

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 40

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAKAMASA TANIAI, YASUHIKO HANAOKA, and YUZURU KOGA

Appeal No. 96-2742
Application No. 08/311,371¹

HEARD: August 3, 1999

Before THOMAS, MARTIN, and GROSS, Administrative Patent Judges.
GROSS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 17, which are all of the claims pending in this application.

¹ Application for patent filed September 23, 1994. According to appellants, this application is a continuation of Serial No. 07/601,728, filed May 21, 1992, now abandoned.

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The appellants' invention relates to a library system for recording mediums. More specifically, the library system includes a carrier for transporting the recording mediums and a recording and reproducing unit, with electrical communication signals being transmitted to (and from) the recording and reproducing unit from (and to) the carrier. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A library system, comprising:

storing means (51) for storing a plurality of recording mediums;

recording and reproducing means (52) for recording and reproducing data to and from the recording mediums;

carrying means (53) for moving the recording mediums between said storing means (51) and said recording and reproducing means (52);

control means (54) for controlling said recording and reproducing means (52) and for controlling said carrying means (53);

first communication means (54a) for transmitting instructions between said control means and said recording and reproducing means;

second communication means (54b) for transmitting instructions between said control means and said carrying means; and

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As a preliminary matter we note that appellants indicate on page 9 of the Brief that the claims do not stand or fall together and are each separately patentable. However, for each of claims 2 through 17, appellants merely reproduce a limitation recited in the claim. As stated in 37 CFR § 1.192(c)(7), "Merely pointing out differences in what the claims cover is not an argument as to

why the claims are separately patentable." Thus, appellants have failed to explain why the claims are believed to be separately patentable. Accordingly, we will treat only the independent claims, with the dependent claims as standing or falling together with the corresponding independent claims.

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by the appellants and the examiner. As a consequence of our review, we will reverse the obviousness rejection of claims 1 through 17.

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The only limitation of claim 1 in dispute is a third communication means. All other limitations are clearly shown in appellants' admitted prior art, Figures 1-4. In particular claim 1 requires

third communication means (55) for transmitting electrical instruction signals from said carrying means to said recording and reproducing means indicating that the recording medium is ready to be loaded into said recording and reproducing means and from said recording and reproducing means to said carrying means indicating that the recording medium is ready to be unloaded from said recording and reproducing means, said third communication means being separate from said control means (underlining added for emphasis).

We will focus our discussion on the underlined portions.

Independent claims 12, 13, and 16 recite method steps drawn to the transmission of a loading instruction signal directly to the recording and reproducing means from the carrying means.

Claim 7

includes electrical instruction signals from the carrying means directly to the recording and reproducing means. Claims 14, 15, and 17 recite ejection electrical end signals from the carrying means directly to the recording and reproducing means. In other words, the carrying means must transmit

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electrical instruction signals to the recording and reproducing unit without going through the control means.

For the loading instruction signals from the carrying means to the recording and reproducing unit, the examiner relies (Answer, page 6) on lines 2-8 on page 6 of appellants' specification:

The carrying apparatus 8 . . . inserts such medium to the loading unit 6a of the recording and reproducing unit 6, causes the loading unit 6a to insert the recording medium into the loading unit 6a and thereafter causes the carrying mechanism 8a to be retired

The examiner asserts (Supplemental Answer, pages 1 and 2) that the above-noted portion discloses that the carrying apparatus "causes the loading unit 6a" to do something, and "[t]o cause such an action, some sort of signal must be sent (via a mechanical, electrical or other medium)."

In quoting the above portion (Answer, page 6), the examiner substitutes "read/write processing unit 6b" for the last occurrence of "loading unit 6a" as "an attempt to make it read as it is believed [was] intended" (Supplemental Answer, page 2). Further, the examiner alludes to a potential issue under 35 U.S.C. § 112, first paragraph. Thus, the examiner

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has demonstrated that the relied upon portion is confusing. Accordingly, we find that without support in the drawings for such an interpretation, the above-noted part of the specification does not provide suggestion for the claimed communication from the carrying apparatus to the recording and reproducing unit. The figure described at page 6 of the specification, Figure 3, shows no direct communication between the carrying apparatus and the recording and reproducing unit; all communication between the two goes through the director. Additionally, although Figure 3 shows loading and ejecting instructions, it does not show any instructions (directly or indirectly) from the carrying means to the recording and reproducing unit. Therefore, we find no support in the drawings for the electrical signals from the carrying means as recited in claims 1, 12, 13, and 16.

Further, the examiner states (Answer, page 7) that "if a first component is going to hand-off a workpiece to a second component, there must clearly be some kind of signal between the two to indicate that the first component is done manipulating the workpiece." However, detectors in the

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recording and reproducing unit sense the presence and absence of the carrying means. When

the carrying means finishes loading the recording medium into the loading means, the carrying means moves away from the loading unit, which the detectors sense, and the detectors send a signal to the read/write processing unit of the recording and reproducing unit to indicate that the first component is done. In other words, contrary to the examiner's assertion, no signal must be sent between the two elements, as detectors in the recording and reproducing means supply the necessary information. Therefore, we find no electrical signals sent from the carrying means to the recording and reproducing unit to indicate that the recording medium is ready for loading.

As to the electrical instruction signal from the carrying means for claim 7 and the electrical ejection end signals from the carrying means for claims 14, 15, and 17, the examiner points to no further sections of the admitted prior art to meet these limitations. As explained above, we find no electrical instruction signals sent from the carrying means to

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the recording and reproducing unit, either directly or indirectly, in Figure 3 of the admitted prior art.

The examiner takes the position (Answer, page 4) that

Appellant's [sic] admitted prior art does not disclose (i) that the third communication means are separate from the control means, or (ii) that the carrier (8) directly communicates loading or ejecting instructions to the player and vice versa.

The examiner turns to Kuo for a teaching to make the third communication means direct and separate from the control means, stating that "Kuo shows (in Figure 1) a direct line of communication between 'ROBOT' and 'CASSETTE PLAYER' that is separate from the 'CENTRAL PROCESSING UNIT'." As stated above, we find no such communication from the carrier to the recording and reproducing unit either directly or indirectly. Furthermore, contrary to the examiner's assertion, in Figure 1 Kuo shows the mechanical path the carrier takes from a storing unit to the cassette player, not electrical (or even mechanical) signals between the carrier and the cassette player. Thus, Kuo does not provide a teaching or suggestion to have the carrier and the recording and reproducing unit of the admitted prior art communicate directly with each other.

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In summary, the admitted prior art does not disclose or suggest any electrical signals from the carrier to the recording and reproducing unit, and more specifically does not suggest direct signals without use of the director. Kuo does not disclose or suggest adding communication between the carrier and the recording and reproducing unit, and particularly does not suggest a direct communication between the two. Therefore, the

examiner has failed to establish a prima facie case of obviousness, as the combination does not include all of the limitations recited in the claims. Accordingly, we cannot sustain the rejection.

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CONCLUSION

The decision of the examiner rejecting claims 1 through
17 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
JOHN C. MARTIN)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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)	
ANITA PELLMAN GROSS)	
Administrative Patent Judge)	

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ARMSTRONG, WESTERMAN, HATTORI
MCLELAND & NAUGHTON
1725 K STREET NW
SUITE 1000
WASHINGTON, DC 20006