

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. 45

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** MITSUAKI DOI and MASATSUGU OKUYAMA

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Appeal No. 1997-2656  
Application No. 07/907,472

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On Request for Rehearing

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Before JERRY SMITH, DIXON, and BARRY, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON REQUEST FOR REHEARING**

This is a decision on a Request for Rehearing, filed Nov. 18, 2001, requesting rehearing of our decision, mailed Sep. 18, 2001 affirming the examiner's rejection of claims 1-9. Claims 10-12 were filed in an amendment filed with appellants' reply brief in response to a new ground of rejection, but we found no rejection of these claims. Therefore, claims 1-9 were before us on appeal in this application.

We GRANT the Request for Rehearing and modify our decision to AFFIRM-IN-PART.

## **BACKGROUND**

The appellants' invention relates to a data communication apparatus having a common memory for storing video and audio data. The common memory stores data for each type of data starting at the high and low addresses and increasing or decreasing toward the other address to leave a block in the middle. Therefore, additional flexibility is gained in setting a boundary address between the two data areas. Additionally, the display of the remaining space in memory is made in a user-friendly terms of pages and messages for facsimile transmission and for answering machine operation. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. In a data communication apparatus including communication means for transmitting and receiving video data and audio data, said video data being derived from documents, a memory for storing at least video data and audio data received by said communication means, memory control means for executing management of utilization of said memory and for controlling data write and read operations of said memory, and data display means;

the improvement comprising display control means for controlling said data display means to display first memory capacity information representing an amount of capacity available in said memory for storing video data and second memory capacity information representing an amount of capacity available in said memory for storing audio data, said display control means comprising means for expressing said first memory capacity information as a number of first data units, each of said first data units consisting of an amount of data corresponding to one standard document page, and for expressing said second memory capacity information as a number of second data units, each of said second data units consisting of an amount of data corresponding to one fixed-duration telephone message, and means for controlling said display means to display said number of first data units and number of second data units.

Appeal No. 1997-2656  
Application No. 07/907,472

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Yoshida	5,208,681	May 4, 1993
		(Effective filing date Mar. 8, 1988)

APA - the background of the specification section and Figure 1

Claims 1-9 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of the admitted prior art in the preamble of the Jepson format claim, the admitted prior art in the specification and the Yoshida patent. Claim 9 is rejected under 35 U.S.C. § 103 as being unpatentable over Yoshida alone. We sustained the examiner's rejection of claims 1-9 under 35 U.S.C. § 103 over the combination of prior art, but reversed the examiner's rejection under Yoshida alone in our decision, mailed Sep. 18, 2001.

### **ON REQUEST FOR REHEARING**

This is in response to appellants' request for rehearing of our decision, mailed Nov. 18, 2001, wherein we affirmed the examiner's rejection of claims 1-9 under 35 U.S.C. § 103.

We have carefully considered the arguments raised by appellants in the request for rehearing. Those arguments do persuade us that we overlooked or misapprehended appellants' arguments concerning the grouping of the claims, but the arguments do not persuade us that we overlooked or misapprehended any matter in our original consideration of the appeal of independent claims 1, 8 and 9.

We address appellants' arguments in the order presented in the request for rehearing.

In item (1), appellants argue that the prior art disclosure of communicating an available remaining memory space or data amount in a facsimile machine without more, would not have motivated one of ordinary skill in the art to display the number of fixed-duration audio messages which may be received. Appellants argue that our affirmance of the rejection of claim 1 overlooks the clear and patentable difference between claim 1 and the prior art. (See Request for Rehearing at pages 1-2.) We disagree as discussed in our Decision at pages 4, 5, and 8. Appellants have not identified anything we have overlooked or misapprehended beyond a disagreement with the result. Therefore, this argument has not persuaded us that there was an error in our decision with respect to this item.

In item (2), appellants argue that our statement agreeing with the examiner with respect to the combination of prior art teachings is "unrelated to the concept of obviousness." We acknowledge that the statement may have been able to be drafted/crafted better, but we find that it conveyed our reasoned agreement with the examiner's combination of teachings. Restating our agreement with the examiner's combination of the teachings of the admitted prior art and the teachings of Yoshida, we find that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine teachings of the APA concerning the well-known storage of both

audio and video data in the same memory of a facsimile machine with the teaching of Yoshida of displaying the amount of remaining memory space in a user friendly format which is displayed as a transmissible paper number which represents the fixed size video pages. (Decision at pages 4-5.) We find that the teachings and suggestions of Yoshida concerning providing a display of remaining space in memory would have been desirable to a skilled artisan in the facsimile arts.

With the bodily incorporation of Yoshida into the APA, the remaining memory space in the APA would be displayed in one user friendly format for the remaining video memory and one display of the numeric size, e.g. kilobytes, which would not be a user-friendly and understandable format for the audio. But, it is the examiner's reasoned opinion that it would have been obvious to one of ordinary skill in the art at the time of the invention to also modify the format of display of the remaining memory space for audio data to have the display of both remaining data spaces in user friendly and understandable formats for consistency in the display format to the user. The most analogous format for the audio data to the format taught and suggested by Yoshida for video data would have been a fixed duration message. (See answer at page 4.) We agreed with the examiner's reasoned analysis of the prior art in our decision at pages 4-5. Therefore, as explained, we find that the statement quoted by appellants is related to the concept of obviousness, contrary to appellants' assertion.

Appeal No. 1997-2656  
Application No. 07/907,472

Appellants argue that the implementation of Yoshida would not result in the claimed invention unless it were shown that it would have been obvious to provide a structure which combines the structure of Yoshida and the APA. (See Request for Rehearing at page 2.) Appellants argue that the decision overlooks the examiner's failure to demonstrate the obviousness of the underlying combination and failure to show any motivation for the combination. (See Request for Rehearing at page 3.) We disagree with appellants. As discussed above, we find that the skilled artisan would have been motivated to combine the teachings and suggestions of the two prior art references, and in our decision, we agreed with the examiner that the suggestion of Yoshida to display the remaining data space in a user friendly and understandable format would have provided the motivation to skilled artisans to have consistency in the display of both formats to the user. (Decision at page 5.) Appellants argue that appellants' disclosure is the only disclosure of the combination of an audio message display with a display of a number of document pages which may be received by the communication apparatus. We agree with appellants, but the argument does not address the basic combination of the teachings and the motivation to have a similarity of display units/format, as discussed for the two types of stored units.

Appellants argue that the examiner's rejection is based upon hindsight, and the Board's affirmance overlooked the examiner's reliance upon appellants' own teaching. (See Request for Rehearing at page 3.) We disagree with appellants, as discussed

above. Appellants argue that the rejection relies on the obviousness of implementing the invention after the combination of the APA and Yoshida. (See Request for Rehearing at page 3.) We agree with the appellants, but do not find this persuasive in light of the suggestion of Yoshida concerning the user understandable format of the display. Appellants argue that the rejection fails to consider the nonobviousness of the combination, which is not suggested by either reference. (See Request for Rehearing at page 3.) We do not find this argument persuasive since appellants have not identified why it would not have been obvious to have the display of both types of information in a user understandable format as is suggested by Yoshida.

Appellants argue that the examiner has not demonstrated any prior art motivation for the combination of references. (See Request for Rehearing at page 4.) We disagree with appellants, as discussed above. Appellants argue that *a posteriori* ease of implementation is not equivalent to *a priori* obviousness of the implementation. We agree with appellants' distinction, but do not find this argument persuasive.

In item (3) with respect to the separate patentability of claim 3, appellants argue that "numerous references to the patentable differences between the dependent claims and the parent claims" are present in the brief. Here, this amounts to merely pointing out differences in what the claims cover and not why the claims are separately patentable. We note that an argument that a claim is different from another claim in its content is a requirement to avoid double patenting, but does not amount to an

argument for separate patentability, nor does it point out the errors in the examiner's rejection.

Appellants argue that the brief set forth the argument that the reasons underlying the rejection of dependent claim 3 have never been fully set out by the examiner. (See Request for Rehearing at pages 5-6.) Appellants argue that the examiner has not met the burden of establishing a *prima facie* case of obviousness. After further review of appellants' brief at pages 11-19, 33 and 34, we agree with appellants that the arguments under the heading "[t]he Claims are Improperly Grouped" include various arguments directed to the separate patentability of the claims, their distinction over the applied prior art, and the lack of establishment of a *prima facie* case of obviousness by the examiner. Therefore, we will reconsider the arguments made at pages 11-19, 33 and 34 of the brief as clarified in the request for rehearing.

Appellants argue that with respect to claim 3, the examiner has not addressed the limitation/concept of identifying a plurality of different boundary addresses between the audio and video storage regions. (See brief at pages 11-12.) The examiner maintained that figure 1 of appellants' disclosure shows the concept of a boundary address setting mode and also the concept of using different memory configurations as shown in figures 1(a) - 1(c). The examiner concludes that combination would have clearly suggested the boundary setting concept. (See answer at page 4.) While we

agree with the examiner that a boundary address would necessarily need to be set, the examiner has not addressed the details of the language of claim 3 with respect to the plurality of respective different values which are displayed during the selection.

Therefore, we agree with appellants that the examiner has not established a ***prima facie*** case of obviousness with respect to dependent claim 3, and we will not sustain the rejection of claim 3. Appellants identify at page 7 of the request for rehearing, various general assertions at the conclusion of the brief at page 33 concerning the language of the claims and that these limitations are lacking in the prior art. We do not find these general arguments to be specific arguments, and we find that they are not persuasive.

In item (4) with respect to dependent claim 4, appellants argue that claims 1 and 4 have distinct differences. (See brief at page 13.) We agree that the claims are different, but the examiner maintained it would have been obvious to adapt the prior art to include the feature of informing the transmitter of the number of pages which can be stored as suggested by Yoshida, and Yoshida would further suggest that the number of audio messages which can be stored should be included. (See answer at pages 3-4.) It is our understanding that the communication of the number of pages that can be received would have been the "amount of capacity that is currently vacant . . ." as recited in dependent claim 4. Therefore, we find that the examiner has addressed the limitations recited in claim 4 to establish a ***prima facie*** case of obviousness. Therefore,

the argument that the examiner has not addressed claim 4 is not persuasive. We find that appellants' argument at page 13 of the brief is not persuasive. Appellants argue that lines 17-19 on page 33 of the brief points out that the prior art fails to provide "two different displays with two different unit-values in on display of two memory portions." (See Request for Rehearing at page 8.) This argument does not accurately reflect the language of either claim 2 or 4 nor do we find it to be a specific argument with respect to the prior art. Therefore, this argument is not persuasive.

In item (5) appellants argue that claim 5 differs from claim 1, and differs from claim 3 because of the inverse relationship between the two recitations. (See Request for Rehearing at page 9.) We agree that claim 5 is different from claims 1 and 3, but do not find appellants' arguments persuasive. Appellants argue that "[t]here is no disclosure or suggestion in Yoshida that such is displayed. However, whether or not such a disclosure or suggestion is found in Yoshida is clearly a separate question from whether the underlying concepts are suggested therein." (See brief at page 15.) Appellants further argue that at page 34 of the brief that appellants set forth a separate argument for patentability that the prior art does not teach display of plural sets of different unit values corresponding to different user settable durations of telephone messages. The examiner has indicated the corresponding teachings in Yoshida and the line of reasoning associated therewith for modifying the teaching to "inform the operator of which selection was taken." Therefore, the examiner has established a

**prima facie** case of obviousness that the combination of teachings would have included a display of the selection. (See answer at page 4.) We agree with the examiner, and do not find that appellants have rebutted the examiner's line of reasoning and **prima facie** case. With respect to the underlying concepts, appellants have identified neither how the "underlying concepts" are present in the language of the claim nor how they distinguish over the combination of the admitted prior art and Yoshida. Therefore, this argument is not persuasive.

In item (6) with respect to claim 6, appellants argue that the argument at pages 15-16 of the brief sets forth arguments for separate patentability. (See Request for Rehearing at page 10.) We agree with appellants. Appellants argue that the audio and video data stored in addresses starting from opposite ends of the memory towards each other. (See brief at page 15.) The examiner maintains that "the choice of which comes first the video or the audio is clearly an arbitrary engineering design choice and as such it would have been obvious." (See answer at page 4.) From our understanding of the examiner's statement of the rejection, the examiner has not addressed the limitations of the claims. From our review of the admitted prior art and Yoshida, neither teaches the filling of the memory from opposite ends. Therefore, the examiner has not set forth a **prima facie** case of obviousness, and we will not sustain the rejection of claim 6 and its dependent claim 7. (Therefore, we have not addressed item (7) in the Request.)

In item (8) with respect to claims 8 and 9, appellants clarify the statement at page 18 of the brief concerning a hypothetical situation. (See Request for Rehearing at pages 12-14.) While we understand appellants' position, we note that statement "at this point in their Brief" may be easily misunderstood to encompass sections (a)(1) - (a)(6) since the next section is entitled "The Claims are Patentable Over the Applied Art." Therefore, in light of the clarification, we withdraw our reliance on the statement as evidence of a lack of argument and have addressed appellants' arguments above. With respect to claims 8 and 9, appellants argue that there are significant differences between claims 8 and 9. (See brief at page 18.) We agree with appellants that the claims are different and that claim 1 implements a feature of both claim 8 and claim 9. Yet, at pages 17-19 of the brief in the groupings section, we find no argument for these claims with respect to patentability over the admitted prior art and Yoshida. Appellants identify page 19, lines 2-3 of the brief which states that claims 1, 8, and 9 "require separate consideration as to patentability over the prior art" as contradiction to our findings in the decision that appellants have not provided separate arguments for patentability. (See Request for Rehearing at page 13.) This argument is not persuasive since appellants have not addressed the teachings of the prior art.

Appellants argue that "having demonstrated that the claim recitations had not been considered by the Examiner, appellants had presented requisite and sufficient arguments for patentability of each of these claims." (See Request for Rehearing at

page 14.) We disagree with appellants. Further, if the examiner has considered and identified the teachings and corresponding line of reasoning with respect to specific claims to establish a *prima facie* case, the burden then shifts to appellants to rebut the examiner's *prima facie* case. In the present appeal brief and request for rehearing, appellants go to great length to identify the differences between individual claims which would be readily apparent to skilled artisans from a cursory reading of the claims, but presents sparse commentary about the prior art and its application to the claimed invention by the examiner. In most instances, appellants have not adequately rebutted the examiner's *prima facie* case of obviousness. Appellants argue that "upon arguing specific features present only in the dependent claims and their distinction over the prior art, appellants have provided the requisite arguments." (See Request for Rehearing at page 15.) To the extent appellants have provided arguments directed to the "distinction over the prior art in the brief," we have modified our decision as discussed above.

### **CONCLUSION**

To summarize, in light of appellants' arguments, we have reconsidered the arguments and have modified our rejection to reverse the examiner's rejection of dependent claims 3 and 6. Since claim 7 depends from claim 6, we will similarly reverse the rejection of claim 7. With respect to independent claims 1, 8, and 9, and dependent claims 2, 4, 5, appellants have not convinced us of any error in our decision.



Appeal No. 1997-2656  
Application No. 07/907,472

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