

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(2) is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ANDREW J. PINES and DON G. MARSHALL

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Appeal No. 95-1942  
Application 08/135,190<sup>1</sup>

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ON BRIEF<sup>2</sup>

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Before HAIRSTON, KRASS, and MARTIN, Administrative Patent Judges.

MARTIN, Administrative Patent Judge.

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<sup>1</sup> Application for patent filed October 12, 1993. According to applicants, this application is a continuation of Application 07/835,862, filed February 18, 1992.

<sup>2</sup> Appellants filed a hearing waiver on September 23, 1998 (Paper No. 28).

DECISION ON APPEAL

This is an appeal from the final rejection of claims 7, 16, and 17, all of appellants' pending claims, under 35 U.S.C. § 103. We affirm the rejection with respect to claims 7 and 17 and reverse it with respect to claim 16.

The invention relates to play control in jukeboxes. The specification includes the following description of prior art jukeboxes, which the examiner relies on in the rejection as admitted prior art:<sup>3</sup>

Jukeboxes typically consist of a cabinet which contains a display of the available recordings, a mechanism for accepting valid currency, a mechanism for making selections from the available recordings, a mechanism for conveying selected recordings to a player capable of playing the recordings, some form of control unit, and the necessary audio (or audio and video) circuitry and output devices to publicly perform the selected recording.

According to appellants, prior art jukeboxes provide the customer with no way of knowing how long it will take for a selected piece to play. Appellants' invention enables the customer to pay extra to have his selection designated as a priority play and inserted at the top of the play list, provided no other pending selection is designated as a priority play.

Claim 17, which is representative, reads as follows:

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<sup>3</sup> Spec. at 1-2.

17. A system for playing recordings in a jukebox comprising the steps of:

maintaining a play list of recordings selected for play and their order of play:

playing recordings upon accepting credit of at least a predetermined amount;

determining if an amount greater than said predetermined amount has been received;

determining if the customer has made a prioritized recording selection; [and]

if an amount greater than said predetermined amount has been received and the customer has made a prioritized recording selection, then prioritizing the play list whereby the prioritized selection will be played in advance of other selections which have not been prioritized.

All of the appealed claims stand rejected under 35 U.S.C. § 103 based on the admitted prior art jukeboxes described in appellants' specification in view of both of the following references, copies of which were submitted with appellants' Invention Disclosure Statement filed April 23, 1992:<sup>4</sup>

Rowe CD-100 Laser Star Field Service Manual, pages 2-29 (date unknown) ("Rowe").

Pioneer Laser Juke Operator's Manual CJ-V77 and CJ-V99, page 35 (date unknown) ("Pioneer").

Although the dates of these references are unknown, appellants do

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<sup>4</sup> Paper No. 2.

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dispute their availability as prior art with respect to the claims on appeal.

Appellants argue claims 7 and 17 together and claim 16 separately (Brief at 4).

#### OPINION

The Rowe reference, under the heading "Table 2-2. Menu & Command Descriptions," provides the following description of codes 61 and 62:

61    **Priorities** - Displays and sets priority selections (10 maximum). When these selections are made by the customer, they will be inserted at the top of the play list and they will be played next (see Programming, Autoplay, Premiums, Priorities, and Lockouts).

62    **Premiums** - Displays and sets premium selections. These selections (25 maximum) will be priced at twice the regular price (see Programming, Autoplay, Premiums, Priorities, and Lockouts).

(Emphasis in original.) The Pioneer reference includes the following description under the heading "Service mode function":

A maximum of 25 songs/discs (PRIORITY songs/discs) can be set for inserting at the beginning of a reserved song.

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Inasmuch as this description appears to be cumulative to the description of the "Priorities" code in the Rowe reference, we will limit our discussion to that reference.

The examiner contends that these references "teach the payment of funds to prioritize a selected recording in a playlist" (Answer at 4). To the extent the examiner is arguing that these references teach having the customer decide whether a selected recording is to be given priority status, we do not agree. As appellants correctly note in their Brief (at 8),

"[i]n both Rowe and Pioneer, 'priority' has nothing to do with the customer -- it is a feature that is programmed in advance by the jukebox owner. Therefore, we also agree with appellants that if one were to combine the teachings of Rowe and Pioneer with the admitted prior art, the result would be a jukebox in which the jukebox owner can (1) program certain selections (such as "Happy Birthday") as "priority" selections which will have play list priority over non-priority selections and (2) program certain selections (such as the

most popular songs) as "premium" selections requiring twice the normal payment. Because it is the jukebox owner rather than the customer who decides whether a particular selection is to have priority status, the rejection of claim 16, which calls for "determining if the customer has selected a recording for being prioritized" (our emphasis), cannot be sustained.

Appellants are incorrect, however, to argue that each of claims 7 and 17 likewise "makes it clear that the customer selects the recording for being prioritized" (original emphasis) (Brief at 9). These claims recite "determining if the customer has made a prioritized selection,"<sup>5</sup> which is broad enough to read on a customer's conscious or unconscious selection of a recording

that has been given priority status by the jukebox owner, as the examiner suggests when he argues that the references "both disclose a priority list system wherein a selection can be chosen (from a list) by the user that is moved to the top of the playlist" (Final Office action at 3) and also that "the

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<sup>5</sup> The version of claim 7 in the appendix omits the term "a" from this passage.

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customer makes his/her own selection as to which recording should be prioritized (even if only from a subset of 'Priority' choices)" (Answer at 6). The examiner further contends (final Office action at 4; Answer at 5) that

one of ordinary skill in the art would have been motivated to require additional payments (an amount greater than a predetermined amount) in exchange for a prioritized selection in view of the teachings of Rowe and Pioneer of requiring payment, because one of ordinary skill in the art at the time the invention was made would have been motivated to maximize the proceeds from the jukebox.

Although the examiner did not elaborate, we assume he means it would have been obvious to designate the same recordings as "priority" selections and as "premium" selections. Appellants have not addressed this aspect of the examiner's reasoning, which appears to be reasonable to us. Nor have appellants explained why claim 17, the broader of claims 7 and 17, does not read on the foregoing combination of prior art teachings as follows:

17. A system for playing recordings in a jukebox [the admitted prior art jukebox as modified in view of Rowe and Pioneer] comprising the steps of:

maintaining a play list of recordings selected for play and their order of play [the "play list" in Rowe]:

playing recordings upon accepting credit of at least a predetermined amount [the amount required to play a non-"premium" recording];

determining if an amount greater than said predetermined amount [the "premium" amount] has been received;

determining if the customer has made a prioritized recording selection [has selected a recording designated by the owner as having both "priority" and "premium" status];

if an amount greater than said predetermined amount [if the "premium" amount] has been received and the customer has made a prioritized recording selection [has selected a recording that has "priority" and "premium" status], then prioritizing the play list whereby the prioritized selection will be played in advance of other selections which have not been prioritized.

We note the last paragraph of the claim does not require that the "priority" status of the "prioritized selection" be determined by whether or not the customer has paid "an amount greater than said predetermined amount," i.e., the "premium" amount.

Consequently, we are affirming the § 103 rejection of claim 17 and of claim 7, which is grouped therewith, over the admitted prior art jukeboxes in view of Rowe and Pioneer.

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

AFFIRMED-IN-PART

	KENNETH W. HAIRSTON	)	
	Administrative Patent Judge	)	
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	ERROL A. KRASS	)	BOARD OF
PATENT	Administrative Patent Judge	)	APPEALS AND
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	JOHN C. MARTIN	)	
	Administrative Patent Judge	)	

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