

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte AKIHIRO KIKUCHI

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Appeal No. 1999-0063  
Application No. 08/602,366

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BRIEF

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Before JERRY SMITH, RUGGIERO, and LEVY, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 16-25, which are all of the claims pending in the application. Claims 1-15 have been canceled. An amendment filed August 7, 1997 after final rejection was denied entry by the Examiner.

The claimed invention relates to a method and apparatus for controlling the traveling of a tape in a data recording apparatus in which a travel request signal is initially

received which includes a travel target position. A difference is calculated between an identified present tape position and the target position and a determination is made as to whether the calculated difference exceeds a predetermined value. If so, the tape is moved to a position between the target position and the present position. On receipt of a write request signal, the tape is then moved to the target position where data is recorded on the tape.

Claim 16 is illustrative of the invention and reads as follows:

16. An apparatus for controlling the travelling [sic. traveling] of a tape in a data recording apparatus, the apparatus comprising:

means for receiving a travel request signal, the travel request signal including a target position representing a position on the tape at which data is to be recorded or reproduced;

means for identifying a present position of the tape;

means for calculating a difference between the present position and the target position to produce a difference value, and for determining if the difference value is larger than a predetermined value;

means for producing a control signal only if it is determined that the difference value is larger than the predetermined value;

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means for moving the tape to a position between the target position and the present position only if the travel request signal is received and the control signal is produced;

means for receiving a write request signal indicating a request to record the data on the tape;

said means for moving the tape being operable to move the tape to the target position when the write request signal is received; and

means for recording the data on the tape after the tape is moved to the target position.

The Examiner relies on the following prior art:

|                            |           |          |
|----------------------------|-----------|----------|
| Inazawa et al. (Inazawa)   | 4,958,244 |          |
| Sep. 18, 1990              |           |          |
| Yoshioka et al. (Yoshioka) | 5,384,673 | Jan. 24, |
| 1995                       |           |          |

Claims 16-25 stand finally rejected as being based on an inadequate disclosure under the first paragraph of 35 U.S.C. § 112. Claims 16-25 stand further finally rejected under 35 U.S.C. § 103 as being unpatentable over Yoshioka in view of Inazawa.<sup>1</sup>

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<sup>1</sup> At page 4 of the Brief, Appellant directs arguments to an "objection" to claim 16 made by the Examiner in the Advisory Office action mailed September 8, 1997 (Paper No. 10). We decline to rule on the merits of these arguments since claim objections are petitionable matters not appropriate for decision on appeal. Further, while the substance of the Examiner's objection could conceivably have led to a rejection under the second paragraph of 35 U.S.C. § 112, no such rejection is before us.

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Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs<sup>2</sup> and Answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, the arguments in 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, 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 Answer.

It is our view, after consideration of the record before us, that Appellant's specification in this application describes the claimed invention in a manner which complies

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<sup>2</sup> The Appeal Brief (Paper No. 13) was filed December 1, 1997. In response to the Examiner's Answer (Paper No. 14) dated February 10, 1998, a Reply Brief (Paper No. 16) was filed April 9, 1998, which was acknowledged and entered by the Examiner without further comment in the communication (Paper No. 18) dated July 8, 1998.

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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 have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 16-25. Accordingly, we reverse.

We consider first the Examiner's rejection of claims 16-25 under the "written description" requirement of the first paragraph of 35 U.S.C. § 112. The function of the written description requirement of the first paragraph of 35 U.S.C. § 112 is to ensure that the inventor has possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him. In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976).

The genesis of the Examiner's assertion of the lack of compliance with the statutory written description requirement was the submission of new claims 16-25 which added the language "travel request signal" which, in the Examiner's view, has no support in the original disclosure. We agree with Appellant (Brief, pages 9-11; Reply Brief, pages 5 and 6), however, that the Examiner's position is without support on the record. Initially, we find to be correct Appellant's

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assertion that there is no requirement that language added by amendment to claims be in the originally filed claims, as incorrectly asserted by the Examiner. In any case, our review of the language of the originally filed claims 1-15 in fact reveals clear support for the added "travel request signal" language in later submitted claims 16 and 21. Original claims constitute their own description. In re Koller, 613 F.2d 819, 823, 204 USPQ 702, 706 (CCPA 1980). Although the exact language "travel request signal" is not used in the original claims, original claim 1 clearly provides description support by reciting "a first command signal for receiving a position traveling request...." Further, contrary to the Examiner's concern (Answer, page 5) that the language in the later submitted claims was an attempt to improperly cover both rewind and forward tape movement, we point out that originally filed claim 4 specifies that the position traveling request "is a rewind request or a fast-forward request."

Further, notwithstanding our finding that the originally filed claims in this application provide clear support for the language added in claims 16-25, we are in agreement with Appellant that the disclosure at page 27, lines 8-20 and page

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29, lines 9-16 in connection with Figures 18A-18D, 19A-19C, and 20A-20C also provides a clear description of the "travel request signal" language. Accordingly, we find Appellant to be correct in the assertion that the originally filed disclosure provides written description support for the invention as claimed and, therefore, the Examiner's rejection of claims 16-25 under the first paragraph of 35 U.S.C. § 112 is not sustained.

We will also not sustain the rejection of claims 16-25 under 35 U.S.C. § 103. The Examiner has failed to set forth a prima facie case of obviousness. 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 (CCPA 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

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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 presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

In response to the Examiner's obviousness rejection of the appealed claims, Appellant initially attacks (Brief, page 13; Reply Brief, page 10) the Examiner's establishment of any motivation for the proposed combination of Yoshioka and Inazawa. After reviewing the applied prior art references in light of the arguments of record, we are in agreement with Appellant's position as stated in the Briefs. As the supposed rationale for the proposed combination, the Examiner suggests

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(Answer, page 4) that the skilled artisan would be led to modify Yoshioka by the desire to reduce the travel speed of the tape medium as stated in the Abstract of Inazawa. We agree with Appellants, however, that the Examiner's line of reasoning is devoid of any indication as to why one would want to reduce tape travel speed in Yoshioka. To the contrary, our review of Yoshioka reveals that the object of the Yoshioka's invention is to increase speed of access to information on the tape medium (Yoshioka, Abstract, column 6, lines 48-53).

We further agree with Appellant that, even assuming arguendo that the skilled artisan would be motivated to combine Yoshioka with Inazawa, such a proposed combination would not result in the invention as claimed. First of all, we find no indication in the Answer as to how and where the tape positioning technique of Inazawa would be utilized in the system Of Yoshioka to arrive at the claimed invention. Secondly, our interpretation of the disclosure of Inazawa coincides with that of Appellant, i.e. the tape in Inazawa travels back and forth over the target position rather being positioned at a location between the target and present positions as recited in Appellant's claims. Further, even

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assuming that the intermediate tape positions in the search procedure illustrated in Figures 10A-10C in Inazawa could be construed as between a present and target position as the Examiner seems to suggest, all of the limitations of the appealed claims would still not be met. Each of the independent claims 16 and 21, in addition to setting forth the "in between" tape positioning feature discussed above, also has a specific recitation of the necessary conditions for initiating tape movement. As called for in the claims, a control signal is produced only if the difference between a present position and a target position exceeds a predetermined value, and the tape is moved only if this control signal and a travel request signal are received. We find no suggestion of these tape movement conditions in either of the applied Yoshioka and Inazawa references.

Since, for the above reasons, it is our view that all of the limitations of the appealed claims are not taught or suggested by the applied references, we do not sustain the 35 U.S.C. § 103 rejection of independent claims 16 and 21, nor of claims 17-20 and 22-25 dependent thereon.

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In summary, we have not sustained either of the Examiner's rejections of the claims on appeal. Therefore, the Examiner's decision rejecting claims 16-25 is reversed.

REVERSED

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|-----------------------------|---|-----------------|
| JERRY SMITH                 | ) |                 |
| Administrative Patent Judge | ) |                 |
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|                             | ) | BOARD OF PATENT |
| JOSEPH F. RUGGIERO          | ) | APPEALS         |
| Administrative Patent Judge | ) | AND             |
|                             | ) | INTERFERENCES   |
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|                             | ) |                 |
| STUART S. LEVY              | ) |                 |
| Administrative Patent Judge | ) |                 |

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APJ LEVY

APJ JERRY SMITH

DECISION: REVERSED  
Send Reference(s): Yes No  
or Translation (s)  
Panel Change: Yes No  
Index Sheet-2901 Rejection(s):  
Prepared: August 14, 2002

Draft                  Final

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PALM / ACTS 2 / BOOK  
DISK (FOIA) / REPORT