

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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte TETSUYA NISHIKUBO  
AND MAKOTO SUZUKI

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Appeal No. 96-3212  
Application 07/826,699<sup>1</sup>

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ON BRIEF

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Before THOMAS, HAIRSTON and KRASS, Administrative Patent Judges.  
THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's  
final rejection of claims 1 to 7, which constitute all the claims  
in the application.

There are no references relied on by the examiner.

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<sup>1</sup> Application for patent filed January 28, 1992.

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Claims 1 to 7 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on a nonenabling disclosure.

Rather than repeat the positions of the appellants and the examiner, reference is made to the brief and answer for the respective details thereof.

#### OPINION

As the case law in appellants' brief correctly indicates, the examiner bears the initial burden of setting forth a reasonable basis as to why he or she believes the present disclosure does not enable the artisan to make and use the claimed invention, and that the correct measure is that this disclosure must be done in such a manner as to enable this artisan to do so without undue experimentation. After due consideration of the present disclosure, including the drawings, as well as the positions of the appellants and the examiner, we conclude that the examiner has either failed to set forth an adequate basis to question the adequacy of the disclosure or, if so, the artisan would have been able to enable the claimed invention without undue experimentation.

Pages 12 and 13 of the brief show a direct correspondence

of the elements of each claim on appeal to the structural configuration of the disclosed invention in Figure 1. The operation of this figure is further detailed in exemplary operational figures showing the outputs of various circuit elements of Figure 1 in Figures 2 and 3. Figure 1 shows discrete, well-known circuit elements which are described to operate together in a certain manner. It is beyond the scope of the present claimed subject matter what device is controlled and what inputs are derived from such a controlled device to affect the operation of the microcomputer 16 in Figure 1. Similarly, the microcomputer 16 is not directly claimed.

The disclosure makes clear that the microcomputer 16 in Figure 1 must be programmed to perform certain operations to yield the various outputs to affect the various circuit elements shown in Figure 1. The overall aim of the invention is to lessen the amount of program dependency to yield a variable output on output 1. Thus, the invention represents a design tradeoff between hardware/software dependencies. The details of the microcomputer program and the inputs thereto are not necessary for the artisan to enable the presently claimed invention since the details of all this is beyond the scope of the present claims. Furthermore, what outputs exit from the microcomputer to

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feed the various circuit elements in Figure 1 are well explained in the disclosure as filed. The two examples in figures 2 and 3 show to the artisan two examples of the operation of the circuit elements of Figure 1. It is apparent to us, and we believe to the artisan, that the overall aim of the invention is achieved, that is, to minimize program control from the microcomputer 16 to control the overall circuit operation with minimal numbers and types of signals outputted therefrom to control the external circuitry.

Although the examiner is correct in concluding that the noted declaration is based upon beliefs and presents conclusions without much factual support thereto, it does add some measure of evidence to that which we have already concluded from our independent study of the disclosure as a whole that the subject matter of the present claimed invention is adequately disclosed from an artisan's perspective within 35 U.S.C. § 112, first paragraph.

Finally, we note that appellants' brief lists and discusses, in detail in a corresponding manner to the disclosed invention, each of the questions raised by the examiner in the final rejection to our satisfaction.

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In view of the foregoing, the decision of the examiner  
rejecting claims 1 to 7 under the first paragraph of 35 U.S.C.  
§ 112 is reversed.

REVERSED

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
KENNETH W. HAIRSTON	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
ERROL A. KRASS	)	
Administrative Patent Judge	)	

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