

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 TAKAHIRO SAKAGUCHI

Appeal No. 1998-3365
Application No. 08/673,214

ON BRIEF

Before JERRY SMITH, RUGGIERO, and BLANKENSHIP, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1, 3 and 4, which constitute all the claims remaining in the application.

The disclosed invention pertains to an optical disk apparatus comprising an optical head for writing and reading

information, an optical head moving means and an optical disk supporting and rotating means. The invention particularly relates to a recess created by protrusions in a rotor unit which form a space that the optical head goes into when the head is moved to a position corresponding to an innermost portion of the optical disk.

Representative claim 1 is reproduced as follows:

1. An optical disk apparatus comprising:

an optical head for writing and reading information to and from an optical disk while being opposed thereto;

optical head moving means for moving the optical head in a radial direction of the optical disk;

disk supporting and rotating means including:

a pole-shaped portion extending along a rotation axis of the optical disk;

a rotor unit which has a rotor magnet and rotates while supporting the optical disk; and

a stator unit having a stator coil that is disposed in the vicinity of the rotor magnet,

the rotor unit including first and second protrusions extending outward from the pole-shaped portion so as to form a recess in between, the first protrusion being a portion for supporting the optical disk while contacting with it, the second protrusion being a portion for accommodating the rotor magnet, and the recess being a space which the optical head goes into when it is moved to a position corresponding to an innermost portion of the optical disk, wherein a sum of a

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It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1, 3 and 4. Accordingly, we reverse.

Appellant has indicated that for purposes of this appeal the claims will all stand or fall together as a single group [brief, page 5]. Consistent with this indication appellant has made no separate arguments with respect to any of the claims on appeal. Accordingly, all the claims before us will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will consider the rejection against independent claim 1 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual

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determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467

(1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the

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relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

With respect to representative, independent claim 1, the examiner points out several features of the magnetic disk apparatus taught by Ohsawa. The examiner observes that Ohsawa teaches all the features of claim 1 except for the recitation of an optical head. The examiner finds that it would have been obvious to the artisan to place the spindle motor of Ohsawa into an optical disk drive to read and write from an optical head rather than a magnetic head as taught by Ohsawa [answer, pages 3-4]. The examiner also indicates that the relationship recited in the last clause of claim 1 is met by the magnetic head apparatus of Ohsawa.

Appellant argues that the magnetic disk supporting and rotating means of Ohsawa does not need the protrusions and

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recess as recited in claim 1, and appellant argues that there is no recess in Ohsawa. Appellant also argues that Ohsawa teaches no design relationship between an optical head and a recess [brief, pages 6-8]. The examiner responds that the recess formed by protrusions 2b and 11a of Ohsawa form a recess as recited in claim 1. The examiner argues that there is no requirement that the protrusions overlap one another in order to form the claimed recess [answer, pages 5-6].

Appellant responds that the first protrusion must extend radially over a portion of the second protrusion in order to form a recess in between as recited in claim 1 [reply brief].

We agree with the position argued by appellant. The first and second protrusions of Ohsawa identified by the examiner (2b and 11a) do not form a recess in between, the recess being a space which the optical head goes into when it is moved to a position corresponding to an innermost portion of the optical disk as recited in claim 1. We agree with appellant that the claimed recess must be formed by protrusions which at least partially overlap each other to create the space into which the optical head is moved. Protrusions 2b and 11a of Ohsawa do not form such a recess.

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We also do not agree with the examiner that the relationship in the last clause of claim 1 is satisfied by the apparatus of Ohsawa. The claimed relationship has one parameter defined as the "distance between a lens portion and an inner end of the optical head." Since Ohsawa relates to a magnetic head only, there is no suggestion of any relationship using a distance between a lens portion and an inner end of the optical head since the magnetic head of Ohsawa does not have these components. The artisan would have no motivation to consider this relationship based on the magnetic disk apparatus of Ohsawa.

In summary, Ohsawa does not provide evidentiary support for the rejection as proposed by the examiner. Therefore, the decision of the examiner rejecting claims 1, 3 and 4 is reversed.

REVERSED

JERRY SMITH

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