

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SYOJI MITSUHASHI,
and SATORU GOZU

Appeal No. 97-2582
Application 08/484,353¹

ON BRIEF

Before KRASS, FLEMING and LEE, Administrative Patent Judges.

LEE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 7, 8-10 and 15-18. No claim has been allowed.

References relied on by the Examiner

Kinoshita et al. (Kinoshita)	5,170,262	Dec. 8, 1992
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¹ Application for patent filed June 7, 1995. According to appellants, the application is a division of Application 08/144,809, filed October 28, 1993, now Patent No. 5,497,193, granted March 5, 1996.

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recorded in said memory means on said display means in response to a second switching operation performed by pushing the push button partially in.

15. An electronic still camera comprising:

means for forming a data image of an object to be photographed;

means for displaying said image data as a picture on a display means;

a memory;

means for recording said image data in said memory in response to a first switching operation;

means for reproducing and displaying said image data recorded in said memory on said display means in response to a second switching operation; and

a two-level push button wherein said second switching operation is made when said push button is pushed partially in and said first switching operation is made when said push button is pushed all the way in.

17. An electronic still camera comprising:

a push button having a first, second, and third operating positions;

means for forming a data image of an object to be photographed;

means for displaying said image data as a picture on a display means when said push button is in said third operating position;

a memory;

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means for recording said image data in said memory in response to said push button being in said second operating position;

means for reproducing and displaying said image data recorded in said memory on said display means in response to said push button being in said first operating position.

Opinion

We reverse.

A reversal of the rejections on appeal should not be construed as an affirmative indication that the appellants' claims are patentable over prior art. We address only the positions and rationale as set forth by the examiner and on which the examiner's rejection of the claims on appeal is based.

All independent claims require at least two operative positions of a single push-button switch, one of which causes the recording of image data into a memory means and the other of which causes reproduction of the recorded image data. Claim 17 requires a third operative position of the push-button which simply displays the formed image data as a picture on a display means.

In its first disclosed embodiment, Kinoshita discloses a switch 15 which when depressed freezes a current image on

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display and records the same on a recording disk 20. When the switch is depressed again, operation of the camera returns to that of displaying on a monitor the new images formed.

(Column 4, lines 1-30). In column 3, lines 40-48, Kinoshita describes:

An FM demodulator 24 demodulates an FM reproduction signal supplied from the recording/reproduction amplifier 22. An analog image signal output from the FM demodulator 24 is supplied to the camera signal processing circuit 5 of the image pickup section 1. Therefore, the signal reproduced from the recording disk 20 can be displayed on the monitor 10 in the same manner as an image signal from the image pickup element 4.
(Emphasis added.)

Thus, it is evident that Kinoshita does contemplate the reproduction of the recorded image on a monitor, even in the case of its first disclosed embodiment. How reproduction of the recorded image is triggered, however, is not specifically discussed. It is not known which switch is acted on to provide reproduction of the recorded image data, although it is apparent that the recording/reproduction amplifier 22 is involved. For instance, in column 3, lines 33-36, Kinoshita states: "A recording/reproduction amplifier 22 is used to amplify a signal when the signal is to be recorded on the magnetic disk 20 or when a signal described later is

reproduced."

A second embodiment is disclosed in Kinoshita, which involves the use of a switch 30. In column 5, lines 28-37, it is stated:

A switch 30 controls the start of a recording/reproduction amplifier 22. The switch 30 is used to determine whether an image in a frame memory 7 of the image pickup section 1 is recorded on a disk 23. When the switch 30 is lightly depressed, a current image is not recorded on the disk 23 but a next image in the frame memory 7 is transferred. When the switch 30 is strongly depressed, a current image on the frame memory 7 is transferred, and both the frame memory 7 and a recording disk 20 can record a new image.

It appears that although the amplifier 22 can be used for either recording or reproduction, switch 30 only activates the recording function of amplifier 22. To the extent that amplifier 22 can be activated to reproduce information from the disk 23, Kinoshita is silent as to what activates that aspect of amplifier 22, similar to the case with the first disclosed embodiment.

For the foregoing reasons, whether the second embodiment is implemented on top of the first embodiment, consistent with the examiner's position, or is separate and independent of the

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first embodiment, as is argued by the appellants, is not particularly relevant. Even if the examiner's view is presumed to be correct, there is inadequate basis for the examiner to conclude that switch 30 somehow activates the reproduction functions of the recording/reproduction amplifier 22. It is simply unclear how one triggers reproduction of the data recorded on the disk 23.

In any event, we disagree with the examiner that the second disclosed embodiment necessarily includes all features of the first disclosed embodiment. The examiner correctly points out that in column 5, lines 16-21, Kinoshita states:

Some necessary circuits shown in detail in FIG. 1 [first embodiment] are not shown in FIG.4 [second embodiment]. However, an image pickup section 1 has the same arrangement and operation as those of the first embodiment.

The above-quoted text must be read in context. In our view, the discussion means only that to the extent any detailed circuits from the first embodiment illustrated in Figure 1 is needed to carry out the operations according to the second embodiment, the illustrations are omitted in Figure 4. Here, operation of the second disclosed embodiment does not require

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the switch 15. As described, both switches are used to cause recording of image data onto the disk 23. It would appear that they are alternatives to each other.

Assuming for the moment that Kinoshita discloses a switch 15 for recording image data and a switch 30 for reproducing image data, both in the same embodiment, we further disagree with the examiner that in light of Taguchi's multi-level push-button it would have been obvious to one with ordinary skill in the art to merge the functions of switch 15 and switch 30 into a single push-button. The appellants are correct that the multiple functions activated by Taguchi's single multi-level push-button, i.e., (1) off, (2) supplying power to applicable circuit elements to get them ready for operation, and (3) start recording, are not of the same type of combination required by the appellants' claims. In our view, Taguchi would not have reasonably motivated one with ordinary skill in the art to merge the "recording" function and the "reproduction" function onto a single control button. What is missing is a teaching or suggestion about combining controls for opposite flow of information on a single switch. The mere fact that a switch can be used to control plural functions

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does not itself render obvious the merging of all types of functions on a single control. We reject the examiner's position that any combination of functions to be merged on a single control button would have been obvious, in light of the existence of a multi-function control switch.

At some point, the inherent advantages of using one switch instead of two is insufficient to overcome the disparate nature of certain functions to be alone considered a reasonable motivation to combine those functions on a single control. In our view, that is the case here. Accordingly, the examiner has failed to make out a case of prima facie obviousness.

The 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); 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., Inc. v. SGS

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Importers Int'l., Inc., 73 F.3d 1085, 1087, 37 USPQ2d 1237,
1239 (Fed. Cir. 1995), cert. denied, 117 S.Ct. 80 (1996).

For the foregoing reasons, the rejection of claims 7 and 15-18 under 35 U.S.C. § 103 as being unpatentable over Kinoshita and Taguchi cannot be sustained.

Claims 8-10 were rejected under 35 U.S.C. § 103 as being unpatentable over Kinoshita, Taguchi, and Ogawa. Claim 8 depends from claim 7 and further recites that the recording is repeated in response to the first switching operation to thereby continuously record successively image data in the memory means. Claim 9 depends from claim 8 and claim 10 depends from claim 9. With regard to claim 8, the appellants argue (Br. at 8):

While Ogawa discloses a camera that is capable of continuous recordation or reproduction, the Ogawa device must be switched into a recordation mode to accomplish the continuous recordation, and switched into a reproduction mode to accomplish the continuous reproduction.

The feature added by claim 8, however, does not preclude switching first between a recordation mode and a reproduction mode. It appears that for claims 8-10 the appellants continue to rely on the feature of putting both recording and reproduction controls on the same push-button for patentable

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distinction over the prior art. With regard to that aspect of the appellants' claimed invention, Ogawa, as applied by the examiner, does not make up for the above-discussed deficiencies of Kinoshita and Taguchi. Accordingly, the rejection of claims 8-10 cannot be sustained.

Conclusion

The rejection of claims 7 and 15-18 under 35 U.S.C. § 103 as being unpatentable over Kinoshita and Taguchi is reversed.

The rejection of claims 8-10 under 35 U.S.C. § 103 as being unpatentable over Kinoshita, Taguchi, and Ogawa is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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)	
JAMESON LEE)	
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JL:yrt

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