

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 60

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte SHIGEO YAMAGATA

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Appeal No. 97-3642  
Application 08/364,519<sup>1</sup>

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ON BRIEF

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Before SCHAFER, LEE and TORCZON, Administrative Patent Judges.  
LEE, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 15-17, 19-21, and 36-39. Claims 1-14, 18, and 22-35 have been canceled. No claim has been allowed.

**References relied on by the Examiner**

Toyoda et al. (Toyoda)	4,456,931	Jun. 26, 1984
Hashimoto (Hashimoto)	5,053,898	Oct. 01, 1991

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<sup>1</sup> Application for patent filed December 27, 1994. According to the appellant, it continues from a chain of parent applications beginning with application 06/923,324, filed on October 27, 1986.

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Uchitoi et al. (Uchitoi)  
1979  
(Japanese Kokai)

54-140507

Oct. 31,

### The Rejections on Appeal

Claims 15-17, 19-21, and 36-39 stand rejected under 35 U.S.C. § 103 as being unpatentable over Uchitoi, Hashimoto, and Toyoda.

### The Invention

The invention is directed to a recording apparatus for recording image information in blocks provided on a recording medium. The appellant has, for purposes of argument in this appeal, grouped all claims together with independent claim 36. (Brief at page 5). The only independent claims are claims 15 and 36, and both require a means for detecting the number of pictures continuously recordable and a means for displaying the number of pictures continuously recordable. Claim 36 is reproduced below:

36. A recording apparatus for recording image information in recording blocks provided on a recording medium, comprising:

switching means for switching a recording mode between a single recording mode and a continuous recording mode;

detecting means for detecting a number of pictures continuously recordable on said recording

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medium, the number of unrecording blocks not corresponding to the pictures continuously recordable on the recording medium; and

means for displaying the number of pictures continuously recordable when said switching means is switched to said continuous recording mode.

### Opinion

The rejection of claims 15-17, 19-21, and 36-39 cannot be sustained.

A reversal of the rejection on appeal should not be construed as an affirmative indication that the appellants' claims are patentable over prior art. We address only the positions and rationale as set forth by the examiner and on which the examiner's rejection of the claims on appeal is based.

Claim 36 requires a detecting means for detecting a number of pictures continuously recordable on the recording medium, and that the number of unrecorded blocks does not correspond to the pictures continuously recordable on the recording medium. Claim 15 has a similar requirement. It appears that in light of the appellant's specification, both the examiner and the appellant agree that the claim term "continuously recordable" requires consecutively vacant tracks

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on the recording medium. We adopt the same construction for the term. Furthermore, according to the claim, such number of consecutively vacant tracks does not represent the total number of unrecorded or vacant blocks remaining on the medium.

Hashimoto is the only reference the examiner relied on for a suggestion that the number of pictures continuously recordable should be detected and then displayed. Even according to the examiner, however, Hashimoto does not expressly teach counting the number of consecutively vacant tracks on a given recording medium and displaying that number when the continuous recording mode is selected. The examiner first (answer at page 5) points to one section of Hashimoto (column 1, lines 31-45) and explains that according to Hashimoto, if the next vacant recording tracks are not contiguous, there can be a significant delay in locating a blank track. We agree with that assessment of Hashimoto. The examiner then points (answer at page 5) to another portion of Hashimoto which supposedly suggests keeping track of the number of next consecutive vacant tracks. We disagree with that part of the examiner's analysis.

In column 1, lines 31-51 of Hashimoto, the following is

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stated:

In a conventional arrangement, the head is automatically shifted to the next recording track upon completion of the recording on one track. If the next track is found already recorded on, the head is further shifted to another track until a vacant track is found. In such a conventional system, the head moves from one recording track to another while detecting the presence or absence of a recording signal. Accordingly, the length of time required for accessing the vacant track increases with the number of tracks that must be skipped. Where it is only the last recording track that is found unrecorded and vacant, or where the recording medium has no vacant track, much time is wasted in a useless search and shift operation.

Another shortcoming of the conventional arrangement becomes evident when recording a signal requiring five or six tracks, for example, and only four consecutively vacant tracks remain. Recording would then have to be stopped unfinished and a valuable recording opportunity would be missed.

The examiner is correct in noting (answer at page 5) that per the first paragraph of the above-reproduced text, Hashimoto teaches that if the [vacant] recording tracks are not contiguous, there can be a significant delay in locating a blank track, if one even exists, and that such delay is dependent upon the number of tracks that must be skipped. We disagree with the examiner's position, however, that the second of the above-quoted paragraph reasonably would have suggested (1) the undesirableness of not knowing the number of

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next consecutively vacant tracks, or (2) the desirability of knowing the current number of consecutively vacant tracks as the recording apparatus is operating.

The examiner has ignored the significance of the word "remain" in the phrase "and only four consecutively vacant tracks remain." We understand the above-quoted text of Hashimoto to

mean that if a signal requires five or six tracks to record and it is not until the end that one finds out there are not enough vacant tracks (since there are only four consecutive tracks remaining), then an opportunity to record a signal requiring only four or less tracks would have been wasted.

The word "consecutively" is used in the second of the above-quoted paragraphs of Hashimoto before the words "vacant tracks" not because of any requirement that consecutive tracks must be used to record a signal requiring multiple tracks, but to distinguish the scenario from the other set of problems, mentioned in the first of the above-quoted paragraphs, which is associated with vacant tracks that are interspersed on the medium, i.e., delay in shifting the recording head.

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Hashimoto is concerned with the problem of not knowing the number of vacant tracks that remains on a disk, whether consecutive or not. Hashimoto, therefore, counts the number of total vacant tracks remaining on the medium and does not ascertain the number of next consecutively vacant tracks. The examiner has not demonstrated the existence of any motivation reasonably derivable from Hashimoto for ascertaining the number of next consecutively vacant tracks if they do not also represent the total number of vacant tracks remaining. Based on Hashimoto, it cannot be said that knowing the number of next consecutively vacant tracks, which number does not represent the total number of vacant tracks remaining, is desirable. The appearance of the words "consecutively vacant tracks" in Hashimoto does not alone provide the necessary motivation. On this record, the motivation relied on by the examiner stems improperly from the appellant's own specification.

For the foregoing reasons, the rejection of claims 15-17, 19-21, and 36-39 cannot be sustained.

**Conclusion**

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The rejection of claims 15-17, 19-21, and 36-39 under  
35 U.S.C. § 103 as being unpatentable over Uchitoi, Hashimoto,  
and Toyoda is reversed.

**REVERSED**

RICHARD E. SCHAFER	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
JAMESON LEE	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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RICHARD TORCZON	)	
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