

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HO-JIN JANG

Appeal No. 97-3201
Application No. 08/360,866¹

ON BRIEF

Before STONER, *Chief Administrative Patent Judge*, ABRAMS and STAAB, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claim 1, which is the only claim remaining of record in the application.

¹Application for patent filed December 21, 1994.

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The appellant's invention is directed to a video cassette recorder reel table driving device. The claim on appeal can be found in an appendix to the Appeal Brief.

THE REFERENCES

The reference relied upon by the examiner to support the final rejection is:

Japanese application (Akagi) ² 6, 1983	58-150158	Sep.
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THE REJECTIONS

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by the Japanese reference.

Claim 1 also stands rejected under 35 U.S.C. § 103 as being unpatentable over the Japanese reference.³

The rejections are explained in the Examiner's Answer.

²Our understanding of this reference has been obtained from a PTO translation, a copy of which is enclosed.

³These rejections were set forth in the Examiner's Answer as being in the alternative.

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The opposing viewpoints of the appellant are set forth in the Appeal Brief.

OPINION

The Rejection Under Section 102

Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See *In re Paulsen*, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994).

The claim before us is directed to a reel table driving device for use in a video cassette recorder. The mechanism requires, *inter alia*, a pair of idlers disposed adjacent to a supply reel table and a take-up reel table, with each of the idlers including axially spaced first and second gears with

said second gear of the first idler having more teeth than the first gear of the first idler to rotate the supply reel table at a relatively high speed, and said second gear of the second idler has [*sic*, having] fewer teeth than the first gear of the second idler to rotate the take-up reel table at a relatively low speed.

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There is no explicit teaching in the Japanese reference that the first and second gears of the idlers have different numbers of teeth, much less that they be arranged on the two gear sets in the manner specified. Moreover, since the first and second gears of each of the idlers appear from the drawings to be of the same diameter, in the absence of amplifying information the presumption is that each has the same number of teeth, in our view. For these reasons, we agree with the appellant that the Japanese reference fails to disclose all of the subject matter recited in the claim, and thus the rejection on the basis of anticipation cannot be sustained.

The Rejection Under Section 103

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). However, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the

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desirability of doing so. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

As we stated above, there is no explicit teaching in the Japanese reference that the first and second gears of each idler have different numbers of teeth. It is the examiner's position, however, that it would have been obvious to one of ordinary skill in the art "to provide a difference in the number of gear teeth between the stepped gears to obtain a desired gear ratio based upon the intended use" (Answer, page 4). We do not agree.

The gear ratio "desired" in the reference apparently is 1:1, that is, the same number of teeth on each gear. We fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to alter this ratio to meet the terms of the claim, other than the hindsight accorded one who first viewed the appellant's disclosure. This, of course, is impermissible.

This rejection also will not be sustained.

SUMMARY

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Neither of the rejections is sustained.

The decision of the examiner is reversed.

REVERSED

	BRUCE H. STONER, JR., Chief)	
	Administrative Patent Judge)	
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	NEAL E. ABRAMS)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
	LAWRENCE J. STAAB)	
	Administrative Patent Judge)	

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