

File

95-1679

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

MAILED

MAR 12 1997

Ex parte KIMOSHI OHMORI
and HIDEOSHI HORIMOTO

PT & TM OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 95-1679
Application 07/079-663

ON BRIEF

Before HAIRSTON, KRASS and CARMICHAEL, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claim 1. Claims 2 through 4 have been cancelled and claim 5 has been allowed.

¹ Application for patent filed November 20, 1992.

Appeal No. 95-1679
Application No. 07/979,665

The invention is directed to a disk drive device having a stabilized spindle. More particularly, a positioning block fixed to the chassis of the device has a reference planar projection for restricting an upper limit of a vertical stroke of the spindle motor and compression coil springs are attached to guide shafts for biasing the spindle motor against the positioning block.

Independent claim 1, the sole claim, is reproduced as follows:

1. A disk drive device comprising:

a chassis;

rotatively driving means vertically movably mounted on said chassis, for rotatively driving a disk-shaped recording medium;

vertically driving means contacting a part of said rotatively driving means, for vertically driving said rotatively driving means;

a loading motor mounted on said chassis, for rotatively driving said vertically driving means;

positioning means fixed to said chassis, for restricting an upper limit of a vertical stroke of said rotatively driving means; and

biasing means for biasing said rotatively driving means against said positioning means.

The examiner relies on the admitted prior art [APA] presented in Figures 3-5 of the instant disclosure.

Appeal No. 95-1679
Application No. 07/979,665

Claim 1 stands rejected under 35 U.S.C. 102(b) as anticipated by APA.

Reference is made to the brief and answer for the respective details of the positions of appellants and the examiner.

OPINION

Anticipation, under 35 U.S.C. § 102, requires that each element of the claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference. Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983).

The examiner has identified each of the claimed elements in APA Figures 3-5 as follows: chassis 3; rotatively driving means 5; vertically driving means 10, 11; loading motor 8; positioning means (unlabeled projections on the chassis which connect to the ends of springs 13 opposite to the ends connected to projections 12); and biasing means (coil springs 13). As the examiner explains [bottom of page 3 to the top of page 4 of the answer], either projection connecting the ends of spring 13 may be considered "fixed" to the chassis, either directly or indirectly since the "chassis is the supporting means for the whole apparatus and all components would be fixed to the chassis."

Appeal No. 95-1679
Application No. 07/979,665

The examiner's rationale appears, to us, to be reasonable and such an interpretation appears to meet each element of the claim, establishing prima facie anticipation. At this time, the burden shifts to appellants to establish that no anticipation, in fact, exists.

Appellants rely on In re Donaldson, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994), contending that the claimed "positioning means," which is recited in the means plus function format permitted by 35 U.S.C. 112, sixth paragraph, must be construed to cover the corresponding structure described in the specification and its equivalents. Appellants then specifically and unambiguously state [brief, page 7] that

The claimed positioning means corresponds to the block 21, with the reference planar projection 21a, described in the specification (see, e.g., page 8, lines 16-18; Figs. 1 and 2).

Since appellants have specifically indicated the corresponding structure in the specification that they wish to ascribe to the claimed "positioning means," without any indication as to what other structure may be considered "equivalent," we will strictly construe the claimed "positioning means" as consisting of, to the exclusion of any and all other

Appeal No. 95-1679
Application No. 07/979,665

types of positioning means, only the disclosed block 21 having the disclosed reference planar projection 21a.

Under these circumstances, the burden has shifted back to the examiner to show that the brackets connected to the springs of APA are, indeed, "equivalent" structure to appellants' block 21. Since the examiner has not done this, we will not sustain the rejection of claim 1 under 35 U.S.C. 102(b).

We realize that such a finding results in the strange situation in which a claim whose clear language literally reads on the prior art may be the subject of a patent because of an interpretation of the claim language based on structure disclosed in the specification but that is what Donaldson permits and we are constrained to follow that precedent until and unless Donaldson is modified and/or overruled.

We do hold, however, that appellants are bound by their own interpretation of the claimed positioning means, i.e., it covers ONLY the block having the reference planar projection as shown in Figures 1 and 2 since appellants have not shown or argued what would constitute an "equivalent" thereof.

Appeal No. 95-1679
Application No. 07/979,665

Philip M. Shaw, JR.
Limbach & Limbach
2001 Ferry Building
San Francisco, CA 94111-4262