

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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD M. PERMUT

Appeal No. 96-1183
Application 08/102,858¹

ON BRIEF

Before JERRY SMITH, LEE, and TORCZON, 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 final rejection of claims 1-6, 9-12 and
15. Claims 7, 8, 13, 14 and 17-20 were indicated as

¹ Application for patent filed August 6, 1993.

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containing allowable subject matter. A first amendment after final rejection was filed on December 12, 1994, and was entered by the examiner. This amendment cancelled claims 7, 8, 13 and 14 and amended claim 15. This amendment resulted in the withdrawal of a rejection of claim 15 under 35 U.S.C. § 112. A second amendment after final rejection was filed on September 13, 1995, and was entered by the examiner. This amendment cancelled claims 6, 12 and 17-20. Accordingly, only claims 1-5, 9-11 and 15 remain pending in this application, and the rejection of all of these claims is on appeal before us.

The disclosed invention pertains to a method and apparatus for translating and rotating a cartridge, particularly for the loading and unloading of optical disks. The invention uses a rack and pinion mechanism for implementing translational motion of a cartridge carrying an optical disk followed by rotational motion of the cartridge and ending with additional translational motion of the cartridge.

Representative claim 1 is reproduced as follows:

1. An apparatus for translating and rotating a

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cartridge, the apparatus comprising:

a base;

a linear motion carriage slidably mounted to the base for translation in a direction of translation;

a carrier having a rotation point, the carrier rotatably mounted on the linear motion carriage for rotation about its rotation point, for carrying the cartridge;

a rack attached to the carrier, the rack having two straight sections in spaced parallel relation and a curved section connected between the straight sections, the curved section defined by a radius of curvature measured from the rotation point;

a pinion rotatably mounted to the base in a position for cooperating with the rack;

a roller rotatably mounted to the base in a position for cooperating with the rack, the roller and pinion positioned on opposite sides of the rack; and

means for rotating the pinion.

The examiner relies on the following references:

Crain et al. (Crain)	5,025,436	June 18, 1991
Fitzgerald et al. (Fitzgerald)	5,056,073	Oct. 08, 1991
Christie et al. (Christie)	5,062,093	Oct. 29, 1991
Ikedo et al. (Ikedo)	5,195,078	Mar. 16, 1993

Rached	WO 84/02165	June 07, 1984
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Claims 1-3, 9-11 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over the basic combination of Christie, Ikedo and Rached. Claim 4 stands rejected under 35

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U.S.C. § 103 as unpatentable over the basic combination considered further with Crain. Claim 5 stands rejected under 35 U.S.C. § 103 as unpatentable over the basic combination considered further with Fitzgerald.

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

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

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the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-5, 9-11 and 15. Accordingly, we reverse.

We consider first the rejection of claims 1-3, 9-11 and 15 under 35 U.S.C. § 103 as being unpatentable over the teachings of Christie in view of Ikedo and Rached. 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 (CCPA 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,

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Inc. v. Delta 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).

With respect to independent claims 1, 9, 10 and 15, the examiner cites Christie as teaching a device for effecting translational-rotational-translational movement of an optical disk cartridge carrier. The movement in Christie is not effected using a rack and pinion system. The examiner cites Ikedo as teaching a rack and pinion system for moving an optical disk cartridge carrier. The Ikedo rack and pinion system provides translational movement only. The examiner cites Rached as teaching a rack and pinion positioning system in which linear movement can be converted to rotational movement and vice versa. It is the position of the examiner that it would have been obvious to the artisan to effect the desired movement in Christie using a rack and pinion system as

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taught by Ikedo and to configure the rack and pinion system to have the same arrangement as the Rached rack and pinion system [answer, pages 4-7].

Appellant argues that the rack and pinion positioning system of Ikedo would not rotate the Christie cartridge, thus rendering Christie inoperable. Appellant also argues that none of the references cited by the examiner suggest that a rack and pinion system is suitable for effecting rotational movement of a disk carrying cartridge. It is further argued by appellant that the Rached rack and pinion system is disclosed as a substitute for

cranks and crankshafts, and there is no suggestion that a U-shaped rack should be attached to a rotatably mounted cartridge carrier as claimed [brief, pages 4-8].

The examiner responds that given that the artisan would desire to effect the motions already shown in Christie, the artisan would have been motivated to use a rack and pinion system to carry out these motions [answer, pages 11-12]. Appellant argues that this conclusion by the examiner is

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unsupported by the applied prior art. We agree with appellant that the examiner's position is unsupported by the record in this case.

The critical question in this case is whether it would have been obvious to implement the Christie motions using a rack and pinion system. The examiner simply concludes that it would have been obvious to the artisan to use a rack and pinion system to implement any desired motions such as those of Christie. Appellant argues that the only suggestion for obtaining the claimed translational and rotational movement out of a single rack and pinion system configured as claimed comes from appellant's own disclosure. We are constrained to agree with appellant on this record.

Neither Ikedo nor Rached suggests that a rack and pinion assembly can achieve the translation and rotation of a carrier attached to the rack. Ikedo teaches no rotation whatsoever, and Rached merely teaches that linear and rotational forces can be converted to each other. The examiner's finding that the artisan would even look to a rack and pinion assembly for achieving the motion in Christie is based on the fact that appellant disclosed that a rack and pinion assembly could

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achieve this motion. The applied prior art alone would not lead the artisan to use a rack and pinion assembly to achieve the claimed translational and rotational movements of a carrier attached to the rack.

Since we are of the view that the prior art applied by the examiner does not support the examiner's rejection, we do not sustain the rejection of independent claims 1, 9, 10 and 15.

Therefore, we also do not sustain the rejection of dependent claims 2, 3 and 11.

We now consider the rejection of dependent claims 4 and 5. These claims were rejected on the combination of Christie, Ikedo and Rached as discussed above, and further in view of Crain and Fitzgerald, respectively. Since neither Crane nor Fitzgerald overcomes the deficiencies noted in the combination of Christie, Ikedo and Rached, the examiner's rejection of claims 4 and 5

fails for the same reasons discussed above with respect to the independent claims. Therefore, we do not sustain the

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rejection of dependent claims 4 and 5.

In summary, we have not sustained any of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-5, 9-11 and 15 is reversed.

REVERSED

	Jerry Smith)	
	Administrative Patent Judge)	
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)	
	Jameson Lee)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
	Richard Torczon)	
	Administrative Patent Judge)	

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