

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

Appeal No. 98-0003
Application No. 08/601,896¹

ON BRIEF

Before COHEN, STAAB, and McQUADE, *Administrative Patent Judges*.

STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-4, 6-12 and 15-17. Claim 5, the only other claim

¹Application for patent filed February 15, 1996.

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remaining in the application, has been indicated by the examiner as being allowable if rewritten in independent form to include all of the limitations of the base claim. Two amendments have been filed subsequent to the final rejection. The first (Paper No. 12), filed March 7, 1997, has been entered. The second (Paper No. 15), filed April 17, 1997, has been denied entry.

Appellant's invention pertains to a support² (element 1 in appellant's drawings) for accommodating an information containing disc (element 19) during both a storage mode, and an operational, or scanning, mode in a playback or recording device, without requiring the disc to be removed from the support. Also disclosed is a holder (element 3 in appellant's drawings) for use with the support when the disc is in a storage mode. Independent claim 1, a copy of which is found in the aforementioned first amendment (i.e., the amendment filed March 7, 1997), is illustrative of the appealed subject matter.

²This element is also termed a "cartridge" in the appealed claims.

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The references of record relied upon by the examiner in support of rejections under 35 U.S.C. § 103 are:

Ouwerkerk et al. (Ouwerkerk) 3, 1992	5,093,823	Mar.
Karakane et al. (Karakane) 1994	5,370,224	Dec. 6,
European Patent (Einhaus) 1989	0,315,255	May 10,

The following rejections under 35 U.S.C. § 103 are before us for review:³

(a) claims 1-4, 6-12, 16 and 17 as being unpatentable over Ouwerkerk in view of Karakane; and

³In the final rejection, claims 1-4, 6-12 and 15-17 were also rejected under 35 U.S.C. § 112, second paragraph. Since these claims have been amended by the first amendment filed subsequent to the final rejection in such a manner so as to apparently overcome the examiner's criticism of the claims, and since no mention of this rejection has been made by the examiner in the answer, we presume that the examiner has withdrawn the final rejection thereof on this ground. *Ex parte Emm*, 118 USPQ 180, 181 (Bd. App. 1957). Additionally, the rejection of claim 16 under 35 U.S.C. § 102(b) made in the final rejection has been withdrawn in view of entry of the first amendment filed subsequent to the final rejection.

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(b) claim 15 as being unpatentable over Ouwerkerk in view of Karakane, and further in view of Einhaus.

The rejections are explained in the examiner's answer (Paper No. 18, mailed June 30, 1997).

The opposing viewpoints of appellant are set forth in the brief (Paper No. 17, filed May 7, 1997).

*The § 103 rejection based on Ouwerkerk and Karakane
(rejection (a))*

At the outset, we note that appellant states on page 5 of the brief that claims 1-4, 6-12 and 17 stand or fall together. We therefore select claim 1 as representative of this group of claims, and decide the appeal of these claims based on that claim alone. See 37 CFR § 1.192(c)(7).

The examiner's rationale in support of the rejection of claim 1, as set forth on pages 3 and 4 of the brief, is not a model of clarity. However, to the extent understood, we cannot support that rationale. Nevertheless, for reasons

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explained *infra*, we believe the reference evidence adduced by the examiner in support of the rejection is sufficient to establish a *prima facie* case of obviousness of the subject matter of representative claim 1. Accordingly, we will affirm the § 103 rejection thereof, and because of the altered thrust of our reasoning, designate our affirmance to be a new ground of rejection under 37 CFR § 1.196(b) in order to provide appellant a fair opportunity to react thereto (*See In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976)).

Considering first Ouwerkerk, this reference pertains to a cartridge 2 for containing a disc 1 during both a storage mode, and an operational, or scanning, mode in a playback or recording device, without requiring the disc to be removed from the cartridge. Accordingly, Ouwerkerk's cartridge corresponds to appellant's claimed "support" or "cartridge" (element 1 in appellant's drawings). Like appellant's cartridge, the cartridge of Ouwerkerk includes a window through which the read head of the playback device accesses the disc. The cartridge of Ouwerkerk is equipped with

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shutters 8 for covering the window to prevent dust and grime from entering the window and damaging the disc. Figure 2 of Ouwerkerk shows the cartridge in the storage mode, with the shutters covering the window, while Figure 3 of Ouwerkerk shows the cartridge in the operational mode, with the shutter pulled back to expose the window and allow access to the disc.

Turning to Karakane, this reference pertains to a disc holder for storing and carrying an information storage disc. With reference to Figure 2 and column 3, lines 34-56, Karakane's disc holder 7 comprises a base member 9 and a sheet member 10 formed of resin material. The sheet member 10 is joined to the base member to form a pocket 11 having a circular line along the edge of the joint, so that the edge of a disc 13 housed in the pocket 11 is in contact along its edge with this circular joint line. In this way, the disc 13 is securely housed in the pocket 11. As can be seen in Figure 2, when housed in the pocket, a major portion of the disc is covered by the base member and the sheet member so that the adhesion of dust or grime to the disc 13 is prevented.

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Although not specifically stated, it is clear from a reading of Karakane's specification that the above noted disc holder 7 is intended only for use in storing the disc. That is, when the disc is to be used in its operational mode in a player device, it must first be removed from the disc holder. Karakane further discloses a case 8 for cooperating with the disc holder 7. According to Karakane (column 4, lines 22-24), the disc holder 7 may be received in the case 8 to securely store the disc. Also, the case may be modified to receive a plurality of holders 7 (column 4, lines 25-31). In that Karakane's disc holder 7 and case 8 only house the disc when it is in the storage mode, Karakane's disc holder 7 and case 8 more or less correspond to appellant's claimed "holder" (element 3 in appellant's drawings).

As we understand it, the examiner has taken the position in rejecting claim 1 that it would have been obvious to one of ordinary skill in the art to provide the cartridge 2 of Ouwerkerk with a sliding holder like that disclosed by Karakane at case 8 "to . . . cover the window portion of the container [of Ouwerkerk] to prevent the accumulation of dust

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and scratches" (answer, page 4). Presumably, cartridge 2 of the proposed Ouwerkerk/Karakane combination would correspond to the "support" of claim 1 and the case 8 of the proposed Ouwerkerk/Karakane combination would correspond to the "holder" of claim 1. However, in that the shutters 8 of Ouwerkerk's cartridge 2 already provide protection from dirt and grime, there is no apparent need for providing Karakane's case to cover the window thereof, as proposed by the examiner. Accordingly, there is simply no cogent reason for the examiner's proposed reference combination, as we understand it.

Returning to the Ouwerkerk reference, Ouwerkerk's support 2 comprises two parallel rigid main walls 3A, 3B, with said main walls having inwardly facing spaced apart inner surfaces for loosely receiving the disc 1 so as to allow it to rotate freely during playback. Main wall 3A has a window 6A and main wall 3B has a window 6B for allowing access to the disc. Thus, Ouwerkerk's cartridge responds to all the requirements of claim 1 regarding the "support" or "cartridge." Appellant is not understood to argue otherwise.

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As to the claim 1 requirements regarding the holder, as noted above, shutters 8 cover the windows in their Figure 2 position. These shutters may collectively be considered a "holder" having a wall portion for covering the windows, as broadly claimed in claim 1. Viewed in this sense, Ouwerkerk provides response for all the limitations of appellant's claim 1, making the teachings of Karakane cumulative in this rejection. While a rejection over a single reference such as Ouwerkerk that responds to all the limitations of a claim would ordinarily be based on 35 U.S.C. § 102 rather than 35 U.S.C. § 103, the practice of nominally basing rejections on § 103 when, in fact, the actual ground of rejection is that the claim is anticipated by the prior art has been sanctioned by a predecessor of our present review court in *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982) and *In re Pearson*, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974). For these reasons, appellant's arguments of nonobviousness are simply not germane to the novelty issue discussed above.

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We therefore will sustain the examiner's rejection of representative claim 1 under 35 U.S.C. § 103, noting however that the reference to Karakane is cumulative. We will also sustain the standing § 103 rejection of claims 2-4, 6-12 and 17 since appellant expressly states that claims 1-4, 6-12 and 17 stand or fall as a group.

Claim 16 is directed to "[a] support for a disc-shaped recording medium for use with a holder in a combination as claimed in claim 1." For purposes of this appeal, we interpret claim 16 as being directed to a support *per se* which is capable of being used with the holder of claim 1. Ouwerkerk's cartridge comprises a support having the required capability, as broadly claimed. Accordingly, Ouwerkerk's cartridge responds to all the limitations of claim 16, as interpreted, such that claim 16 lacks novelty over Ouwerkerk. We therefore will sustain the examiner's rejection of claim 16 under 35 U.S.C. § 103, with the reference to Karakane once again being cumulative. Appellant's argument on page 12 of the brief with respect to claim 16 is moot in that it is directed to limitations to claim 16 that were to be effected

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by the second amendment filed subsequent to the final rejection, which has not been entered.

*The § 103 rejection based on
Ouwkerk, Karakane and Einhaus
(rejection (b))*

Claim 15 is directed to a system including the cartridge and holder combination of claim 1 and a scanning device, with the cartridge having locating apertures and the scanning device having locating pins for cooperation with the locating apertures of the cartridge.

In rejecting this claim, the examiner states on page 4 of the answer that Ouwkerk does not disclose locating pins on the scanning device, as recited in claim 15. The examiner then goes on to make findings with respect to Einhaus. However, the examiner does not point out how Einhaus makes up for the locating pin deficiency of Ouwkerk. Finally, the examiner concludes that it would have been obvious in view of Einhaus "to provide a disc-record player with locating pins . . ." (answer, page 5).

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This rejection cannot be sustained. Because the examiner has failed to point out where in the combined teachings of the references the claimed locating pins are to be found, and because it is not apparent to us where the applied references teach or suggest the claimed locating pins, appellant's general argument that claim 15 is patentable over the combined teachings of Ouwerkerk, Karakane and Einhaus is well taken.

New rejection pursuant to 37 CFR § 1.196(b)

Pursuant to our authority under 37 CFR § 1.196(b), we enter the following new rejection:

Claims 16 and 17 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 16 and 17 read as follows:

16. A support for a disc-shaped recording medium for use with a holder in a combination as claimed in claim 1.
17. A holder for use in a combination with a support as claimed in claim 1.

A first possible interpretation of claim 16 is that it is directed to a support *per se* that is capable of being used

with the holder of claim 1.⁴ Similarly, a first possible interpretation of claim 17 is that it is directed to a holder *per se* that is capable of being used with the support of claim 1. However, the "in a combination" language appearing in each of the claims casts doubt on these interpretations and raises the possibility that the claims are actually intended to cover a support (or holder) in combination with a holder (or support). Our uncertainty is compounded by appellant's statement on page 7 of the brief that claim 1 claims the combination of the support and the holder, and that all other claims depend therefrom.^{5,6}

⁴This is apparently in accord with appellant's understanding of the scope of claim 16. See page 12 of the brief.

⁵The exact quote is: "Applicant's claim 1, upon which all other claims depend, specifically claims the combination of these two parts, the support and the holder . . ." (brief, page 7; emphasis added).

⁶Of course, if claims 16 and 17 are directed to, respectively, a support *per se* and a holder *per se*, and if they are dependent claims depending from claim 1, they are improper dependent claims because they do not further limit the subject matter of the claim from which they depend. See 35 U.S.C. § 112, fourth paragraph.

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The purpose of the requirement stated in the second paragraph of 35 U.S.C. § 112 is to provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent, with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. *In re Hammack*, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). For the reasons stated above, we do not believe claims 16 and 17 meet this requirement.

Summary

The rejection of claims 1-4, 6-12, 16 and 17 as being unpatentable over Ouwerkerk in view of Karakane (rejection(a)) is affirmed, our affirmance being designated a new ground of rejection under 37 CFR § 1.196(b).

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The rejection of claim 15 as being unpatentable over
Ouwkerk in view of Karakane, and further in view of Einhaus
(rejection (b)) is reversed.

Pursuant to our authority under 37 CFR § 1.196(b), a new
rejection of claims 16 and 17 under 35 U.S.C. § 112, second
paragraph, has been made.

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

This decision contains a new ground of rejection pursuant
to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final
rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203
Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

§ 1.196(b) provides that, "A new ground of rejection shall not
be considered final for purposes of judicial review."

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37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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; 37 CFR § 1.196(b)

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Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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