

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHINICHIRO KATO and SHUICHI KIKUCHI

Appeal No. 1997-3478
Application 08/397,648¹

HEARD: January 24, 2000

Before KRASS, RUGGIERO and FRAHM, Administrative Patent Judges.

FRAHM, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 1 to 6, which constitute all of the pending claims in the case before us.

¹Appellant relies upon a foreign priority filing date under 35 U.S.C. § 119 of March 10, 1994.

BACKGROUND

The subject matter on appeal is directed to a disc cassette for use in a disc player, wherein the cassette housing has an opening for disc recording/playback which has a sliding shutter for exposing or concealing the disc (see appellants' Figure 11 and page 1 of the specification). As indicated in the specification (see page 3), when several disc cassettes are stacked for playing in succession (Figures 13 and 14), the shutter of one disc suffers from the problem that it gets hung on the disc below it (see Figures 15 and 16). To overcome this problem with conventional disc cassettes, appellants provide a disc cassette as shown in Figure 5 which has an angled back wall 3a' at the opening 3 of the disc housing, thus preventing disc cassettes stacked on each other from hanging up (e.g., see Figures 6 and 7). Thus, appellants' invention of a disc housing having an angle back wall, as recited in claims 1 to 6 on appeal, provides an important advantage over prior art disc cassettes.

As further discussed, infra, we find that the applied

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reference to Fujita fails to teach or suggest at least the feature of a disc cassette and shutter where the disc housing has an angled back wall as defined in claims 1 to 6 on appeal.

Representative independent claim 1 is reproduced below:

1. A disc cassette comprising:

a case in which a disc-like recording medium having an information recording area is rotatably received, said case having an opening through which at least a part of said information recording area of said medium is exposed;

means for defining a rectangular recess on a front area of said case where said opening is positioned, said rectangular recess being defined by two opposed side walls, a back wall and a bottom wall, said back wall being oriented to face forward; and

a shutter slidably engaged with said rectangular recess in a manner to selectively open and close said opening, said shutter being slidable in a direction parallel to a direction in which said back wall extends,

wherein said back wall of said rectangular recess has a surface inclined relative to said bottom wall, said back wall and said bottom wall forming an obtuse angle, and wherein a height of said back wall defines a depth of said rectangular recess, said depth being greater than a thickness of said shutter.

The following reference is relied on by the examiner:

Fujita et al. (Fujita)	5,084,862	Jan. 28,
1992		

Claims 1 to 6 stand rejected under 35 U.S.C. § 103. As

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evidence of obviousness, the examiner relies upon Fujita.

Rather than repeat the positions of appellants and the examiner, reference is made to the Brief and the Answer for the respective details thereof.

OPINION

It is our view, after consideration of the record before us, that the reference to Fujita 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 set forth in claims 1 to 6. In reaching our conclusion on the issues raised in this appeal, we have carefully considered appellants' specification and claims, the applied reference, and the respective viewpoints of appellants and the examiner. As a consequence of our review, we find that the applied prior art to Fujita fails to teach or suggest the feature of representative claim 1 on appeal of a disc cassette having a rectangular recess with an inclined or angled back wall of claim 3 of a back wall having perpendicular and inclined portions, and of claim 4 of a back wall having an inclined

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surface with a contoured convex curve. Accordingly, we will reverse the examiner's decision rejecting claims 1 to 6 on appeal as being obvious under 35 U.S.C. § 103.

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 (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.),

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cert. denied, 488 U.S. 825 (1988); Ashland Oil, 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 Hospital Systems, Inc. v. Montefiore Hospital, 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).

As a general proposition in an appeal involving a rejection under 35 U.S.C. § 103, an examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to appellants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

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We find that the examiner, at pages 3 to 5 of the Answer, has met his burden of establishing a prima facie case of obviousness. The examiner, by pointing to Figure 9 of Fujita, has established a reasonable likelihood that the back wall 41 of the rectangular recess of Fujita's disc cassette 40 is inclined or angled. Accordingly, the burden is then shifted to appellants to demonstrate nonobviousness based on the evidence as a whole and the relative persuasiveness of the arguments.

We find, however, that appellants have successfully rebutted the prima facie case presented by the examiner. We are persuaded by the weight of the evidence and appellants' arguments that Fujita does not fairly teach or suggest an angled or inclined back wall. Specifically, we agree with appellants (Brief, pages 8 to 9) that because Figure 5 of Fujita fails to show two lines corresponding to the back wall of the rectangular recess, no incline of that wall is disclosed. In addition, we note our agreement with appellants (Brief, page 6) that nowhere in the text of Fujita is the back wall described as being angled or inclined. Furthermore, we find that there is no motivation or suggestion in Fujita for

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the back wall to be inclined, since Fujita is not concerned at all with the same problem as appellants of preventing two disc cassettes having shutters from catching on each other. This is due to the fact that Fujita concerns a single disc cassette, whereas appellants' invention pertains to the shuffling of multiple discs in a disc player such as that shown in appellants' Figure 13. Accordingly, we cannot sustain the rejection of claims 1 to 6 under 35 U.S.C. § 103.

Appellants argue (Brief, pages 6 to 7) that the feature of claim 3 of a perpendicular/inclined back wall combination is also neither taught nor suggested by Fujita. Appellants also argue (Brief, page 9) that the feature of claim 4 of an inclined back wall having a contoured convex curve is also neither taught nor suggested by Fujita. Because we have found, as discussed supra, that Fujita would not have fairly taught or suggested even an angled or inclined back wall as recited in representative claim 1, we are in agreement with appellants that Fujita would not have taught or suggested any further modification of the back wall to include a perpendicular/inclined combination as recited in claims 3 and 6, or a contoured convex curve as recited in claim 4. We

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agree with appellants that one of ordinary skill in the art would not have found it obvious to "optimize" in order to achieve these shapes for the back wall, especially since Fujita is not concerned with sticking of multiple disc cassette shutters as are appellants.

Although we find that the examiner originally set forth a prima facie case of obviousness, we must agree with appellants that a disc cassette having an inclined back wall is not specifically taught or suggested by the applied references. Thus, we find that appellants have successfully rebutted the examiner's prima facie case, and we will reverse the rejection.

In view of the foregoing, the decisions of the examiner rejecting claims 1 to 6 under 35 U.S.C. § 103 are reversed.

REVERSED

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