

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AKIO MURATA, HIDEAKI MUKAE,
TAKAAKI MAEGAWA,
MASARU HIGASHIONJI,
and TOSHIHARU OKADA

Appeal No. 1998-0158
Application No. 08/427,587

HEARD: April 6, 2000

Before THOMAS, FLEMING, and BARRY, Administrative Patent Judges.
BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134
from the final rejection of claims 10-12. We reverse.

BACKGROUND

In a video cassette recorder (VCR), rotary heads are used to record and reproduce audio and video signals. The heads are bonded on small metal plates called head bases. In turn, the head bases are attached to a drum. Precise positioning of the heads on the drum is required.

Conventionally, the height of the rotary heads is set using screws to elastically deform the head bases. When the drum is subjected to mechanical vibrations or temperature changes, however, the screws can loosen. Such loosening changes the height of the heads, thereby increasing tracking errors and crosstalk interference.

The invention at issue in this appeal sets the height of a rotary head free from the influences of mechanical vibrations and temperature changes. Specifically, a laser beam heats a head base, causing it to deform plastically. Such deformation bends the head base, thereby adjusting its height.

Claim 10, which is representative for our purposes,
follows:

10. A rotary head which is adapted to be mounted on a rotary drum of a magnetic recording/reproducing apparatus, and which comprises:

a head base which is a single metal plate having at a specified area thereon a thermally caused plastic deformation area, said head base being bent in a direction parallel to a rotation axis of said rotary head at a boundary of said plastic deformation area; and

at least one head chip bonded on said head base at a position defined by a bent amount of said head base.

The references relied on in rejecting the claims follow:

1991	Yohda	5,065,267	Nov. 12,
			(filed July 20,
1990)			
1987	Nanba et al. ¹ (Nanba)	62-093028	Apr. 28,
	(Japanese Patent Application)		
1986.	Takeshita ¹	61-189463	Nov. 26,
	(Japanese Patent Application)		

¹ Copies of the translations of Nanba and of Takeshita prepared by the U.S. Patent and Trademark Office are included with and relied upon for our opinion. We will refer to the translations by page number.

Claims 10-12 stand rejected under 35 U.S.C. § 103 as obvious over Yohda in view of Nanba or Takeshita. Rather than repeat the arguments of the appellants or examiner in toto, we refer the reader to the brief and answer for the respective details thereof.

OPINION

In reaching our decision in this appeal, we considered the subject matter on appeal and the rejection advanced by the examiner. Furthermore, we duly considered the arguments and evidence of the appellants and examiner. After considering the totality of the record, we are persuaded that the examiner erred in rejecting claims 10-12. Accordingly, we reverse.

We begin by noting the following principles from In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden

of coming forward with evidence or argument shift to the applicant. Id. "A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

With these in mind, we address the following issues:

- obviousness over Yohda in view of Nanba
- obviousness over Yohda in view of Takeshita.

We first address the obviousness of the claims over Yohda in view of Nanba.

Obviousness over Yohda in view of Nanba

The appellants make the following argument.

[T]he Examiner is completely changing the method of Yohda to one that is not close to being that disclosed by Yohda. There is insufficient motivation to do so from JP 93028 [i.e., Nanba], as the reference recognizes no problem in the process of Yohda, and suggests no significant advantage to employing the method of JP 93028 (Appeal Br. at 18.)

The examiner replies, "the Difference section suggested deformation of a specified part of the head plate in order to adjust the position of a head mounted at the end of a head base" (Examiner's Answer at 7.)

The examiner misconstrues the criteria for combining references. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d

1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), cert. denied, 519 U.S. 822 (1996)(citing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983)). "When determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" In re Beattie, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992)(quoting Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)).

Here, the examiner fails to identify a permissible suggestion to combine Yohda and Nanba to obtain the claimed

invention. The "Difference section" to which he refers is part of the appellants' Information Disclosure Statement. (Paper No. 3.) Although the section mentions bending a head plate, it explains that the head plate is bent by the appellants' invention. (Id.)² The examiner's reliance on the appellants' explanation of their invention is impermissible.

For the foregoing reasons, we are not persuaded that the prior art as a whole would have suggested the desirability, and thus the obviousness, of combining Yohda and Nanba. The examiner has impermissibly relied on the appellants' teachings or suggestions; he has not established a prima facie case of obviousness. Therefore, we reverse the rejection under 35 U.S.C. § 103 over Yohda in view of Nanba. We next address obviousness of the claims over Yohda in view of Takeshita.

Obviousness over Yohda in view of Takeshita

The appellants argue, "one of skill in the art would take no suggestion from JP 189463, because the problems being

² The section merely indicates that Nanba's invention bends "a metallic plate." (Id.)

addressed in the two references are completely different."
(Appeal Br. at 20.) The examiner replies, "JP 189463 [i.e.,
Takeshita] shows the positioning of a head with respect to a
medium." (Examiner's Answer at 8.)

The examiner fails to identify a permissible suggestion
to combine Yohda and Takeshita to obtain the claimed
invention. Takeshita teaches that "a laser beam is irradiated
on [a] head spring portion to adjust the spring pressure so as
to realize an appropriate head flotation height as desired."
Translation, p. 5. The examiner does not allege, let alone
show, however, any advantage of combining the teaching with
those of Yohda.

For the foregoing reasons, we are not persuaded that the
prior art as a whole would have suggested the desirability,
and thus the obviousness, of combining Yohda and Takeshita.
The examiner has impermissibly relied on the appellants'
teachings or suggestions; he has not established a prima facie
case of obviousness. Therefore, we reverse the rejection
under 35 U.S.C. § 103 over Yohda in view of Takeshita.

CONCLUSION

To summarize, the rejections of claims 10-12 under 35
U.S.C. § 103 are reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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LANCE LEONARD BARRY)	
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