

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AKIRA TSUKIHASHI

Appeal No. 2004-0507
Application No. 09/476,862

ON BRIEF

Before RUGGIERO, GROSS, and BARRY, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 3-12, which are all of the claims pending in the present application. Claims 1 and 2 have been canceled.

The claimed invention relates to the recording of data which is sent at a slower data transmission speed than the data processing speed at which data is written on to a disk. Operation of a recording data processing circuit is suspended by a control circuit until the amount of received data temporarily

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stored in a buffer memory reaches a predetermined amount which is equivalent to the writing capacity of the data processing circuit. According to Appellant (specification, pages 3 and 4) the suspension of operation, effected by either interrupting the power supply or halting the supply of an operating clock, results in a reduction of power consumption. Further provided is a synchronization feature which enables new data to be recorded successive to the recording region where the last data was recorded before the suspension of operation.

Claim 3 is illustrative of the invention and reads as follows:

3. A recording data processing circuit for processing received data sent at a slower data transmission speed than a data processing speed at which to write recording data onto a non-erasable, write-once disk, comprising:

a buffer memory for temporarily storing the received data;

a data processing circuit for preparing the recording data to record onto the disk, based on the received data read from the buffer memory;

a system control circuit for controlling writing and reading of the received data with respect to the buffer memory, and the operation of the data processing circuit, and

a writing circuit for writing the recorded data supplied from the data processing circuit, onto the disk,

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wherein

the system control circuit suspends operation of the data processing circuit until an amount of received data equivalent to a predetermined writing capacity has been stored in the buffer memory, and releases suspension of the operation of the data processing circuit when an amount of received data equivalent to the predetermined writing capacity has been stored in the buffer memory, said data processing circuit for recording data being placed in a suspended state by interrupting the power supply or by halting the supply of an operation clock,

wherein

the system control circuit stores an address successive to an address of received data last recorded onto the disk, as a recording start address on the disk, and controls the writing circuit so as to write the recording data supplied from the data processing circuit onto the disk at the recording start address,

and wherein

the system control circuit synchronizes the recording data to be newly recorded onto the disk, supplied from the data processing circuit to the writing circuit, with recording data recorded on the disk, said data processing circuit being operated in synchronism with a reproduction clock obtained by reproducing the data already recorded on the disk.

The Examiner relies on the following prior art:

Landry et al. (Landry)	5,434,997	Jul. 18, 1995
Shinada	5,436,875	Jul. 25, 1995

Claims 3-12, all of the appealed claims, stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Shinada in view of Landry.

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Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs¹ and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in claims 7 and 8. We reach the opposite conclusion with respect to claims 3-6 and 9-12. Accordingly, we affirm-in-part.

¹ The Appeal Brief was filed July 28, 2003 (Paper No. 21). In response to the Examiner's Answer dated August 22, 2003 (Paper No. 22), a Reply Brief was filed October 24, 2003 (Paper No. 23), which was acknowledged and entered by the Examiner as indicated in the communication dated November 6, 2003 (Paper No. 24).

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As a general proposition in an appeal involving a rejection under 35 U.S.C. § 103, an Examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to Appellant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1051-52, 189 USPQ 143, 147 (CCPA 1976).

With respect to independent claim 7, after reviewing the Examiner's analysis (Answer, pages 7 and 8) of the claimed invention relative to the applied prior art, it is our view that such analysis carefully points out the teachings of the Shinada and Landry references, reasonably indicates the perceived differences between this applied prior art and the claimed invention, and provides reasons as to how and why the prior art teachings would have been modified and/or combined to arrive at the claimed invention. In our opinion, the Examiner's analysis is sufficiently reasonable that we find that the Examiner has at

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least satisfied the burden of presenting a prima facie case of obviousness. The burden is, therefore, upon Appellant to come forward with evidence and/or arguments which persuasively rebut the Examiner's prima facie case of obviousness. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived (see 37 CFR § 41.37(c)(1)(vii)).

Appellant's arguments in response to the obviousness rejection of claim 7 based on the combination of Shinada and Landry assert that the Examiner has failed to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art references. After careful review of the applied Shinada and Landry references in light of the arguments of record, we find Appellant's assertions to be unpersuasive.

Initially, Appellant contends (Brief, page 4; Reply Brief, pages 3 and 4) that, unlike the claimed invention, the recording system of Shinada is not directed to a non-erasable, write-once disk (CD-R). It is apparent to us, however, from the language of

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claim 7 that, to whatever extent Appellant may be correct that Shinada does disclose a CD-R disk, no such limitation appears in claim 7 as pointed out by the Examiner (Answer, page 10).

As to Appellant's arguments directed to the alleged lack of motivation for the Examiner's proposed combination of Shinada and Landry, we find no error in the Examiner's position as articulated at page 8 of the Answer. In our view, Appellant's arguments unpersuasively focus on the individual differences between the limitations of claim 7 and each of the applied references. It is apparent, however, from the Examiner's line of reasoning in the Answer, that the basis for the obviousness rejection is the combination of Shinada and Landry. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986).

In other words, while Appellant contends (Brief, page 4; Reply Brief, page 5) that Landry lacks a teaching of suspending system operation dependent on buffer capacity, this feature is provided by Shinada. Further, although Appellant argues (id.) that Shinada fails to disclose that suspension of operation is

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performed by interrupting the power supply or halting the supply of a system clock, such a teaching is clearly provided by Landry.

For the above reasons, since it is our opinion that the Examiner's prima facie case of obviousness has not been overcome by any convincing arguments from Appellant, the Examiner's 35 U.S.C. § 103(a) rejection of independent claim 7, as well as dependent claim 8 not separately argued by Appellant, is sustained.

We next consider the Examiner's 35 U.S.C. § 103(a) rejection of claims 3-6 and 9-12 and note that, while we found Appellant's arguments to be unpersuasive with respect to the Examiner's rejection of claims 7 and 8 discussed supra, we reach the opposite conclusion with respect to claims 3-6 and 9-12. In particular, we agree with Appellant that, as presently claimed, neither Shinada nor Landry has any suggestion of performing synchronization of newly recorded data with previously recorded data on a disk by utilizing a reproduction clock obtained by reproducing the previously recorded data.

We recognize that the Examiner, in addressing the claimed synchronization feature, directs attention (Answer, page 5) to the portion of Shinada (column 8, lines 19-26) which describes the returning of a recording head to a previous recording

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position during repeated processing steps. In the Examiner's view, this disclosure inherently would involve the synchronization of newly recorded data with previously recorded data. We find, however, no evidence forthcoming from the Examiner that would support such a conclusion. To establish inherency, evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and would be recognized as such by persons of ordinary skill. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) citing Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." Id. citing Continental, 948 F.2d at 1269, 20 USPQ2d at 1749.

It is further our view that even assuming, arguendo, that the Examiner's assertion of inherency is correct, the limitations of independent claim 3 (and its dependent claims 4-6) and dependent claim 9 (and its dependent claims 10-12) would not be satisfied. It is apparent from the clear language of the claims that it is not merely synchronization of new data with previous data that is being claimed but, rather, a particular manner in

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which synchronization is being performed. We find this particular synchronization feature, i.e., synchronizing by the use of reproduced data to obtain a reproduction clock, not taught or suggested by either of the applied Shinada and Landry references. Accordingly, for the reasons discussed above, since the Examiner has not established a prima facie case of obviousness, the 35 U.S.C. § 103(a) rejection of claims 3-6 and 9-12 is not sustained.

In summary, with respect to the Examiner's 35 U.S.C. § 103(a) rejection of appealed claims 3-12, we have sustained the rejection of claims 7 and 8, but have not sustained the rejection of claims 3-6 and 9-12. Therefore, the Examiner's decision rejecting claims 3-12 is affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(effective September 13, 2004; 69 Fed. Reg. 49960 (August 12, 2004); 1286 Off. Gaz. Pat. and TM Office 21 (September 7, 2004)).

AFFIRMED-IN-PART

JOSEPH F. RUGGIERO)	
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)	BOARD OF PATENT
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