

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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte FREDERICK FRANK KAZMIERCZAK  
and MICHAEL JOHN RAFFETTO

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Appeal No. 2002-1477  
Application No. 09/544,849

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ON BRIEF

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

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 13-22, which are all of the claims pending in the present application. Since Appellants indicate (Brief, page 1) that the rejection of claims 13 and 16 is not being appealed, the appeal as to those claims is hereby dismissed. Accordingly, only the Examiner's rejection of claims 14, 15, and 17-22 is before us on appeal.



Appeal No. 2002-1477  
Application No. 09/544,849

Claims 14, 15, and 17-22, all of the appealed claims, stand finally rejected under 35 U.S.C. § 102(b) as being anticipated by Nishimura.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (Paper No. 14) and Answer (Paper No. 15) for the respective details.

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of anticipation relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Brief 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 Nishimura reference does not fully meet the invention as set forth in claims 14, 15, and 17-22. 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,

Appeal No. 2002-1477  
Application No. 09/544,849

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).

With respect to independent claim 14, the Examiner attempts to read the various limitations on the disclosure of Nishimura. In particular, the Examiner (Answer, page 3) points to the illustrations in Figures 4 and 5 of Nishimura of the spring element 6 which is disposed between a disc 3 and spindle motor hub 2 and which serves to mount the disc to the hub.

Appellants' arguments in response (Brief, pages 9-18) focus on the assertion that independent claim 14 is set forth in means-plus-function format and that the Examiner has not properly interpreted the limitations of the appealed claims in accordance with the decision in In re Donaldson, 16 F.3d 1189, 1191, 29 USPQ2d 1845, 1848-49 (Fed. Cir. 1994). After reviewing the Nishimura reference in light of the arguments of record, we are in general agreement with Appellants' position as stated in the Brief.

As alluded to by Appellants, in order to properly interpret a claimed means-plus-function element, the Examiner's burden of establishing a prima facie case involves at least two requirements. Initially, the Examiner must provide evidence that the structure identified in a prior art reference actually performs the function

Appeal No. 2002-1477  
Application No. 09/544,849

set forth in the claims. Further, the Examiner is required to show whether the identified prior art structure which performs such a function is equivalent to the structure disclosed in Appellants' specification.

While it is indisputable that Nishimura's spring elements 6 perform the function of mounting a disc to a spindle motor hub, it is our view that the Examiner has not established that Nishimura's spring elements perform the claimed disc mounting function in the same manner as the corresponding elements described in Appellants' specification. See Kemco Sales, Inc. v. Control Papers Co., 208 F.3d 1352, 1360, 54 USPQ2d 1308, 1316 (Fed. Cir. 2000). At pages 5 and 10 of the specification and in Figures 3 and 4 of the drawings, Appellants describe a disc mounting structure in the form of a spring element 50 which is C-shaped in cross-section. As asserted by Appellants (Brief, pages 2 and 10), the arms of the C grip the upper and lower surfaces of the disc thereby immobilizing the disc in the axial direction while the disc-plane curvature of the spring element immobilizes the disc in the radial direction. In contrast to the C-shaped spring element 50 of Appellants which envelops the disc by gripping the upper and lower surfaces of the disc, the wavy shaped spring element 6 of Nishimura is wedged between the hub and the disc hole. While the compressive force established by

Appeal No. 2002-1477  
Application No. 09/544,849

Nishimura's spring element 6 tends to hold the disc and hub in fixed positions in the radial direction, there is no restraint against movement in the axial direction.

In view of the above discussion, it is our opinion that the disclosure of the Nishimura reference does not provide the factual basis necessary to support a finding that the spring element disc mounting structure disclosed therein is of the equivalent structure and arranged in an equivalent manner to the C-shaped mounting structure described in Appellants' disclosure. Accordingly, since all of the claim limitations are not present in the disclosure of Nishimura, the Examiner's 35 U.S.C. § 102(b) rejection of independent claim 14, as well as claim 15 dependent thereon, is not sustained.

Turning to a consideration of the Examiner's 35 U.S.C. § 102(b) rejection of independent method claim 17 which concludes with a disc mounting step, we do not sustain this rejection as well. We note that, while the absence of "step for" language associated with the "mounting" step raises a rebuttable presumption that the limitation should not be construed as a "step-plus-function" limitation, it is our view that Appellants' arguments (Brief, pages 20-22) successfully rebut this presumption. The Federal Circuit has recognized that the absence of express "step-

Appeal No. 2002-1477  
Application No. 09/544,849

plus-function" language is not conclusive as to whether a claim limitation will be interpreted as invoking 35 U.S.C. § 112, sixth paragraph. See Seal-Flex, Inc. v. Athletic Track and court Construction, 172 F.3d 836, 850, 50 USPQ2d 1225, 1234 (Fed. Cir. 1999). Similarly, it has been held that the word "step" is not necessary in setting forth a "step-plus-function" limitation. See In re Roberts and Burch, 470 F.2d 1399, 1401, 176 USPQ 313, 315 (CCPA 1973).

We also find to be convincing Appellants' arguments (Brief, page 21) that the claim language "in a manner such that" is equivalent to the language "so that" which the Federal Circuit has construed as being equivalent to "means for" language. See Greenburg v. Ethicon Endo-Surgery, Inc., 91 F.3d 1580, 1584, 39 USPQ2d 1783, 1786-87 (Fed. Cir. 1996), citing Raytheon Co. v. Roper Corp., 724 F.2d 951, 957, 220 USPQ 592, 597 (Fed. Cir. 1983), cert denied, 469 U.S. 835 (1984). In view of the above discussion, since we agree with Appellants that the claim language of independent claim 17 properly invokes the provisions of the sixth paragraph of 35 U.S.C. § 112, it is our view that the Examiner has not established a prima facie case of anticipation. For all of the reasons discussed supra with regard to independent claim 14, the Examiner has not shown how the spring element 6 in Nishimura is

Appeal No. 2002-1477  
Application No. 09/544,849

equivalent to and arranged in the same manner as Appellants C-shaped disc mounting structure.

We also do not sustain the Examiner's 35 U.S.C. § 102(b) rejection of independent claims 18 (and its dependent claims 19 and 20) and 21. Each of independent claims 18 and 21 contains the language "means for mounting" which, as previously discussed, we found must be properly interpreted as invoking the sixth paragraph of 35 U.S.C. § 112. Under this interpretation, we reiterate our finding that the Examiner has not established the equivalence of Nishimura's spring element and Appellants' C-shaped mounting structure.

We also find to be without merit the Examiner's contention (Answer, pages 5, 6, 10 and 11) that the "means for mounting" language need not be given patentable weight since claims 18 and 21 are method claims. Our reviewing courts have held that, in assessing patentability of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1282, 1385, 165 USPQ 494, 496 (CCPA 1970). We further agree with Appellants (Brief, page 24) that the C-shaped mounting structure described in the

Appeal No. 2002-1477  
Application No. 09/544,849

specification, and which corresponds to the claimed "means for mounting," clearly affects the method of mounting a disc to a hub in accordance with the criteria for giving patentable weight to structural limitations in method claims set forth in the Leesona case cited (Answer, page 6) in support of the Examiner's position.

Lastly, we do not sustain the Examiner's 35 U.S.C. § 102(b) rejection of independent method claim 22 which includes specific structural limitations directed to the C-shaped disc mounting structure. As in our previous discussion, we find no basis for the Examiner disregarding the structural limitations directed to the claimed mounting elements, especially since the claimed C-shaped structure clearly affects the method of mounting a disc to a hub as claimed.

In summary, we have not sustained the Examiner's 35 U.S.C. § 102(b) rejection of any of the claims on appeal. Accordingly,

Appeal No. 2002-1477  
Application No. 09/544,849

the decision of the Examiner rejecting claims 14, 15, and 17-22 is reversed.

REVERSED

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JERRY SMITH	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JOSEPH F. RUGGIERO	)	
Administrative Patent Judge	)	

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Appeal No. 2002-1477  
Application No. 09/544,849

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