

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. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAKAYUKI NEMOTO, KUNIYOSHI SUSAKI, MASANORI UCHIDOI
and AKIHIKO SUZUKI

Appeal No. 2000-1727
Application 08/486,114

ON BRIEF

Before HAIRSTON, FLEMING, and GROSS, **Administrative Patent Judges**.

FLEMING, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 33,35-38, and 44-48. The remaining claims have been canceled.

The invention is an image recording apparatus which enables recording of one picture and a continuous recording of an image signal.

Independent claim 33 present in the application is reproduced as follows:

1. An image recording apparatus, comprising:

(A) recording means for recording an image signal obtained by photoelectrically converting a light image to be recorded, said recording means having a recording position on a changeable recording medium;

(B) drive means for rotating said recording medium and said recording means relatively to each other;

(C) feeding means for feeding said image signal to said recording means;

(D) operating means for generating an operation signal for operating said drive means and a recording trigger, according to the operation thereof, said operating means generating the operation signal and the recording trigger independently;

(E) change-over means for changing over a first mode wherein an image signal for only one picture is recorded even when said record trigger is sustained and a second mode where the image signal comprising more than one picture is continuously recorded on said recording medium as long as said record trigger is sustained wherein said change-over means being arranged to previously change-over said first mode and said second mode before the recording operation of the image signal; and

(F) control means for recording the image signal for one picture fed by the feeding means at the time of change-over to the first mode of said change-over means, for recording the image signal for one picture by feeding means onto said recording means at predetermined intervals as long as said record trigger is

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sustained at the time of change-over to the second mode, and for continuing the rotation of said drive means until the recording of the image signal for one picture which is being recorded, even if the operation of said operating means is released during recording operation of said recording means and said operating signal is interrupted and thereafter stopping said rotation.

References

The references relied on by the Examiner are as follows:

Adcock	4,057,830	Nov. 8, 1977
Morishita et al. (Morishita)	4,188,642	Feb. 12, 1980

Rejections at Issue

Claims 33,35-38, and 44-48 stand rejected under 35 U.S.C. § 103 as being unpatentable over Adcock and Morishita.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the brief¹ and the answer² for the details thereof.

OPINION

The issue on appeal is whether claims 33, 35-38, and 44-48 are unpatentable under 35 U.S.C. 103 as being unpatentable over

¹Appellants filed an Appeal Brief on August 9, 1999. We will refer to this appeal brief as simply the Brief. Appellants filed a reply brief on December 27, 1999. We will refer to this reply brief as the Reply Brief.

² The Examiner responded to Appellants' Appeal Brief on October 25, 1999. We will refer to this answer as simply the Answer.

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Adcock and Morishita. The Examiner has provided a statement withdrawing objections to patentability based on the judicially created doctrine of double patenting. Therefore, that issue is no longer on appeal.

Appellants first argue that Adcock and Morishita lack many important features of the present invention, and when combined, do not lead to the claimed invention. See Brief page 13, lines 15-17. Specifically, Appellants argue that Adcock does not teach or suggest the first mode for recording one picture even if the recording trigger is sustained and the second mode for continuously recording the image signal, as called for in claims 33 and 44. See Brief page 12, lines 1-4. Further, Appellants argue that Morishita does not disclose any change-over means of claims 33 and 44, and only teaches a change-over between a single image mode and the respective image mode with a switch (25). See Reply Brief page 6, lines 5-8.

The Examiner argues that Morishita discloses a CCD imager operable in single frame and repetitive frame modes having change-over means (25) for changing over a first mode wherein an image signal for only one picture is outputted and a second mode wherein the image signal comprising more than one picture is continuously outputted. See Answer page 11, lines 3-6.

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The first step in our analysis is determining the scope of Appellants' claim. As the Federal Circuit has pointed out, "the name of the game is the claim." *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998).

In determining the scope of Appellants' claims, we find that Appellants' claims 33 and 44 claim two separate modes, such as in the first mode only one picture is recorded even if the record trigger is sustained and in the second mode a continuous picture is recorded when the record trigger is sustained. Both claims 33 and 44 claim:

change-over means for changing over a first mode wherein an image signal for only one picture is recorded even when said record trigger is sustained and a second mode where the image signal comprising more than one picture is continuously recorded on said recording medium as long as said record trigger is sustained wherein said change-over means being arranged to previously change-over said first mode and said second mode before the recording operation of the image signal.

We agree that Morishita does teach two modes, one for imaging and one for a series of repetitive images. Morishita also teaches a switch being used to switch between two modes. However, Morishita does not teach Appellants' claimed change-over means for changing over a first mode wherein an image signal for only one picture is recorded even when said record trigger is sustained and a second mode where the image signal comprising

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more than one picture is continuously recorded on said recording medium as long as said record trigger is sustained wherein said change-over means being arranged to previously change-over said first mode and said second mode before the recording operation of the image signal.

In view of the foregoing, the decision of the Examiner rejecting 33,35-38, and 44-48 under 35 U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
MICHAEL R. FLEMING)	
Administrative Patent Judge)	APPEALS AND
)	
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ANITA PELLMAN GROSS)	
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