

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. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUHISA SUGIYAMA and ATSUKO TSUKAMOTO

Appeal No. 1997-4315
Application No. 08/159,618

ON BRIEF

Before HAIRSTON, JERRY SMITH and BARRETT, Administrative Patent Judges¹.

JERRY SMITH, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants filed a request for rehearing on August 23, 2000 responsive to a decision by the Board mailed on June 23, 2000. In that decision, the Board affirmed the rejection of claims 1-6, 19 and 21, and reversed the rejection of claims 7-15 and 17. Appellants request that we reconsider that portion of

¹ Administrative Patent Judge Frahm, who authored the original decision, is no longer at the Board.

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the decision of June 23, 2000 wherein the Board affirmed the rejection of claims 1-6, 19 and 21 as unpatentable under 35 U.S.C. § 103.

We have reconsidered the decision of June 23, 2000 in light of appellants' comments in the request for rehearing, and we find no errors therein. We, therefore, decline to make any changes in the prior decision for the reasons which follow.

The request for rehearing initially points to supposed errors made by the Board in affirming the rejection of claims 1-6. Claims 1-6 were rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Tsujino and Fukuyama. Appellants argue that the Board failed to consider the proper meaning of the word "set" when viewed in light of the disclosure. Specifically, appellants argue that the term "set" means a "pre-specified tool is or is not present" [request, page 3]. The earlier decision relied on Tsujino for teaching this recitation of independent claim 1. Appellants argue that a "tool set condition displaying means" cannot be met by the types of tool parameters described by Tsujino or Fukuyama. We do not agree.

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First, we note that the definition proposed by appellants is not mandated by any special definition set forth in the specification. Second, Tsujino does not simply disclose tool parameters such as length, diameter and offset, but also discloses the ability to identify or discriminate the type of tool within the tool holder. This discrimination in Tsujino is done for the same purpose disclosed by appellants which is to prevent the use of the wrong tool. Tsujino states that "the tool to be carried to the spindle 3 by the tool changing apparatus 4 is checked by the receiver 30 arranged at the position B to see if it is the designated proper tool or not. Therefore, it is possible to prevent that the workpiece is erroneously worked by use of the improper tool" [column 7, lines 10-15]. Thus, Tsujino determines if a tool located in the tool holder is the correct tool for the job. The data for identifying the tool is "set condition" data within the meaning of the claims. The earlier decision agreed with the examiner that displaying machine tool data was well known as evidenced by Fukuyama. We still agree with the examiner's conclusion that it would have been obvious within the meaning

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of 35 U.S.C. § 103 to display any tool identifying information of Tsujino as taught by Fukuyama.

We now consider the Board's earlier decision with respect to claims 19 and 21 which were rejected under 35 U.S.C. § 103 as being unpatentable over admitted prior art in view of Takeuchi. With respect to claim 19, appellants' arguments are directed to the workpiece data set indicating means. This means is recited for stopping a program, displaying workpiece data, or prompting an operator. In the earlier decision, the Board noted that this element was satisfied by prior art which performs any one of the three claimed functions, and the Board considered that Takeuchi taught at least the function of stopping. Appellants argue that the stopping function is not performed by Takeuchi because there is no affirmative action taken to stop the processing of the program and nothing inherently requires the program in Takeuchi to stop when the data runs out [request, pages 5-6].

Although the Board considered only the claimed function of stopping and found stopping in Takeuchi when the data runs out, we find that Takeuchi teaches much more than

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the original panel considered. Specifically, Takeuchi teaches an affirmative action of not moving a tool to the machining center when the data is inaccurate [note column 9, lines 28-32]. As noted in Takeuchi, the movement of the defective pallet is inhibited. We view such inhibition of movement as an action of stopping processing of a program. We also view such stopping as a stopping when necessary workpiece data has not been set in said workpiece fixing means as recited in claim 19.

We are also of the view that Takeuchi teaches the prompting function of claim 19. Takeuchi states that “[i]f the normal data cannot be received even after the resending operation was requested a predetermined number of times, the CPU 30 of the write/readout unit 25 turns on the error indicator 72, thereby instructing the checking by the operator” [column 8, lines 13-17]. Such an indication to the operator would have suggested the claimed prompting of an operator to set workpiece data.

With respect to claim 21, the Board in the earlier decision observed that the claimed position and height data of each workpiece was conventional information that would have

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been obvious to store in the admitted prior art and Takeuchi combination. Appellants argue that the admitted prior art usage of position and height data does not suggest the efficient and accurate positional control achieved by the claimed invention [request, pages 8-9].

Takeuchi discloses that "even if the machining condition differs for every workpiece every pallet, the pallet itself has the machining data corresponding to the machining condition" [column 9, lines 39-42]. This passage suggests that whatever data is needed to properly machine a given workpiece is stored in a workpiece data storage means (the pallet). The artisan would have appreciated that no workpiece can be properly machined unless the relative positional dimensions and locations of the tool and the workpiece are stored as part of the machining program. Therefore, we still agree with the examiner's conclusion that it would have been obvious to store position and height data of each workpiece in a workpiece data storage means.

Appellants argue that the means plus function language of claims 1-6, 19 and 21 has not been properly interpreted. This argument was first made at the oral hearing, and the

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earlier Board decision noted that this argument was not timely made since the issue had not been addressed in the brief. Appellants note that 37 CFR § 1.193(b)(1) was amended to permit an appellant to file a reply brief without restriction to new points of argument. The relevance of this argument is not understood because appellants filed no reply brief in this application. The critical question as we view it is the timeliness of the arguments with respect to the interpretation of the means plus function language.

Appellants are correct to assert that the examiner has the responsibility to interpret means plus function language in the manner required by the sixth paragraph of 35 U.S.C. § 112. Whether or not the examiner successfully complied with this responsibility, however, is a legal and factual question which must be argued. When a rejection on appeal is decided by the Board, arguments not made by appellant in the brief are not considered and are effectively waived. Appellants' failure to address the question of claim interpretation in the brief has deprived us of an opportunity to consider the examiner's position with respect to this question. Thus, we agree with the earlier Board decision that appellants'

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arguments related to claim interpretation were not timely made at oral hearing and, therefore, are not timely made as part of this request for rehearing.

We note appellants' request that we remand this application to the examiner for a consideration of the claim interpretation question. For reasons discussed above, we decline to remand this application to consider an issue which was not timely raised. Appellants are free to argue this issue, however, in continued prosecution of this invention before the examiner. In summary, we have carefully considered the arguments raised by appellants in their request for rehearing, but we can find no errors in the original Board decision. We are of the view that the invention set forth in claims 1-6, 19 and 21 would have been obvious within the meaning of 35 U.S.C. § 103 in view of the applied prior art.

We have granted appellants' request to the extent that we have reconsidered the decision of June 23, 2000, but we deny the request with respect to making any changes therein.

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

REHEARING DENIED

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Administrative Patent Judge)	
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JERRY SMITH)	BOARD OF PATENT
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