

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENJI TAKAHASHI

Appeal No. 1999-0565
Application 08/700,526

ON BRIEF

Before KRASS, JERRY SMITH and RUGGIERO, 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 1-4, 6 and 8-10, which constitute all the claims remaining in the application. An amendment after final rejection was filed on March 16, 1998 and was entered by the examiner.

Appeal No. 1999-0565
Application 08/700,526

The disclosed invention pertains to a disk cartridge for containing a disk used for the recording and reproduction of data to and from the disk.

Representative claim 1 is reproduced as follows:

1. A disk cartridge comprising:

a cartridge body formed by mating and connecting an upper half and a lower half,

a disk accommodated rotatably in said cartridge body and having data signals recorded on it,

a disk support projecting from at least one of the facing inner surfaces of the cartridge body corresponding to the non-signal recording region of the inner periphery of the disk,

a plurality of disk support members with a high wear resistance and high lubricity arranged in a ring at predetermined intervals on a surface of the disk support facing the disk, and

a recording and/or reproduction use opening formed in the cartridge body, wherein said disk support is formed in a substantially horseshoe shape having a cutaway portion at a side facing the recording and/or reproduction use opening and said disk support members are arranged at a plurality of locations spread at equal intervals in the circumferential direction of said substantially horseshoe shaped disk support,

wherein said disk support members are arranged at least at three locations spread at equal intervals in the circumferential direction of said substantially horseshoe shaped disk support.

The examiner relies on the following references:

Tanaka et al. (Tanaka)	4,863,031	Sep. 05, 1989
------------------------	-----------	---------------

Appeal No. 1999-0565
Application 08/700,526

Takahashi	5,084,861	Jan. 28, 1992
Hashimoto et al. (Hashimoto) (Japanese)	51-111334	Sep. 08, 1976

The admitted prior art set forth in appellant's application.

The following rejections are on appeal before us:

1. Claims 1, 2, 6 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of the admitted prior art in view of Takahashi.

2. Claim 3 stands rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of the admitted prior art in view of Takahashi and further in view of Tanaka.

3. Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of the admitted prior art in view of Takahashi and further in view of Hashimoto.

4. Claims 9 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of the admitted prior art in view of Takahashi and Tanaka.

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

Appeal No. 1999-0565
Application 08/700,526

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

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 have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-4, 6 and 8-10. Accordingly, we affirm.

Even though the examiner has applied three different groupings of references to reject all the claims on appeal, appellant has, nevertheless, indicated that the claims should stand or fall together in a single group [brief, page 3]. Consistent with this indication, appellant has only argued the rejections with respect to claim 1 and claim 9 (relying on the arguments made for claim 1). Since appellant has not argued each of the rejections independently, we will consider the

Appeal No. 1999-0565
Application 08/700,526

rejection against independent claim 1 as representative of all the claims on appeal. 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).

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 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

Appeal No. 1999-0565
Application 08/700,526

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 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 refers to the admitted prior art of appellant's

Appeal No. 1999-0565
Application 08/700,526

Figure 4 as disclosing the claimed invention except that the admitted prior art has a single disk support member 117 instead of the claimed plurality of disk support members. The examiner cites Takahashi as teaching a disk cartridge which has a plurality of disk support members spaced around the disk support. The examiner finds that it would have been obvious to the artisan to replace the single support member of the admitted prior art with the plural support members as taught by Takahashi [answer, pages 3-4].

Appellant makes four arguments which we will consider in turn. Appellant's first argument is that the admitted prior art does not teach that the disk support member has high wear resistance [brief, page 5]. The examiner responds that the material used in the admitted prior art is disclosed to be polyacetal resin, and the examiner asserts that this material inherently has high wear resistance and high lubricity [answer, pages 8-9].

We agree with the examiner on this point. Appellant never denies that polyacetal resin has high wear resistance as well as high lubricity. In any event, we find that it would

Appeal No. 1999-0565
Application 08/700,526

have been obvious to use disk support members with a high wear resistance so that the disk would be protected for a longer period of time.

Appellant's second argument is that the artisan would not look to Takahashi to modify the high wear resistant and high lubricity support member of the admitted prior art because Takahashi teaches silicone rubber disk support members with rough top surfaces and Takahashi also uses additional support surfaces along the outer rim of the disk as well [brief, page 6]. The examiner responds that the rough top surface in Takahashi is used to prevent the disk from sticking to the support member, and therefore, the rough surface operates to improve lubricity [answer, page 8]. The examiner also responds that the language of claim 1 does not preclude additional support members along the outer periphery of the disk [id., page 9].

We agree with the examiner's position as set forth in the answer. Takahashi does not teach away from support members having high wear resistance and high lubricity. The construction of the plural support members in Takahashi is consistent with these properties. Takahashi is only being

used to teach the plurality of support members. There is no reason why the material of the support member of the admitted prior art would have been changed when making the proposed modification.

Appellant's third argument is that the modification proposed by the examiner would not have been obvious to a person of ordinary skill in the art [brief, page 6]. We find, however, that the examiner has properly established a prima facie case of the obviousness of claim 1.

Appellant's fourth argument is that there is no suggestion that a plurality of support members with high wear resistance and high lubricity could be used to support a disk on the inner periphery without the need for other supporting members on the outer periphery or a continuously formed support member on the inner periphery [brief, page 7]. As noted above, the examiner has properly pointed out that the presence of support members on the outer periphery of the disk in Takahashi does not detract from the teachings of the inner periphery support members. Claim 1 does not preclude such outer periphery support members as an additional teaching of a reference. Takahashi still teaches the plurality of support

Appeal No. 1999-0565
Application 08/700,526

members as recited in claim 1.

In summary, we find that the examiner has established a prima facie case of the obviousness of claim 1. We have considered each of appellant's arguments in the brief, and we have not found any of them to be persuasive that the examiner's rejection is improper. Therefore, we sustain the rejection of claim 1 and of claims 2-4, 6 and 8-10 which have not been separately argued. Accordingly, the decision of the examiner rejecting claims 1-4, 6 and 8-10 is affirmed.

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

AFFIRMED

Appeal No. 1999-0565
Application 08/700,526

ERROL A. KRASS)	
Administrative Patent Judge)	
)	
)	
JERRY SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	

js/ki

Appeal No. 1999-0565
Application 08/700,526

Oblon, Spivak, McClelland
Maier & Neustadt
1755 Jefferson Davis Highway
Fourth Floor
Arlington, VA 22202