

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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRUCE TOGNAZZINI

Appeal No. 1998-2541
Application No. 08/608,372

ON BRIEF

Before HAIRSTON, JERRY SMITH, and LALL, 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 2, 5, 9, 12, 15-17 and 19-21. Claims 1, 3, 6-8, 13 and 14 have been cancelled. Claim 18 has been indicated to be allowable. Claims 4, 10 and

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11 stand withdrawn from consideration as being directed to a nonelected invention. An amendment after final rejection was filed on September 25, 1997 and was entered by the examiner.

The disclosed invention pertains to a method and apparatus for recording audio and/or video information (program material) after the point in time at which the program material occurred. Specifically, the program material is first stored in a memory which holds the program material for a period of time after the material has occurred. The data in the memory can then be recorded at a point in time after the information first occurred and was stored in memory.

Representative claim 2 is reproduced as follows:

2. Apparatus for recording program material from a source of program material from a beginning, after the beginning of the program material has passed, comprising:
 - a. a recording device;
 - b. a delayed recording circuit configured to introduce delay between said source and said recording device and to activate said recording device to record information from said source from the beginning after said delay; and
 - d. a start-of-program detector which detects the start of a program to be recorded.

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The examiner relies on the following references:

Moe	5,345,430	Sep. 6, 1994
Logan et al. (Logan)	5,371,551	Dec. 6, 1994

Claims 9, 12, 15-17 and 19-21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Moe. Claims 2 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Moe in view of Logan.

Rather than repeat the arguments of appellant or the examiner, we make reference to the brief 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 anticipation and 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 brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

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It is our view, after consideration of the record before us, that the disclosure of Moe fully meets the invention as set forth in claims 15-17, 19 and 20. We reach the opposite conclusion with respect to claims 9, 12 and 21. We are further of the view 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 obviousness of the invention as set forth in claims 2 and 5. Accordingly, we affirm-in-part.

We consider first the rejection of claims 9, 12, 15-17 and 19-21 under 35 U.S.C. § 102(b). Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). The

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examiner indicates how he read these claims on the disclosure of Moe [answer, pages 3-7].

With respect to independent claim 9, appellant argues that Moe has no element for "identifying said beginning [of one type of information]." The examiner argues that the mark in Moe which denotes the ending of the material to be recorded also marks the beginning of the material to be recorded since the material is stored as an endless loop [answer, page 9].

We do not agree with the examiner's position. When the mark in Moe is designated, the Moe system begins recording the endless tape from the point just after the mark until the mark is reached, which means the entire endless tape is recorded. Thus, a specific point on the endless tape is identified, but not the beginning of the material it is desired to record. The phrase "identifying the beginning" in claim 9 refers to the beginning of one type of information and not to the beginning of an area in memory to be recorded. Therefore, we agree with appellant that there is no element in Moe for identifying the beginning of one type of information to be recorded from the beginning. Accordingly, we do not sustain the anticipation rejection of independent claim 9 or of claim

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12 which depends therefrom. Since independent claim 21 has the same recitation as claim 9, we also do not sustain the anticipation rejection of claim 21.

With respect to independent claim 15, appellant argues that Moe does not "cause said recording device to continue to record information delayed by said delayed recording circuit after a stop button has been pushed until all information delayed up until the time the stop button is pushed has been recorded" [brief, page 5]. We do not agree. The recovery button in Moe corresponds to the claimed stop button. When the recovery button in Moe is pushed, all the material which has been delayed on the endless tape loop is recorded beginning at the point just after the location of the stop mark until the stop mark is reached. This results in the recorder continuing to record delayed information until all information on the tape has been recorded ending with the point where the stop button was pushed. In our view, the delayed recording circuit of Moe is configured to perform exactly as recited in claim 15. Therefore, we sustain the anticipation rejection of claim 15.

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With respect to dependent claim 16, appellant argues that Moe does not mark the location in memory where data was last recorded when the stop button was pushed using a computer. Since Moe discloses an endless tape loop, the location on the tape loop begins just after the stop mark. Since Moe also discloses that a random access memory could replace the endless tape loop, Moe discloses that an address pointer would indicate this same location in memory. Finally, the control circuitry of Moe's Figure 5 is a computer as broadly recited. With respect to claim 17, appellant argues that a computer in Moe does not stop the recording device. As noted above, however, Moe discloses a computer in Figure 5, and this computer stops the recording device in the manner recited in claim 17. With respect to dependent claim 19, we agree with the examiner that switch 16 of Moe constitutes a record immediate button as recited in the claim. With respect to dependent claim 20, the recovery button of Moe also operates as the claimed reset button. Since we find that Moe fully meets all the limitations of claims 15-17, 19 and 20, we sustain the anticipation rejection of these claims.

We now consider the rejection of claims 2 and 5 under

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35 U.S.C. § 103 as unpatentable over the teachings of Moe and Logan. 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 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

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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 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, 1052, 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 claims 2 and 5, the examiner notes that Moe fails to teach a start of program detector. The examiner cites Logan as teaching a clock/calendar unit for automatically recording programs in a recorder at preprogrammed times. The examiner asserts the obviousness of combining the teachings of Moe and Logan. Appellant argues that the claimed detection of the start of a program to be

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recorded in a delayed recording system as recited in claim 2 is quite different from a clock and a calendar to start recording at a scheduled time as taught by Logan.

We agree with appellant. The conventional timer recording of Logan which permits future program material to be recorded based on time has absolutely no relationship to the recording of delayed program material as taught by Moe and as recited in the appealed claims. Therefore, there would be no basis for applying Logan's conventional timer recording to Moe's system for recording material which has previously been stored. Therefore, we do not sustain the examiner's rejection of claims 2 and 5 based on the teachings of Moe and Logan.

In summary, the anticipation rejection based on Moe has been sustained with respect to claims 15-17, 19 and 20, but has not been sustained with respect to claims 9, 12 and 21. The obviousness rejection of claims 2 and 5 has not been sustained. Accordingly, the decision of the examiner rejecting claims 2, 5, 9, 12, 15-17 and 19-21 is affirmed-in-part.

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

AFFIRMED-IN-PART

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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JERRY SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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