

File

Cooper

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 462

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte J. CARL COOPER

Appeal No. 93-2012
Control No. 90/002,107

MAILED

AUG 12 1996

PAT & TM OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

~~MAILED
JUL 30 1996~~

~~PAT & TM OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES~~

Before THOMAS HAIRSTON and CARDILLO, Administrative Patent Judges

HAIRSTON, Administrative Patent Judge

REQUEST FOR RECONSIDERATION

Appellant has requested reconsideration of our decision

dated September 21, 1994.

Request filed August 13, 1990, for reexamination of U.S. Patent No. 4,305,091, issued to J. Carl Cooper on December 8, 1981, which is a continuation in part of Application 09/763,904, filed January 19, 1977, now abandoned.

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According to appellant (Request, pages 1 and 2), petitions to the Commissioner were filed to address Issues I and IV of the request. Appellant has requested (Request, pages 3 and 12) that any action on the other issues in this request be postponed until the Commissioner renders a decision on the petitions².

Turning to Issue II, appellant believes (Request, page 8) that "the Board should give deference to the original prosecution examiner who faced and resolved the issue based on the whole specification and thus allow the claim 31 at issue." The subsequent examiner's rejections, and not the original examiner's comments, were on appeal to the Board. The Board considered the propriety of the rejections and affirmed the examiner's rejections of claim 31 under both the first and second paragraphs of 35 U.S.C. § 112. With respect to the statement (Request, page 9) that "[t]here need come a time when the USPTO stops revisiting already visited and determined issues," appellant is well aware

² The record indicates that a Decision on Petition (paper number 57) dismissing both petitions was mailed on February 6, 1995.

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That the purpose of the reexamination process is to revisit old issues, and to investigate new issues.

Under Issue III, appellant argues (Request, pages 9 and 10) that the examiner's alternate rejections under 35 U.S.C. § 102(b)/35 U.S.C. § 103 were speculative and improper. It was neither speculative nor improper for the examiner to use alternative grounds of rejection. The rationale for such a practice is that if anticipation of a claim is not found because of some difference between the claimed invention and the teachings of the reference, then obviousness may still be found because the difference would have been obvious to the skilled artisan.

Although the operation of the Spencer and Rossi circuits may differ from the circuit operation disclosed by Cooper '091, the appellant still has not demonstrated in Issue III that the Spencer and Rossi circuits are not "equivalents" to the disclosed and claimed circuit under In re Donaldson, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994) (in banc). Appellant's arguments (Request, pages 10 through 12) to the contrary notwithstanding,

we are still of the opinion that the circuits in the applied references operate in accordance with the means plus function recitations in the claims on appeal.

Appellant's argument (Request, page 10) that the "disclosure [sic, disclosures] of Spencer and Rossi is [sic, are] ambiguous on their operation" lacks supporting evidence.

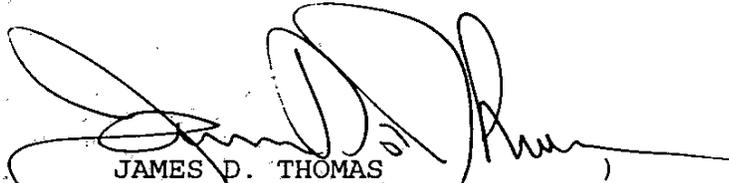
Turning lastly to Issue V, every claim on appeal that had patentability arguments directed thereto was individually considered in our decision. All other claims that lacked such patentability arguments were allowed to stand or fall with the claims that had such arguments. Appellant's arguments (Request, pages 13 through 15) concerning the failure of the examiner to address every dependent claim should have been presented before appeal to the Board.

Appellant's request has been granted to the extent that our decision has been reconsidered, but such request is denied with respect to making any modifications to the decision.

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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).

DENIED

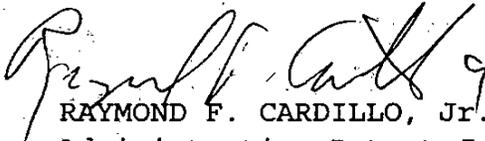


JAMES D. THOMAS)
Administrative Patent Judge)



KENNETH W. HAIRSTON)
Administrative Patent Judge)

BOARD OF PATENT
APPEALS AND
INTERFERENCES



RAYMOND F. CARDILLO, JR.)
Administrative Patent Judge)

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Control No. 90/002,107

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Art. Unit 2505

Paper No. 40

Appeal No. 93-2012

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte J. Carl Cooper

Request filed August 13, 1990, Control No. 90/002,107 by JVC Corporation, for the Reexamination of Patent No. 4,305,091 issued to Cooper on October 8, 1985, based on application Serial No. 06/030,288 filed April 16, 1979; which is a continuation-in-part of Serial No. 05/763,904 filed January 31, 1977, abandoned. Electronics Noise Reducing Apparatus and Method.

Charles R. Rust et al. for appellant.

Primary Examiner - John Shepperd.

Before Craig, Lynch and Stewart, Examiners-in-Chief.

Stewart, Examiner-in-Chief.

REMAND TO THE EXAMINER

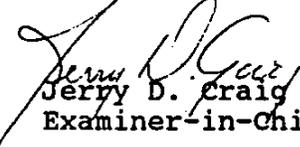
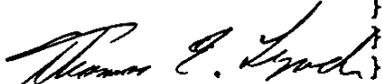
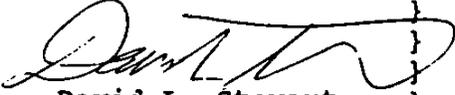
On March 11, 1993, the examiner of this reexamination issued a supplemental examiner's answer. On April 9, 1993, appellant filed a petition seeking to strike the supplemental examiner's answer. On April 27, 1993, the case was remanded to the group for a decision on the petition. On June 17, 1993, the Director denied appellant's petition and the file was forwarded

to us for a decision. On August 16, 1993, appellant filed a supplemental reply brief and a disclosure statement.

We are currently without the examiner's position vis-à-vis the most recently filed papers.

Accordingly, this case is remanded to the examiner for action on the supplemental reply brief and disclosure statements filed on August 16, 1993 (Paper Nos. 38 and 39, respectively).

This application, by virtue of its "special" status, requires an immediate action, M.P.E.P. 708.01(d). It is important that the Board be informed promptly of any action affecting the appeal in this case.


Jerry D. Craig }
Examiner-in-Chief }

Thomas E. Lynch }
Examiner-in-Chief }

David L. Stewart }
Examiner-in-Chief }

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