

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HARALD BRUSEWITZ

Appeal No. 95-3811
Application 08/249,081¹

HEARD: November 3, 1998

Before URYNOWICZ, THOMAS and FLEMING , Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner

¹ Application for patent filed May 25, 1994

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final rejections of claims 3-6 and 13, which constitute all the claims remaining in the application.

Representative claim 13 is reproduced below:

13. A method for image coding a video signal having a known frame rate comprising the steps of:

coding and quantising the video signal to effect digitalisation and compression of the signal to form a bit stream having a bit rate determined by the transmission line on which the bit stream is to be transmitted;

storing the bit stream in a buffer store such that
 $(\text{GOB} - 1 + \text{MB}/33)/12 \times (k1 + g) R/\text{fo} + \text{bR}/\text{for}$
where GOB is the number of the block group,

of MB is the number of the macroblock, k1 is the number of skipped frames, which are determined by the coder,

fo is the frame rate of video signal,

R is the bit stream rate,

g takes into account when the coding is terminated, and bR/fo is the minimum allowed content in the buffer;

monitoring the content of the buffer store;

sensing the rate of the bit stream at the output of the buffer store, calculating the ideal buffer store content, and

adjusting the step height in the quantiser as a function of the difference between the monitored and ideal buffer store contents.

There are no references relied by the examiner.

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Claims 3-6 and 13 stand rejected under 35 U.S.C. 112, first paragraph, as being based upon a nonenabling disclosure.

Rather than repeat the positions of the appellant and the examiner, reference is made to the brief and the answer for the respective details thereof.

Opinion

We reverse this rejection.

Generally speaking, "[t]he test of enablement is whether one reasonably skilled in the art could make or [sic and] use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), citing Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986). The specification need not disclose what is well known in the art. In re Buchner, 99 F.2d 660, 18 USPQ 2d 1331, 1332 [Fed. Cir. 1991].

It appears that the examiner had reasonable basis for questioning the adequacy of the disclosure upon our review of

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the prosecution history of this application. However, the examiner has made no effort to provide a nexus of the enumerated deficiencies noted in the answer to the subject matter of the present claims on appeal. As disclosed, the context of the implementation of the disclosed and closed invention is the formats and standards provided by the International Consultative committee for Telegraphs and Telephones 'CCITT' H. 261 video standard. The examiner does not appear to appreciate the impact that such standards have upon the level of enablement necessary to meet the first paragraph of U.S.C. 112.

It is not necessarily fatal that appellant may albeit, as has been done during the prosecution of this application, that certain errors occurred in the original filing of the translation or even the original priority document itself. What is significant is that the standard of judging such a disclosure remains that under experimentation must be necessary for the artist to make and use the claimed invention for such a rejection to be sustained. While some degree of experimentation is permitted in order for a specification to be considered enabling under 35 U.S.C. 112, first paragraph, that

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level of experimentation must not be "undue." In re Wright, 99 Fd 2 1557, 1561, 27 USPQ 2d 1510, 1513 (Fed. Cir. 1993): In re Back, 949 Fd2 488, 495, 20 USPQ 2D 1438, 1444 (Fed. circuit 1991). Obviously, this must be determined on a case-by-case basis. Appellant has provided an initial and supplemental declaration from someone other than himself recognizing the noted errors in the specification as filed and deficiencies therein and offering opinion and factual evidence and common sense in the art from an artisan's perspective how the artisan would have reacted or does react to these noted deficiencies. Over all, to the extent we find a direct relationship of the noted deficiencies in the specification by the examiner to the presently claimed subject matter, the weight of the evidence clearly indicates that the overall specification and drawings would not have led the artisan to conduct undue experimentation but only a reasonable degree of routine experimentation in order to make and use the presently claimed subject matter. Therefore, the decision of the examiner rejecting claims 3-6 and 13 under the first paragraph 35 U.S.C. 112 is reversed.

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REVERSED

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Stanley M. Urynowicz))
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)	BOARD OF PATENT
James Thomas)	
Administrative Patent Judge)	APPEALS AND
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