

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MANABU INOUE, KEIJI TAMAI,
SHIGEAKI IMAI and KATSUYUKI NANBA

Appeal No. 1999-2687
Application 08/174,353

ON BRIEF

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

JERRY SMITH, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants request that we reconsider our decision of January 14, 2002 wherein we sustained the rejection of claims 1, 3-6, 8-12, 14-16, 21, 23-28, 31, 33-35 and 37-40 as unpatentable under 35 U.S.C. §§ 102 or 103.

We have reconsidered our decision of January 14, 2002 in light of appellants' comments in the request for rehearing, and we find no errors therein. We, therefore, decline to make any

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changes in our prior decision for the reasons which follow.

A brief review of the prosecution of this appeal is instructive. Appellants filed an appeal brief in which each of the examiner's rejections was argued to some extent. The examiner's answer in response to this appeal brief responded to each of the arguments in the brief in a manner that was complete and persuasive. Appellants filed a reply brief in which they stated the following:

The Examiner's Answer clarifies the Examiner's position in regard to many of the rejections.

The Applicants' primary position on Appeal is that one skilled in the art would not have been motivated to combine the disclosure of *Wilson* with that of *Brownstein* and/or *Hamada et al.* to achieve the present invention [reply brief, page 1].

The reply brief did not address any of the specific responses made by the examiner in the answer, but only addressed the propriety of the combination of references used by the examiner. The previous decision essentially affirmed the examiner's rejections because appellants did not respond to the persuasive arguments of the examiner set forth in the answer, and because we agreed with the examiner that there was appropriate motivation to combine the prior art teachings in the manner proposed by the

examiner.

In the request for rehearing, appellants' first point asserts that the decision by the Board reflects a technical misunderstanding of the prior art. Specifically, appellants argue that Hamada corrects for shake on a real-time basis, and therefore, does not use stored shake information for shake correction. Appellants also argue that the portions of Wilson and Hamada relied on in formulating the rejection are inconsistent with each other [request, pages 1-4].

Appellants' position improperly analyzes the obviousness of physically combining Wilson's preferred embodiment with Hamada's preferred embodiment. Wilson was used as a teaching that shake can be corrected at a later time by using previously stored shake information. Wilson, however, does not describe the nature of the shake correction. Hamada was cited for the sole purpose of teaching that shake correction involves a comparison between detected shake information and image information. Thus, when the shake correction occurs at a later time as suggested by Wilson, it would have been obvious to the artisan that this correction would be achieved by performing a comparison as suggested by Hamada. Therefore, we are not persuaded by this particular argument that the previous decision was in error.

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Appellants' second point in the request is that the previous decision ignores the significance of the still image claim language. Specifically, appellants argue that Wilson cannot be used with still images and Hamada does not teach shake correction at a later time [request, pages 4-5].

In the original brief, appellants simply argued that the applied prior art did not teach a reproducing apparatus in which a still image is reproduced from a developed film and corrected based on shake information of the still image. They supported this argument by noting that Hamada corrected for shake before the film was developed and Wilson corrected the video signal during the buffering function [brief, pages 29-30]. The examiner clearly responded to this argument [answer, pages 24-25]. Although appellants filed a reply brief as noted above, they never addressed the examiner's response nor made any further mention of the separate patentability based on a still image.

To the extent that this request asks that we change the previous decision based on the fact that the claimed image is a still image, we decline to do so. As noted in the previous decision, we only considered those arguments actually made by appellants in the brief. To the extent that appellants argued the patentability of claims containing a recitation of still

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images in the original brief, the examiner persuasively responded to these arguments as was evident in our previous decision. Appellants are attempting to have new arguments considered in this request for rehearing, and we will not consider arguments in a rehearing which have not been first presented during prosecution of the appeal before the examiner. Therefore, we are not persuaded by this particular argument that the previous decision was in error.

Appellants' third point in the request is that there is no motivation to combine the references. Specifically, appellants argue that the Board failed to consider the requisite legal requirements necessary for the combination of references [request, pages 6-11].

To the extent that appellants raised issues of motivation for the combination of references in the briefs, the examiner responded to these issues in the answer and we responded to these issues in the previous decision. For the most part, the request for rehearing simply raises additional arguments which were not presented in the briefs. As noted above, these are arguments that appellants could have made and should have made while prosecution was before the examiner. It is not appropriate for us to consider arguments made for the first time in a request for

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rehearing. We have carefully reviewed the record in this appeal, and we find that the questions regarding motivation to combine were properly addressed by the examiner and by the Board. Therefore, we are not persuaded by this particular argument that the previous decision was in error.

Appellants' fourth point in the request is that the decision ignores In re Donaldson. Specifically, appellants argue that the rejection of claim 1 be reconsidered in view of the requirements of Donaldson, as requested in the original brief on appeal. Appellants then analyze the relevant differences that affect this analysis [request, pages 11-13].

We note that the original brief did raise the Donaldson issue with respect to claim 1 only. The brief only raised the question of whether the first and second recording means were anticipated by Wilson under a Donaldson analysis [brief, pages 12-13]. The examiner responded to this argument by analyzing why the corresponding elements of Wilson were equivalents to the claimed first and second recording means [answer, page 15]. Although appellants filed a reply brief, they did not further challenge the examiner's response with respect to the Donaldson issue.

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In the previous decision, we noted that the examiner had persuasively responded to each of appellants' arguments with respect to the rejection of claim 1 [previous decision, page 5]. We also stated the following:

Since we agree with each of the examiner's assertions with respect to the disclosure of Wilson as set forth in the response to arguments section of the answer, and since appellants have not persuasively challenged these assertions, we agree with the examiner that claims 1 and 3 are fully met by the disclosure of Wilson [previous decision, page 7].

Thus, based on the record before us, we agreed with the examiner's analysis of claim 1 based on the Donaldson issue.

The request for rehearing essentially seeks to change our previous decision by asking us to look at a new record by making several new arguments with respect to the Donaldson question. As noted above, these are arguments that appellants could have made and should have made while prosecution was before the examiner. It is not appropriate for us to consider arguments made for the first time in a request for rehearing. We have carefully reviewed the record in this appeal, and we find that the questions regarding Donaldson were properly addressed by the examiner and by the Board. Therefore, we are not persuaded by this particular argument that the previous decision was in error.

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We have carefully considered the arguments raised by appellants in their request for rehearing, but none of these arguments are persuasive that the original decision was in error. We are still of the view that the invention set forth in claims 1, 3-6, 8-12, 14-16, 21, 23-28, 31, 33-35 and 37-40 is not patentable over the applied prior art based on the record presented to us in the original appeal.

We have granted appellants' request to the extent that we have reconsidered our decision of January 14, 2002, but we deny the request with respect to making any changes therein.

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

REHEARING DENIED

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

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