

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte SE YOUNG CHOUNG

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Appeal No. 1996-1253  
Application 08/113,034<sup>1</sup>

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HEARD: December 9, 1999

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Before JERRY SMITH, FRAHM and BARRY Administrative Patent Judges.

FRAHM, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed August 31, 1993. Appellant relies upon a foreign priority filing date under 35 U.S.C. § 119 of August 31, 1992.

Appellant has appealed to the Board from the examiner's final rejection of claims 1 to 23, which constitute all of the pending claims in the application before us.

### BACKGROUND

The subject matter on appeal is directed to a method for detecting playing time and residual time of a magnetic tape (e.g., a VCR tape or a cassette tape) by detecting various positions of a signal on the tape (see specification, pages 1 and 2).

Representative independent method claim 1 is reproduced below:

1. A method for detecting playing time of a magnetic tape by detecting an instantaneous position of the magnetic tape loaded on a head drum of a deck, said method comprising the steps of:
  - (a) when a video signal is recorded on a magnetic tape, storing a first residual time of the magnetic tape by detecting a finishing position;
  - (b) storing a second residual time of the magnetic tape by detecting a beginning position of a video signal recorded in the magnetic tape;
  - (c) storing a third residual time of the magnetic tape by subtracting said first residual time from said second residual time; and
  - (d) increasing said third residual time in response to operation of said deck in a corresponding recording/reproducing mode of operation.

The following reference is relied on by the examiner:

Orimoto et al. (Orimoto)

Kokai 57-14108

(Sept. 1, 1992)<sup>2</sup>

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<sup>2</sup> We have been provided a translation, on which we rely, of this reference from the Translations Branch of the PTO Scientific Library. A copy is provided to appellant as an attachment to this opinion. For purposes of this opinion, we will reference the Orimoto translation, which contains pages 1 through 12, accompanying this opinion.

Japanese

Claims 1 to 23 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking an enabling disclosure.

Claims 1 to 23 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Orimoto.

Rather than repeat the positions of appellant and the examiner, reference is made to the Brief, Reply Brief,<sup>3</sup> and the Answer for the respective details thereof.

#### OPINION

In reaching our conclusion on the issues raised in this appeal, we have carefully considered appellant's specification and claims, the applied patents, and the respective viewpoints of appellant and the examiner. As a consequence of our review, we are in agreement with appellant (Brief, pages 15 to 19; Reply Brief, pages 7 to 9) that the examiner has not provided a prima facie case of non-enablement under 35 U.S.C. § 112, first paragraph. With respect to the art rejection, we are in general agreement with the examiner (Answer, pages 5 to 9) that Orimoto would have fairly suggested the invention of claims 1 to 5 on appeal. However, we agree with appellant (Brief, pages 25 to 34; Reply Brief, pages 1 to 7 and 10 to 12) that claims 6 to 23 on appeal are neither taught nor suggested by Orimoto. For the reasons which follow, we will sustain the decision of the examiner rejecting claims 1 to 5 under 35

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<sup>3</sup> We note that the Reply Brief submitted January 22, 1996, was entered and considered by the examiner as per the letter from the examiner dated February 22, 1999.

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U.S.C. § 103, and we will reverse the decisions of the examiner rejecting claims 1 to 23 under 35 U.S.C. § 112, first paragraph, and rejecting claims 6 to 23 under 35 U.S.C. § 103.

Rejection of Claims 1 to 23 Under 35 U.S.C. § 112, First Paragraph:

We turn first to appellant's arguments (Brief, pages 3 to 10 and 11 to 12) that the examiner improperly rejected all of the claims on appeal under 35 U.S.C. § 112, first paragraph. Claims 1 to 23 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification so as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims (see Answer, pages 3 to 5). Because we agree with appellant that undue experimentation would not be required to enable the ordinarily skilled artisan to make and/or use the invention, we will not sustain the examiner's rejection under 35 U.S.C. § 112, first paragraph.

To comply with the enablement clause of the first paragraph of 35 U.S.C. § 112, the disclosure must adequately describe the claimed invention so that the artisan could practice it without undue experimentation. In re Scarbrough, 500 F.2d 560, 566, 182 USPQ 298, 302 (CCPA 1974); In re Brandstadter, 484 F.2d 1395, 1407, 179 USPQ 286, 294-95 (CCPA 1973); In re Gay, 309 F.2d 769, 772, 135 USPQ 311, 315 (CCPA 1962). Stated another way, "[t]he test of enablement is

whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), citing Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986). The burden is initially upon the examiner to establish a reasonable basis for questioning the adequacy of the disclosure. In re Angstadt, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976); and In re Armbruster, 512 F.2d 676, 678, 185 USPQ 152, 154 (CCPA 1975). It is well settled that the examiner has the initial burden of establishing lack of enablement by compelling reasoning or objective evidence. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982); In re Armbruster, 512 F.2d 676, 677, 185 USPQ 152, 153 (CCPA 1975); In re Marzocchi, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971).

In the instant case before us, the specification describes a method of detecting a playing time and a residual time of a magnetic video tape. The method is described in relation to Figure 3 of the disclosure, which shows a single signal (region "L") recorded on the tape. The examiner's rejection under § 112, first paragraph, is based on the assertion that one reasonably skilled in the art reading appellant's disclosure (which describes the method in relation to a single signal being on the magnetic tape) would not reasonably understand how to apply the method of the claimed invention to a magnetic tape having plural recorded signals thereon. We cannot agree with the examiner. We find that the

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single signal example of appellant's disclosure is explained in enough detail to enable one of ordinary skill in the art to make and use the recited method in relation to magnetic tapes having plural signals thereon without undue experimentation.

We find that in this case the examiner has not met his burden of showing a reasonable basis for questioning the sufficiency of the disclosure. We agree with appellant (Brief, pages 16 to 17) that the examiner has not established a prima facie case of non-enablement and that there should be no need for appellant to provide numerous examples regarding different tape formats.

Taken in light of the above discussion, we find that appellant's disclosure adequately teaches how to make and use the claimed invention, and we will reverse the rejection of claims 1 to 23 under 35 U.S.C. § 112, first paragraph.

Rejection of Claims 1 to 5 Under 35 U.S.C. § 103:

Turning first to the rejection of claims 1 to 5 under § 103, we find that claims 1 to 5 on appeal would have been obvious to one of ordinary skill in the art at the time the invention was made in light of the teachings and suggestions of Orimoto. We note that claims 1 to 5 on appeal differ significantly from claims 6 to 23 on appeal in that claims 1 to 5 broadly call for a method of detecting tape playing and

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residual times wherein a residual time is increased in relation to concurrent recording or reproduction operations. Claims 6 to 23 are much narrower in that they further call for a tape detecting method wherein high speed winding and rewinding search modes of operation are employed. Because claims 1 to 5 are so broad as to encompass the method taught and/or fairly suggested by Orimoto, we will sustain the examiner's rejection under 35 U.S.C. § 103 as to claims 1 to 5 on appeal. Further, since we conclude that Orimoto fails to teach

or suggest a tape detecting method employing high speed rewinding and winding search modes of operation, we will reverse the examiner's rejection under 35 U.S.C. § 103 as to claims 6 to 23 on appeal.

We agree with the examiner's reasoning (Answer, pages 8 to 9) that the ordinarily skilled artisan looking at Orimoto would have been motivated to increment measured length of a pre-recorded area. In turn, we cannot agree with appellant's argument that claims 1 to 5, requiring that residual time be incremented corresponding to a recording/reproducing operation, would have been nonobvious since Orimoto only measures a pre-recorded signal length, which length does not change. By way of explanation, we repeat the examiner's well thought out logic below:

The reason the [Orimoto] reference does not show the incrementing step as claimed by [a]ppellant is due to the fact that the method is used to measure musical selections already

recorded on a tape. However, tape recorders [as in the Orimoto reference] and video cassette recorders [as in appellant's preferred embodiment and in claim 1 on appeal] are commonly known to enable both reproducing and recording operations. It would have been obvious to one of ordinary skill in the art at the time the invention [of claims 1 to 5] was made to increase the playing time of Orimoto in accordance with a recording mode of the tape deck. The rationale is as follows: One of ordinary skill in the art at the time of the invention would have been motivated to increase the playing time of Orimoto in accordance with a recording mode of the tape deck so that the playing time is updated to accurately reflect how much tape is used. (Answer, page 9).

Thus, we cannot agree with appellant (Brief, pages 19 to 24) that the incrementing step as broadly set forth in claims 1 to 5 on appeal would not have been obvious in view of the tape detecting method of Orimoto. We find that it would have been obvious, and even common sense, to increment playing or residual time in proportion to an increase in recording or reproducing time since the recorded signal would be increasing in length and the user would want to be apprised of such increase.

Rejection of Claims 6 to 23 Under 35 U.S.C. § 103:

Turning next to the question of the obviousness of claims 6 to 23 under § 103, we are in agreement with appellant that the examiner has failed to show a prima facie case of obviousness, and that the combination of method steps recited in claims 6 to 23 is neither taught nor suggested by the applied reference to Orimoto. We conclude that since Orimoto teaches a tape detecting method wherein only a single operation, winding or rewinding, is performed in order to detect signal length, the

invention of claims 6 to 23 calling for a tape detecting method employing both winding and rewinding would not have been obvious.

Each of appellant's claims 6 to 23 call for "a high speed winding search mode of operation" and "a high speed rewinding search mode of operation" (see independent method claims 6, 11, 16, and 21). The examiner relies upon Orimoto's page 4, line 27, to show these modes of operation (Answer, page 9). Orimoto does not teach both a high speed winding search mode and a high speed rewinding mode of operation as recited in the claims, and the examiner has failed to properly address how these steps are taught or suggested by Orimoto. Our review of Orimoto reveals that "fast forwarding (or rewinding)" is performed (Orimoto, page 4, line 27)(emphasis added). Thus, we are in agreement with appellant (Brief, pages 25 to 34; Reply Brief, pages 1 to 7 and 10 to 12) that the combination of tape detecting method steps recited in claims 6 to 23 is neither taught nor suggested by Orimoto. Accordingly, we will reverse the 35 U.S.C. § 103 rejection as to claims 6 to 23.

In light of the foregoing, the differences between the subject matter recited in claims 1 to 5 and Orimoto are such that the claimed subject matter as a whole would have been obvious within the meaning of 35 U.S.C. § 103. Accordingly, we shall sustain the standing rejections of claims 1 to 5. We reach the opposite conclusion with respect to claims 6 to 23 which recite the details of combining

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high speed winding and rewinding search modes for detecting playing and residual times of a magnetic tape.

CONCLUSION

The decision of the examiner rejecting claims 1 to 23 under 35 U.S.C. § 112, first paragraph, for lack of an enabling disclosure, is reversed.

The decision of the examiner rejecting claims 1 to 5 under 35 U.S.C. § 103 is affirmed.

The decision of the examiner rejecting claims 6 to 23 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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JERRY SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
ERIC FRAHM	)	
Administrative Patent Judge	)	APPEALS AND
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