

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

(90/004,017)

Paper No. 34

(90/004,145)

Paper No. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YOSEMITE INVESTMENTS INC.

Appeal No. 98-3142
Reexamination Nos. 90/004,145 and 90/004,017¹

HEARD: April 8, 1999

Before KRASS, JERRY SMITH and RUGGIERO, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

¹ Reexaminations filed October 23, 1995 and February 9, 1996. This is a reexamination of U.S. Patent No. 4,697,932 issued October 6, 1987.

Appeal No. 98-3142
Reexamination Nos. 90/004,145 and 90/004,017

This is a decision on appeal from the final rejection of claims 1 through 4, all of the pending claims.

The claims on appeal herein are the subject of two reexamination requests, Reexamination Control Nos. 90/004,145 and 90/004,017. Each of the reexamination requests was granted and each involves the same United States Patent No. 4,967,932. Since the claims and issues involved in each of the reexamination files are identical, the reexamination proceedings for both files were merged (see Paper No. 7 in '017 and Paper No. 9 in '145). Accordingly, the decision herein applies to each of the two reexamination proceedings which have been merged.

The invention is directed to a multi-signal alarm which is a signaling device having a timer for establishing a desired time interval, a pulser for emitting pulses at a desired pulse rate during the time interval, and an oscillator which includes a piezoelectric transducer and feedback circuitry, the transducer oscillating at a resonant frequency which is different from the pulse rate and emitting an audible sound.

Independent claim 1 is reproduced as follows:

Appeal No. 98-3142
Reexamination Nos. 90/004,145 and 90/004,017

1. A signaling device comprising:

a timer means for producing a timer signal defining a predetermined time;

a pulser means responsive to said timer signal for producing pulse signals at a predetermined rate during said predetermined time;

electrical oscillator means including a piezoelectric transducer and responsive to said pulse signals for producing a predetermined number of audio signals, said electrical oscillator means having a frequency of oscillation different than said predetermined rate of said pulser means.

The examiner relies on the following references:

Itoyama et al. (Itoyama) 8, 1972	3,681,916	Aug.
Kawaki et al. (Kawaki) 1972	3,697,982	Oct. 10,
Sweany (Sweany '129) 1974	3,815,129	Jun. 4,
Sweany et al. (Sweany '628) 1978	4,104,628	Aug. 1,

Hnatek (EDN), "Put the IC timer to work in a myriad of ways,"
EDN (March 5, 1973) pp. 54-58.

Signetics Analog Applications Manual (Signet), San Francisco
(January 1979) pp. 149-156.

Claim 1 stands rejected under 35 U.S.C. 103,
alternatively, over any one of 1. Itoyama and Sweany('129 or

Appeal No. 98-3142
Reexamination Nos. 90/004,145 and 90/004,017

'628), or 2. Kawaki and Sweany('129), or 3. Signet and Sweany('129 or '628) and either Kawaki or Itoyama. Claims 2 through 4 stand rejected under 35 U.S.C. 103, alternatively, over any one of 1. Itoyama and Sweany('129 or '628), or 2. Kawaki and Sweany('129), or 3. Signet and Sweany('129 or '628) and EDN.

Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

OPINION²

We reverse.

Turning first to the rejection based on Itoyama and Sweany, the examiner contends that Itoyama teaches all of the features of instant claim 1 but for the use of an "oscillator including a piezoelectric transducer" in the circuit of Figure 2. However, reasons the examiner, since Itoyama teaches the use of an oscillatory sound generator and Sweany teaches an oscillatory sound producer, which includes a piezoelectric element, it would have been obvious to adapt Itoyama "to include the oscillatory sound producer of Sweany as this is a substitution of one of many possible equivalent sound producers any of which are capable of producing the results of that shown in figs.3a-3c" [answer-page 4].

While we agree that Itoyama appears to be a very relevant reference, considering the similarity of Itoyama's Figures 3A-3C to Figure 2 of the patent under reexamination, upon a closer examination, we conclude that there are patentable

² Unless otherwise indicated, our reference to "Sweany" refers to either one of Sweany ('129) or Sweany ('628), each of these references being employed for the same teaching of the use of a piezoelectric element in a sound generator.

Appeal No. 98-3142
Reexamination Nos. 90/004,145 and 90/004,017

distinctions between the subject matter of instant claim 1 and that disclosed by Itoyama and Sweany.

Instant claim 1 requires "electrical oscillator means including a piezoelectric transducer..." Figure 2 of Itoyama, relied upon by the examiner, discloses an oscillator sound generator 12 but there is no disclosure or suggestion therein that such a sound generator would include a piezoelectric transducer. Itoyama does disclose other embodiments, such as Figure 4, wherein there is a "crystal speaker" which appears to be a piezoelectric element. However, in these other embodiments, wherein a crystal speaker is disclosed, it appears that any oscillations have already occurred and that the speaker is downstream of such oscillations. We contrast this with the instant claimed invention, wherein claim 1 requires that the piezoelectric transducer be part of the electrical oscillator means. The crystal speaker in the other embodiments of Itoyama is not part of the electrical oscillator means whereas in Figure 2 of Itoyama, the embodiment relied upon by the examiner, there is no indication or suggestion, anywhere within the four corners of Itoyama,

Appeal No. 98-3142
Reexamination Nos. 90/004,145 and 90/004,017

that oscillator means 12 might include a piezoelectric transducer.

With Itoyama's teachings in mind, it does appear to involve impermissible hindsight for the examiner to turn to Sweany which is contended to teach nothing more than a general concept of using a circuit for driving an oscillator/piezoelectric transducer and to conclude that the skilled artisan would have been led to substitute such a piezoelectric transducer for the sound generator 12 of Itoyama. Contrary to the examiner's contention, combining Itoyama and Sweany is more than a mere choice "between known types of sound producers based on their advantages/disadvantages" [answer-page 6]. In our view, it is instructive to note that the only embodiments of Itoyama which might employ any type of piezoelectric element, such as the crystal speaker of Figure 4, only employ such an element downstream of the oscillator means and not as part of the oscillator means itself. Thus, one might reasonably conclude that Itoyama would lead one away from employing a piezoelectric transducer as part of the oscillator sound generator. Since there is no suggestion in the applied

Appeal No. 98-3142
Reexamination Nos. 90/004,145 and 90/004,017

references for employing an oscillating sound generator comprising a piezoelectric transducer as the sound generator 12 of Itoyama's Figure 2 embodiment, we find no reason, within the meaning of 35 U.S.C. 103, to have combined the Itoyama and Sweany teachings in any manner so as to result in the subject matter of instant claim 1. Thus, we find that the examiner has not established a prima facie case of obviousness with regard to the obviousness of the subject matter of claim 1 in view of Itoyama and Sweany. Accordingly, we have no need to consider secondary considerations of obviousness such as the evidence presented by the declarations of Louis Sweany.

We turn now to the rejection of claim 1 under 35 U.S.C. 103 based on Kawaki and Sweany.

We also will not sustain this rejection for reasons similar to our refusal, supra, to sustain the rejection based on Itoyama and Sweany. The examiner contends that Kawaki shows all of the claimed elements but for specifying a piezoelectric transducer as part of the electric tone generator Z in Figure 1. Again, the examiner concludes that it would have been obvious to substitute the piezoelectric element of Sweany for the element Z of Kawaki. We disagree.

Appeal No. 98-3142
Reexamination Nos. 90/004,145 and 90/004,017

While we do not necessarily find persuasive appellant's argument, at page 15 of the principal brief, that "Claim 1 expressly does not permit continuous operation, whereas Kawaki allows both pulsing and continuous," because if Kawaki allows both, then it must, at least sometimes, allow that which is claimed, we do agree with appellant that instant claim 1 distinguishes over that taught or suggested by the applied references. That is, even if Kawaki's Z element could be considered to be an electrical oscillator, there is nothing in Kawaki which teaches that the frequency of oscillation is different from the pulsing rate, as required by claim 1. Moreover, in our view, appellant has provided sufficient reasoning, at page 16 of the principal brief, which we will not repeat here, as to why any substitution of Sweany's piezoelectric transducer for element Z in Kawaki would produce a sound having a frequency the *same* as, rather than *different* from, that of the astatic multivibrator in Kawaki, in contradistinction to that which is claimed. The examiner has provided no response to this persuasive argument by appellant.

With regard to the rejection of claim 1 under 35 U.S.C. 103 based on Signet in combination with Sweany, Kawaki and

Appeal No. 98-3142
Reexamination Nos. 90/004,145 and 90/004,017

Itoyama, we also will not sustain this rejection. For the reasons supra, we find any combination of Sweany, Kawaki and/or Itoyama to be lacking in making obvious the subject matter of instant claim 1. Moreover, we do not find anything in Signet which would remedy the deficiencies of the other references.

The examiner finds that it would have been obvious to combine the timing circuit at page 154 of Signet with the astable multivibrator on page 151 of Signet so as to produce a tone burst generator as on page 156 of Signet and then include a piezoelectric oscillator as suggested by Sweany with the key elements being suggested by Itoyama and/or Kawaki [see answer-page 5]. In our view, the examiner's rejection is faulty on its face since various circuits of the Signet reference have been connected in an attempt to replicate the subject matter of instant claim 1 with no direction, within the disclosure of the applied references, for doing so. The examiner's attempted reconstruction of the claimed subject matter by picking and choosing various circuits from within the Signet manual appears to us to be nothing more than impermissible hindsight gleaned from appellant's own disclosure. Moreover,

Appeal No. 98-3142
Reexamination Nos. 90/004,145 and 90/004,017

even if the various circuits of Signet were to be combined as set forth by the examiner, we find nothing which would have led the artisan to use a piezoelectric transducer, as taught by Sweany, with any such combination of circuits in any manner which would result in the subject matter set forth by instant claim 1.

Since we do not find any combination of Signet, Itoyama, Sweany and Kawaki to make obvious the subject matter of claim 1, we also will not sustain the rejection of dependent claims 2 through 4 under 35 U.S.C. 103 because we do not find the EDN reference, applied in combination with the other references, to remedy the deficiencies of the other references.

The examiner's decision is reversed.

REVERSED

ERROL A. KRASS)
Administrative Patent Judge)
)
)
)

Appeal No. 98-3142
Reexamination Nos. 90/004,145 and 90/004,017

)	BOARD OF PATENT
JERRY SMITH)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	

bae

Appeal No. 98-3142
Reexamination Nos. 90/004,145 and 90/004,017

Joseph N. Hosteny
Niro, Scavone, Haller & Niro
181 West Madison Street
Suite 4600
Chicago, IL 60602

REQUESTER:

Frank H. Foster
Kremblas, Foster, Millard & Pollick
7632 Slate Ridge Boulevard
Reynoldsburg, OH 43068