

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TEPPEI YOKOTA

Appeal No. 96-4202
Application 08/033,181¹

ON BRIEF

Before HAIRSTON, KRASS and JERRY SMITH, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

¹Application for patent filed March 16, 1993.

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Application 08/033,181

This is a decision on appeal from the final rejection of claims 1, 3 through 7, 9 and 10, all of the claims in the application.

The invention is directed to a method and apparatus for selectively inhibiting reproduction of recorded sets of data on a disc.

Independent apparatus claim 1 is reproduced as follows:

1. A disc recording and reproducing apparatus comprising:

means for receiving independent sets of data to be recorded;

means for encoding each set of data for recording onto a disc, the disc having a lead-in section for recording thereon of recording state information regarding each set of data and a recording area for recording thereon of each encoded set of data;

a magnetic head for recording onto the recording area of the disc each encoded set of data and for recording onto the lead-in section of the disc recording state information regarding each set of data, the recording state information including reproduction information indicating whether to inhibit reproduction of any recorded encoded set of data; and

controller means for selectively masking an unnecessary recorded encoded set of data by changing the reproduction information to indicate inhibition of reproduction of such set of recorded encoded data while retaining the information indicating the order of recording, and for selectively cancelling the masking of a masked recorded encoded set of data by changing the reproduction information to indicate non-inhibition of reproduction of such set of recorded encoded data while retaining the information indicating the order of recording.

The examiner relies on the following references:

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Takahashi et al. (Takahashi '116)	4,688,116	Aug. 18, 1987
Takahashi et al. (Takahashi '765)	RE 33,765	Dec. 10, 1991
Sako	5,325,347	Jun. 28, 1994 (filed Sep. 19, 1991)

Claims 1, 3, 5 through 7, 9 and 10 stand rejected under 35 U.S.C. 103 as unpatentable over Takahashi '765.² Claims 1, 3 through 7, 9 and 10 are rejected under 35 U.S.C. 103 as unpatentable over Sako in view of Takahashi '116.

Reference is made to the briefs and answers for the respective positions of appellant and the examiner.

OPINION

At the outset, we note that new grounds of rejection, introduced in the answer, under 35 U.S.C. 112, first and second paragraphs, have been withdrawn by the examiner in the supplemental answer responsive to entry of the amendment submitted with the reply brief, such entry being mandated by the grant of a petition filed by appellant on February 12, 1996. Accordingly, rejections under 35 U.S.C. 112 are not before us on this appeal.

After careful consideration of the record before us, including, inter alia, the applied references and the arguments

²The examiner does not include claim 4 in this rejection.

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of appellant and the examiner, we reverse both rejections under 35 U.S.C. 103 because it is our view that the examiner has failed to establish a case of prima facie obviousness.

Both independent claims 1 and 7 require, inter alia, that there be recorded on the lead-in section of the disc recording state information regarding each set of data wherein the recording state information includes reproduction information indicating whether to inhibit reproduction of any recorded encoded set of data. The claims further require that a controller selectively mask unnecessary recorded encoded sets of data "by changing the reproduction information to indicate inhibition of reproduction of such set of recorded encoded data while retaining the information indicating the order of recording" and that the controller selectively cancel the mask "by changing the reproduction information to indicate non-inhibition of reproduction of such set of recorded encoded data while retaining the information indicating the order of recording."

While the examiner contends that a controller means, as claimed, is taught or suggested by elements 25-28 of Takahashi '765 or by element 37 of Sako as modified by Takahashi '116, our

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interpretation of the teachings of those references does not comport with the examiner's interpretation.

We have reviewed the examiner's arguments at pages 7-8 of the principal answer, regarding the "recording order of data" and we are in agreement with appellant, at page 7 of the principal brief, that the examiner

has confused the physical order of recorded data as it appears on magnetic recording tape as shown in FIG. 5 of Takahashi et al. (either '765 or '111 [sic, '116]) with the claimed "information indicating the order of recording."

While Sako is directed to a disc, the Takahashi references relate to storing and reproducing data on and from a magnetic tape. Therefore, since there is no lead-in section of a disc in the Takahashi references, because there is no disc at all, there can be no "recording state information," indicative of whether to inhibit reproduction of a recorded encoded set of data, recorded onto the lead-in section of a disc.

Further, we do not find a controller in the references (identified, by the examiner, as element 37 in Sako and elements 25-28 in Takahashi '765) which retains information indicating the order of recording while changing the reproduction information on

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the lead-in section of the disc to indicate inhibition or non-inhibition of reproduction of sets of recorded encoded data.

The examiner argues [principal answer, page 7] that since an unnecessary set of data is masked in Takahashi, but not deleted, the recording order is kept unchanged even when the unnecessary set of data is not to be reproduced. We agree with this observation. However, that is no suggestion for the claimed limitation of "retaining the information indicating the order of recording" by the controller which selectively masks or unmasks recorded encoded sets of data by changing the reproduction information on the lead-in section of a disc to indicate inhibition or non-inhibition of reproduction of such sets of recorded encoded data.

With regard to Sako, the examiner admits [principal brief, pages 4-5] that the control means in Sako does not selectively mask and/or unmask unnecessary recorded data by changing the reproduction information to indicate inhibition or non-inhibition of reproduction of the recorded data as claimed. Since Takahashi '116, as explained supra, also does not disclose or suggest the controller functions, as claimed, the claimed subject matter is not reached even if, somehow, the disc

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recording/reproducing system of Sako and the magnetic tape
recording/reproducing system of Takahashi '116 are combined.

Accordingly, the examiner's decision rejecting claims
1, 3 through 7, 9 and 10 under 35 U.S.C. 103 is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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ERROL A. KRASS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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