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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte YOSHIFUMI KIRA

Appeal 2017-005101
Application 11/989,944
Technology Center 2800

Before CHRISTOPHER L. OGDEN, AVELYN M. ROSS, and
DEBRA L. DENNETT, *Administrative Patent Judges*.

DENNETT, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ In our Opinion, we refer to the Non-final Action mailed October 29, 2015 (“Non-final Act.”); the Appeal Br. filed August 17, 2016 (“App. Br.”); the Examiner’s Answer mailed November 23, 2016 (“Ans.”); and the Reply Brief filed February 13, 2017 (“Reply Br.”).

STATEMENT OF THE CASE

Appellant² appeals under 35 U.S.C. § 134(a) from the Examiner's Non-final Rejection of claims 1–3, 5, 7–9, 11, and 12. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

The subject matter on appeal relates to storing timbre combinations in electronic musical instruments and apparatuses. Spec. 1, ll. 17–24. Claim 3, reproduced below, is illustrative of the claimed subject matter:

3. A timbre storing apparatus comprising:

a plurality of timbre selection means, each timbre selection means allowing selection of a single, different timbre data;

memory means in which are stored, as a timbre combination, the different single timbre data which have been respectively selected by different ones of said plurality of timbre selection means, such that the selected different single timbre data are stored as the timbre combination in said memory means in correspondence with one of said timbre selection means;

first selecting means for selecting one timbre from a previously stored timbre combination and changing one more timbres of said previously stored timbre combination in said memory means in correspondence with one said timbre selection means which corresponds to said selected one timbre;

means for switching between (i) a first mode in which each of said timbre selection means selects one of said single timbres and (ii) a second mode in which each of said timbre selection means selects one of said stored timbre combinations;

² Appellant identifies Kawai Musical Instruments Mfg. Co., Ltd. as the real party in interest. App. Br. 1.

means for reading said single timbre data corresponding to the one said timbre selection means according to operation of the one said timbre selection means, and generating a single tone corresponding to the read single timbre data, when said first mode is selected by said switching;

means for reading data of all timbres of one said timbre combination simultaneously according to operating of the one said timbre selection means, tones of the all timbres in the timbre combination being generated simultaneously, when said second mode is selected by said switching; and

second selecting means to select a timbre in one of the timbre combinations so that a tone of said timbre selected by the second selecting means is kept from being generated, and only tones of a plurality of timbres not selected by the second selecting means are generated, and an output volume of the plurality of timbres not selected by the second selecting means is individually controlled.

Claims App'x A-4–A-5 to App. Br.

REFERENCES

The Examiner relies on the following prior art in rejecting the claims on appeal:

Matsuda et al. ("Matsuda")	US 5,177,314	Jan. 5, 1993
Saito	US 5,412,153	May 2, 1995
Arnold et al. ("Arnold")	US 5,908,997	June 1, 1999

REJECTIONS

The Examiner maintains and Appellant seeks review of the following rejections under 35 U.S.C. § 103(a): (1) claims 1–3, 5, 7, and 8 over Matsuda in view of Arnold; and (2) claims 9, 11, and 12 over Matsuda in

view of Arnold and further in view of Saito. Non-final Act. 4–10; App. Br. 9–11.

OPINION

Appellant substantively argues patentability only of independent claim 3, as the claim contains all limitations disputed by Appellant. Appeal Br. 9–11. We, therefore, select claim 3 as representative. 37 C.F.R. § 41.37(c)(1)(iv).

In the Non-final Rejection, the Examiner finds that the combination of Matsuda and Arnold discloses all elements of claim 3. Non-final Act. 4–8. The Examiner finds that Matsuda fails to disclose “that the selected different single timbre data are stored as the timbre combination in the memory means in correspondence with one of the timbre selection means,” but determines that Arnold teaches this limitation. *Id.* at 5–6.

Appellant’s argument is limited to two points: (1) the applied art, even if combined, would not have included memory means in which a timbre combination is stored in correspondence with one of said timbre selection means; and (2) the applied art, even if combined, would not have included the required means for switching between a first mode and a second mode. App. Br. 9–11.

In response to Appellant’s first point, the Examiner revises the rejection, finding that Matsuda teaches the “storing in correspondence with one timbre selection means” limitation. Ans. 2–4. Specifically, the Examiner finds that

Matsuda . . . discloses that different single timbre data (two types of timbre) are stored as a timbre combination in a memory means in correspondence with one key operation . . . in

which musical tones with two types of timbres, the master timbre set in normal mode and another (second) timbre set [in] a similar manner . . . are simultaneously generated by a single key operation, where said key operation is one of a timbre selection means (timbre keys T1-T5).

Id. at 2–3 (citing Matsuda, col. 3, l. 66–col. 4, l. 3 and col. 7, ll. 7–11).

Appellant argues that the Examiner’s Answer on this issue is a new ground of rejection that was not properly designated as such. Reply Br. 1.

We agree with Appellant that the Examiner’s use of Matsuda as teaching the “memory means in correspondence with one of said timbre selection means” is an unapproved new ground of rejection. However, Appellant has not petitioned for review of the rejection as an improper new ground, thus waiving arguments on this issue.³ Accordingly, we address the rejection based on the Examiner’s findings and reasoning in the Answer and Appellant’s response.

Appellant disputes that the Examiner shows Matsuda discloses the “memory means in correspondence with one of said timbre selection means” required by claim 3. Reply Br. 3. The Examiner finds that Matsuda’s timbre keys T1-T5 meet the “timbre selection means” element. Ans. 3.

³ See 37 C.F.R. § 41.40(a) (“Any request to seek review of the primary examiner’s failure to designate a rejection as a new ground of rejection in an examiner’s answer must be by way of a petition to the Director under § 1.181 of this title filed within two months from the entry of the examiner’s answer and before the filing of any reply brief. Failure of appellant to timely file such a petition will constitute a waiver of any arguments that a rejection must be designated as a new ground of rejection”); *see also, e.g.*, Manual of Patent Examining Procedure § 1002.02(c)6 and § 1207.03(b) (9th ed., Rev. 7, November 2015); *In re Berger*, 279 F.3d 975, 984–85 (Fed. Cir. 2002) (Issues regarding whether an examiner abused his or her discretion in matters of practice and procedure are not subject to appeal).

Appellant argues that a “key operation” is not a “key,” (timbre selection means), thus the Examiner does not show that the timbre combination is stored “in correspondence with” one of keys T1-T5. Reply Br. 3. Appellant contends that the Examiner provides no evidence that “operation” of keys T1-T5 means that the timbre combination is stored “in correspondence with” one of the keys T1-T5. *Id.*

Matsuda teaches that timbre keys T1-T5 are assigned to different timbres. Matsuda, col. 2, ll. 44–50. Matsuda also teaches a tone mix mode in which musical tones with two types of timbres, a master timbre and a slave timbre, are simultaneously generated by a single key. *Id.* col. 3, l. 66–col. 4, l. 3, col. 6, ll. In the tone mix mode the tone bank function is enabled, or “ON.” Matsuda teaches:

[T]he timbre control register comprises a tone bank flag, a master timbre number register and a slave timbre number register. The tone bank flag is “1” when the tone bank function is set ON or enabled, and it is “0” when this function is set OFF or disabled. When the tone bank function is disabled, the master timbre number register serving as the first memory means stores one of timbre numbers (0 to 9) of the timbres selected by the operation of the select key F1 and timbre keys T1-T5. When the tone bank function is enabled, the slave timbre number register serving as the second memory means stores one of timbre numbers (0 to 9) of the timbres similarly selected.

Id. col. 4, ll. 5–19 (bolding omitted). Therefore, Matsuda teaches that the master timbre and the slave timbre are set separately, one at a time, each set by select key F1 and timbre keys T1-T5. When the tone bank key F2 is set to ON, musical tones with two types of timbres (master and slave timbres) are generated. *Id.* col. 7, ll. 7–11.

Claim 3 requires that “selected different single timbre data are stored as the timbre combination in said memory means *in correspondence with one of said timbre selection means.*” Claim App’x A-4. The Board gives claims their broadest reasonable interpretation in light of the specification. *In re Translogic Tech. Inc.*, 504 F.3d 1249, 1256 (Fed. Cir. 2007). The broadest reasonable interpretation of “in correspondence with” in the claim limitation is that a timbre combination is stored in and retrieved from the memory means by selecting a single timbre selection means. *See Spec.* 29:3–5.

Matsuda teaches storing the timbre combination in correspondence with two timbre selection means—one use of timbre keys T1-T5 to set the master timbre and a second use of timbre keys T1-T5 to set the slave timbre. The timbre combination could be said to be stored in correspondence with the single tone bank key F2, but this is not a “timbre selection means.” The timbre combination in Matsuda is not retrieved from the memory by selecting a single timbre key.

Based on the above analysis, Matsuda does not disclose the claim limitation “the selected different single timbre data are stored as the timbre combination in said memory means in correspondence with one of said timbre selection means.” The Examiner does not find that Arnold discloses the limitation. *See Ans.* 2–4.

Having determined that the combination of cited references does not teach one limitation, we need not address Appellant’s second argument.

The rejection of claim 3 as obvious over Matsuda in view of Arnold is not sustained. For the reasons given above, the rejection of claims 1, 2, 5, 7–9, 11, and 12 also is not sustained.

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DECISION

The Examiner's rejection of claims 1–3, 5, 7–9, 11, and 12 is reversed.

REVERSED