

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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHIGEAKI KOIKE, and YASUO IWASAKI

Appeal No. 1999-0225
Application No. 08/563,188

ON BRIEF

Before HAIRSTON, KRASS, and RUGGIERO, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-7, which are all of the claims pending in the present application. An amendment filed January 14, 1998 after final rejection, which did not amend the claims, was approved for entry by the Examiner.

The disclosed invention relates to a data recording and reproducing apparatus which includes a tape recording and reproducing unit and a disc recording and reproducing unit which are integrally assembled together and are directly connected to a

data transfer unit. Audio and/or visual input data is recorded on the tape recorder unit, reproduced, and then transferred to the disc unit where it is recorded. A user of the system can access a desired video image using the random access characteristic of the disc device and then transfer the data to the tape recording and reproducing unit where editing can be performed.

Representative claim 1 is reproduced as follows:

1. A data recording and reproducing apparatus comprising:

a disc recording and reproducing means;

a tape recording and reproducing means for recording and reproducing either or both of audio data and video data of a digital format;

a data transfer means;

a first input/output means, and

a second input/output means,

said disc recording and reproducing means, said tape recording and reproducing means, said first input/output means, and said second input/output means all being directly connected to the data transfer means and integrally assembled together;

said disc recording and reproducing means recording audio-visual data, which comprises audio and visual data, audio data or visual data, transferred from said data transfer means in a disc recording medium to which random access is possible and reproducing said audio-visual data from said disc recording medium and outputting the same to said data transfer means;

said tape recording and reproducing means recording said audio-visual data transferred from said data transfer means in a tape recording medium and reproducing said audio-visual data from

said tape recording medium and outputting the same to said data transfer means;

said data transfer means transferring said audio-visual data among any of the elements selected from among said disc recording and reproducing means, said tape recording and reproducing means, said first input/output means, and said second input/output means;

said first input/output means receiving an analog audio-visual signal from a first outside apparatus, converting the same to audio-visual data of a digital format, and outputting the same to said data transfer means and converting said audio-visual data transferred from said data transfer means to an audio-visual signal of the analog format and outputting the same to a second outside apparatus; and said second input/output means receiving audio-visual data from a communication line connected to a third outside apparatus and outputting the same to said data transfer means and outputting said audio-visual data transferred from said data transfer means to a communication line connected to a fourth outside apparatus.

The Examiner relies on the following prior art:

Tindall	4,839,745	Jun. 13, 1989
Lang	5,164,839	Nov. 17, 1992
Schnorf	5,367,341	Nov. 22, 1994
Honjo	5,432,769	Jul. 11, 1995

(filed Apr. 20, 1993)

Claims 1-7 stand finally rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner offers Schnorf in view of Lang with respect to claims 1, 2, and 6, adds Honjo to the basic combination with respect to claims 3-5, and adds Tindall to the basic combination with respect to claim 7.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (Paper no. 15) and Answer (Paper No. 16) for the respective details.

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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, Appellants' arguments set forth in the Brief 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 obviousness of the invention as set forth in claims 1-7. Accordingly, we affirm.

Appellants' arguments in response to the Examiner's obviousness rejection of the appealed claims are organized according to a suggested grouping of claims indicated at page 4 of the Brief. We will address these arguments accordingly and will consider the appealed claims separately only to the extent that separate arguments are of record in this appeal. Any dependent claim not argued separately in the Briefs will stand or fall with

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its base claim. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

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 Appellants 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, 1052, 189 USPQ 143, 147 (CCPA 1976).

With respect to the 35 U.S.C. § 103 rejection of independent claim 1 (the representative claim for Appellants' first suggested grouping including claims 1, 3, 4, 6, and 7), the Examiner, as the basis for the obviousness rejection, proposes to modify the recording and reproducing editing system disclosure of Schnorf. According to the Examiner, Schnorf discloses the claimed invention except for "... the disc, Tape/VCR, and the first and second input/output means all being directly connected to the data

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transfer means and integrally assembled together." (Answer, pages 4 and 5). To address this deficiency, the Examiner turns to Lang and asserts (Id. at 5):

It would have been obvious to one of ordinary skill in the art at the time of [sic] the invention was made to modify the editing system of Schnorf by incorporating the teaching of directly connecting the disk, tape and first and second input/output means having all elements integrally assembled together as taught by Lang in order to provide an editing system that is lighter and easier to carry by eliminating multiple housings of each element.

After reviewing the Examiner's analysis, it is our view that such analysis carefully points out the teachings of the applied Schnorf and Lang references, reasonably indicates the perceived differences between this 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 least satisfied the burden of presenting a prima facie case of obviousness. The burden is, therefore, upon Appellants to come forward with evidence or arguments which persuasively rebut the Examiner's prima facie case of obviousness. Only those arguments actually made by Appellants have been considered in this decision. Arguments which

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Appellants could have made but chose not to make in the Brief have not been considered [see 37 CFR § 1.192(a)].

Appellants' arguments in response to the Examiner's obviousness rejection of representative independent claim 1, rather than attacking the combinability of the applied Schnorf and Lang references, instead focus on the contention that the prior art does not teach or suggest all of the limitations set forth in the claim. Initially, Appellants contend (Brief, page 7) that, contrary to the Examiner's position, Schnorf lacks a disclosure of a tape recording and reproducing means for data in a digital format, as well as lacks a teaching of a second input/output means.

After reviewing the Schnorf reference in light of the arguments of record, we find neither of these arguments of Appellants to be persuasive. As indicated at page 8 of the Answer, the Examiner has identified the "TAPE" unit which is clearly in the digital processing area of Schnorf as corresponding to the claimed digital data recorder and reproducer. We also agree with the Examiner that the network interface 23a in Schnorf which provides a separate communication path 23b to network devices (Schnorf, column 4, lines 13-15) constitutes a "second input/output means" as claimed.

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We further find to be unfounded Appellants' contention (Brief, page 8) that the Examiner has improperly assigned multiple roles to elements of Schnorf in order to meet the claimed limitations. As set forth at page 11 of the Answer, it is the "TAPE" unit in Schnorf's digital processing area that corresponds to the claimed digital data recorder and reproducer while it is the inputs in Schnorf's analog processing area that correspond to the "first outside apparatus". Similarly, in our view, a reasonable interpretation of Schnorf's disclosure would lead to the conclusion that the connections to the various VCR's and laser disc players and recorders would alternatively correspond to the claimed second and fourth outside apparatus.

Further, contrary to Appellants' contention (Brief, page 8), our review of the applied prior art indicates a direct connection between the system elements and the data transfer bus 21 in Schnorf as well as with the system elements and the video control unit 12 in Lang, at least in the manner broadly claimed by Appellants. Any argument by Appellants that Schnorf and Lang lack such a direct connection is unpersuasive since, to the extent that any intervening elements exist between the data transfer structure and the recorders and input/output circuitry in Schnorf and Lang, intervening elements are also present between the data transfer

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circuitry 40 and the claimed elements in Appellants' illustrations in Figures 1 and 3.

In view of the above discussion and the totality of the evidence on the record, it is our opinion that the Examiner has established a prima facie case of obviousness which has not been rebutted by any convincing arguments from Appellants. Accordingly, the Examiner's 35 U.S.C. § 103 rejection of independent claim 1, as well as dependent claims 3, 4, 6, and 7 not separately argued by Appellants, is sustained.

With respect to dependent claim 2, grouped separately by Appellants, we sustain the Examiner's 35 U.S.C. § 103 rejection of this claim as well. Although Appellants suggest (Brief, page 8) that the Examiner has not addressed the language of this claim, we find a detailed explanation of the Examiner's position at pages 5 and 13 of the Answer. In our view, the Examiner's line of reasoning establishes a prima facie case of obviousness which has not been rebutted by any arguments from Appellants.

We also sustain the Examiner's obviousness rejection of dependent claim 5, grouped and argued separately by Appellants. We agree with the Examiner (Answer, page 14) that, in view of the applied Schnorf and Lang references, the skilled artisan would recognize the obviousness of reproducing data from a transfer bus

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at the same data rate as the recording of data transferred to a transfer bus. In considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

In summary, we have sustained the Examiner's 35 U.S.C. § 103 rejection of all of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-18 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

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)	BOARD OF PATENT
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