

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. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JUNG-WAN KO, DONG-HO SHIN, IN-SIK PARK,
YOUNG-SUN SEO, HAN-KOOK CHOI, JONG-PHIL PARK,
HEE-DEUK PARK, and KYU-HYOONG LEE,

Appeal No. 2002-1860
Application No. 09/204,275

HEARD: AUGUST 19, 2003

Before KRASS, 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 1-8, 33-40, and 42-53, which are all of the claims pending in the present application. Claims 9-32 and 41 have been canceled. At page 3 of the Answer, the Examiner indicates the allowability of claims 44-47. Accordingly, only the Examiner's rejection of claims 1-8, 33-40, 42, 43, and 48-53 is before us on appeal. Amendments

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after final rejection filed January 23, 2001 and June 15, 2001 have been approved for entry by the Examiner.

The claimed invention relates to a cartridge for receiving a disc which includes an opening cover separably mounted to a rear side of the cartridge. Further included in the cartridge case is a sensor hole, which is opened and closed by a sensor lever, to sense whether the disc has been withdrawn from the cartridge case. A user can manipulate the opening and closing mechanism to prevent the automatic application of a verification operation before recording on the disc.

Claim 6 is illustrative of the invention and reads as follows:

6. A cartridge for receiving a disc, comprising:

a cartridge case to receive the disc;

an opening cover separably mounted to a side of the cartridge case, to support the disc to be withdrawn/received from/into the cartridge case;

at least one sensor hole to determine whether the disc has been withdrawn from the cartridge case;

a sensor lever having an opening/closing member disposed at the sensor hole, to control opening/closing of the sensor hole in accordance with states of the disc; and

a tension part extending over a side of the sensor lever and in contact with an inner side surface of the cartridge case, to provide a tension of a predetermined degree to the sensor lever, and position the opening/closing member of the sensor lever toward an open-position of the sensor hole when the opening cover is opened.

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The Examiner relies on the following prior art:

Akiyama	5,289,457	Feb. 22, 1994
Satoh et al. (Satoh)	5,903,531	May 11, 1999 (filed Feb. 13, 1997)
Fujiura	6,052,359	Apr. 18, 2000 (filed Aug. 19, 1997)

Claims 6-8, 33-36, 38, 39, 42, 43, 48, 49, and 51-53 stand finally rejected under 35 U.S.C. § 102(e) as being anticipated by Fujiura. Claims 1-5, 37, 40, and 50 stand finally rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner offers Fujiura in view of Akiyama with respect to claims 1-5, and Fujiura in view of Satoh with respect to claims 37, 40, and 50.¹

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs² and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, and the evidence of anticipation and obviousness relied upon by the Examiner as support

¹ At page 2 of the Answer, the Examiner indicates that the indefiniteness rejection of claims 36-38 under 35 U.S.C. § 112, second paragraph, has been withdrawn.

² The Appeal Brief was filed June 15, 2001 (Paper No. 22). In response to the Examiner's Answer dated July 17, 2001 (Paper No. 25), a Reply Brief was filed September 13, 2001 (Paper No. 28), which was acknowledged and entered by the Examiner as indicated in the communication dated September 19, 2001 (Paper No. 31).

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for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs 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 Fujiura reference does not fully meet the invention as set forth in claims 6-8, 33-36, 38, 39, 42, 43, 48, 49, and 51-53. With respect to the Examiner's 35 U.S.C. § 103(a) rejection, we are also of the view 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 recited in claims 1-5, 37, 40, and 50. Accordingly, we reverse.

We consider first the rejection of claims 6-8, 33-36, 38, 39, 42, 43, 48, 49, and 51-53 under 35 U.S.C. § 102(e) as being anticipated by Fujiura. 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.

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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 claims 6, 33, 48, and 51, the Examiner attempts to read the various limitations on the disclosure of Fujiura. In particular, the Examiner directs attention to the illustrations in Figures 2 and 5-8 of Fujiura along with the accompanying description beginning at column 1, line 52.

Appellants' arguments in response, initially directed to the limitations in independent claim 6, assert a failure of Fujiura to disclose every limitation in claim 6 as is required to support a rejection based on anticipation. In particular, Appellants assert (Brief, pages 13-15; Reply Brief, pages 3 and 4) that, at the very least, Fujiura lacks a disclosure of a sensor lever having a tension part which provides a predetermined degree of tension to the sensor lever to position the sensor lever toward the open position of the sensor hole when the cover is opened, all as set forth in appealed claim 6.

After reviewing the Fujiura reference in light of the arguments of record, we are in general agreement with Appellants' position as expressed in the Briefs. At the outset, we find no basis for the Examiner's position that the supporting pieces 27 in

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Fujiura, which the Examiner likens to the claimed opening/closing member, also have a tension part providing a predetermined degree of tension to the pin member 26, which the Examiner contends corresponds to the claimed sensor lever. In addition, we find no reasonable interpretation of the language of claim 6 which would support the Examiner's conclusion that the support members 27 of Fujiura, circumferentially spaced around the sensor hole 23 and which are removed by an external tool 28 to open the sensor hole, function to position the opening closing member (pin 26 which is removed by the tool 28) to an open position when the cover is opened.

In view of the above discussion, since all of the claim limitations are not present in the disclosure of Fujiura, we do not sustain the Examiner's 35 U.S.C. § 102(e) rejection of independent claim 6, nor of claims 7 and 8 dependent thereon.

We also find ourselves in agreement with Appellants' arguments with respect to independent claims 33, 48, and 51 and, accordingly, we do not sustain the Examiner's 35 U.S.C. § 102(e) rejection based on Fujiura of claims 33, 48, and 51, nor of claims 34-40, 42-44, 49, 50, 52, and 53 dependent thereon. Our review of the disclosure of Fujiura finds a fundamental difference between what is described in Fujiura and what is set forth in appealed

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independent claims 33, 48, and 51. As pointed out by Appellants (Reply Brief, page 5), once the pin member 26 is removed from sensor hole 23 in Fujiura to provide an indication of an open state, there is no disclosure of any mechanism to control the sensor hole to provide a second state and, in actuality, we find no disclosure of the existence of a second state at all in Fujiura once pin 26 is removed. In view of this fundamental deficiency in Fujiura, we find no disclosure of the control of the sensor hole to an inspected state as set forth in claim 33, no recording without performing a verification process when the sensor hole is in a second state as recited in claim 48, and no resetting of the sensor hole to the first state from a second state based on a user command as set forth in claim 51.

Turning to a consideration of the Examiner's 35 U.S.C. § 103(a) rejection of appealed claims 1-5 based on the combination of Fujiura and Akiyama, we do not sustain this rejection as well. As stated at page 13 of the Answer, the Examiner recognizes that Fujiura has no disclosure of any means for repeatedly opening and closing the sensor hole 23. To address this deficiency, the Examiner turns to the disc cartridge system disclosure of Akiyama which describes a shutter mechanism 6 controlled by a coil spring 10 that is used to open and close spindle hole 4 and head insertion

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hole 5. According to the Examiner (id.), the skilled artisan would have been motivated and found it obvious to add a repeat open and close feature to the device of Fujiura “. . . to avoid disc contamination, as suggested by Akiyama, column 4, line 6.”

Appellants' arguments (Brief, pages 24 and 25; Reply Brief, page 12) in response to the obviousness rejection assert that a prima facie case of obviousness has not been established since there is no suggestion or motivation in the disclosures of the Fujiura and Akiyama references for the Examiner's proposed combination. Upon careful review of the applied prior art in light of the arguments of record, we are in general agreement with Appellants' stated position in the Briefs. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

While the Examiner asserts a problem with disc contamination through an open sensor hole as the motivation for the proposed combination of Fujiura and Akiyama, there is no indication in Fujiura of any problem with disc contamination through the sensor hole. To the contrary, as pointed out by Appellants, the sensor hole 23 in Fujiura extends through the upper and lower cases to

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create a chamber that is physically isolated from the disc chamber so that, even with the pin 26 removed, there is no danger of disc contamination through the open sensor hole. Given the above disclosures of the prior art, it is our view that any suggestion to combine Fujiura and Akiyama could only come from Appellants' own disclosure and not from any teaching in the references themselves.

Lastly, we also do not sustain the Examiner's obviousness rejection of dependent claims 37, 40, and 50 based on the proposed combination of Fujiura and Satoh. The Satoh reference has been added to Fujiura as providing a teaching of informing a user to perform a certification process. We find nothing, however, in Satoh which overcomes the innate deficiencies of Fujiura in disclosing the control of a sensor hole to a second state as discussed supra.

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In summary, we have not sustained either of the Examiner's 35 U.S.C. § 102(e) or 35 U.S.C. § 103(a) rejections of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-8, 33-40, 42, 43, and 48-53 is reversed.

REVERSED

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