

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHUNJI KANEKO

Appeal No. 1999-2379
Application 08/716,061¹

ON BRIEF

Before BARRETT, DIXON, and GROSS, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed September 19, 1996, entitled "Commercial Broadcasting System," which claims the foreign filing priority benefit under 35 U.S.C. § 119 of Japanese Application 7-266434, filed September 20, 1995.

Appeal No. 1999-2379
Application 08/716,061

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1, 3-6, 8-12, 14-18, and 21-24.

We affirm-in-part and enter a new ground of rejection.

BACKGROUND

The disclosed invention relates to a commercial sending system for sending a commercial from a broadcasting station that detects when commercial material (CM) on a "send list" (a list of CM to be sent, also called a "play list") has not been recorded and adds the record information for the non-recorded CM to a "record list" (a list of CM to be stored).

Claim 1 is reproduced below.

1. A commercial sending system for sending a commercial from a broadcasting station, the system comprising:

commercial material recording/storing means for recording and storing a commercial material: [sic, ";"]

record list storing means for storing a record list including record information of the commercial material stored in said commercial material recording/storing means;

send list storing means for storing a send list including send information of the commercial material sent from said commercial material recording/storing means;

a commercial material database composed of storage information of the commercial material stored in said commercial material recording/storing means;

detecting means for comparing the send list stored in said send list storing means and the storage information of said commercial material database and

Appeal No. 1999-2379
Application 08/716,061

(pages referred to as "RBr__") for a statement of Appellant's arguments thereagainst.

OPINION

Grouping of claims

Appellant states that the claims stand or fall together (Br8). This means that the Board may select a single claim to determine patentability. See 37 CFR § 1.192(c)(7) (1998). However, in the argument section of the brief, Appellant argues two groups of claims, one for each ground of rejection. And, within the obviousness group, Appellant makes minor arguments regarding claims 3, 9, 15, and 22, to displaying non-recorded commercial material at both the send list displaying means and the record list displaying means; the limitations of claims 14 and 21, to displaying a record list, are not argued. The Examiner stated that the claims stand or fall together (EA2), but addressed the claims. We will consider the claims argued; however, Appellant should be more careful in designating the grouping of claims. The grouping of claims is as follows:

(1) Claims 1, 4-6, 8, 10-12, 16-18, 23, and 24 stand or fall together with representative claim 1.

Appeal No. 1999-2379
Application 08/716,061

(2) Claims 14 and 21 have not been separately argued.

(3) Claims 3, 9, 15, and 22 stand or fall together with claim 3.

New ground of rejection pursuant to 37 CFR § 1.196(b)

Claims 1, 3-6, and 8-11 are rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Appellant regards as his invention. Claims 1 and 6 are indefinite and/or misdescriptive.

Claim 1 is representative of two problems with claims 1 and 6. First, claim 1 recites "record list storing means for storing a record list including record information of the commercial material stored in said commercial material recording/storing means" (emphasis added) and "said new record list containing the record information of the commercial material stored in said commercial recording/storing means" (emphasis added). A "record list" is disclosed as a working list for obtaining CM materials to be stored (specification, p. 14, lines 4-14), not a list of material stored, as claimed. It is noted that claims 12 and 18 correctly recite "a record list including record

Appeal No. 1999-2379
Application 08/716,061

information of the commercial information that is to be stored" (emphasis added). The problem with the claim language is confirmed by the fact that claim 1 recites "a record list including record information of the commercial material stored in said commercial material recording/storing means" (emphasis added) and "a commercial material database composed of storage information of the commercial material stored in said commercial material recording/storing means" (emphasis added). This implies that both the "record list storing means" and the "commercial material database" include the identical "information of the commercial material stored in said commercial material recording/storing means."

Second, claim 1 recites "send list storing means for storing a send list including send information of the commercial material sent from said commercial material recording/storing means" (emphasis added). A "play list" or "send list" is disclosed as a working list for a CM material to be sent (specification, p. 19, lines 22-23), not sent, as claimed. While it may be true that the send list includes information about what was sent as well as material that is

Appeal No. 1999-2379
Application 08/716,061

to be sent, it makes no sense to detect non-recorded material in the send list if the material was already supposed to have been sent. It is noted that claims 12 and 18 correctly recite "a send list including send information of the commercial information that is to be sent" (emphasis added).

It is noted that the wording of claims 1 and 6 also appears in the specification, e.g., page 5, lines 10-16, page 6, lines 9-15, and should be corrected.

Claim interpretation

For the purposes of this decision, we interpret the "record list" limitations of claim 1 as "record list storing means for storing a record list including record information of the commercial material to be stored in said commercial material recording/storing means" and "new record list containing the record information of the commercial material to be stored in said commercial recording/storing means."

We interpret the "send list" limitation as "send list storing means for storing a send list including send information of the commercial material to be sent from said commercial material recording/storing means."

Appeal No. 1999-2379
Application 08/716,061

Appeal No. 1999-2379
Application 08/716,061

Anticipation

Appellant argues (Br11) that Takeuchi does not teach the following limitation of claim 1:

record list creating means for adding the record information of the non-recorded commercial material to the record list so as to automatically create a new record list when said detecting means has detected the non-recorded commercial material, said new record list containing the record information of the commercial material stored in said commercial material recording/storing means and further containing the record information of the non-recorded commercial material.

Appellant believes that Takeuchi's "control data and order list data p3" corresponds to Appellant's "record list" (Br10; RBr2). It is argued that the record information of the non-recorded commercial material is not added to Takeuchi's order list data p3 (Br11; RBr3) and, contrary to the Examiner's assertion, no list of non-recorded commercial material is created (Br11).

We disagree with the argument that no list of non-recorded commercial material is created. Takeuchi discloses (col. 5, lines 28-50):

Video and audio signals av of the material reproduced by the cart machine 5 are supplied to the recorder/reproducers 6a, 6b, ..., 6n. Any one of the recorder/reproducers 6a, 6b, ..., 6n records the supplied video and audio signals av if data indicative

Appeal No. 1999-2379
Application 08/716,061

of recording among the control data and the order list p3 which are supplied from the controller 2 represents that one of the recorder/reproducer.

The sequence of operations by the above various devices is summarized as follows: When the broadcast schedule list data p1 as shown in FIG. 4 are supplied to the controller 2, the controller 2 compares the broadcast schedule list data p1 with the data bases for the recorder/reproducers 6a, 6b, ..., 6n to determine which ones of the recorder/reproducers 6a, 6b, ..., 6n have not recorded which material.

Thereafter, the control data (including the shelf number data) and the order list data p3 are supplied to the cart machine 5 and the recorder/reproducers 6a, 6b, ..., 6n to enable the cart machine 5 to reproduce the video and audio signals of a desired material and also to enable desired ones of the recorder/reproducers 6a, 6b, ..., 6n to record the reproduced material.
[Emphasis added.]

Assuming the "control data and order list data p3" corresponds to a "record list," as argued by Appellant, we find that a record list of non-recorded materials to be recorded is added to this record list. Takeuchi discloses that one of the recorder/reproducers records the supplied audio signals as if data indicative of recording among the control data and the order list p3 represents that recorder/reproducer (first paragraph quoted above). That is, the order list p3 contains a list of materials to be recorded. Takeuchi determines non-recorded material by

Appeal No. 1999-2379
Application 08/716,061

comparison of a send list (broadcast schedule list data p1) with a database (the databases for the recorder/reproducers) (second paragraph quoted above). These non-recorded materials must be added to the order list data p3 because order list data p3 causes the non-recorded material from the send list to be recorded onto the recorder/reproducers (third paragraph quoted above). The addition of the non-recorded materials to order list data p3 creates a "new" list. Accordingly, we are not persuaded by Appellant's argument that Takeuchi does not add record information of the non-recorded commercial material to the control data and order list data p3. Appellant has not shown error in the Examiner's finding of anticipation. The anticipation rejection of claims 1, 4-6, 8, 10-12, 16-18, 23, and 24 is sustained.

While there is some question in our minds whether control data and order data list p3 is a record list of material to be recorded before the comparison to determine and add a list of non-recorded material, Appellant argues that it is, and, since this application is assigned to the same assignee as Takeuchi, we presume Appellant is correct.

Appeal No. 1999-2379
Application 08/716,061

We do not go looking for issues that were not argued. See 37 CFR § 1.192(c)(8)(iii) (1998) (argument section of brief must specify the errors in the rejection and the specific limitations in the claims which are not described in the prior art). Cf. In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) ("It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art."); In re Wiechert, 370 F.2d 927, 936, 152 USPQ 247, 254 (CCPA 1967) ("This court has uniformly followed the sound rule that an issue raised below which is not argued in this court, even if it has been properly brought here by a reason of appeal, is regarded as abandoned and will not be considered. It is our function as a court to decide disputed issues, not to create them."); In re Wiseman, 596 F.2d 1019, 1022, 201 USPQ 658, 661 (CCPA 1979) (arguments must first be presented to the Board before they can be argued on appeal).

Obviousness

Claims 14 and 21

Appeal No. 1999-2379
Application 08/716,061

The Examiner finds that Takeuchi does not disclose the claimed record list displaying means, but finds that it was well known to connect a display to the output of a recorder/reproducer to display what is recorded/reproduced (FR8), and concludes that it would have been obvious "to modify the recording/reproducing system of Takeuchi by connecting a display means to the output of the recording/reproducing means in order to display what is recorded/reproduced by the recording/displaying [sic] means" (FR8).

Appellant does not respond to this reasoning and, thus, has not shown error in the Examiner's position. See 37 CFR § 1.192(c)(8)(iv). Accordingly, the rejection of claims 14 and 21 is sustained.

Claims 3, 9, 15, and 22

Appellant argues that the Examiner "ignored Appellant's feature of displaying a send list (that is a list of commercial materials to be broadcast by the station)" (Br14).

This argument is without merit. The Examiner found in the final rejection that the claimed "send list displaying

Appeal No. 1999-2379
Application 08/716,061

means" is met by the monitor screen 10 of the controller, described at column 4, lines 24-31 (FR7 ¶ 5a). This finding is correct.

Appellant argues that the Examiner "further ignored Appellant's feature of displaying non-recorded commercial material at both the send list displaying means and record list displaying means as recited in claims 3, 9, 15, 22" (Br14).

The Examiner's rationale does not cover the claim language of "information that represents the non-recorded commercial material is displayed on said record list displaying means and said send list displaying means" (claims 3, 9; similar language in claims 15 and 22). In particular, the Examiner has provided no reason why it would have been obvious to display the information representing non-recorded commercial material on the send list displaying means. Thus, the Examiner has failed to establish a prima facie case of obviousness with respect to claims 3, 9, 15, and 22. The rejection of claims 3, 9, 15, and 22 is reversed.

CONCLUSION

Appeal No. 1999-2379
Application 08/716,061

The rejections of claims 1, 4-6, 8, 10-12, 14, 16-18, 21, 23, and 24 are sustained.

The rejection of claims 3, 9, 15, and 22 is reversed.

A new ground of rejection has been entered as to claims 1, 3-6, and 8-11 pursuant to 37 CFR § 1.196(b).

In addition to affirming the Examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(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

Appeal No. 1999-2379
Application 08/716,061

the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

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

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the Appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

Appeal No. 1999-2379
Application 08/716,061

Appeal No. 1999-2379
Application 08/716,061

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 | 37 CFR § 1.196(b)

	LEE E. BARRETT)	
	Administrative	Patent Judge)
)	
)	
)	
)	BOARD OF
PATENT)	
	JOSEPH L. DIXON)	APPEALS
	Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
	ANITA PELLMAN GROSS)	
	Administrative Patent Judge)	

Appeal No. 1999-2379
Application 08/716,061

FROMMER LAWRENCE & HAUG
745 Fifth Avenue- 10th Floor
New York, NY 10151