

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 47

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY J. KALIS
and RICHARD VAN DYK

Appeal No. 1997-4395
Application No. 08/351,044¹

ON BRIEF

Before, THOMAS, HAIRSTON and DIXON, Administrative Patent Judges

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 32 through 37, 39 through 44 and 46.

Representative claim 32 is reproduced below:

¹This application is a continuation of application Serial No. 07/383,745, filed 07/20/1989, now abandoned.

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32. In an automatic phonograph having a compact disc player adapted to read from a compact disc encoded information as to the starting time, ending time, and reported elapsed playing time of each selection on the disc, apparatus comprising:

means responsive to starting a selection for generating a measured elapsed time signal synchronized with a reported elapsed time signal read from the disc;

means for comparing said measured elapsed time signal with said reported elapsed time signal;

means responsive to said comparing means for recording a skip when the difference between said measured elapsed time signal and said reported elapsed time signal is greater than a predetermined amount; and

means for resynchronizing said measured elapsed time signal to correspond with said reported elapsed time signal upon the occurrence of said skip so that subsequent skips can be detected and recorded.

There are no references relied on by the examiner.

The parent application was the subject of Appeal 1994-0365 decided January 31, 1994, in which a panel of this Board in-part affirmed the rejection of claims 3 through 9 under the enablement portion of the first paragraph of 35 U.S.C. § 112, while reversing the rejection of the examiner as to claims 1

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and 2 as to the same issue. The final rejection and answer in this application maintains the view that the present claims on appeal

do not satisfy the enablement portion of the first paragraph of 35 U.S.C. § 112 because, in the examiner's view, the "Board of Appeals found that the entire specification was not enabling for any detection, no matter how claimed, of subsequent skips." (Answer page 4.) Thus, the sole issue in this appeal is whether the present claims on appeal satisfy the enablement requirement of the first paragraph of 35 U.S.C. § 112.

Rather than repeat the positions of the examiner and the appellants, reference is made to the briefs, the Declaration of Ronald Coppersmith and the answer for the details thereof.

OPINION

As to the enablement issue, the specification must teach those skilled in the art how to make and use the claimed invention without undue experimentation. Genentech, Inc. v. Nordisk A/S, 108 F.3d 1361, 1365, 42 USPQ2d 1001, 1004 (Fed. Cir. 1997), cert. denied, 118 S. Ct. 397 (1997). This same case indicates that the scope of the claims must bear a

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reasonable correlation to the scope of enablement provided by the disclosure. Enablement is also not precluded even if some experimentation is necessary, although the amount of experimentation needed must not be unduly excessive. Hybritech, Inc. v. Monoclonal Antibodies Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987).

Generally, for the reasons set forth by the appellants in the brief and the reply brief, we reverse the rejection. As the brief and reply brief attempt to make clear, the Board did not find, contrary to the examiner's view, that the entire specification was not enabling for any detection, no matter how claimed, of subsequent skips.

As a starting point, each of the independent claims 32, 39 and 46 presently on appeal contains language in some manner at the end of each of them relating to the resynchronization of the stated measured elapsed time signal to correspond with the reported elapsed time signal upon the occurrence of the determination of a skip so that subsequent skips can be

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detected and recorded. This feature distinguishes over the claims in the earlier appeal, and it is noted that the remaining subject matter basically of independent claim 32 on appeal in this application is substantially the same as presented in independent claim 1 in the previous appeal in which the rejection was reversed. The brief and reply brief make it clear that presently there is a differently claimed invention than that set forth in the claims affirmed under the first paragraph of 35 U.S.C. § 112 in the prior decision. Pages 7 through 9 of the principal brief on appeal track substantially all of the features disclosed in the present application by making specific reference to the written description and figures as appropriate to justify the subject matter of the resynchronization clause of each independent claim on appeal.

The subject matter of earlier claim 3, on which the Board did affirm the rejection, is not by itself, presently on appeal. Even though the subject matter of this claim is present in dependent claim 34 in this application, for example, this claim depends from parent claim 32 which includes necessarily the resynchronization clause at the end

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of it.

Without belaboring the issue, appellants' discussion of pages 7 through 9 of the principal brief on appeal is well taken. Contrary to the subject matter affirmed in the rejection in the previous appeal, the present claims require the resynchronization operation as noted implicitly within the showing in Figure 9 in the lower right hand corner thereof for any subsequent skip count beyond the first skip. The discussion at specification page 18, lines 6 through 15, does indicate that there is an ability of the user to set a predetermined skip count which is part of the decision block in the lower right-hand corner of Figure 9 on appeal. Additionally, although not noted by appellants or the examiner, the discussion at page 14, lines 1 through 22 of the specification as filed relates to the operation of the internal timer interrupt in the microprocessor 232 shown in Figure 7 to indicate that it functions in accordance with the operation of the termination of plural skips in the same manner which tracks with the description at pages 15 and 16 and of the flow chart operation in Figure 9.

From our study of the entire written description and

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figures as originally filed, we conclude that the examiner's rejection of the presently claimed invention under the enablement portion of the first paragraph of 35 U.S.C. § 112 must be reversed. The subject matter of the present claims on appeal track the disclosed invention very closely. We, therefore, find no need to consider the Declaration of Mr. Coppersmith on its merits. Even though we have considered it on the merits, it in turn tracks our own individual understanding of the disclosed invention as originally filed. The statement in the sentence bridging pages 3 and 4 of the declaration that the "[t]he application teaches at p. 16, lines 13-17, that when a skip occurs, if one desires to monitor the disc for a second skip, the interrupt timer generating the measured elapsed time signal must again be synchronized with the reported elapsed time signal so that additional skips can be identified by comparing the measured and reported elapsed time signals" is a much more succinct statement than that which is found in the noted portions of the specification as filed.

We note, however, that this statement is consistent with the overall disclosure of the invention and its logical

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operation, from an artisan's perspective, and discernible from the logic presented in Figure 9 alone. The present specification under the operative conditions described in Figure 9 clearly indicates to the reader that subsequent skips may be determined only after the interrupt timer has been resynchronized such that additional potential, subsequent skips up to the skip count identified in the lower right-hand corner of Figure 9 may be determined after the initial first skip. It is thus apparent to us that, utilizing the determinative standard of review set forth in the earlier noted case law in this opinion, no undue experimentation or excessive amount of experimentation would have been necessary from an artisan's perspective to make and use the claimed invention.

In view of the foregoing, the decision of the examiner rejecting claims 32 through 37, 39 through 44 and 46 under the

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enablement provision of the first paragraph 35 U.S.C. § 112
must be reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
KENNETH W. HAIRSTON)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
JOSEPH L. DIXON)	
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