

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HIDEKI NAGASHIMA,  
RYO ANDO, YASUAKI MAEDA, HIDEO OBATA,  
TADAO YOSHIDA, and KAZUHIKO FUJIIIE

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Appeal No. 95-3185  
Application 08/129,029<sup>1</sup>

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ON REQUEST FOR REHEARING

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Before JERRY SMITH, LEE and CARMICHAEL, Administrative Patent Judges.

LEE, Administrative Patent Judge.

**ON REQUEST FOR REHEARING**

A final decision was rendered in this case on July 13, 1998, reversing the rejection of claims 1, 2, 5, 6, 8 and 9, and affirming the rejection of claims 7 and 10. On September 17, 1998, the applicants requested rehearing (Paper No. 24).

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<sup>1</sup> Application for patent filed September 29, 1993. According to the appellants, this is a continuation of application 07/832,021, filed February 6, 1992, abandoned.

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The request for rehearing was not received by the Board until December 1, 1998.

The applicants make four arguments in the request for rehearing. First, it is said that the applicants "disagree with the Board's characterization of the Yamaguchi reference as disclosing a disk duplicating system which records signals read from the master disk, presumably in compressed form, onto another disk" (Request at 2). However, nowhere in the original appeal brief or reply brief did the applicants specifically argue that Yamaguchi's disk mastering system does not reproduce recorded signals in compressed form for direct recordation onto another disk. What the applicants did argue was that Yamaguchi does not disclose reproduction of signals from both the master and the copy disk, and that the Yamaguchi apparatus does not reproduce signals from the copy disk. Thus, no argument of the applicants in this regard was overlooked. In any event, arguments not specifically raised by the applicants in the appeal or reply briefs are not at issue, are not before us, and are considered waived.

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Moreover, in the background section of the applicants' specification, it is acknowledged that it has been known to record digital audio signals in compressed form. While Yamaguchi does not expressly state that the digital audio signals on the master disk are in compressed form, it cannot be reasonably argued that one with ordinary skill in the art would not have recognized that the stored signals can be in compressed form.

Furthermore, the applicants are estopped from arguing that Yamaguchi's stored signals are not in compressed form. In the appeal brief on page 9 and in connection with Yamaguchi's disclosure, the applicants state "conversion of the bit compressed data from the [Yamaguchi] master disk to a form which could be audible to a user, i.e., by decompression, expansion, etc. requires considerable time as opposed to direct recording without decompression and expansion, so that monitoring the mastering progress would just slow it down for no good reason." Thus, the applicants themselves have assumed that the recorded signals on Yamaguchi's master disk can be in compressed form.

The applicants make a second argument that in the context of the rejected claims, the "another source" is the reproducing-only system itself, whereas the Board's decision relies on an external system as the "another source." The argument is misplaced because claims 7 and 10 refer to receiving digital audio signals "from a source" and that source need not be the reproducing-only means recited in those claims. The applicants' argument is not commensurate in scope with what has been claimed. The "from a source" language is in the recited function portion of a means-plus-function clause and thus is not subject to narrowing in scope by way of a "means" interpretation under 35 U.S.C. § 112, sixth paragraph. The applicants also have not argued that it is.

The applicants further argue that the order of operations is not suggested by the prior art, i.e., first recording from "a source," and then recording the compressed information reproduced from a disk. We disagree. Once it is recognized that information can be recorded from two separate sources for later selective reproduction, it would have been obvious to one with ordinary skill in the art that the information from

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either source may be recorded first. One with ordinary skill is presumed to have some basic skills and common sense.

Finally, the applicants argue that the examiner's stated rationale for combining the references, i.e., economic incentive or business profits, is contrary to our view that "it is not a requirement for obviousness that there must be an economic incentive or commercial viability to a proposed modification." The argument misses the point that no economic or business incentive is necessary. The applicants had argued that the examiner was incorrect in his view that there would be an economic motivation for listening to the recorded music to check for errors as it is being duplicated. We stated (Decision at 8):

While it is true that real time monitoring by listening may not keep up with high speed duplication of data in compressed form, it is not a requirement for obviousness that there must be an economical incentive or commercial viability to a proposed modification. The issue is obviousness from a scientific or technical point of view to one of ordinary skill in the art, not whether an idea would make a profit from a business perspective. Here, we agree with the examiner that it would have been obvious to one with ordinary skill in the art to check for errors in recording by listening to the recording, regardless of whether the data is recorded in a compressed format.

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Thus, in our opinion, it does not matter whether it makes good business or economic sense to perform real-time monitoring while duplication is taking place. Checking for errors by listening to the signal being duplicated onto another disk nonetheless would have been obvious to one with ordinary skill in the art, from a technical or scientific point of view. One with ordinary skill in the art would have recognized that error checking can be performed at any time, including the duplication period.

#### **Conclusion**

We have reconsidered our decision in light of the applicants' request for rehearing. However, the request is denied, insofar as we decline to make any change in our 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**

JERRY SMITH	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
JAMESON LEE	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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JAMES T. CARMICHAEL	)	
Administrative Patent Judge	)	

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Philip M. Shaw, Jr.  
Limbach & Limbach  
2001 Ferry Building  
San Francisco, CA 94111