

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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YOSUKE YASUI

Appeal No. 96-2383
Application 08/217,418¹

ON BRIEF

Before THOMAS, JERRY SMITH, and FLEMING, Administrative Patent
Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed March 24, 1994.

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Appellant has appealed to the Board from the examiner's final rejection of claims 6 through 10, which constitute all the claims remaining in the application.

Claim 6 is further illustrative of the subject matter on appeal and reads as follows:

6. An information processing device, comprising:

a recording medium on which data is recorded thereon as files, the recording medium including identification information for identifying whether a file should be time-continuously processed or time-discontinuously processed;

reproducing means for reading out data recorded on said recording medium;

buffer means having storage capacity corresponding to a plurality of data storage units on said recording medium; and

control means for controlling data write-in and readout operations for said buffer means so that when it is judged on the basis of the identification information read out from said recording medium by said reproducing means that a selected file read out from said recording medium should be time-continuously processed, data contained in the selected file are written in a first part of said buffer means and at the same time data contained in the selected file are read out from a second part

of said buffer means, to thereby continuously output the data contained in the selected file, and when it is judged on the basis of the identification information read out from said recording medium by said reproducing means that the selected file read out from said recording medium should be time-discontinuously processed, data contained in the selected file are written into said buffer means and thereafter read out

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from said buffer means, to thereby discontinuously output the data contained in the selected file.

The following references are relied on by the examiner:

Kondo	5,177,720	Jan. 5, 1993
Yamauchi et al. (Yamauchi)	5,243,582	Sep. 7, 1993 (filed July 2, 1991)

Claims 6 to 9 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Yamauchi. Claim 10 stands rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Yamauchi in view of Kondo.

Rather than repeat the positions of the appellant and the examiner, reference is made to the brief and the answer for the respective details thereof.

OPINION

Essentially for the reasons set forth by appellant at pages 4 through 7 of the brief, we reverse the rejection of claims 6 through 9 as being anticipated by Yamauchi. As such, we also reverse the rejection under 35 U.S.C. § 103 of claim 10

because the combination of references there does not cure the deficiencies with respect to Yamauchi alone.

Yamauchi teaches a so-called "karaoke" playback apparatus utilizing prior art CD-ROM/XA disc stores. The data structure in which this disc is formatted is taught in Yamauchi to be consistent with appellant's discussion in the background of the invention as well as the conventional CD-ROM sector structures shown in Figure 1. Note also the bottom of column 4 of Yamauchi indicates that data structures for CD-ROM's have been standardized in the art. The particular data structures shown in Figures 2 and 5 of Yamauchi as discussed from columns 4 through 7 are also consistent with the prior art or conventional CD-ROM data structure of appellant's Figure 1 including a settable real-time flag within the sub mode portion of the sub-header.

Our detailed study of Yamauchi leads us to conclude as appellant asserts at the bottom of page 4 of the brief that Yamauchi "does not appear to teach time-discontinuous processing, since with karaoke it is both unnecessary and undesirable to do so." This argument is continued in the

context of claim 6 on appeal at page 5 of the brief where it is further argued that even in the detailed discussions of Figure 2 and the various portions of Figure 5 there is no indication in these figures or the written description portion of the specification "that the recording medium contains identification information indicating that a file should be time-discontinuously processed." From our study of Yamauchi, we have the same doubts as expressed at page 6 of the brief that a conventional karaoke playback apparatus has displays of successive phrases of lyrics which appear to continuously change in synchronism with the music, thus apparently causing these visual displays to be continuously processed at the same time in synchronism with the music by a control means.

Yamauchi does not teach in the written description portion or show in any of the figures that data is per se processed in a time-continuous or time-discontinuous manner. Audio information reproduced from a CD-ROM is that type of data that would be continuously processed, which would be consistent with that portion of independent claim 6 on appeal. However, serious doubts are raised by the absence of specific

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teachings of time discontinuous processing as required by claim 6 on appeal for the visual display capabilities in Yamauchi. For the karaoke environment of Yamauchi, there is simply no specific teaching that the data structure of Yamauchi, which is consistent with the conventional data structure of the prior art in disclosed Figure 1, is specifically taught to permit the use of the time discontinuous or non-real-time setting of the appropriate flag to process the graphic or other information in association with the audio information time continuously processed at substantially the same time.

For his part, the examiner appears to merely assert that Yamauchi teaches the noted time continuous and time discontinuous capabilities in a coordinating manner. Our study of Yamauchi does confirm the examiner's basic assertion that Yamauchi processes audio information in a time continuous manner but does not confirm that the other or graphic information is processed in a time discontinuous manner in accordance with the requirements of claim 6 on appeal.

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To sustain the examiner's rejection, we would need to resort to speculation or unfounded assumptions to supply the factual deficiencies in the record before us. This we decline to do.

Note the guidance provided by In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968), reh'g denied, 390 U.S. 1000 (1968). Here, simply put, more evidence is needed to convince us. To the extent the examiner's position may be viewed as being based upon inherency, inherency may not be established by probabilities or possibilities since inherency requires a teaching must be necessarily present in the applied prior art. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) relying on In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981). These findings are consistent with a more recent case from our reviewing court, In re Robertson,

___ F.3d ___, 49 USPQ2d 1949 (Fed. Cir. 1999).

In view of the foregoing, the decisions of the examiner rejecting various claims under 35 U.S.C. § 102 and § 103 are reversed.

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REVERSED

	JAMES D. THOMAS)	
	Administrative Patent Judge)	
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	JERRY SMITH)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	MICHAEL R. FLEMING)	
	Administrative Patent Judge)	

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