

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD J. BOWATER, MICHAEL COBBERT
and MERVYN A. STATON

Appeal No. 1998-2577
Application No. 08/594,054

ON BRIEF

Before THOMAS, HAIRSTON, and HECKER, Administrative Patent Judges.

HECKER, Administrative Patent Judge.

DECISION ON APPEAL

Appeal No. 1998-2577
Application No. 08/594,054

This is a decision on appeal from the final rejection of claims 1, 3 through 14¹ and 16 through 26, all claims pending in this application.

The invention relates to processing a stored digitized audio signal to vary the playback speed of the signal without changing the pitch or causing any distortion. In particular, the playback speed is varied by deleting or repeating selected encoded blocks of the digitized audio signal.

Representative independent claim 1 is reproduced as follows:

1. A method for varying the speed of playback of a stored audio signal encoded as a sequence of digitised audio data blocks using a history based encoding technique, the audio data blocks each corresponding to a fixed time period of the audio signal, comprising the steps of
accessing a stored set of digitised audio data blocks
processing said set of digitised audio data blocks in encoded form by omitting or repeating complete selected digitised audio data blocks in accordance with a desired variation in speed, and

¹ The Examiner correctly notes that the copy of claim 14 included in the appendix to the brief is missing the phrase "audio output from said decoded digitized audio data blocks."

Appeal No. 1998-2577
Application No. 08/594,054

decoding said processed digitised audio data blocks to produce an audio signal output, wherein said outputted audio signal has the desired variation in playback speed relative to the stored audio signal.

The Examiner relies on the following references:

Asada et al. (Asada)	4,435,832	Mar. 6, 1984
Hejna, Jr. et al. (Hejna)	5,175,769	Dec. 29, 1992

Claims 1, 3 through 14 and 16 through 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Asada in view of Hejna.²

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the brief and answer for the respective details thereof.

OPINION

After a careful review of the evidence before us, we will not sustain the rejection of claims 1, 3 through 14 and 16 through 26 under 35 U.S.C. § 103.

² A 35 U.S.C. § 112, second paragraph rejection and a 35 U.S.C. § 103 rejection based on Yuzo in view of Hejna have been withdrawn, advisory action, paper no. 11, mailed Jan. 16, 1998.

Appeal No. 1998-2577
Application No. 08/594,054

The Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983).

"Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." *Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) (*citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

The Examiner reasons that Asada teaches the claimed invention but fails to explicitly teach the system is a voice mail system. The Examiner cites Hejna for this teaching and states:

It would have been obvious to one of ordinary skill in the art at the time the present invention was

Appeal No. 1998-2577
Application No. 08/594,054

made to combine the teachings of Hejna, Jr. et al into the system of Asada et al because Hejna, Jr. et al teaches time scale modification system (stretching and compressing the speech time base is considered as TSM) can be used by a voice mail system in order to provide a message to a listener as a faster or slower rate than that at which the message was recorded as taught by Hejna, Jr. et al (col. 1, lines 40-43). [Answer-pages 3 and 4.]

Appellants do not contest the use of Hejna in the rejection, and accept Hejna for its teaching of use in a voice mail system. Appellants also indicate that the Examiner's reliance on Hejna for history-based encoding is moot since they concede Asada teaches such a technique (brief-page 10).

Appellants also acknowledge that Asada relates to altering the playback speed of a voice signal without changing the pitch (brief-page 5), and "operates on audio data encoded as 20 ms LPC frames (blocks), exactly the same form of input data as the present invention." (brief-page 8).

However, Appellants argue that Asada discloses two systems, neither of which teaches Appellants' claimed invention. The first system of Asada is disclosed as a prior art system. The prior art system repeats or deletes unencoded waveforms to vary the playback speed. This is contrary to

Appeal No. 1998-2577
Application No. 08/594,054

Appellants' claimed invention in that Appellants repeat or delete encoded data blocks. Appellants' data blocks are of a fixed time period as opposed to waveforms which vary in time period. Thus, although Asada repeats or deletes a waveform, the waveform is very different than Appellants' data block. That is, Asada's prior art is repeating or deleting unencoded waveforms that do not have a fixed time period (i.e., waveforms having varying time periods), as opposed to Appellants' encoded data blocks (blocks which have a fixed time period).

Appellants argue that Asada's second system, Asada's main embodiment, differs from that claimed by Appellants in that Asada varies playback speed by stretching or compressing data blocks, not repeating or deleting data blocks as claimed by Appellants. (brief-pages 10 and 11.)

We agree with Appellants that Asada's prior art and main embodiment each individually fails to teach the argued limitations of both independent claims 1 and 14.

The Examiner responds that the rejection combines the repeating or deleting teachings of Asada's prior art

Appeal No. 1998-2577
Application No. 08/594,054

disclosure with the encoded data blocks of Asada's main embodiment, stating "It would have been obvious to one of ordinary skill in the art that the main embodiment of Asada et al is based on the improvement of the prior art of Asada et al, thus, it is clear that the prior art of Asada et al can be combined with the main embodiment of Asada et al." (answer-page 5).

We find the Examiner's rationale rather circular and without motivation as argued by Appellants (brief-pages 9 and 10).

The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." **In re Fritch**, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), **citing In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." **Para-Ordnance Mfg. v. SGS**

Appeal No. 1998-2577
Application No. 08/594,054

Importers Int'l, 73 F.3d at 1087, 37 USPQ2d at 1239, **citing** *W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13.

As pointed out by Appellants, "The Examiner's rejection has...cojoined features from two quite distinct systems (one prior art, one new in Asada). This has created a system that is neither taught nor suggested by Asada (and indeed is technically infeasible, due to incompatible input data formats);" (brief-pages 9 and 10). Since there is no evidence in the record that the prior art suggested the desirability of such a modification, or how such a combination would operate in view of incompatibilities, we will not sustain the Examiner's rejection of claims 1 and 14.

The remaining claims on appeal also contain the above limitations discussed in regard to claims 1 and 14 and thereby, we will not sustain the rejection as to these claims.

Appeal No. 1998-2577
Application No. 08/594,054

We have not sustained the rejection of claims 1, 3
through 14 and 16 through 26 under 35 U.S.C. § 103.
Accordingly, the Examiner's decision is reversed.

REVERSED

	JAMES D. THOMAS)	
	Administrative Patent Judge)	
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)	
	KENNETH W. HAIRSTON)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
	STUART N. HECKER)	
	Administrative Patent Judge)	

Appeal No. 1998-2577
Application No. 08/594,054

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