

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(2) is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENJI OHTA et al.

Appeal No. 96-1669
Application 08/054,125¹

ON BRIEF

Before HAIRSTON, FLEMING and RUGGIERO, **Administrative Patent Judges**.

FLEMING, **Administrative Patent Judge**.

¹ Application for patent filed April 27, 1993.

Appeal No. 96-1669
Application 08/054,125

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1, 3 through 6, and 9 through 13. At the time of the final rejection, claims 2, 7 and 8 had been cancelled. On March 21, 1995, Appellants filed an amendment after final which was entered by the Examiner into the record. This amendment cancelled claims 11 through 13 and amended claim 1. Therefore, amended claim 1 is properly before us for our consideration.

The invention relates to optical discs for recording and reproducing data by a laser beam. In particular, the invention is related to using a moisture proof film made of AlSiN having a thickness that results in a refractive index of 42 nanometers or less. The moisture proof film is placed on the optical disc so as to avoid the moiré phenomenon.

Independent claim 1 is reproduced as follows:

1. An optical disc comprising a recording film formed on one surface of a plastic substrate transparent to light, a first protection film formed on the recording film, a

Appeal No. 96-1669
Application 08/054,125

moisture proof film formed on the other surface of the substrate, and a second protection film formed on the moisture proof film, wherein the moisture proof film consists of AlSiN, and wherein a product of the refractive index of the moisture proof film and the thickness thereof is 42 nanometers or less.

The Examiner relies on the following reference:

Ohta et al. (Ohta) 0,467,705 Jan. 22,
1992
(European Patent Application)

Claims 1, 3 through 6, 9 and 10 stand rejected under
35 U.S.C. § 103 as being unpatentable over Ohta.

Rather than reiterate the arguments of Appellants
and the Examiner, reference is made to the briefs² and answer³
for the respective details thereof.

² On October 16, 1995, Appellants filed an appeal brief. On February 10, 1996, Appellants filed a reply brief. On September 30, 1996, the Examiner mailed a communication stating that the reply brief has been entered into the record.

³ The Examiner has filed an Examiner's answer on December 4, 1998. The record shows that the Examiner had previously filed three additional Examiner's answers. However, the case was remanded to the Examiner on October 22, 1998 and in response to the remand, the Examiner filed the Examiner's answer dated December 4, 1998. Therefore, we will consider only the Examiner's answer dated December 4, 1998 for this appeal.

Appeal No. 96-1669
Application 08/054,125

OPINION

We will not sustain the rejection of claims 1, 3 through 6, 9 and 10 under 35 U.S.C. § 103.

The Examiner has failed to set forth a **prima facie** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings

or suggestions. **In re Sernaker**, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." **Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.**, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), **cert. denied**, 117 S.Ct. 80 (1996) **citing W. L. Gore & Assoc., Inc. v. Garlock, Inc.**, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), **cert. denied**, 469 U.S. 851 (1984).

Appeal No. 96-1669
Application 08/054,125

On page 6 of the brief, Appellants argue that Ohta fails to teach the two claimed features of claim 1, AlSiN, the specific material used to make up the moisture proof film, and the product of the relative index of moisture proof film and the thickness thereof is 42 nanometers or less. Appellants emphasize that these limitations are neither shown nor suggested by Ohta. On page 7 of the brief, Appellants point to the declaration in the record which compares one of the disclosed materials for making up the moisture proof film taught in Ohta with Appellants' material AlSiN. Appellants point to the fact that Declarant has shown that the Appellants' material AlSiN is superior to the material taught in Ohta. Appellants argue that the declaration

provides evidence of superiority of AlSiN, and directly refutes the Examiner's position that the skilled artisan would find it a matter of routine experimentation to choose AlSiN instead of one of the materials disclosed in Ohta.

On page 5 of the answer, the Examiner states that Ohta does not expressly show the moisture proof film to be

Appeal No. 96-1669
Application 08/054,125

made of AlSiN. The Examiner argues that it would have been obvious to one of ordinary skill in the art to substitute the moisture proof film consisting of SiAlON, SiN, etc. of Ohta with a moisture proof film consisting of AlSiN. The Examiner provides a rationale that it would be a matter of routine engineering skill to make this substitution and to achieve the product of the moisture proof film thickness and its relative refractive index equal to 42 nanometers or less. We note that the Examiner does not provide any further evidence for this rationale. On pages 7 and 8 of the answer, the Examiner argues that the declaration is given very little weight because it does not compare AlSiON, which is one of the materials disclosed in Ohta, with AlSiN, the Appellants' compound.

We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a

Appeal No. 96-1669
Application 08/054,125

prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a *prima facie* case. *In re Knapp-Monarch Co.*, 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); *In re Cofer*, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

Turning to Ohta, we find that Ohta teaches on page 3 that the moisture-impermeable film may be selected from inorganic moisture-impermeable film such as AlN, SiN, ZnS, Al₂O₃, SiO₂, SiAlON, or from organic moisture-impermeable films such as polyvinylidene chloride and polytrifluorochloroethylene. Ohta further discloses that among these materials AlN is particularly preferred. Furthermore, Ohta teaches that the thickness of the moisture-impermeable films depends on the material used thereof. Further, we note that Ohta does not teach using AlSiN nor does Ohta teach a product of the refractive index of the moisture proof film and the thickness thereof is 42 nanometers or less.

Appeal No. 96-1669
Application 08/054,125

The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." **In re**

Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), **citing In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." **Para-Ordnance Mfg.**, 73 F.3d at 1087, 37 USPQ2d at 1239, **citing W. L. Gore**, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-313.

Upon a review of Ohta relied upon by the Examiner, we fail to find any suggestion or reason to provide a moisture proof film wherein the moisture proof film consists of AlSiN and wherein a product of the refractive index of the moisture proof film and the thickness thereof is 42 nanometers or less. To the contrary, we find that Ohta's teaching would have led those skilled in the art to choose from one of the many other

Appeal No. 96-1669
Application 08/054,125

materials listed as suitable for a moisture proof film. Appellants' declaration further buttresses our findings in that the declaration shows that AlSiN is superior to one of the materials in that group as taught by Ohta. Therefore, we will not sustain the rejection of claims 1, 3 through 6, 9 and 10 under 35 U.S.C. § 103 as being unpatentable over Ohta.

We have not sustained the rejection of claims 1, 3 through 6, 9 and 10 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

REVERSED

	KENNETH W. HAIRSTON)	
	Administrative Patent Judge)	
)	
)	
)	BOARD OF
PATENT)	
	MICHAEL R. FLEMING)	APPEALS AND
	Administrative Patent Judge)	
INTERFERENCES)	
)	
)	
	JOSEPH F. RUGGIERO)	
	Administrative Patent Judge)	

Appeal No. 96-1669
Application 08/054,125

MRF:psb

Appeal No. 96-1669
Application 08/054,125

David G. Conlin
130 Water Street
Boston, MA 02109