

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 41

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KIYOSHI SAWAGATA

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Appeal No. 95-2855  
Application 08/075,338<sup>1</sup>

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HEARD: June 10, 1998

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Before JERRY SMITH, BARRETT and CARMICHAEL, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

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<sup>1</sup> Application for patent filed June 11, 1993. According to the appellant, this application is a continuation of Application 07/958,469, filed October 8, 1992, now abandoned; which is a continuation of Application 07/823,613, filed January 17, 1992, now abandoned; which is a continuation of Application 07/355,344, filed May 23, 1989, now abandoned.

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DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-11, which constitute all the claims in the application.

The disclosed invention pertains to a video signal reproducing apparatus. Specifically, the invention is directed to the rapid identification and synchronization of the output of a video tape recorder (VTR) to specific frames of the recorded video signal which have been externally supplied. A plurality of successive frames near the desired frame are simultaneously stored in a shift memory. The time code of a desired frame is compared to the time codes of the plurality of stored frames, and the memory holding the corresponding frame of video data is selected for output.

Representative claim 1 is reproduced as follows:

1. A video signal reproducing apparatus for reproduction of a video signal recorded on a recording medium in synchronism with a reference time code signal supplied from outside said apparatus wherein a time code signal is also recorded corresponding to each frame or field of the video signal, said apparatus comprising:

first reproducing means for sequentially reproducing the video signal from said recording medium;



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support of the rejections and the evidence of obviousness relied upon by the examiner as support for the obviousness rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answers.

It is our view, after consideration of the record before us, that the disclosure in this application does provide support for the claimed invention in a manner which complies with the requirements of 35 U.S.C. § 112. We are also 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 1-11. Accordingly, we reverse.

We consider first the rejection of claims 1-11 under the first paragraph of 35 U.S.C. § 112. For purposes of this rejection, the claims stand or fall together as a single group [brief, page 6]. With respect to representative independent claim 1, the rejection focuses on the "reading control means." According to the examiner, the original specification does not provide support for the newly added limitation of the reading

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control means [answer, page 4]. A rejection on this basis is directed to the written description requirement of the first paragraph of 35 U.S.C. § 112.

The purpose of the written description requirement is to ensure that the applicant conveys with reasonable clarity to those skilled in the art that he was in possession of the invention as of the filing date of the application. For the purposes of the written description requirement, the invention is "whatever is now claimed." Vas-cath, Inc. v. Mahurkar, 935 F.2d 1555, 1564, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). It is the position of the examiner that the original specification supports the reading of a single frame of data from one of the storage areas of the memory means, but the original specification does not support the sequential reading of frames of data from the single storage area as now recited in the claims. Appellant argues that there is clear support in the original specification for this claimed operation. We agree with appellant on this issue for the reasons which follow.

The invention is described as an improvement on the conventional technique for synchronizing playback of a VTR to a desired frame of the recorded video signal. In the prior art a tape is driven to the vicinity of the desired location, is caused

to overrun this location by a preroll amount, and is stopped [specification, page 3]. It typically happens that the tape is not stopped at precisely the location of the desired frame of video data. The tape is then played until the actual desired frame is detected [Id.]. According to appellant, the time it takes to locate this desired frame could be up to five seconds or so [Id., page 4]. The invention seeks to reduce this period of time for synchronizing the playback of video data to the desired frame of data.

The invention achieves this goal by storing a plurality of successive frames of data which are known to exist around the desired frame of data. The invention can quickly compare a time code of the desired frame of video data with the time codes of each of the stored plurality of successive frames of data. Thus, since the desired frame of data is already stored in one of the storage areas, the desired frame of data can be immediately output when desired.

The question to be resolved is whether there is any indication from the original specification that the inventor ever considered reading out more than the first desired frame of data. Appellant argues that the memories 14-1 to 14-i clearly store successive frames of the video signal [brief, page 8]. We agree

with this statement, but this argument misses the point. Even though memories 14-1 to 14-i are disclosed as being filled with successive frames of data after the data is stored in the memory, the availability of this data does not require that more than one frame of data be output.

Of more importance to the issue before us is the operation shown in Figures 2 and 3 of the application and described in the specification. Figure 3 shows the prior art synchronization operation wherein synchronization is not obtained between the preroll point  $t_0$  and the lock-in point  $t_1$ . After synchronization is achieved at point  $t_1$ , the graph shows the time codes linearly changing with time as the tape continues to play. Figure 2 shows the operation of the invention. It can be seen there that a start signal  $V_s$  occurs before lock-in point  $t_1$ , and one of the memories is selected as the memory holding the desired frame of data. Although each of the memories in Figure 2 is shown as continuing to linearly output time code data with respect to time, only one of the memories has been selected by the comparator of Figures 1 or 4. Once the comparison is made by comparator 12, a single one of the memories is selected for read out of the video data.

Once synchronization has been achieved, frames of data continue to be played as shown by the graph of time codes versus time in Figure 2. Because there is synchronization, and because there is only one memory enabled by the comparator, the additional synchronized playback of frames of data indicated by the graph of Figure 2 would have to come from the same memory which has already been selected. In other words, once the memory holding the starting frame of data has been determined, synchronization thereafter is maintained by selecting the output of that particular memory as shown in Figure 2.

As we noted above, the question is whether the original specification conveys that appellant was in possession of the invention now being claimed at the time the first application was filed. It is clear from the original specification, for reasons discussed above, that the original specification expected that playback of a videotape would continue after synchronization was obtained. It is clear from the original specification that the invention picks one of the memories 14-1 to 14-i for playing back frames of data which are synchronized to the desired playback of the data recorded on the videotape. Therefore, we agree with appellant that the original specification does provide support for the invention now being claimed. Accordingly, we do not

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sustain the rejection of claims 1-11 as failing to comply with the written description requirement of the first paragraph of 35 U.S.C. § 112.

We now consider the rejection of claims 1-11 under 35 U.S.C. § 103 as being unpatentable over Ichinose. 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 Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221

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USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to independent claims 1 and 5, it is basically the examiner's position that Ichinose teaches all the claimed features except for the location of the memory holding the reference time codes being outside of the video signal reproducing apparatus [answer, page 5]. The examiner concludes that this difference between the claimed invention and Ichinose would have been obvious to the artisan within the meaning of 35 U.S.C. § 103.

Appellant argues that the rejection fails to consider the fact that Ichinose's apparatus does not synchronize a time code from a video tape recorder with that from an external reference time code [brief, page 11]. The examiner responds that the time code signals stored in RAM 58 of Ichinose are reference time code signals. Ichinose compares the time codes of an incoming video signal with time codes of video signals which have previously been stored and displayed on Ichinose's monitor 41. We agree with appellant that there is no suggestion in Ichinose of supplying a reference time code signal from outside of the

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reproducing apparatus. We also agree with appellant that the obviousness of moving the location of RAM 58 has nothing to do with the claimed invention.

Appellant also argues that Ichinose does not read video signals from only one storage area of the memory means as recited in claims 1 and 5. Ichinose stores the plurality of video signals in "n" storage locations indicated as 25a to 25n. While one of these storage locations is receiving a new frame of data, all the other storage locations are read and the data is transferred to monitor 41 [Ichinose, column 3]. The examiner has looked at adjacent memory locations in Ichinose as making up a plurality of memory areas [answer, pages 9-10]. Regardless of how the examiner attempts to define a storage area, the claimed requirement that readout be from only one storage area cannot be met by Ichinose because Ichinose reads data from the memories 25 in a loop 25a, 25b, 25c, ..., 25n, 25a, 25b, ... in which the beginning location of the loop keeps shifting with each new read [column 3]. Thus, we agree with appellant that the reading control means of claims 1 and 5 is not suggested by the Ichinose device.

Since independent claims 1 and 5 recite features which are not taught or suggested by Ichinose, we do not sustain the

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rejection of these claims under 35 U.S.C. § 103. Although there are several arguments in the briefs and the answers related to the dependent claims, we will not consider these arguments since our decision to reverse the rejection of claims 1 and 5 necessarily means that the rejection of the dependent claims must also be reversed.

In summary, we have determined that the original specification does provide support for the invention now being claimed by appellant. We have also determined that Ichinose and the level of skill in the art would not have suggested the

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obviousness of the invention recited in claims 1-11.  
Accordingly, the decision of the examiner rejecting claims 1-11  
is reversed.

REVERSED

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JERRY SMITH	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
LEE E. BARRETT	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JAMES T. CARMICHAEL	)	
Administrative Patent Judge	)	

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