

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN CHRISTOPHER MORRIS,
BRIAN ROBERT POLLOCK
and
TIMOTHY FRANCIS ELLIS

Appeal No. 2002-1300
Application 09/481,422

ON BRIEF

Before JERRY SMITH, BARRETT, 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 claim 17, which constitutes the only claim remaining in the application.

Appeal No. 2002-1300
Application 09/481,422

The disclosed invention pertains to a disc drive having a servo loop which includes a head and a servo controller. The servo loop is coupled to a compensation means which compensates the disc drive for repeatable run-out.

Sole claim 17 is reproduced as follows:

17. A disc drive comprising:

a servo loop including a head and a servo controller
capable of controlling the location of the head;
and

compensation means coupled to the servo loop for
compensating for repeatable run-out.

The examiner relies on the following reference:

Witt et al. (Witt) 5,535,072 July 9, 1996

Claim 17 stands rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Witt.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence

Appeal No. 2002-1300
Application 09/481,422

of anticipation relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the disclosure of Witt does not fully meet the invention as set forth in claim 17. Accordingly, we reverse.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. 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); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner has indicated how he finds the claimed invention to be fully met by the disclosure of Witt [answer,

page 3]. Appellants argue that the compensation means of claim 17 is recited in means-plus-function form. They argue that the disclosed structure corresponding to the compensation means is limited to compensation values that are defined by the servo loop's transfer function. Appellants argue that Witt does not determine the transfer function of his servo loop and does not use the servo loop's transfer function to generate the compensation values. According to appellants, Witt does not disclose the claimed compensation means nor an equivalent to the claimed compensation means [brief, pages 4-7]. The examiner responds that the compensation means of Witt performs the same function as the claimed compensation means and the artisan would instantly recognize that the claimed compensation means and the prior art compensation means are equivalent for the function of compensating for repeatable run-out [answer, pages 3-6]. Appellants respond that in order for the examiner to find an equivalent, the examiner must find that the prior art element performs the specific function in the claim in substantially the same way and produces substantially the same result. Appellants argue that the compensation means of Witt does not perform

Appeal No. 2002-1300
Application 09/481,422

compensation in the same way as the disclosed and claimed compensation means [reply brief].

As noted from the arguments above, the issue in this appeal is whether the structure disclosed by Witt can be said to anticipate under 35 U.S.C. § 102 the compensation means of claim 17 when the compensation means is interpreted to mean the corresponding structure disclosed in appellants' specification and its equivalents. Although the only corresponding "structure" disclosed in appellants' specification is a box labeled "COMPENSATION CIRCUIT" in Figure 4, the compensation circuit performs the process shown in Figures 5 or 6. Appellants' argument is essentially that the prior art compensation means must perform the function of the claimed compensation means in substantially the same way to produce substantially the same result.

We agree that appellants' argument constitutes at least one way in which an examiner can demonstrate equivalence between the prior art and the claimed means. Four factors are pointed out at MPEP § 2183 to demonstrate equivalence. Each of these factors requires a factual analysis to support the ultimate

Appeal No. 2002-1300
Application 09/481,422

finding of equivalence. We agree with appellants that the examiner has failed to provide any evidence, other than his mere opinion, that the structure disclosed by Witt is an equivalent to the claimed compensation means. The structure disclosed in Witt clearly performs the claimed function in a different way from the corresponding structure disclosed in appellants' specification, and the Witt structure is not clearly interchangeable with the appellants' disclosed structure. Since we find that appellants have demonstrated non-equivalence, and since the rejection is under 35 U.S.C. § 102, we do not sustain the examiner's rejection of claim 17.

Although we have found that Witt does not disclose an equivalent structure under 35 U.S.C. § 102, MPEP § 2183 also notes that the examiner should also consider whether the prior art supports a rejection under 35 U.S.C. § 103. We have made no findings as to whether the claimed compensation means would have been obvious to the artisan within the meaning of 35 U.S.C. § 103. We leave it to the examiner to determine in the first

Appeal No. 2002-1300
Application 09/481,422

instance whether a rejection under 35 U.S.C. § 103 is appropriate based on Witt or on any other prior art.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	

JS:psb

Appeal No. 2002-1300
Application 09/481,422

Theodore M. Magee
Westman Champlin & Kelly
Suite 1600 International Centre
900 South Second Avenue
Minneapolis, MN 55402-3319