media format. Cleaner 5 at p. 62.

**decoding the video information in the first format to raw video information in an uncompressed format;**

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

**directly resizing the raw video information in the uncompressed format into a size associated with the desired output media format and the desired video presentation standard and adjusting the uncompressed format in the size associated with the desired output media format and the desired video presentation standard to a frame rate associated with the desired video presentation standard;**

Cleaner 5 discloses converting the uncompressed raw video information into a resolution size of 720x480 pixels which is associated with the DVD media format and the NTSC video presentation standard. Cleaner 5 at p. 62, 204, 209. Moreover, Cleaner 5 discloses using the pop-up menu to adjust the frame rate of the uncompressed format to 29.97 frames per second (fps) which is associated with the NTSC video presentation standard. Cleaner 5 at p. 207. Moreover, a user may “choose a frame rate between 23.967 - 60 frames per second.” Cleaner 5 at p. 207.

**encoding the uncompressed format in the size and the frame rate into an elementary video stream; and**



Cleaner 5 discloses encoding the YUV uncompressed format. Cleaner 5 at p. 138. Additionally, Cleaner 5 discloses “[t]he Stream Type pop-up menu lets you select between System or Elementary streams for MPEG-1 files and Program or Elementary streams for MPEG-2.” Cleaner at p. 206. Thus, the YUV uncompressed format is encoded to a size and frame rate of an MPEG-1 elementary stream. Cleaner 5 at pp. 138, 206.

**multiplexing the elementary video stream with audio information in the desired output media format and the desired video presentation standard to form video and audio information in a presentation format based upon the desired output media format and the desired video presentation standard.**

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

\*\*\*\*\*

In view of the analysis presented above, Requester submits that Cleaner 5 not only presents a substantial new question of patentability with respect to the requested claims, but also anticipates each of the requested claims. Therefore, the claims of the ‘172 patent should be found null, void, unenforceable and otherwise unpatentable and a Certificate of Reexamination should issue with the same effect.

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

**SUMMARY OF MPEG CHARGER**

MPEG Charger was published at least one year before the priority date of the ‘172 patent and accordingly is prior art under 35 U.S.C. § 102(b). *See* MPEG Charger copyright page (copyright 1995-2001).

Just as in the ‘172 patent, MPEG Charger is a software application for converting a video file into a MPEG video file based on certain parameters. MPEG Charger at pp. 9, 14. MPEG Charger is explicitly configured to work with Cleaner 5 in the process of

converting video files for recording onto a disc. *See generally* MPEG Charger. Specifically, MPEG Charger can produce MPEG-1 files for Video CD projects and MPEG-2 files for “producing high-data rate, full broadcast-quality files that require DVD, fast CD-ROM or hard drives for playback.” MPEG Charger at p. 10. Importantly, MPEG Charger performs the method entirely using software run from a disc.

Requester respectfully submits that claims 5, 6 and 8 of the ‘172 patent are rendered obvious by the Cleaner 5 User Manual (“Cleaner 5”) in view of Cleaner MPEG Charger (“MPEG Charger”). Neither the Examiner nor the Applicant discussed or applied either Cleaner 5 or MPEG Charger during the original prosecution. The combination of Cleaner 5 and MPEG Charger raises a substantial new question of patentability with respect to the claims of the ‘172 patent because it is not cumulative of any art previously of record and its teachings are such that a reasonable examiner would have considered Cleaner 5 in view of MPEG Charger pertinent to deciding the question of patentability of the requested claims. A claim chart setting forth the pertinency and manner of applying Cleaner 5 and MPEG Charger to these claims is submitted herewith as Exhibit CC-B.

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

**5. The method of claim 1 wherein the desired output media format is selected from either DVD, VCD, and Super VCD.**

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

Cleaner 5 discloses that a user may output media in VCD format. Cleaner 5 at p. 209. Specifically, Cleaner 5 states that a user can select the “Video CD preset in the

Advanced Settings window” in Cleaner to “easily produce MPEG-1 files for Video CD projects.” Cleaner 5 at p. 209.

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

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

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

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

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

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

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

## REASONS TO COMBINE

A person of ordinary skill in the art would have been motivated to combine Charger 5 with MPEG Charger in view of the explicit motivation found within the MPEG Charger Reference: “MPEG Charger is a software-only MPEG option for Cleaner 5 that gives you comprehensive control over both MPEG-1 and MPEG-2 encoding,” and reference within Cleaner 5: “Cleaner MPEG Charger integrates seamlessly with Cleaner.” MPEG Charger at p. 9; Cleaner 5 at p. 209. The hypothetical person of ordinary skill in the art would have been aware of both of these references since they were publically available before the filing date of the ‘172 patent and would have known to combine the teachings of the two references in view of the explicit instruction within each of these references to do so. Accordingly, the references are properly combinable.

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In view of the analysis presented above, Requester submits that Cleaner 5 in view of MPEG Charger not only presents a substantial new question of patentability with respect to the requested claims, but also renders obvious each of the requested claims. Therefore, the claims of the ‘172 patent should be found null, void, unenforceable and otherwise unpatentable and a Certificate of Reexamination should issue with the same effect.

**C. CLAIMS 1-3, 5, 7, 9 AND 13-19 ARE RENDERED OBVIOUS BY AVID XPRESS IN VIEW OF AVID XPRESS DV AND THE MPEG STANDARD UNDER 35 U.S.C. 103(A)**

### SUMMARY OF AVID XPRESS

AVID Xpress was published at least one year before the priority date of the ‘172 patent and accordingly is prior art under 35 U.S.C. § 102(b). *See* Avid Xpress p. 4 (copyright 2000).

Avid Xpress is an advertising document promoting a software application for converting and editing video and audio files based on user input parameters. Avid Xpress at p. 1. The Avid Xpress system can receive video in many different input formats including popular animation file formats on Windows, Macintosh and SGI, including QuickTime formats. Avid Xpress at pp. 1, 3. The Avid Xpress software is designed to

accept these file types (and more) for editing and output. Among Avid Xpress' output features is the ability to output to format files into NTSC and PAL TV formats and further outputting video in compliance with the ITU R-601 standard for broadcast television. Avid Xpress at p. 3.

### **SUMMARY OF AVID XPRESS DV**

Avid Xpress DV was publically available at least one year earlier than the priority date of the '172 patent as evidenced by the retrieval of this document from the "Way Back Machine" indexed at [www.archive.org](http://www.archive.org).<sup>5</sup> Archive.org catalogues archived versions of websites and presents them on [www.archive.org](http://www.archive.org) for visitors to browse as those sites existed on the date "crawled." The crawled date is included within the URL of each page. The crawled date of this reference, which includes several different linked web pages<sup>6</sup> is no later than April 14, 2001, and therefore this reference qualifies as prior art under 35 U.S.C. 102(b).

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

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<sup>5</sup> Further, the Way Back Machine is a proper source for dating a reference. See [www.uspto.gov/web/menu/pbmethod/aiplafall02paper.htm](http://www.uspto.gov/web/menu/pbmethod/aiplafall02paper.htm); (paper authored by Wynn W. Coggins, Group Director of Technology Center 3600, supporting the use of the Way Back Machine by Examiners for dating references). See also [www.uspto.gov/web/menu/pbmethod/partnership.pps](http://www.uspto.gov/web/menu/pbmethod/partnership.pps) (slide show authored by Wynn W. Coggins, Group Director of Technology Center 3600, supporting the use of the Way Back Machine by Examiners for dating references).

<sup>6</sup> Avid Xpress DV: Overview page, dated March 31, 2001; Avid Xpress DV: Features page, dated April 10, 2001; Avid Xpress DV: Specifications page: dated April 10, 2001; Avid Xpress DV: Press Quotes page: dated April 14, 2001.

## SUMMARY OF MPEG STANDARD

MPEG standard was publically available at least one year earlier than the priority date of the '172 patent and is prior art under 35 U.S.C. § 102(b). MPEG standard is a document describing the international standard for creating MPEG files as recognized by the International Standards Organization. All MPEG files must be created in accordance with this standard.

The MPEG standard provides support for that which is inherent in creating MPEG files, however, for clarity, the MPEG standard is being presented here as a supporting reference in combination with Avid Xpress and Avid Xpress DV. The MPEG standard presents detailed teachings showing that many of the claim elements recited by the '172 patent were so well known that they were adopted in the international standard.

Requester respectfully submits that claims 1-3, 5, 7, 9 and 13-19 of the '172 patent are obvious over Avid Xpress in view of Avid Xpress DV and MPEG standard. The references were not discussed or applied either by the Examiner or the Applicant during the original prosecution and raise a substantial new question of patentability with respect to the claims of the '172 patent because they are not cumulative of any art previously of record and their teachings are such that a reasonable examiner would have considered Avid Xpress in view of Avid Xpress DV and MPEG standard pertinent to deciding the question of patentability of the requested claims. A claim chart setting forth the pertinency and manner of applying Avid Xpress and Avid Xpress DV and MPEG standard to these claims is submitted herewith as Exhibit CC-C.

**1. A method for converting video information from an incoming format to an outgoing format using a continuous pass conversion process free from one or more intermediary files, the method comprising:**

The Avid Xpress system is a software system for converting and editing video and multimedia content quickly and in a single step. Avid Xpress at p. 1. Additionally, Avid Xpress DV is a related application to Avid Xpress having a variety of exporting options including MPEG output abilities. Avid Xpress DV at p. 1 and FEATURES, p. 1.

**inputting video information in a first format;**

Avid Xpress is a software application having code to receive video in many different input formats including popular animation files on Windows, Macintosh and

SGI, and QuickTime formats. Avid Xpress at pp. 1, 3. Further, Avid Xpress supports the ITU R-601 standard for converting video into broadcast digital formats. Avid Xpress at p. 1. Furthermore, Avid Xpress DV, also receives RealMedia, Windows Media/ASF, IWMV, AVI and OMF/JFIF files input formats. Avid Xpress DV at FEATURES, p. 1.

**directly converting the video information in the first format to raw video information in an uncompressed format;**

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

**inputting a desired output media format based upon a first input;**

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

**inputting a desired video presentation standard based upon a second input;**

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

**directly resizing the raw video information in the uncompressed format into a size associated with the desired output media format and the desired video presentation standard;**

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

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

**directly adjusting the uncompressed format in the size associated with the desired output media format and the desired video presentation standard to a frame rate associated with the desired video presentation standard;**

The Avid Xpress software conforms to the ITU R-601 broadcast industry standard output for PAL and NTSC TV standards. Avid Xpress at p. 3. Therefore, Avid Xpress must adjust the output frame rate to comply with these standards having standard frame rates.

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

Table 2-40 – Video stream descriptor

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

**MPEG Standard at p. 62.**

**directly processing the uncompressed format in the size and the frame rate into an elementary video stream; and**

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



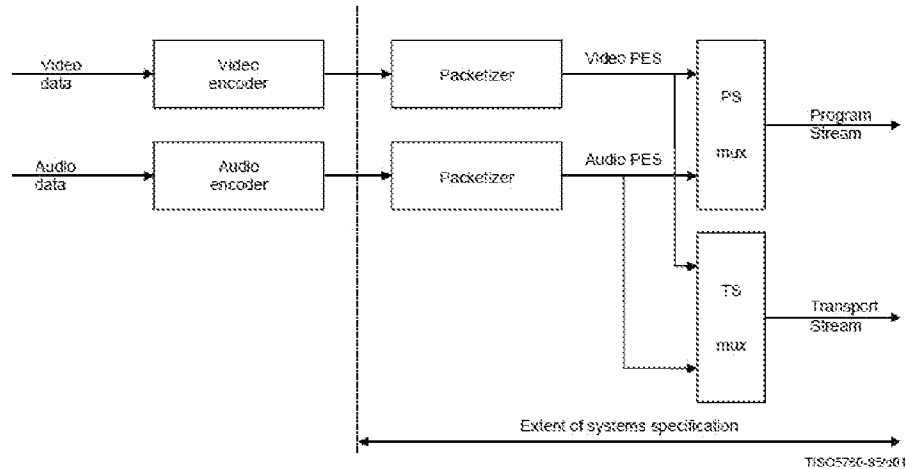


Figure Intro. 1 – Simplified overview of the scope of this Recommendation | International Standard

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

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

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

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

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

Both Avid Xpress and Avid Xpress DV support several different first formats including popular animation files on Windows, Macintosh and SGI, QuickTime,

RealMedia, Windows Media/ASF, IWMV, AVI and OMF/JFIF formats. Avid Xpress at pp. 1, 3 and Avid Xpress DV at FEATURES, p. 1.

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

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

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

**5. The method of claim 1 wherein the desired output media format is selected from either DVD, VCD, and Super VCD.**

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

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

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

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

Avid Xpress DV discloses seamlessly delivering the audio-visual output file to DVD. Avid Xpress DV at p. 1. Avid Xpress DV further discloses providing MPEG outputs and media formats including Web, DVD, and tape. Avid Xpress DV at p. 1 and FEATURES, p. 1.

**9. The method of claim 1 wherein the processing of the elementary video stream with audio information comprises a multiplexing process.**

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

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

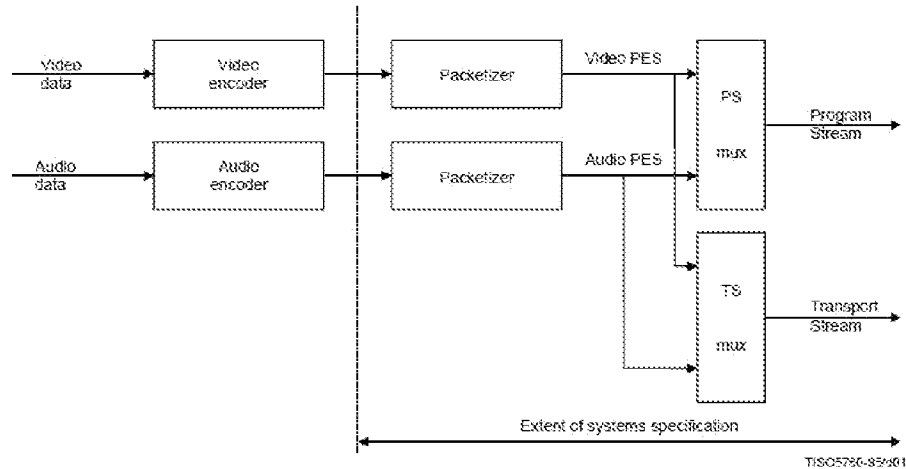


Figure Intro. 1 – Simplified overview of the scope of this Recommendation | International Standard

**13. The method of claim 1 further comprising processing the raw video information based upon video editing information based upon a fourth input.**

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

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

**14. The method of claim 1 further comprising processing the audio information based upon audio editing information based upon a fifth input.**

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

Both Avid Xpress and Avid Xpress DV comprise code directed to editing the audio information. Avid Xpress at p. 1 and Avid Xpress DV at FEATURES, p. 1. Both systems support eight-channel audio editing, equalizer options and gain adjustments among other audio processing capabilities. Avid Xpress at p. 1 and Avid Xpress DV at FEATURES, p. 1.

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

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

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

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

The Avid Xpress system is a software system provided on one or more memories for converting and editing video and multimedia content quickly. Avid Xpress at p. 1. Additionally, Avid Xpress DV is a related application to Avid Xpress having a variety of exporting options including MPEG output abilities. Avid Xpress DV at p. 1 and FEATURES, p. 1.

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

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

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

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

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

**a code directed to receiving a desired video presentation standard based upon a second input;**

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

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

The Avid Xpress software includes code for converting video information into uncompressed video using its uncompressed video option. Avid Xpress at pp. 1-2. Furthermore, since the Avid Xpress system receives compressed, encoded formats and outputs uncompressed formats it inherently uses a decoding process.

**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 video presentation standard;**

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

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

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

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

MPEG Standard at pp. 57, 58, 62, 121.

Table 2-46 – Video stream descriptor

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

MPEG Standard at p. 62.

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

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

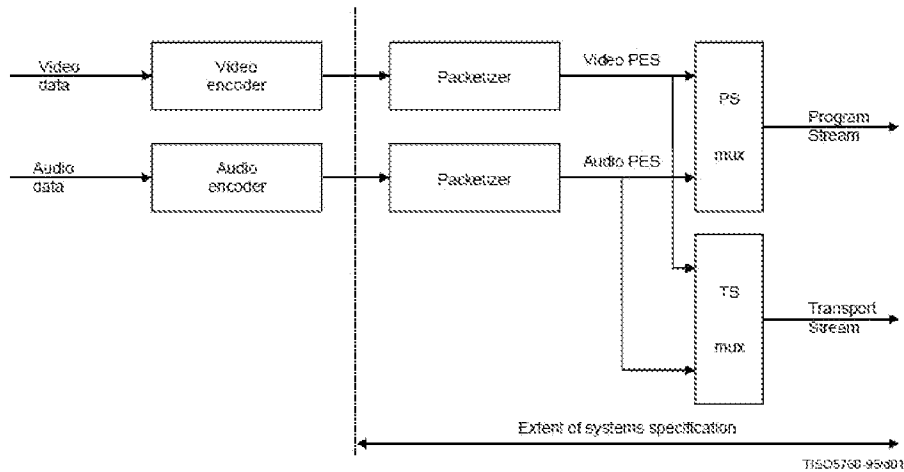


Figure Intro. 1 – Simplified overview of the scope of this Recommendation | International Standard

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

Avid Xpress and Avid Xpress DV include code for processing the elementary

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

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

**a code directed to receiving video editing information based upon a third input.**

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

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

Avid Xpress in view of Avid Xpress DV discloses the limitations of claim 16 as explained above.

Both Avid Xpress and Avid Xpress DV comprise code directed to editing the audio information. Avid Xpress at p. 1 and Avid Xpress DV at FEATURES, p. 1. Both systems support eight-channel audio editing, equalizer options and gain adjustments among other audio processing capabilities. Avid Xpress at p. 1 and Avid Xpress DV at FEATURES, p. 1.

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

Avid Xpress in view of Avid Xpress DV discloses the limitations of claim 16 as explained above.

The Avid Xpress system is an integrated computer software application for performing all audio and video editing in one application. Avid Xpress at p. 1.

**19. A method for converting video information from an incoming format to an outgoing format using a process free from one or more intermediary files, the method comprising:**

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

**receiving video information in a first format;**

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

**receiving a desired output media format based upon a first input and a desired video presentation standard based upon a second input;**

Avid Xpress is a software application having code to output video in many different formats including popular animation files on Windows, Macintosh and SGI, and QuickTime formats. Avid Xpress at pp. 1, 3. Further, Avid Xpress supports the ITU R-601 standard for converting video into broadcast digital formats in both the NTSC and PAL TV standards. Avid Xpress at pp. 1, 5. Therefore, Avid Express has code to receive output video in a compliant ITU-R601 format and in a desired video presentation standard. Furthermore, Avid Xpress DV, which is a companion application to Avid Xpress, also receives output formats such as MPEG-1, MPEG-2 and OMF/JFIF formats. Avid Xpress DV at FEATURES, p. 1. Avid Xpress DV enhances Avid Xpress capabilities providing MPEG outputs and media formats including Web, DVD, and tape. Avid Xpress DV at p. 1 and FEATURES, p. 1.

**decoding the video information in the first format to raw video information in an uncompressed format;**

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.

**directly resizing the raw video information in the uncompressed format into a size associated with the desired output media format and the desired video presentation standard and adjusting the uncompressed format in the size associated with the desired output media format and the desired video presentation standard to a frame rate associated with the desired video presentation standard;**

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

**encoding the uncompressed format in the size and the frame rate into an elementary video stream; and**

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

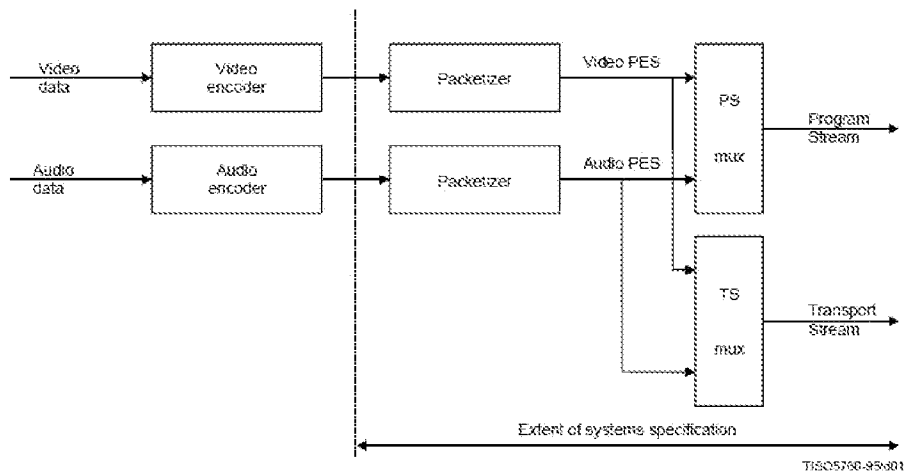


Figure Intro. 1 – Simplified overview of the scope of this Recommendation | International Standard

**multiplexing the elementary video stream with audio information in the desired output media format and the desired video presentation standard to form video and audio information in a presentation format based upon the desired output media format and the desired video presentation standard.**

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

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

### **REASONS TO COMBINE**

A person of ordinary skill in the art would have been motivated to combine the Avid Xpress reference with the Avid Xpress DV reference since Avid Xpress DV is a related software product made by the same entity. Their features significantly overlap and perform substantially the same functions. As further evidence of the combinability of Avid Xpress and Avid Xpress DV, a later version of Avid Xpress DV - Avid Xpress DV 2.0 - was explicitly designed to work with Avid Xpress and was marketed as having this compatibility. *See* OTH-C, Avid Xpress 2.0 (“Avid Xpress DV version 2 is simple to learn, yet hard to outgrow. It’s the personal Avid solution you’ve been waiting for: an easy-to-use, portable companion to Media Composer, Symphony and Avid Xpress systems.”).<sup>7</sup> Further the MPEG standard is properly combined with Avid Xpress and Avid Xpress DV since the MPEG standard discloses the international standard for creating MPEG files which implicitly (if not inherently) must already be a part of AVID

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<sup>7</sup> It is possible that Avid Xpress DV was also compatible with Avid Xpress, but Requester could not find any printed publication stating such compatibility. As such Avid Xpress DV 2.0 is presented as circumstantial evidence of the compatibility of Avid Xpress and Avid Xpress DV.

Xpress DV since it can create MPEG files. Therefore a person of ordinary skill in the art would have been explicitly motivated to combine the references. Accordingly, the references are properly combinable.

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In view of the analysis presented above, Requester submits that Avid Xpress in view of Avid Xpress DV and further in view of the MPEG standard not only presents a substantial new question of patentability with respect to the requested claims, but also renders obvious each of the requested claims. Therefore, the claims of the '172 patent should be found null, void, unenforceable and otherwise unpatentable and a Certificate of Reexamination should issue with the same effect.

**D. CLAIMS 1-12, 15 AND 19 ARE ANTICIPATED BY U.S. PATENT NO. 6,370,198 (“WASHINO”) UNDER 35 U.S.C. 102(E)**

**SUMMARY OF WASHINO**

Washino was filed as a United States Patent Application at least one year before the filing date of the '172 patent and accordingly is prior art under 35 U.S.C. § 102(e).

As noted above, Washino was not applied in a rejection by the Examiner during the prosecution of the '172 patent, but was used to reject and cause cancelation of claims that are not patentably distinct from claims 1-12, 15 and 19 during the prosecution of the '655 patent, which is the parent patent of the '172 patent. Since the claims in the '655 patent were rejected and eventually canceled, the same result should be given effect to the claims of the '172 patent. Please see above (Section III. C.) for a comparison of the rejected and canceled claims of the '655 patent and the presently patented claims of the '172 patent. Requester reiterates that Washino was never applied to the presently patented claims of the '172 patent. Indeed, no claim of the '172 has faced a rejection based on prior art.

In rejecting claims 1-12, 15 and 20 in the prosecution of the '655 patent (which correspond to claims 1-12, 15 and 19 in the '172 patent) the Examiner characterized the teachings of Washino as follows:

Washino discloses a wide-band multi-format audio/video production system with frame rate conversion. In figs. 3, 6 and 8, Washino discloses embodiment of the playback device for multi-format production system comprising graphics processor and signal processor, controller and user interface 814; the multi-format digital video production system enables a user to process an input video program to produce an output version of the program in a final format which may have a different frame rate. Washino discloses compatibility with existing and other formats associated with HDTV standard 4:3 or widescreen 16:9 high definition television, and film. Washino teaches that images are re-sized horizontally and vertically by pixel interpolation and frame rates are adapted by inter-frame interpolation. (see Abstract of the disclosure) Further, Washino teaches converting the signal to a HDTV format using a modified up conversion process for wideband signals (utilizing a higher sampling clock frequency) and a resizing to HDTV format frame dimensions in pixels. Washino on fig. 8 teaches that the video data stream may undergo a number of modifications within the graphics processor, shown generally at 830, depending on the desired final output format. Assuming that the output desired is NTSC or some other form of wide-screen or HDTV signal output at a nominal frame rate of 30 fps, a signal sourced from the disk at 24 fps would undergo a "3:2-pull-down" modification as part of the conversion process (as explained herein above). (col. 21, line 34-63) Washino also teaches "if output at 25 fps is desired, it is a simple matter to configure the various components of this system to replay the video information of the disk 802 at this higher frame rate. The controller will configure the speed control unit 806 (if necessary) to drive the motor 804 at a greater rotational speed to sustain the increased data rate associated with the higher frame rate. The audio processor 822, if so equipped, will be configured to correct for the change in pitch associated with the higher frame rate, and the graphics processor will be configured to provide all output signals at the 25 fps frame rate. As Alternate method for audio pitch correction, additional audio data can be stored in disk which is already corrected. When the frame rate is changed, the corresponding audio data is selected in accordance with the invention. (col. 22, lines 43-57) Furthermore, Washino teaches "In order to ensure accurate conversion, interlace and de-interlace processes should only be applied to decompressed signals. Conversely, speed-up and slow-sown [sic] procedures are preferably applied with compressed data, as the raw data rate for uncompressed video, depending on the image dimensions in pixels and frame rate, will be in the range of 30 to 100 MB per second, which is not practical for current technology storage devices." See col. 18, lines 50-63) Furthermore, Washino discloses that "materials produced at 25 fps and stored on the disk-based mass storage means of this example could originate from conventional standard or widescreen PAL format signals. Utilizing the slow-down method, these signals are readily converted to 24 fps frame rate, from which conversion to various 30 fps formats is

implemented, as disclosed hereinabove. This feature has significance in the commercial development of HDTV as the ability to utilize more-or-less conventional PAL format equipment greatly facilitates the economical production and origination of materials intended for HDTV markets ... A wide range of output frame rates may be made available through combination of the techniques of speed-up, slow-down, "3-2-pull-down," and other related field-rearrangement, de-interlacing, interlacing/de-interlacing, frame repetition, and frame reduction techniques ... " col. 22, line 58 thru col. 23, lines 10.

PAT-C, Non-Final Rejection, March 22, 2005, pp. 2-4.

In view of the Examiner's findings during the prosecution of the '655 patent and the arguments presented below, requester respectfully submits that claims 1-12, 15 and 19 in the '172 patent are anticipated by Washino. The reference was not discussed or applied either by the Examiner or the Applicant during the original prosecution and raises a substantial new question of patentability with respect to the claims of the '172 patent because it is not cumulative of any art previously of record and its teachings are such that a reasonable examiner would have considered Washino pertinent to deciding the question of patentability of the requested claims. A claim chart setting forth the pertinency and manner of applying Washino to these claims is submitted herewith as Exhibit CC-D.

**1. A method for converting video information from an incoming format to an outgoing format using a continuous pass conversion process free from one or more intermediary files, the method comprising:**

Washino discloses a multi-format digital video production system that enables a user to process an input video program to produce an output version of the program in a final format. Washino, Abstract, lines 1-3.

**inputting video information in a first format;**

Washino discloses inputting video information in a first format. Washino, Col 11, lines 51-54.

**directly converting the video information in the first format to raw video information in an uncompressed format;**

Washino discloses converting the inputted video information in the first format to an uncompressed format, such as YUV. Washino, Col 11, lines 54-63.

**inputting a desired output media format based upon a first input;**

Washino discloses that outputs can be configured to RGB format or other output media formats. Washino, Col 11, lines 51-54.

**inputting a desired video presentation standard based upon a second input;**

Washino discloses that the video data stream may undergo a number of modifications based on the desired output format such as NTSC/PAL or HDTV. Washino, Col. 21, line 56 to Col. 22, line 11; Col 11, lines 54-63.

**directly resizing the raw video information in the uncompressed format into a size associated with the desired output media format and the desired video presentation standard;**

Washino discloses that images are re-sized horizontally and vertically by pixel interpolation and frame rates are adapted by inter-frame interpolation. Washino, Abstract; Col. 18, lines 50-63.

**directly adjusting the uncompressed format in the size associated with the desired output media format and the desired video presentation standard to a frame rate associated with the desired video presentation standard;**

Washino discloses adjusting the frame rate of the uncompressed format to the desired frame rate of the video presentation standard. Washino, Abstract; Col. 18, lines 53-63.

**directly processing the uncompressed format in the size and the frame rate into an elementary video stream; and**

Washino discloses processing the uncompressed format in any selected size and frame rate into an elementary video stream. Washino, Col. 18, lines 50-63; Col. 20, lines 6-10.

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

Washino discloses processing the video format with audio information in the desired output media format. Specifically, Washino discloses adjusting the pitch of the audio based on the frame rate of the video which is related to the desired video standard. Washino, Col. 21, lines 45 to Col. 22, lines 15; Col. 22, lines 49-53.

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

Washino discloses the limitations of claim 1 as explained above.

Washino discloses the first format including a digital file, captured video stream, and analog captured video stream. Washino, Col. 15, lines 1-5. Specifically, Washino discloses that the input format can be either an analog signal, which will be processed into a digital file or a digital file. Washino, Col 11, lines 51-54; Col. 15, lines 1-5.

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

Washino discloses the limitations of claim 2 as explained above.

Washino discloses that the digital file can be in MPEG format. Washino, Col 11, lines 63-65; Col. 15, lines 1-5.

**4. The method of claim 1 wherein the uncompressed format is selected from RGB, and YUV.**

Washino discloses the limitations of claim 1 as explained above.

Washino discloses selecting an uncompressed format of RGB or YUV. Washino, Col 11, lines 54-63.

**5. The method of claim 1 wherein the desired output media format is selected from either DVD, VCD, and Super VCD.**

Washino discloses the limitations of claim 1 as explained above.

Washino discloses selecting a media format such as DVD. Washino, Col. 6, lines 48-60.

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

Washino discloses the limitations of claim 5 as explained above.

Washino discloses quality editing for multi-format video production. Washino, Col. 1, lines 14-21. Specifically Washino disclose that if DVD type storage is selected a higher data compression can be used to fit an entire program of 120 minutes onto the storage media. Washino, Col. 17, lines 52-62.

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

Washino discloses the limitations of claim 1 as explained above.

Washino discloses writing or recording the video and audio information onto a disk media, such as DVD. Washino, Col. 6, lines 48-60.

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

Washino discloses the limitations of claim 1 as explained above.

Washino discloses wherein the digital file can be distributed in MPEG-2 format and recorded onto DVD. Washino, Col 5, lines 19-34.

**9. The method of claim 1 wherein the processing of the elementary video stream with audio information comprises a multiplexing process.**

Washino discloses the limitations of claim 1 as explained above.

Washino discloses that audio signals can be included within the digital stream and that the audio can be integrated by available methods such as AVI. Washino, Col. 12, lines 1-7.

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

Washino discloses the limitations of claim 1 as explained above.

Washino discloses adjusting the audio data in accordance with the video output. Washino, Col. 22, lines 43-57.

**11. The method of claim 10 wherein the desired frequency is selected from 48 kHz for DVD, 44.1 kHz for VCD and SVCD.**

Washino discloses the limitations of claim 10 as explained above.

Washino discloses writing audio-video to DVD, which inherently requires an audio frequency of at least 48 kHz. Washino, Col 5, lines 19-34; *see* OTH-D, DVD Authoring, p. 41 (Audio written in DVD-Video format requires a frequency of at least 48kHz).

**12. The method of claim 1 wherein the directing converting, directly resizing, and directly adjusting, and directly processing are performed free from one or more intermediary files.**



Washino discloses the limitations of claim 1 as explained above.

Washino discloses that in some embodiments only one conversion step is required. Washino, Col. 18, lines 50-63.

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

Washino discloses the limitations of claim 1 as explained above.

Washino discloses encoding the uncompressed format to preserve the full bandwidth of the high-resolution signal. Washino, Col. 7, lines 39-43.

**19. A method for converting video information from an incoming format to an outgoing format using a process free from one or more intermediary files, the method comprising:**

Washino discloses a multi-format digital video production system that enables a user to process an input video program to produce an output version of the program in a final format. Washino, Abstract.

**receiving video information in a first format;**

Washino discloses receiving video information in a first format. Washino, Col 11, lines 51-54.

**receiving a desired output media format based upon a first input and a desired video presentation standard based upon a second input;**

Washino discloses that outputs can be configured to RGB format or other output media formats. Washino, Col 11, lines 51-54. Further, Washino discloses that the video data stream may undergo a number of modifications based on the desired output format such as NTSC/PAL or HDTV. Washino, Col. 21, line 56 to Col. 22, line 11; Col 11, lines 54-63.

**decoding the video information in the first format to raw video information in an uncompressed format;**

Washino discloses converting the inputted video information in the first format to an uncompressed format, such as YUV. Washino, Col 11, lines 54-63.

**directly resizing the raw video information in the uncompressed format into a size associated with the desired output media format and the desired video presentation standard and adjusting the uncompressed format in the size associated with the**

**desired output media format and the desired video presentation standard to a frame rate associated with the desired video presentation standard;**

Washino discloses that images are re-sized horizontally and vertically by pixel interpolation and frame rates are adapted by inter-frame interpolation. Washino, Abstract; Col. 18, lines 50-63. Additionally, Washino discloses adjusting the frame rate of the uncompressed format to the desired frame rate of the video presentation standard. Washino, Abstract; Col. 18, lines 50-63.

**encoding the uncompressed format in the size and the frame rate into an elementary video stream; and**

Washino discloses processing and encoding the uncompressed format in any selected size and frame rate into an elementary video stream. Washino, Col. 7, lines 39-43; Col. 18, lines 50-63; Col. 20, lines 6-10.

**multiplexing the elementary video stream with audio information in the desired output media format and the desired video presentation standard to form video and audio information in a presentation format based upon the desired output media format and the desired video presentation standard.**

Washino discloses processing the video format with audio information in the desired output media format. Specifically, Washino discloses adjusting the pitch of the audio based on the frame rate of the video which is related to the desired video standard. Washino, Col. 21, lines 45-55; Col. 22, lines 49-53.

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In view of the analysis presented above, Requester submits that Washino not only presents a substantial new question of patentability with respect to the requested claims, but also anticipates each of the requested claims. Therefore, the claims of the '172 patent should be found null, void, unenforceable and otherwise unpatentable and a Certificate of Reexamination should issue with the same effect.

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## V. CONCLUSION

The claims of the '172 patent discussed herein are unpatentable in light of the prior art documents presented in the Request above. These prior art documents were either not previously considered by the Office or are now being presented in a new light pursuant to MPEP § 2642(II)(A). These prior art documents teach the subject matter of the '172 patent in a manner such that Substantial New Questions of patentability for all claims are raised by this Request.

In view of the foregoing, it is respectfully submitted that a substantial new question of patentability of claims 1-19 of U.S. Patent No. 7,283,172 have been raised by this Request. Accordingly, the Office is requested to grant this Request and to initiate reexamination with special dispatch.

As an aid to the application of the presented prior art to claims of the '172 patent, corresponding claim charts are provided at Exhibit CC-A through CC-D attached hereto.

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

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