

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NOBORU YOSHIDA

Appeal No. 1998-2264
Application No. 08/439,793

HEARD: Jan. 10, 2001

Before JERRY SMITH, LALL, and BLANKENSHIP, Administrative Patent Judges.

LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the final rejection¹ of claims 7 to 11. Claims 1 to 6 have been canceled.

¹There was an amendment after the final rejection [paper no. 15] which was entered by the Examiner [paper no. 17].

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The invention is related to a device for permitting direct viewing of copy protected video signals without stripping the signals of their copy protection, so that the signals can be viewed without distortion but not recorded. Copy protection is usually in the form of additions to the video signal which cause the signal to distort upon passage through the automatic gain control of the video recorder. As a result, the copy protected signal can neither be recorded nor directly viewed. The invention permits viewing of the copy protected signals by including a by-pass of the automatic gain control (AGC) circuit which routes an input signal directly to the television signal processing circuit. The invention is further illustrated by the following claim below.

7. An external input signal processing circuit for a television receiver with a video tape recorder, the video tape recorder having recording and reproducing functions, said external input signal processing circuit comprising:

an automatic gain control circuit having an input terminal connected to an external input terminal of the video tape recorder and an output terminal connected to a video signal recording circuit for recording a video signal on a recording medium;

a video signal reproducing circuit for reproducing a video signal recorded on said recording medium;

an internal/external viewing changeover switch having one input terminal connected to receive a video signal from said

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In rejecting a claim under 35 U.S.C. § 103, an Examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

We are further guided by the precedents of our reviewing court that the limitations from the disclosure are not to be imported into the claims. In re Lundberg, 244 F.2d 543, 548, 113 USPQ 530, 534 (CCPA 1957); In re Queener, 796 F.2d 461, 463-64, 230 USPQ 438, 440 (Fed. Cir. 1986). We also note that the arguments not made separately for any individual claim or claims are considered waived. See 37 CFR § 1.192 (a) and (c). In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ 2d 1281, 1285 (Fed. Cir. 1991) ("It is not the function of this

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court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art."); In re Wiechert, 370 F.2d 927, 936, 152 USPQ 247, 254 (CCPA 1967) ("This court has uniformly followed the sound rule that an issue raised below which is not argued in this court, even if it has been properly brought here by a reason of appeal, is regarded as abandoned and will not be considered. It is our function as a court to decide disputed issues, not to create them.")

Analysis

At the outset, we note that the claims do not stand or fall together. We treat below the various claims under rejection and the corresponding Appellant's arguments.

Claim 7

Claim 7 is rejected over APA (specification, fig. 2) and Damoci. The Examiner recognizes [answer, page 4] that APA does not show the internal/external viewing changeover switch having one terminal connected between an external input of the VTR and an input of the VTR AGC circuit. The Examiner explains [id., 4 to 5] how APA can be modified by the teachings of Damoci to provide the claimed changeover switch.

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Appellant argues [brief, pages 6 to 10 and reply brief, pages 2 to 3] that the combination still does not yield a circuit having the claimed changeover switch. We have reviewed the Appellant's revised illustration on page 2 of the reply brief. But, to the extent claimed, we agree with the Examiner's position that Damoci, at col. 1, lines 28 to 31, discloses that "[f]inally, during record or playback, he (the viewer) may use the VCR/TV button to pass the antenna input directly to the tv, bypassing a conventional tv meter connected to the antenna inputs." Furthermore, Damoci discloses, at col. 1, lines 53 to 57, that "the viewer may, ... either watch what is on the antenna or cable using his tv's tuner or switch to the VCR output and watch a playback or monitor what is being recorded." This meets the noted limitation as recited in claim 7. Therefore, we sustain the obviousness rejection of claim 7 over APA and Damoci.

Claims 8 to 11

The Examiner has rejected these claims over APA, Damoci and Choichi [answer, page 9] and makes a reference to paper no. 10 [final rejection]. However, when we refer to paper no. 10, we find a further reference to paper no. 8. Although this

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is an impermissible procedural practice by the Examiner, we do refer to paper no. 8 and find that Damoci was not used as a reference in the rejection of claims 8 to 11. In this instance³, regardless of whether Damoci was, or was not, used to reject claims 8 to 11, we find that the suggested combination of APA, or APA and Damoci, with Choichi would not have yielded the claimed limitation (recited in claim 8) of the circuit having "a switch circuit for controlling said internal/external viewing changeover switch ... when the video tape recorder is in a recording mode," because the Choichi reference does not disclose, or suggest, such a switch. Therefore, we do not sustain the obviousness rejection of claim 8 and its dependent claims 9 to 11.

In summary, we have sustained the obviousness rejection over APA and Damoci of claim 7, but we have not sustained the obviousness rejection of claims 8 to 11 over APA and Choichi, or over APA, Damoci and Choichi.

³In paper no. 8, Damoci was not used to reject claim 7. But in paper no. 10 (final rejection), Damoci was used to reject claim 7. Since claims 8 to 11 depend on claim 7, Damoci is inherently used in their appealed rejection.

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Accordingly, the decision of the Examiner rejecting
claims 7 to 11 is affirmed-in-part.

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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

	Jerry Smith)	
	Administrative Patent Judge)	
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)	
	Parshotam S. Lall)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
	Howard B. Blankenship))
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PSL:tdl

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