

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(2) is not binding precedent of the Board.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. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUTOSHI SHIMIZUME and MAMORU AKITA

Appeal No. 1998-1540
Application No. 08/317,390

ON BRIEF

Before HAIRSTON, KRASS and LALL, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 4, 7 and 11-13.
Claims 2, 3, 5, 6 and 8 were withdrawn from consideration under a restriction requirement.
Claims 1, 9 and 10 were canceled in response to the examiner's answer (Paper No. 31).

The invention pertains to a servo control system for a disk player.

Representative independent claim 4 is reproduced as follows:

4. A disk player comprising:

signal processor means for processing a reproduced signal obtained from a disk, detecting a speed difference between the rotation speed of the disk and a desired rotation speed thereof, and outputting a speed control signal corresponding to the detected speed difference;

oscillator means for supplying an oscillation output as a system clock signal to said signal processor means; and

speed control means for detecting the phase difference between said oscillation output and a reference clock signal, and controlling the rotation speed of the disk in accordance with the detected phase difference.

No references are relied upon.

Claims 4, 7 and 11-13 stand rejected under 35 U.S.C. § 112, first and second paragraphs as, respectively, being based on a nonenabling disclosure and being indefinite.

A rejection of claims 1, 9 and 10 under 35 U.S.C. § 102(e) is now moot in view of appellants' cancellation of claims 1, 9 and 10.

Thus, we have before us only the rejections based on 35 U.S.C. § 112, first and second paragraphs.

Reference is made to the brief (Paper No. 35) and answer (Paper No. 31) for the respective positions of appellants and the examiner.

OPINION

We reverse both rejections under 35 U.S.C. § 112 as being, on their face, improper.

The rejection of the claims under the first paragraph of 35 U.S.C. § 112 purports to be based on the enablement clause in that certain subject matter in the claims was not described in the specification in such a way as to enable the skilled artisan to make and use the invention.

In particular, the examiner states that the disclosure of the elected species of Figure 2, described at pages 14-27 of the specification as the first embodiment, fails to describe or enable the combination of elements recited in claims 4, 7 and 11-13. The examiner specifically cites the limitations of “detecting the phase difference between an oscillation output and a reference clock...” and “detecting a speed difference between the rotation speed of the disk and the desired rotation speed...” (answer-page 4).

The specification clearly discloses the claimed elements. See, for example, page 28 of the specification, second paragraph, which teaches controlling the rotation of the spindle motor “on the basis of the phase difference between a reproduced clock signal and a reference clock signal.” Further, the subject matter is relatively simple enough for the artisan engaged in such arts that we do not find enablement to be any problem.

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We believe that it is not enablement, per se, that concerns the examiner, rather, it appears that the examiner is really bothered by appellants possibly now claiming a nonelected invention. Thus, the examiner has taken the position that for the Figure 2 embodiment, which was previously elected by appellants, what is now claimed is allegedly not part of that embodiment. If that is the case, we find no basis for the examiner's rejection under 35 U.S.C. § 112, first paragraph, since the specification, as a whole, does provide an enabling disclosure for what is claimed. If the examiner perceives that appellants may now be directing the claimed subject matter to a previously nonelected invention, that would appear to us to be an objectionable matter, not subject to a rejection. But, in any event, we find no basis for a rejection based on the enablement clause of 35 U.S.C. § 112 to lie. The examiner has presented no rational basis for challenging the sufficiency of the disclosure with regard to any particularly claimed subject matter.

Turning now to the alternative rejection of the claims based on 35 U.S.C. § 112, second paragraph, because the claims are indefinite, we also will not sustain this rejection.

The examiner has failed to point to any particular claim language which is allegedly indefinite. The examiner's basis for the rejection is that "[b]ecause appellant believes the claims are readable on the elected invention and the examiner disagrees,

the metes and bounds of the claim(s) cannot be readily ascertained, rendering the claim(s)

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vague and indefinite...” [answer-page 5]. Clearly, it is no basis for a rejection under 35 U.S.C. § 112, second paragraph, to say that the parties disagree as to whether the claim reads on an elected invention. The examiner must point to specific claim language which he/she deems vague and indefinite. The examiner has not done so. We will not sustain the rejection under 35 U.S.C. § 112, second paragraph.

The examiner’s decision is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ERROL A. KRASS)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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PARSHOTAM S. LALL)	
Administrative Patent Judge)	

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