

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAE-CHON YU

Appeal No. 1998-2542
Application No. 08/266,306

ON BRIEF

Before THOMAS, JERRY SMITH, and BLANKENSHIP, 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 1-23, which constitute all the claims in the application.

The disclosed invention pertains to a method and apparatus for permitting a camcorder to record broadcast programs at predetermined times from a broadcast receiver located externally of the camcorder. The camcorder is programmed with times and channels of broadcast programs it is

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desired to record. At the designated times, the camcorder controls the broadcast receiver remotely to turn on and tune to the desired channel and the camcorder records the programs from the receiver.

Representative claim 1 is reproduced as follows:

1. A method of reservation-recording a broadcasting signal in a camcorder, which is a combined video camera and videotape recorder without a tuner, comprising the steps of:

(a) storing reservation-recording information including a reservation recording time in an internal memory of said camcorder;

(b) sending control signal from said camcorder to a receiver external to said camcorder to control said receiver on the basis of the reservation-recording information stored at said step (a) when the present time is the reservation-recording time of the stored reservation-recording information, so as to output the broadcasting signal to said camcorder; and

(c) recording, by means of said camcorder, the broadcasting signal from the receiver controlled at said step (b).

The examiner relies on the following references:

Beyers, Jr. (Beyers)	4,641,205	Feb. 03,
1987		
Levine	4,963,994	Oct. 16,
1990		

The admitted prior art set forth in appellant's specification.

Claims 1-23 stand rejected under 35 U.S.C. § 103. As

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evidence of obviousness, the examiner offers the admitted prior art in view of Beyers with respect to claims 1-19 and 21-23, and Levine is added to the combination with respect to claim 20.

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

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. 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 rejections 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 not have suggested to one of ordinary skill in the art the invention as set forth in claims 1-23. Accordingly, we reverse.

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

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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). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then

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determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; 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, 189 USPQ 143, 147 (CCPA 1976). 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 brief have not been considered (see 37 CFR § 1.192(a)).

With respect to independent claims 1, 6 and 14, the examiner notes that the admitted prior art describes a conventional camcorder which combines a video camera with a videotape recorder without a tuner. The examiner notes that many of the recitations of these claims are not present in this conventional camcorder of the admitted prior art. The examiner cites Beyers as teaching all the elements of the claims which are not part of the prior art camcorder. The examiner concludes that it would have been obvious to the artisan to provide the conventional camcorder of the admitted prior art with Beyers' microprocessor and associated circuitry to achieve efficient operation of the conventional camcorder

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(answer, pages 4-7).

Appellant makes the following arguments: 1) appellant argues that there is no suggestion in the applied prior art of having a recording device perform reservation-record programming using the tuner or receiver of a device which is separate from the recording device; and 2) appellant argues that the examiner has provided no motivation for combining the teachings of Beyers with the admitted prior art to arrive at the claimed invention, and consequently, has failed to establish a prima facie case of obviousness.

We agree with the positions argued by appellant. Beyers teaches the scheduling of programs for a VCR or a television receiver, but in either case, the tuner and the computer controller are located together internally. Beyers provides no motivation for separating the tuner from the controller. If Beyers' circuits were simply incorporated into the conventional camcorder, the camcorder would have its own tuner and there would be no external device as recited in the independent claims. As noted by appellant, however, it was considered unsatisfactory to include a tuner in a camcorder because of size and cost constraints. Although the examiner

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proposes to move only the computer of Beyers into the conventional camcorder, and not the tuner, the examiner has offered no plausible reason why Beyers' computer would be separated from Beyers' tuner. The only basis on this record for making the modification proposed by the examiner is to improperly reconstruct appellant's invention in hindsight.

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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). We can find no suggestion in any of the applied prior art for connecting a camcorder to an external broadcast receiver as recited in independent claims 1, 6 and 14. Therefore, we do not sustain the examiner's rejection of claims 1, 6 and 14 or of claims 2-5, 7-13, 15-19 and 21-23 which depend therefrom.

With respect to claim 20, the examiner additionally applies the teachings of Levine to teach the conventionality of infrared signal control. Since Levine does not overcome the basic deficiencies of the combination of the admitted prior art and Beyers as discussed above, we also do not sustain the examiner's rejection of claim 20 based on the admitted prior art, Beyers and Levine.

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In summary, we have not sustained either of the examiner's rejections of the appealed claims. Therefore, the decision of the examiner rejecting claims 1-23 is reversed.

REVERSED

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JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JERRY SMITH)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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HOWARD B. BLANKENSHIP)	
Administrative Patent Judge)	

JS:hh

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