

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MINORI TAKAGI,
KOUJI ARAMAKI,
and
TAKESHI IKEDA

Appeal No. 1998-0922
Application No. 08/386,862

HEARD: OCTOBER 26, 2000

Before FLEMING, RUGGIERO, and LALL, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 5, 6, and 8-18, all of the claims pending in the present application. Claims 1-4 and 7 have been canceled.

The claimed invention relates to a video tape recorder (VTR) with a monitor-equipped built-in camera. The video tape recorder includes a monitor/VTR portion which is integrally

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formed with a VTR portion for holding a removable tape cassette and a monitor portion which includes a liquid crystal display device. The VTR driving substrate and the monitor driving substrate are integrally "sandwiched" between the VTR mechanical unit and the liquid crystal display panel. Appellants assert at page 12 of the specification that this compact construction achieves miniaturization of the VTR structure while still accommodating a large-sized display panel.

Claim 5 is illustrative of the invention and reads as follows:

5. A VTR with a monitor-equipped built-in camera comprising:

monitor a monitor/VTR portion integrally formed of a VTR portion holding a removable tape cassette and a portion including a liquid crystal display device;

a camera portion;

a rotary mechanism attaching said camera portion to said monitor/VTR portion in a relatively rotatable manner; and wherein

said monitor/VTR portion has a VTR driving substrate for driving said VTR portion and a monitor driving substrate for driving said monitor portion, said VTR driving substrate and said monitor driving substrate integrally sandwiched between said monitor portion and said VTR portion and said monitor driving substrate being

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substantially parallel to a display surface of said
liquid crystal display device.

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The Examiner relies on the following prior art:

Schauer et al. (Schauer) 22, 1991	5,059,134	Oct.
Vertin 1991	5,073,824	Dec. 17,
Kikutani et al. (Kikutani) ¹ 1986 (Published Japanese Patent Application)	61-150474	July 09,
Inada et al. (Inada) (Published European Patent Application)	EP 0 203 783 A2	Dec. 03, 1986

Claims 5, 6, and 8-18 stand finally rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner offers Kikutani alone with respect to claims 5, 6, 16, 17, and 18. In combination with the Kikutani reference, the Examiner adds Schauer with respect to claims 8-13, Vertin with respect to claim 14, and Inada with respect to claim 15.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs² and Answers for the respective details.

¹ A copy of an English language translation provided by the U.S. Patent & Trademark Office, March 1992, is included and relied upon for this decision.

² The Appeal Brief was filed October 31, 1996. In response to the Examiner's Answer dated February 3, 1997, a Reply Brief was filed April 2, 1997 to which the Examiner responded with a Supplemental Examiner's Answer dated June 24, 1997.

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OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answers.

It is our view, after consideration of the record before us, 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 5, 6, and 8-18. Accordingly, we reverse.

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,

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17-18, 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

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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 5, 16, 17, and 18, the Examiner, as the basis for the obviousness rejection, proposes to modify the video tape recorder (VTR) disclosure of Kikutani. In the Examiner's analysis (Answer, page 4), Kikutani discloses a video tape recorder in a unified structure with a camera and a monitor, but lacks any disclosure of the specific claimed structural orientation of the monitor and VTR substrates. This structural orientation of the monitor and VTR substrates is recited in appealed claim 5 as "integrally sandwiched between said monitor portion and said VTR portion" and further that the monitor driving substrate is "substantially parallel to a display surface of said liquid crystal display device." Despite the admitted lack of disclosure of these features in Kikutani, the Examiner nevertheless suggests the obviousness to the skilled artisan of modifying Kikutani to arrive at such structural arrangement

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as a matter of obvious design choice. The Examiner's ultimate conclusion (Answer, page 4) is that the skilled artisan would recognize that the mere change of form or shape or the shift of location of a part does not impart patentability to a claimed structure.

After reviewing Appellants' arguments in response, we are in agreement with Appellants' position as stated in the Briefs. It is our opinion that the Examiner's finding that any modification of the orientation of the internal circuit substrate components of Kikutani would be an obvious design choice is without support on the record, and could only come from an improper hindsight reconstruction of Appellants' claimed invention. In our view, there is a distinct functional difference between Appellants' VTR structure which is designed to produce a compact housing unit while accommodating a large screen display and the unitary structure of Kikutani which is structured so as to allow monitoring of the amount of tape while viewing the monitor. This functional difference is achieved by the specific structural arrangement in appealed claim 5 which results in a clear structural difference over Kikutani in which no explicit disclosure of

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any substrate structural orientation is provided. It is our finding that because of the clear functional difference achieved by Appellants' specific claimed structure over the undisclosed structure of Kikutani, such claimed structure can not be considered as a mere design choice. See In re Chu, 66 F.3d 292, 299, 36 USPQ2d 1089, 1095 (Fed. Cir. 1995), and In re Gal, 980 F.2d 717, 719, 25 USPQ2d 1076, 1078 (Fed. Cir. 1992), cited by Appellants.

Further, we have reviewed the disclosures of Schauer, Vertin, and Inada, applied by the Examiner to address various features of the dependent claims. We find nothing in any of these references which would overcome the innate deficiencies of Kikutani.

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Since it is our opinion, for at least the reasons discussed above, that the Examiner has failed to establish a prima facie case of obviousness, we do not sustain the Examiner's 35 U.S.C.

§ 103 rejection of independent claims 5 and 16-18, nor of claims 6 and 8-15 dependent thereon. Accordingly, the Examiner's decision rejecting claims 5, 6, and 8-18 is reversed.

REVERSED

MICHAEL R. FLEMING
Administrative Patent Judge

JOSEPH F. RUGGIERO
Administrative Patent Judge

PARSHOTAM S. LALL
Administrative Patent Judge

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