

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ASHOK B. NAYAK

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Appeal No. 1998-1798  
Application No. 08/596,538<sup>1</sup>

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ON BRIEF

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Before ABRAMS, NASE, and GONZALES, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 9, 17, 19 and 20, which are all of the claims pending in this application.<sup>2</sup>

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<sup>1</sup> Application for patent filed February 5, 1996.

<sup>2</sup> Claims 1 and 17 were amended subsequent to the final rejection.

Appeal No. 1998-1798  
Application No. 08/596,538

We REVERSE.

BACKGROUND

The appellant's invention relates to a tape moving mechanism using a direct drive motor. A copy of the claims under appeal appears in the appendix to the appellant's reply brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Ohkubo et al. (Ohkubo)	5,272,579	Dec. 21,
1993		

Claims 1 to 9, 17, 19 and 20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 1 to 9, 17, 19 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ohkubo.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted

rejections, we make reference to the final rejection (Paper No. 7, mailed June 13, 1997) and the examiner's answer (Paper No. 10, mailed January 21, 1998) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 9, filed November 17, 1997) and reply brief (Paper No. 11, filed March 16, 1998) for the appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

#### **The indefiniteness issue**

We will not sustain the rejection of claims 1 to 9, 17, 19 and 20 under 35 U.S.C. § 112, second paragraph.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

The examiner stated (final rejection, pp. 2-3) that

[t]he claims reciting the following **functions/functional languages** lack recitation of sufficient structures/elements and/or necessary structural cooperation between the structures/elements to enable the functions to be effected: "is thereby rotatably driven ... motor" (claim 1, last two lines) . . . "whereby ... cartridge" (claim 17, last three lines).

The appellant argues (brief, pp. 6-8 and reply brief, pp. 2-4) that claims 1 and 17 comply with the requirements of 35 U.S.C. § 112, second paragraph. In addition, the appellant argues that the examiner has not provided a basis in fact and/or cogent technical reasoning to support a legal conclusion of indefiniteness. We agree.

In our view, claims 1 and 17 define the metes and bounds of the claimed invention with a reasonable degree of precision

and particularity. Specifically, we find the functional language set forth in the wherein clause of claim 1 and the whereby clause of claim 17 to be definite. In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977).

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented can be determined from the language of the claims with a reasonable degree of certainty,

a rejection of the claims under 35 U.S.C. § 112, second paragraph, is inappropriate.

Furthermore, the appellant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the Court in In re Swinehart, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

For the reasons stated above, claims 1 and 17 are considered by us to be definite, as required by the second paragraph of 35 U.S.C. § 112. Accordingly, the decision of the examiner to reject claims 1 to 9, 17, 19 and 20 under 35 U.S.C. § 112, second paragraph, is reversed.

**The obviousness issues**

We will not sustain the rejection of claims 1 to 9, 17, 19 and 20 under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)). In considering the question of the obviousness of the claimed invention in view of the prior art relied upon, we are guided by the basic principle that the question under 35 U.S.C. § 103 is not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the art at the time the invention was made. See Merck & Co., Inc. v. Biocraft Laboratories, Inc., 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). When it is necessary to select elements of various teachings in order to form the

claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the appellant. That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the modification. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

With this as background, we analyze the prior art applied by the examiner in the rejection of the claims on appeal.

Ohkubo discloses a tape drive apparatus 100 for driving a drive roller 9 in a data cartridge 5 that advances tape 11 in the tape cartridge. As shown in Figures 5 and 6, the tape drive apparatus 100 includes a movable base member 24 arranged to pivot about shaft 36 in a direction generally opposite to a direction of insertion of the data cartridge 5 in the tape drive apparatus 100; a motor 23 mounted to the movable base

member 24 and having a rotatable outer rotor 27; and a roller member 35 mounted on and around the outer rotor 27 of the motor 23. The movable base member 24 and motor 23 are positioned within the tape drive apparatus 100 such that when the drive roller 9 of the data cartridge 5 has been inserted into the tape drive apparatus 100, the drive roller 9 directly contacts and bears upon the roller member 35 and is thereby driven rotatably by the motor 23 upon rotation of the rotor 27 of the motor 23.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Ohkubo and claims 1 and 17 (the independent claims on appeal), it is our opinion that the only differences are: (1) claim 1 recites that the movable plate is arranged "to move in a linear direction parallel to a direction of insertion of the tape cartridge in

the tape drive;" and (2) claim 17 recites that the motor "moves in the substantially linear direction with the tape cartridge."

With regard to these differences, the examiner determined (answer, p. 4) that to have arranged Ohkubo base member 24 to move in a linear direction (rather than pivoting about shaft 36) would have been an obvious matter of design choice to a person having ordinary skill in the art.

The appellant argues (brief, pp. 8-14 and reply brief, pp. 5-8) that the examiner has not presented a prima facie case of obviousness. We agree. It is our opinion that the examiner has not proffered a sufficient factual basis to support his conclusion of obviousness. In that regard, we note that the examiner has not presented any evidence that it was known in the tape drive art (or any analogous art) to either (1) arrange the drive motor support plate to move in a linear direction parallel to a direction of insertion of a tape cartridge in the tape drive as recited in claim 1, or (2) arrange the motor to move in a substantially linear direction

with the tape cartridge as recited in claim 17. The conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

For the reasons stated above, the examiner has not presented a prima facie case of obviousness with respect to the claims on appeal. Accordingly, the decision of the

examiner to reject claims 1 to 9, 17, 19 and 20 under 35  
U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject  
claims 1 to 9, 17, 19 and 20 under 35 U.S.C. § 112, second  
paragraph, is reversed and the decision of the examiner to  
reject claims 1 to 9, 17, 19 and 20 under 35 U.S.C. § 103 is  
reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JOHN F. GONZALES	)	
Administrative Patent Judge	)	

JVN/gjh

Appeal No. 1998-1798  
Application No. 08/596,538

Page 15

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APPEAL NO. 1998-1798 - JUDGE NASE  
APPLICATION NO. 08/596,538

APJ NASE

APJ GONZALES

APJ ABRAMS

DECISION: **REVERSED**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 17 Mar 99

**FINAL TYPED:**

**PANEL CHANGE (GONZALES FOR COHEN)**