

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(2) is not binding precedent of the Board.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. 49

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YOSHIKAZU SHIMIZU and SATOMI NAKAGAWA

Appeal No. 96-2547
Application 08/101,673¹

ON BRIEF

Before THOMAS, HAIRSTON, and JERRY SMITH, Administrative
Patent Judges.

THOMAS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

¹ Application for patent filed August 4, 1993.
According to appellants, this application is a continuation of
Application 07/729,647, filed July 15, 1991, now abandoned.

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Appellants request reconsideration under 37 CFR § 1.197(a) of our decision rendered on May 26, 1998, affirming the rejection of claims 1 to 6 under 35 U.S.C. § 103. In the light of the most recent amendments to this rule effective December 1997, we treat this request for reconsideration as a request for rehearing.

At the outset, we note appellants request only reconsideration of our affirmance of the rejection of claims 4 and 5. Appellants do not request reconsideration of our affirmance of the rejection of claims 1 to 3 and 6. As such, the affirmance of these claims is not contested. Appellants also state at page 1 of the request that no other reconsideration is requested at the present time. The above noted rule does not permit a reconsideration or rehearing to be requested at any other time. Only one request is permitted.

That portion of our original opinion relating to the affirmance of claims 1 to 6 on appeal begins at page 6 through the end of the earlier decision. More specifically, the discussion of claims 4 and 5 begins at page 10 where we

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indicated that claims 4 and 5 have been treated together by us since appellants have argued them together in the principal Brief on appeal and two Reply Briefs "despite the grouping at page 3 of the principal Brief on appeal that they are separately grouped." Appellants' separate urging at page 4 of the request for rehearing implying that we consider the patentability of claim 5 as distinguished from claim 4 is presented in an untimely manner. Any arguments directed to claim 5 should have been presented before the decision was rendered on May 26, 1998.

In accordance with the discussion at pages 2 and 3 of appellants' request, it appears that appellants and this panel are in some agreement as to the normal operation at page 13 of JVC for purposes of the actual storing operation of JVC's CSRP preset system. As generally expressed in our original opinion, it is our understanding that once the user firstly presets the various sound output circuit states, and then secondly presses the memory button when it is flashing, at least some data is stored as to those states but the complete CSRP preset storage function available to the user in JVC is

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not completed until the user then further thirdly associates this prestored information of the particular chosen output circuits desired with the particular source input device or circuit within five seconds. The implication is clear to the reader that the data already preset by the user and then stored by the actuation of the memory key during its blinking state would be erased if the source device was not then selected within the five second interval.

Appellants have offered no evidence other than their own attorney argument at page 3 of the request for rehearing that the ordinary skilled designer would not have designed JVC in the manner we understand it and inferred from the teachings expressed at page 13 of JVC. Thus, we do not agree with appellants' assertion that the artisan would only store data in memory at the third stop, that is when and if the source key were depressed. We simply do not agree with this view because the memory key is expressly taught to be pressed after the preset output signal circuits have been selected by the user. Though not explicitly stated in JVC, but indicated in our earlier opinion, it appears that two storing operations

must occur in JVC, the second of which is the association of the prestored preset data with a source device. This has been expressed in different words in our discussion between pages 10 and 12 of our original opinion. Thus, we strongly disagree with appellants' assertion at the bottom of page 3 of the request for rehearing that appellants' interpretation of the operation of JVC is the only "plausible" interpretation. Our view is just as plausible.

Without losing sight of the forest for the trees, it must be emphasized that we affirmed the examiner's rejection of claims 1 to 6 in light of appellants' prior art Figure 4 and its attendant discussion in the specification as filed in view of JVC. We attempted to emphasize this in the paragraph bridging pages 7 and 8 of our original opinion. At the top of page 8 of our original opinion, we indicated that the combinability of appellants' prior art Figure 4 with JVC "obviously would have overcome the disadvantages of prior art Figure 4's circuit noted at the bottom of page 3 of appellants' specification." What is generally indicated there is that prior art Figure 4 permitted the user's selection of a

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sound source and the selection of a sound output circuit "individually, without mutual relationship" as indicated at lines 18 through 22. This appears to have been a known disadvantage of the prior art in addition to the subsequent statement that the user must make two selections when a source is changed.

The order in which selection of appellants' prior art Figure 4 was to have been undertaken by the user is not specified. Apparently, it would have obviously occurred such that the user could have selected the sound source first and then selected the sound output circuit or the user could simply have selected manually the sound output circuit and then the particular sound source desired. In any event, still, two individual selections would have had to have been made.

JVC obviates this double selection as expressed by the examiner's rejection by the use of CSRP preset capability which links in its overall teaching sound outputs circuits first and then a particular source device. Claim 1 on appeal relates only to reading operations and claim 4 relates to

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storing operations. On the other hand, appellants' claimed version of the order in which storing operations occur is overall in a different order than that expressed by JVC alone. Appellants' disclosed invention would first select the sound signal source, store this identifying data in the memory and then permit the user to select the sound output circuit, the data selection of which is stored in memory and also enabling the automatic selection of the particular sound output circuits as well. We see no patentable distinction whether the user starts from the source device to store data ending with the selection of the sound output circuit or starting with the selection of the particular sound output circuit desired, storing it and then choosing a particular source device as in JVC. In the context of the particulars of claim 4 on appeal, we see no patentable distinction within the context of the collective teachings of appellants' prior art Figure 4, its associated discussion in the specification in view of JVC's teachings. The actuation of the memory key at page 13 of JVC appears to us to enter data into the memory as well as operate to "select" a particular sound output circuit

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within 35 U.S.C. § 103. We see no patentable distinction between this operation of JVC and a contemporaneous storing operation occurring when a particular sound output circuit is selected, as claim 4 may be interpreted to state.

We have granted appellants' request to the extent that we have reconsidered our decision of May 26, 1998, but we deny the request with respect to making any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

	JAMES D. THOMAS)	
	Administrative Patent Judge)	
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)	BOARD OF
PATENT)	
	KENNETH W. HAIRSTON)	APPEALS AND
	Administrative Patent Judge)	INTERFERENCES
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JERRY SMITH)
Administrative Patent Judge)

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