

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOSHIYUKI ISHII, KOUSUKE MISONO, SEIICHI MISAWA,
JOJI FUKUDA, TETSUO NISHIGAKI, and KIYOSHI OTA

Appeal No. 1998-2518
Application No. 08/442,835

ON BRIEF

Before THOMAS, GROSS, and BARRY, Administrative Patent Judges.
GROSS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 6, 8, and 10, which are all of the claims pending in this application.

Appellant's invention relates to a recording and reproducing apparatus in which an erase head is upstream of a program recording means, and a control head is upstream of the erase head. Position information is recorded on a control signal recording track, and the control head reads the

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position information. When the control head reads program start information that identifies a beginning location of a recorded program, a control means stops the erase head and recording means from erasing and recording, respectively.

Claim 6 is illustrative of the claimed invention, and it reads as follows:

6. A recording and reproducing apparatus for recording at least one program on a recording traveling medium in a transport direction thereof, said recording medium having a control signal recording track extending in the transport direction thereof for recording position information, comprising:

erase head means for erasing program and position information at an erase position of said recording medium in a recording mode of the apparatus as the recording medium travels in the transport direction thereof,

program recording means for recording a new program and position information onto said recording medium in the transport direction thereof at a position downstream of said erase position in said recording mode, said position information including program start information identifying a beginning location of a program recorded on the recording medium,

control head means for reading said position information from said control signal recording track in said recording mode at a position upstream of said erase position in the transport direction of said recording medium, and

control means for controlling said erase head means and said program recording means to stop erasing and recording, respectively, when said control head means reads position data from said recording medium that includes program start

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information that identifies a beginning location of a program recorded on the recording medium.

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

Kosaka 1972	3,671,665	Jun. 20,
Lewis et al. (Lewis) 1980	4,224,644	Sep. 23,
Strubbe et al. (Strubbe) 10, 1991	5,047,867	Sep.

Claims 6, 8, and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kosaka in view of Lewis and Strubbe.

Reference is made to the Examiner's Answer (Paper No. 12, mailed February 12, 1997) for the examiner's complete reasoning in support of the rejections, and to appellant's Brief (Paper No. 11, filed January 9, 1997)¹ for appellant's arguments thereagainst.

OPINION

We have carefully considered the claims, the applied prior art references, and the respective positions articulated

¹ We note that a Reply Brief was filed April 14, 1997 (Paper No. 13) and denied entry by the examiner. Accordingly, we will not consider the arguments made therein in rendering our decision.

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by appellant and the examiner. As a consequence of our review, we will reverse the obviousness rejection of claims 6, 8, and 10.

Claim 6, the only pending independent claim, requires a control signal recording track for recording position information, the position information including program start information identifying a beginning location of a program recorded on a recording medium. Claim 6 further requires a control means for controlling an erase head means to stop erasing and a program recording means to stop recording when the control head means reads position data from the recording medium that indicates that the beginning of a recorded program.

The examiner admits (Answer, page 4) that Kosaka does not disclose a control track with program start position information and, therefore, also lacks the control of the erase head and program recording based on the program start position information. Lewis, according to the examiner (Answer, page 4) discloses start markers stored in a database management field on a tape to indicate the beginning of a program. These markers allow a user to quickly locate the

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start of a program for playback of the program. The examiner concludes (Answer, page 4) that it would have been obvious to include the markers of Lewis in Kosaka's device "to quickly locate a program that is record [sic] on the tape."

The examiner recognizes (Answer, page 4) that the combination of Kosaka and Lewis still does not include using the markers for avoiding overwriting during editing. The examiner turns to Strubbe in which a position on a tape is designated for recording a program depending on the amount of available space. The examiner asserts (Answer, page 5) that it would have been obvious "to provide the above combination with the program recording means of Strubbe et al. in order to record more programs on to the tape."

Appellants argue (Brief, page 13) that the start markers of Lewis are used to locate the exact position of the beginning of a recorded program when reproducing the program. Appellants assert (Brief, page 13) that there is no suggestion in Lewis to use the start markers during recording. Further, Strubbe is concerned with finding a block of available space on a magnetic tape to record a television program. In Strubbe's device, information concerning the contents of a

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particular tape is identified by a code such as a bar code read by a scanner coupled to a controller. Appellants contend (Brief, page 13) that Strubbe does not disclose using program start information recorded on the tape for preventing overwriting of stored programs (by indicating when an erase head and program recording means should stop erasing and recording, respectively). In other words, according to appellants, even if the program start positions of Lewis were added to Kosaka, none of the references suggest using the markers during recording to prevent overwriting.

We agree with appellants. The Federal Circuit states that "[t]he 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, 1783-4 n.14 (Fed. Cir. 1992), *citing In re Gordon*, 733 F.2d 900, 902, 221, USPQ 1125, 1127 (Fed. Cir. 1984). In the present case, there is no teaching or suggestion in any of the references to use program start markers to prevent overwriting, and, therefore, no suggestion

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to use a control head and control means as recited in claim 6. Merely that the start markers of Lewis could be used for such a purpose is insufficient. Thus, even if the three references could be combined, the combination would not yield the claimed invention. Consequently, we cannot sustain the rejection of claim 6, nor of its dependents, claims 8 and 10.

CONCLUSION

The decision of the examiner rejecting claims 6, 8, and 10 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
)	
)	
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)	BOARD OF PATENT
ANITA PELLMAN GROSS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
LANCE LEONARD BARRY)	
Administrative Patent Judge)	

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