

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte JON C. TAENZER and JEFFREY M. SICURELLO

---

Appeal No. 2000-1526  
Application No. 08/902,196

---

ON BRIEF

---

Before KRASS, BARRETT and SAADAT, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 31-47.

The invention pertains to the monitoring of magnetic audio systems. In particular, the invention relates to the testing of magnetic hearing devices. This is accomplished by employing conventional test systems for acoustic hearing devices and

using a magnetic-to-electric transducer and an electric-to acoustic transducer, along with appropriate processing circuitry between the two transducers, in order to test a magnetic hearing device including a magnetic drive unit having a specified drive characteristic.

Representative independent claims 31 and 45 are reproduced as follows:

31. A test apparatus for testing a magnetic hearing device including magnetic drive unit having a specified drive characteristic, the apparatus comprising:

a housing;

a first magnetic-to-electric transducer;

a second electric-to-acoustic transducer; and

signal processing circuitry coupling the first transducer and the second transducer;

wherein the combination of the first transducer, the second transducer and the signal processing circuitry realizes a magnetic-to-acoustic transducer that produces a calibrated acoustic output such that different ones of the test apparatus produce substantially identical test results.

45. Test apparatus for a magnetic drive hearing device, including a drive coil for driving an ear lens magnet removably affixed to the ear drum of a wearer, the test apparatus comprising:

an acoustic chamber;

Appeal No. 2000-1526  
Application No. 08/902,196

a stand for mounting the drive coil in the vicinity of the acoustic chamber; and

a magnetic-to-acoustic converter situated in proximity to the driving coil.

The examiner relies on the following references:

Beaty et al. (Beaty)	3,985,977	Oct. 12, 1976
Frye et al. (Frye)	4,065,647	Dec. 27, 1977
Marutake et al. (Marutake)	5,101,575	Apr. 23, 1991

Claims 31-44 stand rejected under 35 U.S.C. § 112, first paragraph, as relying on an inadequate written description.

Claims 35-38 and 42-44 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 31-47 stand rejected under 35 U.S.C. § 103 as unpatentable over Marutake in view of Beaty and Frye.

Reference is made to the brief and the examiner's supplemental answer [answer] for the respective positions of appellants and the examiner.

#### OPINION

With regard to the rejection of claims 35-38 and 42-44 under 35 U.S.C. § 112, second paragraph, it is the examiner's position that claims 35 and 42 recite the limitations of "the magnetic drive unit" and "the specified drive characteristic" in lines 10-12 and 12-14, respectively and that these recited limitations have no antecedent bases.

We will summarily sustain this rejection, first, because the examiner's observation regarding the lack of proper antecedent bases appears to be correct and, second, because appellants have chosen not to present any arguments regarding this rejection [see the top of page 8 of the brief].

Turning now to the rejection of claims 31-44 under 35 U.S.C. § 112, first paragraph, we will also sustain this rejection.

It is the examiner's position that there is inadequate support for the now claimed recitations of "the acoustic output signal is a calibrated acoustic output signal such that different ones of the test apparatus produce substantially identical test results" and "a combined frequency response of the magnetic drive unit and the signal processing circuitry is substantially linear when the magnetic drive has the specified characteristic."

The test for written description, in accordance with Vas-Cath Inc. V. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991); In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983) is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventors had possession at that time of the later claimed subject matter. It is also true that an invention claimed need not be described *ipsis verbis* in the specification in order to satisfy disclosure requirements of 35 U.S.C. § 112. Ex parte Holt, 19 USPQ2d 1211, 1213 (Bd. Pat. App. & Int.1991).

Appellants counter the examiner's rejection by listing their argument under a section of the brief [page 14] labeled "Enablement" and argue that the specification unambiguously states that the present test device produces a calibrated output signal, that "calibrated" means that the output signal conforms to a standard and that the output signals of different test devices conform to the identical standard. Therefore, conclude appellants, different ones of the test apparatus produce substantially identical test results.

Moreover, appellants argue that while the specification does not explicitly state that the drive characteristic of the device is designed with the inverse response such that the combination of the drive characteristic and the typical psychoacoustic response is flat, this was "well-known in the art" and "common practice in hearing aid design" [brief-pages 14, 15].

Appellants' arguments about what was "well known" and "common practice" in the art appear to be arguments against an enablement rejection and, it appears from the heading at page 14 of the brief, that appellants believe that the rejection is based on the enablement clause of 35 U.S.C. § 112. However, the rejection is clearly based on the written description section of 35 U.S.C. § 112. While something may, in fact, be "well known," this, alone, does not provide evidence that the inventors were in possession of this "something" at the time of filing the patent application.

We find references in the specification to “calibrated” instrument quality test microphone [e.g., page 6] and to a coupler and receiver being designed “to provide a flat response over the frequency range” [page 10] but we find no specific references to “the acoustic output signal is a calibrated acoustic output signal such that different ones of the test apparatus produce substantially identical test results” and “a combined frequency response of the magnetic drive unit and the signal processing circuitry is substantially linear when the magnetic drive has the specified characteristic,” nor have appellants specifically pointed to anything within the instant disclosure which is alleged to provide support for the now claimed limitations.

Accordingly, since the examiner has made a reasonable challenge to the adequacy of the written description and appellants have not convincingly responded thereto, we will sustain the rejection of claims 31-44 under 35 U.S.C. § 112, first paragraph.

Turning, finally to the rejection of claims 31-47 under 35 U.S.C. § 103, we will not sustain this rejection because we do not view the examiner’s rationale as presenting a prima facie case of obviousness.

Each of the instant claims requires at least the testing of a magnetic hearing device. This is accomplished by converting magnetic signals into electric signals and,

eventually, converting the electric signals into acoustic signals which can then be used in a conventional acoustic hearing aid testing device.

The examiner employs Marutake for a showing, on the upper cover figure, of a conversion of magnetic signals to electric (25) and then from electric to acoustic (20) via a processor (12). Realizing that Marutake lacks a magnetic drive unit, the examiner turns to Beaty for a showing of a magnetic drive unit, comprising coil 14, cable 15 and receiver 12. The examiner concludes, with no apparent support, that it would have been obvious to combine these teachings “in order to provide a strong magnetic source and to overcome feedback or distortion problems of conventional hearing aid devices” [answer-page 5].

Even so, the examiner acknowledges that the combination of Marutake and Beaty still lacks a testing apparatus comprising a magnetic-to-acoustic transducer for testing a magnetic hearing device. Therefore, the examiner cites Frye for a testing device and concludes that it would have been obvious to combine this testing device with the magnetic-to-acoustic transducer of Marutake and the magnetic drive of Beaty “in order to adjust hearing aid devices to optimum default settings regarding the frequency response, amplitude response, etc. before sending them out to hearing aid providers” [answer-page 5].

The problem with the examiner's rationale is that there would have been no motivation, or suggestion, other than that provided by appellants' disclosure, for combining the applied references. Frye is the only reference directed to testing hearing devices and that is directed merely to a conventional acoustic hearing device tester. Beaty is the only cited reference directed to a magnetic hearing device of the type which is of interest to appellants but it is only typical of the conventional magnetic hearing devices which appellants wish to test. Marutake does, indeed show a magnetic-to-electric transducer and an electric-to-acoustic transducer, along with processing circuitry therebetween, but Marutake is concerned with picking up a signal from a telephone line and producing a sound output signal. Thus, it is difficult to see why the artisan seeking to test magnetic hearing devices would have applied any teaching from Marutake (which is not related to either magnetic hearing devices or to testing hearing devices) to Beaty's magnetic hearing device. Moreover, since Frye is merely directed to a tester for conventional acoustic hearing devices, there would appear to have been no reason, other than appellants' disclosure, for the artisan to use this type of testing device for magnetic hearing devices. There is clearly no suggestion, from anything identified by the examiner, for modifying the testing device of Frye so as to test magnetic hearing devices and, even if there were such a suggestion, there is no

teaching in the cited references as to how this would be accomplished. That is, even if magnetic-to-acoustic transducers were known, we have no suggestion in the applied references as to how or why the artisan would have employed such a transducer in combination with Marutake to result in a testing device for testing magnetic hearing devices.

We note that, with regard to independent claim 45, appellants only argue the “stand” limitation of the claim. While such a stand may, or may not, be obvious, within the meaning of 35 U.S.C. § 103, regardless of whether a human wearing the drive coil may be considered a “stand,” for consistency purposes, we note that claim 45 also calls for a “test apparatus for a magnetic drive hearing device” and “a magnetic-to-acoustic converter...” Accordingly, for the reasons supra, the examiner has presented no convincing rationale as to why and/or how it would have been obvious to convert Frye’s conventional acoustic hearing device tester into a magnetic drive hearing device tester.

We have sustained the rejection of claims 31-44 under 35 U.S.C. § 112, first paragraph, and we have sustained the rejection of claims 35-38 and 42-44 under 35 U.S.C. § 112, second paragraph. We have not, however, sustained the rejection of claims 31-47 under 35 U.S.C. § 103.

Appeal No. 2000-1526  
Application No. 08/902,196

Accordingly, the examiner's decision is affirmed-in-part.

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

ERROL A. KRASS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
LEE E. BARRETT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
MAHSHID D. SAADAT	)	
Administrative Patent Judge	)	

eak/vsh

Appeal No. 2000-1526  
Application No. 08/902,196

MCCUTCHEN, DOYLE, BROWN & ENERSON LLP  
THREE EMBARCADERO CENTER  
SAN FRANCISCO, CA 94111