

The opinion in support of the decision being entered today was **not** written for publication and 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 TAKUYA SAITOU and SHIGERU TAKEZAWA

Appeal No. 2006-2424  
Application No. 10/318,196

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ON BRIEF

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

JERRY SMITH, Administrative Patent Judge.

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 2-10, which constitute all the claims in the application. Since appellants do not appeal the rejection of claim 10, this appeal is directed to the rejection of claims 2-9. The examiner has withdrawn the rejection of claims 2-9 under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Kobayashi (U.S. Patent No. 5,902,244) [answer, page 10]. The withdrawal of the rejection based on Kobayashi means that there is no rejection pending against claim 5.

The disclosed invention pertains to a waveform measuring instrument configured to write measured signal waveforms into a memory after converting the waveforms to digital data.

Representative claim 2 is reproduced as follows:

2. A waveform measuring instrument configured to write measured signal waveforms into a memory after converting the waveforms to digital data, wherein an

interpolation system for performing interpolation between said digital data is provided and the data obtained after interpolation are written in said memory, wherein a means for measuring the time difference between the time base and the trigger is provided and addresses for writing said digital data into said memory are controlled so that said time difference is corrected.

The examiner relies on the following reference:

Osawa

JP 08-173431

July 9, 1996

Claims 2-4 and 6-9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Osawa.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of anticipation relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the disclosure of Osawa does not fully meet the invention as set forth in claims 2-4 and 6-9. Accordingly, we reverse. We enter a new ground of rejection, however, using our authority under 37 CFR § 41.50(b).

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984); W.L. Gore and Assocs. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983).

The examiner has indicated how the invention of claims 2-4 and 6-9 is deemed to be fully met by the disclosure of Osawa [answer, pages 4-5].

With respect to independent claim 2, the only claim argued by appellants, appellants argue that Osawa fails to disclose the claimed means for measuring the time difference between the time base and the trigger and the claimed controlling of addresses to correct for this time difference. Appellants argue that the examiner points to portions of Osawa in support of the rejection, but that the examiner has failed to explain how Osawa discloses these features of the claimed invention. Thus, appellants assert that the examiner's findings are insufficient to justify the rejection [brief, pages 4-6].

The examiner responds that the claimed "time base" is "the same to a function that serve as reference for time and frequency [sic]," and the "trigger" is "as the same to pulse employed to perform operation generated by pulse generating device in sampling period [sic]" [answer, page 8]. The examiner then cites portions of Osawa which are said to disclose the argued limitations of claim 2. The examiner also indicates that the claimed invention is met by Osawa "as inherently known in the technology" [*id.*, page 9]. Finally, the examiner wonders where is the limitation that the trigger is subtracted to produce the measured time difference recited in claim 2 [*id.*, pages 5-10].

Appellants respond that the examiner has never shown how Osawa teaches the claimed means for measuring the time difference between the time base and the trigger and the claimed controlling of addresses to correct the time difference. Appellants also respond that claim 2 clearly recites a time difference. Appellants note that the examiner has not identified which elements in Osawa represent the time base and the trigger which are relied on to produce the time difference [reply brief, pages 2-4].

We will not sustain the examiner's rejection of claims 2-9 as being anticipated by Osawa for essentially the reasons argued by appellants in the briefs. We are unable to find any disclosure within Osawa of a means for measuring the time difference between a time base and a trigger and the controlling of memory addresses so that the time difference is corrected. The portions of Osawa cited by the examiner simply fail to support the examiner's findings.

We enter the following new ground of rejection in this case using our authority under 37 CFR § 41.50(b). Claims 2-9 are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which appellants regard as their invention. Independent claim 2 recites a means for

“measuring the time difference between the time base and the trigger.” There is no antecedent basis for either “the time base” or “the trigger.” There is no “time base” and no “trigger” recited anywhere in claim 2 to support their use in the claimed means for measuring the time difference. Presumably each of the components recited in claim 2, that is the interpolation system, the means for measuring, the memory, and the means for controlling the memory, could have its own time base and its own trigger. The time difference between the time base and the trigger is critical to the scope of the claim, but it is unclear where the time base and the trigger come from so that the claimed time difference can be measured as claimed. Therefore, we are of the view that the artisan would be unable to ascertain the scope of claim 2.

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (amended effective September 13, 2004, by final rule notice 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. & Trademark Office 21 (September 7, 2004)). 37 CFR §41.50(b) provides that “A new ground of rejection . . . shall not be considered final for judicial review.”

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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

REVERSED  
37 CFR § 41.50(b)

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James D. Thomas	)
Administrative Patent Judge	)
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	) BOARD OF PATENT
Kenneth W. Hairston	)
Administrative Patent Judge	) APPEALS AND
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	) INTERFERENCES
	)
Jerry Smith	)
Administrative Patent Judge	)

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WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP  
1250 CONNECTICUT AVENUE, NW  
SUITE 700  
WASHINGTON DC 20036