

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ISAO WADA, JUNICHI ARAMAKI,  
AKIHISA INATANI, and YOSHIHIRO KAJIYAMA

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Appeal No. 1997-3977  
Application No. 08/267,579

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ON BRIEF<sup>1</sup>

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Before HAIRSTON, BARRETT, and GROSS, Administrative Patent  
Judges.

GROSS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 15, which are all of the claims pending in this application.

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<sup>1</sup> We observe that on December 29, 1999 (paper no. 26), appellants filed a waiver of the oral hearing set for January 24, 2000.

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Appellants' invention relates to a disc recording and reproducing apparatus in which an amount of digital data stored in memory is displayed. Claim 7 is illustrative of the claimed invention, and it reads as follows:

7. A disc recording apparatus in which an input digital data signal is encoded and recorded on a disc, comprising:

first encoding means for compressing the input digital data signal;

memory means for temporarily storing compressed data from said first encoding means;

second encoding means for intermittently receiving the compressed data stored in said memory means and outputting encoded data as recording data to be recorded on said disc at a predetermined position;

control means for controlling said memory means such that said compressed data from said first encoding means is continuously written in said memory means and said compressed data stored in said memory means is intermittently read out from said memory means; and

display means for providing a graphic representation of an amount of said compressed data stored in said memory means to thereby permit a visual confirmation of a change in said amount.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Wakabayashi, deceased et al. 05, 1983 (Wakabayashi)	4,391,530	Jul.
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As pointed out by the examiner (Answer, page 3), Roth monitors the buffer memory fill level. However, Roth does not display the fill level. Roth states (column 5, lines 62-66) that "[f]or the purpose of controlling the recording process and the microcomputer 10, the input buffer memory 6 further supplies an indication signal Vg1 which is indicative of the degree of filling of the input buffer memory 6." In other words, the fill level is monitored for the computer to control the recording process.

Wakabayashi, on the other hand, is directed to an electronic timepiece for which a semiconductor memory is provided for writing voice data. The recording capacity of the semiconductor memory is monitored and displayed so that the person recording the voice data can vary the timing of the recording so as not to exceed the memory capacity and have part of the data omitted from the recording. The examiner asserts (Answer, page 3) that "it was notoriously well-known to display any and all monitored recording/reproducing aspects, to provide an end user with an indication of the recording/reproducing performance" and that "Wakabayashi et

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al. clearly discloses the structure for displaying a memory fill level responsive to a monitored memory fill level."

The examiner's reliance on Wakabayashi appears to be as evidence that displaying monitored information is notoriously well-known. However, merely that it is "notoriously well-known to display ... monitored recording/reproducing aspects" does not explain why it would have been obvious to display the particular monitored aspect as claimed in the device of the primary reference. The claims require that the amount of digital data stored in the memory means be displayed. In Roth the relevant memory capacity is monitored for the computer to control the recording process. The user has no need to view such information absent that disclosed by appellants. Therefore, that it is notoriously well-known to display monitored information is insufficient motivation to modify Roth. Further, as Wakabayashi is directed to a timepiece, Wakabayashi fails to provide evidence that such monitoring is notoriously well-known in the recording/reproducing arts.

Assuming that the examiner intended to combine the display of Wakabayashi with Roth's device, appellants argue (Brief, pages 6-10) that there is no motivation to combine

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Wakabayashi with Roth. In particular, appellants explain (Brief, pages 8-9) that in Wakabayashi

[t]he residual memory is displayed so that a user will know how many additional seconds of voice data can be put in before the semiconductor memory 11 fills up .... Applying this motivation to the Roth et al. device, this motivation clearly would not lead one to select capacity of the buffer memory 6 of Roth et al. as a performance parameter to be displayed. The buffer memory 6 of Roth et al. does not completely fill up during normal recording operations, and the user does not control the amount of data in the buffer memory 6. Rather the flow of data through the buffer memory is controlled automatically.... Because the buffer memory of Roth et al. does not fill up during recording, the user does not need to know the residual capacity of the buffer memory in order to control recording operations without the omission of data. Therefore, the motivation which lead to the use of the display for semiconductor memory 11 in Wakabayashi et al. clearly would not lead one to apply that display to the buffer memory 6 of Roth et al.

We agree with appellants. There is no teaching or suggestion in Wakabayashi that would lead the skilled artisan in the optical recording and reproducing art to display the capacity of the buffer memory of Roth.

Further, appellants contend (Brief, pages 11-12) that Wakabayashi is not analogous art. Applying the criteria set forth in In re Clay, 966 F.2d 656, 658, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992), we conclude the same. The first criteria,

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that the art be from the same field of endeavor, clearly is not met, as timepieces and recording apparatuses are very different fields of endeavor. Therefore, we turn to the second criteria, that the reference be pertinent to the particular problem being solved.

The examiner questions (Answer, page 7) the relevance of the difference between Wakabayashi's and appellants' problem solved to "adding a notorious display of a monitored feature to Roth et al." As stated above, the answer to whether Wakabayashi is analogous art, and therefore potentially combinable with Roth, rests on whether Wakabayashi's problem solved relates to appellants'. Appellants provide a memory display to allow a user of a disc reproducing and recording apparatus to "easily confirm the cause that a reproduced sound is interrupted" (Specification, page 3). In appellants' device, appellants have no control over the contents of the memory. Wakabayashi deals with displaying the memory capacity to allow the user to time speech so that it can be stored without overfilling the memory and losing part of the speech. In other words, Wakabayashi displays the contents of the memory so that the user can control the contents.

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Accordingly, the problems solved are sufficiently different so as to fail the second criteria outlined above. Therefore, we see no reason why the skilled artisan would turn to Wakabayashi to cure the deficiencies of Roth. Consequently, the examiner has failed to establish a prima facie case of obviousness. Thus, we cannot sustain the rejection of claims 1 through 15.

CONCLUSION

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The decision of the examiner rejecting claims 1 through  
15 under 35 U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
LEE E. BARRETT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
ANITA PELLMAN GROSS	)	
Administrative Patent Judge	)	

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