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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte QIAN WU

Appeal No. 97-0445
Application 08/170,020[1]

ON BRIEF

Before HAIRSTON, BARRETT and LALL, 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[2] of claims 1 through 9.

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[1] Application for patent filed December 20, 1993.

[2] An amendment after the final rejection was filed on July 21, 1995 [paper no. 9] and entered in the record.

Claims 10 and 11 are non elected.

The disclosed invention pertains to a device for selectively playing a large number of musical selections or accessing a large amount of data where the music or data selected is stored on a plurality of compact discs. Specifically, the invention concerns a mechanism for selecting and storing compact discs in a manner suitable for use as a juke box. The invention features a housing that contains a plurality of spaced apart, substantially parallel disc holders and two compact disc player assemblies. Each assembly has an extended portion shaped to pass through the cutout portions of the compact disc holders. Each assembly can selectively move up and down and each compact disc holder can selectively rotate, when horizontally aligned with an assembly, between a cache position, where the cutout portion of the holder is vertically aligned with the extended portion of the assembly to allow vertical movement of the assembly past the holders, and a selection position, where the extended portion of the assembly overlies a compact disc storage position of the holder so that the assembly can pick up a compact disc from

the storage position and load it into the assembly's compact disc player. This arrangement provides for a substantially continuous access to and play of data or music selections stored on the compact discs.

Representative claim 1 is reproduced as follows:

1. A selector mechanism for multiple compact disks comprising:

a housing;

a plurality of spaced, substantially parallel compact disk holders stacked vertically within said housing where each holder is capable of supporting a plurality of compact disks in individual storage positions and has a cut-out portion;

a compact disk player assembly movable vertically within the housing including a CD player and a [sic] extended portion shaped to pass through the cut-out portion of the holders;

means for selectively moving said assembly vertically between operating positions corresponding to each of the holders when the extended portion is aligned with the cut-out portion so the extended portion can pass therethrough; and

means for moving the holder corresponding to the assembly when the assembly is in its operating position relative to said holder between a cache position and selection positions, the cache position of the holder being where said cut-out portion is aligned with the extended portion to allow movement by the vertical movement means and the selection positions being where the extended portion overlays a compact disk storage position of said holder so that the assembly can pick up a compact disk supported on the holder at that storage position and load the compact disk within the player.

The Examiner relies on the following reference:

Hasegawa et al. al. (Hasegawa)	4,670,866	Jun. 2, 1987
Kobayashi et al. al. (Kobayashi)	5,033,038	Jul. 16, 1991
Amar	5,319,621	Jun. 7, 1994

Claims 1, 4, 7 and 8 stand rejected under 35 U.S.C. § 102 as being anticipated by Hasegawa. Claims 2, 3, 5, 6 and 9 stand rejected under 35 U.S.C. § 103 as being obvious over various combinations of Hasegawa, Kobayashi and Amar.

Rather than repeat the arguments of Appellant or 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 Appellant’s arguments set forth in the brief.

It is our view that claims 1, 4, 7 and 8 are anticipated by Hasegawa, while claim 5 is obvious over Hasegawa. On the other hand, claims 2, 3, 6 and 9 are not

obvious over the suggested various combinations of Hasegawa, Kobayashi and Amar. Accordingly, we affirm in part.

We take up these rejections in the order they appear in the brief. In our analysis below, we are guided by the precedence of our reviewing court that the limitations from the

disclosure are not to be imported into the claims. In re Lundberg, 244 F.2d 543, 113 USPQ 530 (CCPA 1957); In re Queener, 796 F.2d 461, 230 USPQ 438 (Fed. Cir. 1986). We are also mindful of the requirements of anticipation under 35 U.S.C. § 102. Anticipation under 35 U.S.C. § 102 is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert dismissed, 468 U.S. 1228 (1984).

Rejection of Claims 1, 4, 7 and 8 under 35 U.S.C. § 102

The Examiner has rejected these claims as being anticipated by Hasegawa. We take claim 1 as representative. We have considered Appellant's arguments [brief, pages 4] and Examiner’s position and response [answer, pages 3 and 8] in regard to claim 1. We find that Hasegawa does anticipate claim 1. Hasegawa discloses: “a plurality of ... disk holders ... where each ... a cutout portion” [claim 1, lines 3 to 5] in the form of holders 1 and 3, with respective cutout 5 and 9, figure 1; “a compact disk player assembly movable ... cutout portion of the holders” [claim 1, lines 6 to 8] in figure 10 where disk

player assembly comprising of 13, 14 and 15 moves vertically; “means ... moving said assembly ... therethrough” [claim 1, lines 9 to 11] in figure 10 and also figure 1 where selection of the disk to be played and the vertical movement of the assembly is shown; and “means for moving the holder ... within the player” [claim 1, lines 12 to 18] is shown in figures 1, 2, and 10 where the cache position is defined as where the

cutout 9 of holder 3 is aligned so that player assembly 13,14 and 15 can move up through the cutout portion [figure 10]. The selection position is defined as where the assembly 13, 14 and 15 moves up vertically and is positioned right below the selected disk in the disk holder 1 [figure 10] and lifts up the disk from holder to play. The clause qualifying the holder in the last paragraph of claim 1, namely: “corresponding to the assembly when the assembly is in its operating position relative to said holder” [lines 12 and 13] is broad and can be interpreted to mean that the term “corresponding to the assembly" could be considered as corresponding to either holder 1 or 3. The term “operating position” could hold true for any vertical location of the assembly as the assembly can be considered in its operation position relative to said holder in any position. This

qualifying language does not support the argument by Appellant about Hasegawa “that there is no need for the extended travel which is required by lifter (10) to clear all the holders prior to the next selection phase” [brief, page 5]. We, therefore, conclude that Hasegawa anticipates claim 1 and we

sustain the Examiner's anticipation rejection of claim 1 over Hasegawa.

Claim 4 depends on claim 1 and additionally calls for "where the holders are substantially circular ... movement" [lines 1 to 3]. Hasegawa clearly shows that in figures 1 and 2 where element 2 forms the axis of rotation. Thus, the anticipation rejection of claim 4 over Hasegawa is sustained.

With respect to claims 7 and 8, Hasegawa shows "means for relative motion ... on the assembly" [claim 7, lines 1 to 2] and "are pivotally mounted ... and ... moved." [Claim 8, lines 1 to 3] in the form of elements 14 and 19 in figures 1, 5 and 6, column 3, lines 45 to 58. Thus, we sustain the anticipation rejection of claims 7 and 8 over Hasegawa.

<u>Rejection of Claims 2, 5 and 6 under 35 U.S.C. § 103</u>

These claims are rejected as being obvious over Hasegawa. We have reviewed the Examiner's rejection and response [answer, pages 4 to 6 and 9 to 10] and Appellant's argument

[brief, pages 5 to 6]. We do not find any showing, or any suggestion, in Hasegawa where one of ordinary skill in the art would come up with the claimed limitation: “second means ... within the second CD [compact disk] player;” [claim 2, lines 10 to 15] without the blueprint of Appellant’s invention. Therefore, we do not sustain the obviousness rejection of claim 2 over Hasegawa. The obviousness rejection of claim 6, which depends on claim 2 and contains at least the above discussed limitation of claim 2, is also not sustained.

However, claim 5 depends claim 4 and further contains the limitation: “wherein the cutout portion of each holder ... is substantially pie shaped.” [Claim 5, lines 1 to 3]. After considering the Examiner’s rejection [answer, pages 5 and 6] and Appellant’s argument [brief, pages 5 and 6], we agree with the Examiner that the shape of the cutout portion of each holder and the extended portion of the assembly, as long as they match to allow the movement of the assembly through the cutout portion of the disc holders, see figures 1 and 2 of Hasegawa, can be of any shape including being “pie-shaped”. We, therefore, sustain the obviousness rejection of claim 5 over Hasegawa.

Rejection of Claim 3 under 35 U.S.C. § 103

Claim 3 is rejected as being obvious over Hasegawa and Kobayashi. We have considered Appellant's argument [brief, pages 6 and 7] and Examiner's rejection and response [answer, pages 6, 7 and 11]. Claim 3 depends on claim 2 and thus contains at least the above discussed limitation of claim 2. Kobayashi does not cure the deficiency found in Hasegawa in meeting claim 2. Therefore, we will not sustain the obviousness rejection of claim 3 over Hasegawa and Kobayashi.

Rejection of Claim 9 under 35 U.S.C. § 103

Claim 9 is rejected as being obvious over Hasegawa and Amar. We have reviewed Examiner's position [answer, pages 7, 11 and 12] and Appellant's argument [brief, page 8]. We agree with Appellant that Amar neither shows the presence, nor the suggestion, of "an associated latch that abuts an interior edge of the cutout portion... position" [claim 9, lines 1 to 4]. Therefore, we do not sustain the obviousness rejection of claim 9 over Hasegawa and Amar.

In summary, we have affirmed the rejection of claims 1, 4, 7 and 8 as being anticipated over Hasegawa under 35

U.S.C.

§ 102. We also have affirmed the rejection of claim 5 as being obvious over Hasegawa under 35 U.S.C. § 103. However, we have reversed the obviousness rejection under 35 U.S.C. § 103 of claims 2 and 6 over Hasegawa, claim 3 over Hasegawa and Kobayashi and claim 9 over Hasegawa and Amar.

AFFIRMED IN PART

KENNETH W. HAIRSTON Administrative Patent Judge	)	
LEE E. BARRETT Administrative Patent Judge	)	BOARD OF APPEALS AND INTERFERENCES
PARSHOTAM S. LALL Administrative Patent Judge	)	

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