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PAT.&T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

This opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

95-1371

Paper No. 41

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte SEONG W. JO

Appeal No. 95-1371  
Application No. 07/726,879<sup>1</sup>

HEARD:  
June 5, 1996

Before HAIRSTON, CARDILLO, and FLEMING, Administrative Patent Judges.

FLEMING, Administrative Patent Judge.

DECISION ON APPEAL

<sup>1</sup> Application for patent filed July 8, 1991.

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This is a decision on appeal from the final rejection of claims 1 through 21, all of the claims present in the application.

The invention is directed to a method for checking abnormal operations of a video cassette recorder (VCR).

The independent claim 1 is reproduced as follows:

1. A method of checking the abnormal operation of a video cassette recorder, including a VCR drive circuit composed of a microprocessor for providing control signals, a deck part for providing a reel pulse, a drum pulse, and a mode switch signal according to an operation mode, and a digitron for displaying information, said digitron controlled by said microprocessor, said method comprising:

an auto-check mode decision process for deciding whether said microprocessor is in auto-check mode;

a stop mode decision process for deciding whether said deck part is normally operated according to the stop mode by checking said mode switch signal and said drum pulse;

a fast forward mode and rewind mode decision process for deciding whether said deck part is normally operated according to the fast forward mode or the rewind mode by checking said mode switch signal and said reel pulse;

a play mode, a forward play search mode and reverse play search mode decision process for deciding whether said deck part is normally operated according to said play mode, said forward play search mode and said reverse play search mode by checking said mode switch signal, said reel pulse, and said drum pulse; and

an eject mode decision process for deciding whether said deck part is normally operating according to the eject mode by checking said mode switch signal.

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The Examiner relies on the following references:

Narita	4,553,182	Nov. 12, 1985
Pepsnik	5,055,960	Oct. 8, 1991

Claims 10 and 11 stand rejected under 35 U.S.C. § 102 as being anticipated by Appellant's admitted prior art found in the Appellant's specification, hereafter referred to as simply prior art. Claims 1 and 2 stand rejected under 35 U.S.C. § 103 as being unpatentable over prior art in view of Pepsnik. Claims 3 through 9 and 12 through 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over prior art in view of Pepsnik and Narita.

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

In determining whether the Examiner established a prima facie case, we must first determine what disclosed matter in the specification is admitted by Appellant as being prior art. The

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<sup>2</sup> Appellant filed an appeal brief on March 21, 1994 that was not entered into the record. Appellant filed another appeal brief on May 5, 1994 which was entered into the record. We will reference this appeal brief as the brief. Appellant filed a reply brief on August 22, 1994 which was entered into the record. We will reference this reply appeal brief as the reply brief. We note that the Examiner did not respond to the reply brief.

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Examiner asserts on page 3 of the answer that Figure 1 and page 3, line 3, through page 5, line 11 of the Appellant's specification is admitted by Appellant as being prior art. These pages of the specification are directed to the monitoring of the reel pulse, drum pulse, the mode switch signal and the sensor signals of the deck, DE, by the microprocessor, MP.

Appellant argues on page 5 of the brief and pages 3-5 of the reply brief that the Examiner has erroneously deemed prior art as that part of the specification disclosed between page 3, line 3 and page 5, line 11. Appellant argues that the part of the specification the Examiner has deemed prior art is clearly headed by the descriptive label "DETAILED DESCRIPTION OF THE INVENTION" and page 3 provides a description of the inventive VCR control circuit that is similar to a conventional VCR control circuit that is shown in Figure 1. Appellant further argues that Figure 3, which is not labeled prior art, clearly depicts an invention different from that shown in Figure 1, labeled prior art. Appellant further argues that amendments, filed May 3, 1993 and December 16, 1993 and entered, to the specification for pages 1 and 3 make it clear that the part of the specification which the Examiner deemed as prior art is not prior art but is directed to Appellant's invention.

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Upon reviewing the file history, we note that the Examiner denied entry of Figure 3 and the above amendment as well as an amendment to Figure 1 as being directed to new matter. Appellant petitioned under 37 CFR § 1.181 requesting that the proposed amendments and Figure 3 be entered. The petition was granted to the extent of allowing entry of the amendment and Figure 3, but denied entry of the amendment to Figure 1.

We understand the Examiner's concern in reviewing the Appellant's originally filed specification. However, when reviewing the disclosure as a whole, we find that Appellant did not admit that it was known in the art to have the microprocessor monitor the reel pulse, drum pulse, the mode switch signal and the sensor signals of the deck, DE. Appellant has only admitted that Figure 1 shows a prior art system. Figure 1 only shows four lines connecting the deck, DE, to the microprocessor, MP. These lines are not labeled. Without any labels, we do not wish to speculate what is the purpose of these lines.

When reviewing page 3 of the specification, we note that under the title, "DETAILED DESCRIPTION OF THE INVENTION" in the first sentence, Appellant states that the "present invention will now be described in more detail with reference to accompanying drawings." In the third sentence, Appellant stated in the

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original specification as filed that "[t]he VCR control circuit which is similar to a conventional VCR control circuit is composed of ...". When reading this sentence, the first question is whether "[t]he VCR control circuit" is referring to Appellant's invention or the prior art. In the previous sentence, Appellant originally stated "Fig. 1 is a block diagram of a VCR control circuit to carry out a program for checking abnormal operations of a VCR." Thus, "[t]he VCR control circuit could be viewed as either the invention or the prior art circuit. However, if "[t]he VCR control circuit" is referring to the prior art circuit, the clause in the third sentence, "which is similar to a conventional VCR control circuit" would only be redundant and have no meaning. This is because the sentence would read the prior art circuit, the VCR control circuit, which is similar to a prior art circuit, a conventional VCR control circuit.

Furthermore, the amendment clarifies that the description found on pages 3 through 5 is directed to Appellant's invention. The second sentence on page 3 was amended to read that "Fig 3 is a block diagram of a VCR control circuit to carry out a program

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checking abnormal operations of a VCR." As amended, it is clear that "[t]he VCR control circuit" of the next sentence is referring to the VCR control circuit of Appellant's invention and not the VCR control circuit of the prior art. Since the petition has been granted, we will not revisit the question as to whether entry of this amendment is proper. Thus, the prior art as disclosed by Appellant is only what is shown in Figure 1 which does not show any more than unlabeled lines connecting the deck, DE, with the microprocessor, MP. Because the Examiner's rejections are based upon finding that the prior art included the description found on pages 3 and 5, which is not proper, we will



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