

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. 49

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NOBUHIRO TSURUMAKI

Appeal No. 2000-1234
Application No. 08/911,442

ON BRIEF¹

Before HAIRSTON, KRASS, and BARRY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

The examiner rejected claims 1, 4, 5, 8-12, 16, and 17. The appellant appeals therefrom under 35 U.S.C. § 134(a). We reverse.

BACKGROUND

The invention at issue in this appeal is a cassette auto-changer. The auto-changer includes a bin for housing video

¹An oral hearing scheduled for March 7, 2002 was waived. (Paper No. 48.)

tape cassettes of different sizes or recording formats. Each bin is assigned to house cassettes of a specific format. An elevator selectively removes a cassette from the bin and, based on the assigned format, loads the cassette into a video tape recorder using the same format.

Claim 1, which is representative for present purposes, follows:

1. A cassette auto-changer, comprising:

a cassette accommodating portion including a plurality of accommodating units each having a plurality of substantially identical cassette bins, each individual cassette bin being adapted to accommodate a plurality of different types of cassettes housing different types of recording media having different types of recording formats, a respective one of said recording formats being assigned to each of said cassette bins, the cassette bins in a respective accommodating unit accommodating a plurality of cassettes housing recording media having the same one of said recording formats, each of said accommodating units including a memory circuit for storing recording format information indicating the type of recording format assigned to each of said cassette bins therein, said memory circuit including a plurality of connections each connected to one of a power source and a ground;

an information reading circuit electrically coupled to the memory circuit of each of said

accommodating units for reading the recording format information from the memo circuits;

a plurality of recording and/or reproducing apparatus each provided for selectively recording and/or reproducing a signal on or from the recording medium housed in the cassette loaded therein in a predetermined one of said recording formats;

a cassette transport mechanism for selectively transporting said cassettes between said cassette bins and said recording and/or reproducing apparatus and for loading the transported cassettes into said cassette bins or said recording and/or reproducing apparatus in accordance with a conveyance command signal; and

control means for recognizing the recording format assigned to each of said cassette bins on the basis of the stored recording format information and for generating said conveyance command signal.

(Appeal Br. at 15.)

The prior art applied by the examiner in rejecting the claims follows:

Kulakowski et al. ("Kulakowski") 5,303,214 Apr. 12, 1994
(filed Jan. 3, 1992)

Sato et al. ("Sato") 5,450,254 Sep. 12, 1995
(filed Nov. 3,

1992).

Claims 1, 4, 5, and 8-10 stand rejected under 35 U.S.C.

§ 103(a) as obvious over Kulakowski. Claims 11, 12, 16, and

17 stand rejected under 35 U.S.C. § 102(e) as anticipated by Sato.

OPINION

After considering the record, we are persuaded that the examiner erred in rejecting claims 1, 4, 5, 8-12, 16, and 17. Accordingly, we reverse. Our opinion addresses the following rejections:

- obviousness rejection of claims 1, 4, 5, and 8-10
- anticipation rejection of claims 11, 12, 16, and 17.

I. Obviousness Rejection of Claims 1, 4, 5, and 8-10

Rather than reiterate the positions of the examiner or appellant *in toto*, we address the point of contention therebetween. The examiner asserts, "as seen from figure 33 each of bins (26 and 27) is adapted to accommodate a plurality of different types of cassettes. Also, not [sic] column 6 lines 11-23 which discusses that different types of cartridges can be put in the bins." (Examiner's Answer at 5.) The appellant argues, "in claims 1 and 4, each substantially

identical cassette bin is able to accommodate a plurality of different types of cassettes, whereas in Kulakowski, each cassette bin may be specifically designed to hold a particular mix of cassettes, but each cassette bin is not substantially identical and designed to accommodate a plurality of different types of cassettes." (Appeal Br. at 10.)

In deciding obviousness, "[a]nalysis begins with a key legal question -- *what is the invention claimed?*" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). Here, independent claims 1 and 4 specify in pertinent part the following limitations: "a cassette accommodating portion including a plurality of accommodating units each having a plurality of substantially identical cassette bins, each individual cassette bin being adapted to accommodate a plurality of different types of cassettes housing different types of recording media having different types of recording formats. . . ." Accordingly, limitations require *inter alia* substantially identical

cassette bins wherein each bin accommodates different types of cassettes.

Having determined what subject matter is being claimed, the next inquiry is whether the subject matter is obvious. "In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)(citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "'A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.'" *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, neither bin 26 nor bin 27 of Kulakowski accommodates different types of cassettes. To the contrary,

each of the bins accommodates a single type of cassette. Specifically, "half-sized bin 26 and full-size bin 27 respectively store small and large cartridges." Col. 5, ll. 40-42. More specifically, "bin 26 [is] for storing twenty-two optical disk cartridges 22 in respective cartridge slots 104 and bin 27 [is] for storing five tape cartridges 23 in bin 27 slots 104." Col. 21, ll. 62-65. Although the reference also mentions that labels identifying bin 26 and bin 27 "may include . . . whether multiple types of cartridges are stored," col. 6, ll. 13-15, we are uncertain whether this refers to storing different types of cartridges in different bins or in the same bin. In view of the aforementioned passages of Kulakowski, we favor the former interpretation. Therefore, we reverse the rejection of independent claims 1 and 4 and of claims 5 and 8-10, which depend from claim 1.

II. Anticipation Rejection of Claims 11, 12, 16, and 17

The examiner asserts, "[a]s clearly seen from figure 1 of Sato et al., there is a plurality of bins (6a-6d) each one of the bins accommodating a plurality of cassettes of a first size or only cassettes of a second size. For example, bin 6b

depicts a bin that accommodates a plurality of cassettes of a first size and bin 6c accommodates cassettes of only a second size." (Examiner's Answer at 6.) The appellant argues, "in Fig. 1 of Sato et al., 'bin' 6C accommodates more than one cassette, thus not meeting the claim limitation." (Reply Br. at 4.)

In deciding anticipation, "the first inquiry must be into exactly what the claims define." *In re Wilder*, 429 F2d 447, 450, 166 USPQ 545, 548 (CCPA 1970). Here, independent claim 11 specifies in pertinent part the following limitations: "a cassette accommodating portion having a plurality of cassette bins for accommodating a plurality of different types of cassettes of different sizes housing different types of recording media having different types of recording formats, . . . each one of said cassette bins accommodating a plurality of cassette having a first size or only one cassette having a second size. . . ." Accordingly, limitations require *inter alia* cassette bins wherein at least one of the bins accommodate only one cassette.

Here, bin 6c is not limited to accommodating only one cassette. To the contrary, Figure 1 of Sato shows that the bin accommodates three cassettes. Therefore, we reverse the rejection of independent claim 11 and of claims 12, 16, and 17, which depend therefrom.

CONCLUSION

In summary, the rejection of claims 1, 4, 5, and 8-10 under § 103(a) is reversed. Likewise, the rejection of claims 11, 12, 16, and 17 under § 102(e) is also reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ERROL A. KRASS)	APPEALS
Administrative Patent Judge)	AND
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Once signed, forward to Team 3 for mailing.

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APPLICATION NO. 08/911,442

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Prepared By: APJ BARRY

DRAFT SUBMITTED: 09 Oct 02

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Team 3:

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For any additional reference provided, please prepare PTO 892 and include copy of references

Thanks,
Judge Barry