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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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

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Appeal No. 1999-0298
Application No. 08/486,780

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ON BRIEF

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

FLEMING, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 32 through 36.

The invention relates to a picture image recording device. In particular, Appellants disclose on page 37 of the specification that upon completion of recording on the innermost track of the disc 11, the protrusion 76 provided on the fore end of the counting member 72 comes to open the end switch SWE and the power supply to the whole circuit system is cut off.

The reference relied on by the Examiner is:

Adcock 4,057,830 Nov. 08, 1977

Claims 32 through 36 stand rejected under 35 U.S.C. § 102(b) as anticipated by Adcock.[1]

Rather than repeat the arguments of Appellants and the Examiner, we make reference to the briefs[2] and the answer for the respective details thereof.

OPINION

Upon careful review of the record, we will not sustain the Examiner's rejection of claims 32 through 36 under 35 U.S.C. § 102. In the brief and reply brief, Appellants argue that

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[1] The Examiner has withdrawn the rejection of claims 32 through 36 (see, Paper No. 24, mailed May 7, 2002) under the judicially created doctrine of double patenting based on **In re Schneller**, following a remand by the Board to consider and respond to the rejection as per MPEP § 804 (8th ed., Aug. 2001).

[2] Appellants filed an appeal brief on December 1, 1997 (Paper No. 17). Appellants filed a reply brief on April 13, 1998 (Paper No. 19). The Examiner mailed an office communication on June 25, 1998 (Paper No. 20) stating the reply brief had been entered and considered.

Adcock does not teach or suggest a second control means, for controlling power consumption of the pickup/converting means based on the capacity of the recording medium or memory as recited in independent claims 32 and 33. Appellants point out that Adcock does not teach or suggest controlling power but instead is directed to controlling the tape advance so as to provide sufficient time to record the picture on the tape.

As pointed out by our reviewing court, we must first determine the scope of the claim. "[Tlhe name of the game is the claim." ***In re Hiniker, Co.***, 150 F.3d 1362, 1369, 47 USPQ2d 1523 (Fed. Cir. 1998). In addition, claims are to be interpreted as broadly as the terms reasonably allow. ***In re Zletz***, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Our reviewing court has stated in ***In re Donaldson Co. Inc.***, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) that the "plain and unambiguous meaning of paragraph six is that one construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and

equivalents thereof, to the extent that the specification provides such disclosure."

Independent claim 32 recites

> second control means for controlling a power consumption of said converting means regardless of a given manual operation of said operation member after said recording means records the signal to be recorded on all of the predetermined recordable capacity of the recording medium substantially.

Independent claim 33 recites

> second control means for stopping the recording operation of the recording means after substantially all memory capacity of the memory for the picture image has been used by the recording of the picture image from the pickup means, and controlling the pickup means so as to reduce power consumption thereof despite a new operation of the operation member.

We note that the corresponding structure of this means is found on page 37 of Appellants' specification and also figure 9. In particular, on page 37, Appellants' specification states that

> the number of recording tracks that have been recorded in this manner is indicated on the track number indicating graduation plate 75 by the pointer 73 which is attached to the fore end of the counting member 72 which is shown in Fig. 9. Upon completion of recording on the innermost track of the disc 11, when the heads 15A and 153 are automatically shifted, the protrusion 76 provided on the fore end of the counting member 72 comes to open the end switch SWE and power supply to the whole circuit system is cut off.

Taking a reasonably broad interpretation, claims 32 and 33 require a control means for controlling the power consumption of the pickup/converting means based upon the capacity of the recording medium/memory.

Using the above interpretation, we review the rejection of claims 32 through 36 under 35 U.S.C. § 102. It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. ***See In re King***, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and ***Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.***, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

Upon our review, we find that the Examiner has not shown that Adcock teaches a second control means for controlling power consumption of the pickup/converter means based on the capacity of the recording medium or memory. In the Examiner's answer, the Examiner relies on column 7, lines 4 through 34, of Adcock for a finding of anticipation of the claimed second control means for controlling power consumption of the converting means. See the Examiner's answer, page 7, last two paragraphs through page 8.

However, in our review of Adcock including column 7, we find that Adcock is not concerned with controlling power consumption but instead is concerned with controlling the tape advance so as to provide sufficient time to record the current picture on the tape before recording the next picture. In particular, we point to column 7, lines 29 through 34 which state

> [t]he signal is delayed a sufficient time to enable recordation of the picture on the tape, and then the signal enables the advance tape circuitry 70 and tape rotate motor 72 for positioning a new portion of tape for the next picture. A control 76 provides a signal when all of the available tape has been utilized.

Furthermore, we note that Adcock teaches in column 7, lines 13 through 15, that "[t]he AND gate 56 is effective to preclude operation of the shutter until the previous signal is recorded on the tape." However, we fail to find that Adcock teaches Appellants' claimed second control means which is concerned with controlling power consumption based upon the capacity of the recording means or memory.

Therefore, we cannot sustain the rejection of claims 32 and 33 under 35 U.S.C. § 102. In addition, since the rejection of

independent claims 32 and 33 cannot be sustained, the rejection of dependent claims 34 through 36 also cannot be upheld.

REVERSED

ERROL A. KRASS Administrative Patent Judge	)	
MICHAEL R. FLEMING Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ANITA PELLMAN GROSS Administrative Patent Judge	)	

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