

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 55

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIDEO MAKINO

Appeal No. 97-0783
Application 08/396,184¹

ON BRIEF

Before URYNOWICZ, JERRY SMITH and RUGGIERO, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 7, 8 and 10, which constitute all the claims remaining in the application. An amendment after final

¹ Application for patent filed February 24, 1995. According to appellant, this application is a continuation of Application 08/171,895, filed December 22, 1993, which is a continuation of Application 07/946,005, filed September 15, 1992, which is a continuation of Application 07/865,823, filed April 1, 1992, which is a continuation of Application 07/660,965, filed February 26, 1991, which is a continuation of Application 07/461,735, filed January 8, 1990.

rejection was filed on May 10, 1996 and was entered by the examiner.

The disclosed invention pertains to a remote controller for outputting timing and control signals to a video recorder. More particularly, data is entered and displayed at the remote control for items such as channel number, date or day of the week, and times for starting and ending recording. After all the data for the several items has been stored within the remote control, the data is sent to the video recorder by way of a control signal. The data within the remote control is maintained after the control signal has transferred the data to the video recorder.

Representative claim 7 is reproduced as follows:

7. A remote controller for outputting timing and control signals to a video recorder comprising:
 - a start switch for starting a program sequence in which the controller can be programmed;
 - a display means for displaying data having a plurality of display areas, arranged in a row, for displaying items of data to be entered into the controller for transmission into the video recorder, the items of data including channel number, date or day of the week, and recording start and finish time;
 - rotary switches, arranged in a row parallel to the row of display areas, for setting data displayed in respective corresponding ones of said display areas;
 - each of said rotary switches being positionally aligned with said respective corresponding ones of said display areas;
 - control means for enabling entry of data in said display areas by operation of said rotary switches in response to operation of said start switch;
 - a transfer switch for transferring a control signal to the video recorder, the control signal including data entered in response to operation of said start switch; and

Appeal No. 97-0783
Application 08/396,184

said control means including means for maintaining said data entered in said display areas after operation of said transfer switch despite operation of said rotary switches.

The examiner relies on the following references:

Sakurada et al. (Sakurada)	4,449,805	May 22, 1984
Koide	4,450,487	May 22, 1984

Claims 7, 8 and 10 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Sakurada in view of Koide.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answers for the respective details thereof.

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, the 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 answers.

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 not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 7, 8 and 10. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a

Appeal No. 97-0783
Application 08/396,184

factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to independent claims 7 and 10, the examiner basically finds that Sakurada teaches all the recitations of these claims except for a transfer switch for transferring a control signal to a video recorder and a means for maintaining data entered into the display [answer, pages 3-5]. The examiner cites Koide as teaching the claimed transfer switch and the claimed maintaining means. The examiner

Appeal No. 97-0783
Application 08/396,184

asserts that it would have been obvious to the artisan to modify the Sakurada remote controller to include these features of Koide [id.].

Appellant points out that the claimed transfer switch sends data that has been previously entered into the remote controller by other input means. Appellant argues that the remote controller of Koide does not have a transfer switch as recited in independent claims 7 and 10 [brief, pages 9-14]. It is further argued that there is no control means for maintaining data entered into the display as recited in independent claims 7 and 10 [*id.*, pages 14-15]. We agree with each of appellant's arguments.

The examiner has failed to consider all the language of claims 7 and 10. The rejection only notes that Koide teaches a transfer switch for transferring a control signal to the video recorder. Claims 7 and 10, however, additionally recite “the control signal including data entered in response to operation of said start switch [second user input means] [emphasis added]. Thus, it is not enough that a control signal such as “play” be sent to the video recorder. The control signal must also include data entered in response to operation of the start switch. Koide in no way suggests transferring any data from the remote control unit to the video recorder along with a control signal. The examiner has simply failed to address this limitation of claims 7 and 10 and has failed to address appellant's arguments directed to this language of the claims.

With respect to the means for maintaining data entered into the display feature of claims 7 and 10, the examiner continues to cite column 6, lines 57-61 of Koide despite appellant's assertions that there is nothing in that portion of Koide related to the examiner's point. Appellant is clearly correct that the portion of Koide cited by the examiner is irrelevant to the claimed feature. It appears that the examiner

Appeal No. 97-0783
Application 08/396,184

meant to refer to the same portion of Sakurada rather than Koide. Nevertheless, neither reference supports this recitation of claims 7 and 10.

It should be noted that claims 7 and 10 recite a specific sequence of operations taking place. The control means operates in response to operation of the start switch [second user input means]. The transfer switch also operates to transfer a control signal including data entered in response to the operation of the start switch [second user input means]. Finally, the means for maintaining is invoked after operation of the transfer switch despite operation of the rotary switches [first user input means]. We are unable to find structure in either Sakurada or Koide which implements these functions in the claimed manner.

In summary, we agree with appellant that the examiner's rejection fails to consider the specific recitations of independent claims 7 and 10. Therefore, the examiner has failed to establish a prima facie case for the obviousness of claims 7 and 10. Accordingly, we do not

Appeal No. 97-0783
Application 08/396,184

sustain the examiner's rejection of claims 7 and 10 or of dependent claim 8. The decision of the examiner rejecting claims 7, 8 and 10 is reversed.

REVERSED

STANLEY M. URYNOWICZ, JR.)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JERRY SMITH)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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Appeal No. 97-0783
Application 08/396,184

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