

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD R. SPERCEL and ROBERT J. SPERZEL

Appeal No. 2000-1161
Application No. 09/318,354

HEARD: Mar. 5, 2002

Before FLEMING, LALL, and SAADAT, Administrative Patent Judges.

LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-13, 15, 16, and 21-38. Claims 14 and 17-20 have been canceled. Claim 39 is also

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anceled and the rejection of claim 40 has been overcome by the terminal disclaimer.

The present invention relates to a musical instrument having a body portion, a neck portion and a head portion. A plurality of strings extend from the body portion along the neck portion to the head portion. At the head portion, each of the strings is connected with a tuning device of a plurality of tuning devices mounted on the head portion. Each of the tuning devices includes a generally cylindrical string post. The string posts extend through the head portion of the musical instrument. The string posts have parallel central axes disposed in a linear array. The central axis of each of the string posts is disposed in a plane. The plane extends perpendicular to parallel front and rear side surfaces of the head portion. Each of the tuning devices includes an actuator post. The actuators are manually rotatable to rotate the string posts about their central axes to adjust tension in the strings. The head portion has a linear edge portion and a nonlinear edge portion. The linear and nonlinear edge portions extend between the front side surface and rear side surface of the head portion. The nonlinear edge portion has

an arcuately curving configuration. The actuator knobs for a group of tuning devices are disposed adjacent to the arcuate or nonlinear edge portion while the actuator knobs for the other group of tuning devices are disposed adjacent to the linear edge portion of the head. By having the actuators for some of the tuning devices extend in a direction opposite from the actuators for the other tuning devices, spacing between actuator knobs for the tuning devices is maximized. This provides room for engagement of any one of the actuator knobs by the hand of a person playing the instrument. A further understanding of the invention can be achieved from the following claim.

1. A musical instrument comprising a body portion, a neck portion connected with and extending from said body portion, a head portion connected with said neck portion, said head portion having a front side and a rear side, a plurality of strings which are connected with said body portion and extend along neck portion to said head portion, a plurality of string posts, each of said strings of said plurality of strings being connected with one of said string posts of said plurality of string posts at a location adjacent to said front side of said head portion, each of said string posts having a central axis which extends transverse to said front and rear sides of said head portion, said central axes of said string posts being disposed in one plane which extends transverse to said front and rear sides of said head portion, and actuators which are connected with said string posts and are manually rotatable to rotate said string posts and are manually rotatable to rotate said string posts about the central axes of said string posts to adjust tension in said strings, a

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first plurality of said actuators extend in a first direction from a first group of said string posts and a second plurality of said actuators extend in a second direction from a second group of said string posts.

The examiner relies on the following references:

Krebs	3,443,018	May 6, 1969
Lieber	4,248,127	Feb. 3, 1981

Claims 36-38 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1-13, 15, 16, and 21-38 stand rejected under 35 U.S.C. § 103 as being unpatentable over Krebs in view of Lieber.

Rather than repeat the arguments of appellants and the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have considered the rejections advanced by the examiner and the supporting arguments. We have, likewise, reviewed the appellants' arguments set forth in the brief.

We affirm-in-part.

The rejection under 35 U.S.C. § 112, second paragraph

The examiner rejects claims 36 and 37 (final rejection at page 3 and answer at page 5) as being indefinite and confusing

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because the nomenclature of first, second, and third actuators in claims 36 and 37 is inconsistent with the nomenclature in claims 22, 23, and 29. We note that appellants have not directly responded to the rejection under 35 U.S.C. § 112, second paragraph. However, we note from Exhibits 2 and 3 attached to the appellants' brief that the nomenclature in claims 22 and 36 and corresponding dependent claims is different from each other. The nomenclature is, however, consistent in claims 22, 23, and 29 within themselves, and the nomenclature used in claims 36 and 37 is consistent within themselves. We observe that appellants can use different ordinal nomenclature for the same elements in different independent claims as long as it does not interfere with the substance of the related claims. In this particular case, the actuators are being called as first, second, and third actuators, and the same actuators are designated differently (e.g., first, third and second) in other unrelated claims (Exhibits 2 and 3 of brief). Therefore, we are of the view that the examiner has not presented a prima facie case of a indefiniteness rejection under 35 U.S.C. § 112, second paragraph, of claims 36 and 37. However, we reach a different

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conclusion regarding claim 38. The examiner has clearly set forth the problem with claim 38 at page 5 of the examiner's answer. We find that there is a reasonable place for confusion or indefiniteness in the recited language of claim 38, as is evident from a plain reading of the claim. We again note that appellants have not responded to this rejection. Therefore, we pro forma sustain the rejection of claim 38 under 35 U.S.C.

§ 112, second paragraph.

The Rejection of under 35 U.S.C. § 103

The examiner has rejected claims 1-13, 15, 16, and 21-38 (final rejection at pages 4-14 and answer at pages 5-13) over

Krebs and Lieber. Appellants argue, brief at page 11, that:

There is no reason for a person of ordinary skill in the art to modify the musical instrument disclosed in the patent to Krebs to have a first plurality of actuators extend in a first direction and a second plurality of actuators extend in a second direction from string posts having central axes disposed in one plane. This is because the patent to Lieber does not disclose a first plurality of actuators which extend in a first direction and a second plurality of actuators which extend in a second direction from string posts having central axes disposed in one plane.

The examiner asserts (answer at page 7) that:

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It would have been obvious . . . to modify Krebs' instrument as taught by Lieber to include a first plurality of said actuators extend in a first direction from a first group of said string posts and a second plurality of said actuators extend in a second direction from a second group of said string posts for the purpose of tuning the instrument.
[Emphasis ours]

We do not agree with the examiner's motivation to combine in view of the established law that in rejecting claims under 35 U.S.C.

§ 103, the examiner bears the initial burden of presenting a prima facie case of obviousness (see In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)), which is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art (see In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)).

In our view, here the examiner has used for motivation the road map and the blueprint of the appellants' invention. This is impermissible. We find no suggestion either in Lieber or in Krebs or in the combination of Lieber and Krebs which would have led an artisan to make the modification suggested by the examiner. The examiner has not pointed to any

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particular place in these two references, nor provided any line of reasoning to make the suggested modification. Since all the other independent claims 12, 21, 22, 32, and 36 each have a limitation similar to the one discussed above we cannot sustain the rejection of independent claims 1, 12, 21, 22, 32, and 36, and their dependent claims 2-11, 13-16, 23-31, 33-35, 37, and 38 over Krebs in view of Lieber.

In summary, we have pro forma sustained the rejection of claim 38 under 35 U.S.C. § 112, second paragraph, while we have reversed the rejection of claims 36 and 37 under 35 U.S.C. § 112, second paragraph. We have also not sustained the obviousness rejection of claims 1-13, 15, 16, 21-38 (except that claim 38 is subject to the above noted clarification under 35 U.S.C. § 112, second paragraph).

The decision of the examiner is affirmed-in-part.

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

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	Michael R. Fleming)	
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