

The opinion in support of the decision being entered today was **not** written for publication and is **not** precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** MASARU IKEBE and TAKATERU SATOH

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Appeal No. 1998-0998  
Application 08/426,069

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ON BRIEF

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Before KRASS, FLEMING, and LALL, ***Administrative Patent Judges***,

FLEMING, ***Administrative Patent Judge***.

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of claims 1 and 3 through 7. Claim 2 has been canceled.

The invention relates to a cartridge or recording medium in a computer system. In particular, the invention specifically relates to a shutter or opening and closing the head access slot of a cartridge for a recording medium.

Independent claim 1 is reproduced as follows:

1. A cartridge which comprises a case consisting of upper and lower shells joined and containing a recording medium therein, said case having a slot formed to expose the recording medium partly, a shutter which rests astride on one edge portion of the case and is slidable between an open position where the shutter opens the slot and a closed position where the shutter closes the slot, and a locking member which keeps the shutter in the closed position, said case having a recess formed in a portion of a peripheral edge of said case adjacent and external to the shutter, defined by a cutout across the entire thickness of the case, to receive an unlocking member from a recording-reproducing unit, said locking member having an exposed portion exposed partly in the recess for access of the unlocking member, so that when the unlocking member pushes the locking member on the exposed portion, a hooked head of the locking member is disengaged from an engaging projection formed inside an end face of the shutter.

The Examiner relies on the following reference:

Koyama et al. (Koyama) (European Patent Application)	0,218,231	Apr. 15, 1987
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Claims 1 and 3 through 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Koyama.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs<sup>1</sup> and Answer for the respective details thereof.

### **OPINION**

We will not sustain the rejection of claims 1 and 3 through 7 under 35 U.S.C. § 103.

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<sup>1</sup> Appellants filed an Appeal Brief on April 14, 1997. Appellants filed a Reply Brief on September 15, 1997. The Examiner mailed an office communication on January 22, 1998, stating that the Reply Brief has been entered and considered, but no further response by the Examiner is deemed necessary.

Appeal No. 1998-0998  
Application 08/426,069

The Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." *Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), *citing W.L. Gore & Assocs. Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983).

On pages 2 and 3 of the Reply Brief, Appellants argue that Koyama fails to teach or suggest that the cartridge has a case that has a recessed formed in the portion of the peripheral edge of the case adjacent and external to the shutter. Appellants further argue that Koyama fails to teach that the recess is defined by a cutout across the entire thickness of the case. Appellants point out that Koyama teaches a case that includes no such recess.

As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Moreover, when interpreting a claim, words of the claim are generally given their ordinary and accustomed meaning, unless it appears from the specification or the file history that they were used differently by the inventor. *Carroll*

Appeal No. 1998-0998  
Application 08/426,069

***Touch, Inc., v. Electro Mechanical Sys., Inc.***, 15 F.3d 1573, 1577, 27 USPQ2d 1836, 1840 (Fed. Cir. 1993). Although an inventor is indeed free to define the specific terms used to describe his or her invention, this must be done with reasonable clarity, deliberateness, and precision. ***In re Paulsen***, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

We note that Appellants' claim 1 recites "a case having a recess formed in a portion of a peripheral edge of said case adjacent and external to the shutter, defined by a cutout across the entire thickness of the case, to receive an unlocking member from a recording-reproducing unit." We note that the only other independent claim, claim 7, recites a "case having a recess formed in a portion of a peripheral edge of said case adjacent and external to the shutter, defined by a cutout across the entire thickness of the case, to receive an unlocking member from a recording-reproducing unit." Thus, we find that the scope of the claims before us require a recess formed in the peripheral edge of the case adjacent and external to the shutter. Furthermore the claims before us require that the recess is defined by a cutout across the entire thickness of the case.

Upon our review of Koyama, we fail to find that Koyama teaches or suggests these limitations. In particular, Koyama teaches in Figures 8 and 11 that the shutter comprises element 4 and slider element 3. We note that the recess is formed in the shutter. In particular, Figure 11 shows the recess as element 18. Thus, Koyama does not teach a

recess formed in a portion of a peripheral edge of the case adjacent and external to the shutter since the Koyama recess is in the shutter itself.

We note that on page 5 of the Examiner's Answer the Examiner does agree that Koyama does not disclose that the recess is defined by a cutout across the entire thickness of the case as recited in Appellants' claims. The Examiner argues that it would be obvious to one of ordinary skill in the art at the time the invention was made to extend the recess across the entire thickness of the case for ease of manufacturing and to more easily insert the unlocking member into the recess.

The Federal Circuit states that "[t]he 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 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), *citing In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). It is further established that "[s]uch a suggestion may come from the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem." *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), *citing In re Rinehart*, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976)(considering the problem to be solved in a determination of obviousness). The Federal Circuit reasons in *Para-Ordnance Mfg. Inc. v. SGS Importers Int'l Inc.*, 73 F.3d at 1088-89, 37 USPQ2d at 1239-40, that for the determination of obviousness, the court

Appeal No. 1998-0998  
Application 08/426,069

must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop the prior art, would have been reasonably expected to use the solution that is claimed by the Appellants. However, "[o]bviousness may not be established using hindsight or in view of the teachings or suggestions of the invention."

***Para-Ordnance Mfg. Inc. v. SGS Importers Int'l Inc.***, 73 F.3d at 1087, 37 USPQ2d 1239, ***citing W.L. Gore & Assocs., Inc. v. Garlock, Inc.***, 721 F.2d at 1551-1553, 220 USPQ at 311-313. In addition, our reviewing court requires the Patent and Trademark Office to make specific findings on a suggestion to combine prior art references. ***In re Dembiczak***, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

We fail to find that Koyama suggests the Examiner's modification. Koyama's recess is in the shutter and extending the recess across the entire thickness of the case would only destroy Koyama's slider with regard to its intended purpose. We fail to find that there was any suggestion of modifying Koyama's shutter consisting of elements 4 and 3 such that the recess 18 would somehow be extended across the entire thickness of the case or that the entire invention would be modified to cause an access in the case adjacent and external to the shutter.

Appeal No. 1998-0998  
Application 08/426,069

In view of the foregoing, we have not sustained the rejection of claims 1 and 3 through 7 under 35 U.S.C. § 103. Accordingly, the examiner's decision is reversed.

**REVERSED**

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ERROL A. KRASS	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
MICHAEL R. FLEMING	)	
Administrative Patent Judge	)	APPEALS AND
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	)	INTERFERENCES
	)	
PARSHOTAM S. LALL	)	
Administrative Patent Judge	)	

Appeal No. 1998-0998  
Application 08/426,069

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