

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ISAO ICHIMURA,
FUMISADA MAEDA, KENJI YAMAMOTO,
KIYOSHI OHSATO and TOSHIO WATANABE

Appeal No. 2001-1936
Application 09/049,478

ON BRIEF

Before THOMAS, JERRY SMITH, and FLEMING, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 1-15.

Representative claim 1 is reproduced below:

1. A focus controlling apparatus for focusing a light beam and positioning the focused light beam onto a signal recording layer of a signal recording media, comprising:

a light beam focusing means having a numerical aperture of 0.6 or more;

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a focusing controlling means for providing a focus control to position the light beam focused by the light beam focusing means onto the signal recording layer of the recording media; and

an offset adjusting means for adjusting an offset between the focused light beam focus positioned by the focus controlling means and the signal recording layer of the recording media depending upon an RF signal read from the recording media.

The following references are relied on by the examiner:

Yamamoto et al. (Yamamoto)	5,712,842	Jan. 27, 1998 (filing date Feb. 12, 1996)
Matsui	5,777,961	July 7, 1998 (filing date June 22, 1995)
Ceshkovsky	5,978,331	Nov. 2, 1999 (effective filing date Dec. 6, 1995)
Maeda et al. (Maeda)	6,005,834	Dec. 21, 1999 (filing date Mar. 7, 1997)

Page 3 of the answer also indicates that the following reference is cited in response to appellants' arguments and necessitated thereby:

Kuroda et al. (Kuroda)	5,892,882	Apr. 6, 1999 (effective filing date Mar. 22, 1995)
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Claim 7 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 1-15 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Ceshkovsky in view of Maeda. The examiner has also rejected claims 1, 2, 4, 6, 8, 11, 12, and 14 under 35 U.S.C. § 102(e) as

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being anticipated by Matsui. To this reference the examiner adds in the alternative Maeda or Yamamoto as to claims 3, 7 and 13.

Rather than repeat the position of the appellants and the examiner, reference is made to the briefs and the answer for the respective details thereof.

OPINION

Turning first to the rejection of claim 7 under the second paragraph of 35 U.S.C. § 112, we reverse this rejection. The mere fact that claim 7 recites an apparatus element does not necessarily render this claim indefinite or that its scope is indeterminable by the artisan even though its parent independent claim recites a method. The initial clause in the body of method independent claim 6 recites a positioning feature with respect to "an objective lens." This same lens is referred to as "the objective lens" in the next listed step. It is this or "the objective lens" cited in claim 6 that is further defined in dependent claim 7 as being an aspherical two-group objective lens. There is no ambiguity or indefiniteness apparent to us since dependent claim 7 further restricts the subject matter of its independent claim 6. We note also that the artisan would readily understand the nature of the features recited in claim 7

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in the context of the object lens 106 and aspherical lens 104 in Figures 2 and 3 of the disclosed invention. Therefore, the rejection of dependent claim 7 under the second paragraph of 35 U.S.C. § 112 is reversed.

We also reverse the rejection of claims 1-15 as being obvious within 35 U.S.C. § 103 over Ceshkovsky in view of Maeda. In making no assertion that Maeda teaches the disputed feature of an RF signal being read from the recording media and outputted by various means for structural elements (Note the showings in Figures 1 and 6 of the disclosed invention.), the examiner takes the position at pages 3 and 4 of the answer that Ceshkovsky discloses such a feature, making particular mention to this reference's abstract, its Figure 2 and its corresponding description. The examiner goes on by stating the "examiner believes the RF limitation is inherently present in references, as acknowledged by Appellant's own description of the optical arts- see pate [sic, page] 7, lines 5-10 of the specification."

Correspondingly, appellants in the brief and reply brief take issue with the examiner's approach relying upon this portion of the specification as filed. As noted by appellants, this portion of the specification makes particular reference to discussing the disclosed invention in the context of Figure 1.

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If anything, the statement at page 7, lines 9 and 10 that "[n]ormally, these component systems are incorporated in an optical pick-up" would ordinarily be construed as referring to the manner in which appellants have disclosed the component systems of a reproduction block and a recording block as being in an optical pick-up of the disclosed invention rather than any inference or indication that these are normally found in the prior art. The examiner's attempt to prove inherency in the applied prior art by reference to the specification as filed is problematic at best to begin with.

Appellants correctly rely upon In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) at page 9 of the principal brief on appeal. The earlier noted portions of Ceshkovsky relied upon by the examiner as indicating inherency does not so indicate to us that the disputed RF characteristic of his invention is necessarily present or flowing from the teachings of Ceshkovsky itself. Robertson indicates that certain extrinsic evidence may be utilized to make clear any missing descriptive material that may be necessarily present within Ceshkovsky as long as this would be so recognized by the artisan. It appears to us that this is the basis on which the examiner relies upon Kuroda and the particular portion thereof at column

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4, lines 35-39. From our study of both references, Kuroda does not indicate to us nor do we believe it would have so indicated to the artisan that the disputed RF feature of the independent claims on appeal would have been necessarily inherent within Ceshkovsky. On the other hand, Kuroda may be evidence that it would have been obvious to the artisan within 35 U.S.C. § 103 to have implemented the optical pick-up and related structures in Ceshkovsky according to the RF teachings noted by the examiner in Kuroda at column 4, lines 35-39. This, however, has not been presented to us as a stated rejection of the claims on appeal.

Since the examiner's positions with respect to inherency in Ceshkovsky do not persuade us of the inherency of the disputed RF feature of each claim on appeal, but rather present evidence to us that the claimed feature may have been obvious to the artisan within 35 U.S.C. § 103, we note the examiner should consider setting forth new rejections within 35 U.S.C. § 103 based upon Kuroda, and possibly any additional prior art the examiner may choose to rely upon. On the other hand, the existing rejection before us of claims 1-15 considered by the examiner to have been obvious within 35 U.S.C. § 103 over Ceshkovsky in view of Maeda must be reversed.

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We now consider the rejection under 35 U.S.C. § 102 of claims 1, 2, 4, 6, 8, 11, 12, and 14 as being anticipated by Matsui. As to this rejection we sustain it in light of the examiner's brief statement of the rejection at the bottom of page 4 of the answer, which has been further amplified by the examiner's responsive arguments at pages 7 and 8. It is these responsive arguments that fully address the concerns raised by appellants at pages 10-12 of the principal brief on appeal. Whether the examiner's reliance upon Matsui may have been properly traversed by appellants as being premature is a petitionable matter and not appealable as noted by the examiner at the bottom of page 7 of the answer. With respect to appellants' complaints that the examiner has not fully identified the corresponding features of the claims and the noted figures and textural portions of Matsui relied upon by the examiner, the examiner has set forth a detailed correspondence of certain representative claims on appeal at page 8 of the answer. Significantly, appellants' assertion at the bottom of page 11 of the principal brief on appeal that Matsui is silent as to the use of RF signals is answered by the examiner at the bottom of page 8 by noting at least three locations in Matsui that do teach RF

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signals. Finally, as to this rejection, we note that appellants have presented no arguments relating to this rejection in the reply brief.

Lastly, we turn to the rejection of claims 3, 7 and 13 under 35 U.S.C. § 103 as being alternatively obvious over Matsui in view of Maeda or Matsui in view of Yamamoto. Our study of appellants' position as to this rejection in the brief and reply brief yields the realization that appellants have not argued this rejection in the reply brief. As noted by the examiner at the top of page 10 of the answer, since appellants have "not argued the propriety of the rejection based upon the combination of references Matsui-Yamamoto, the examiner concludes such to be acquiesced and no further response is made." We further extend this observation to the alternative rejection of Matsui in view of Maeda. Appellants' arguments as to the rejection of claims 3, 7 and 13 at pages 14 and 15 of the principal brief on appeal are directed only to the combination of references of Ceshkovsky in view of Maeda, which is the first stated rejection of the claims on appeal and not the one utilized as the fourth stated rejection of claims 3, 7 and 13. As a final matter, we have already indicated our reversal earlier in this opinion of the rejection

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of claims 1-15 under 35 U.S.C. § 103 based upon Ceshkovsky in view of Maeda, the second stated rejection.

In conclusion, we have reversed the rejection of claim 7 under the second paragraph of 35 U.S.C. § 112. We have also reversed the rejection of claims 1-15 under 35 U.S.C. § 103 in light of Ceshkovsky in view of Maeda. We have sustained the rejection of claims 1, 2, 4, 6, 8, 11, 12 and 14 as being anticipated under 35 U.S.C. § 102 by Matsui. The last stated rejection, that of claims 3, 7, and 13 under 35 U.S.C. § 103 in the alternative based upon Matsui in view of Maeda and Matsui in view of Yamamoto is also sustained. Because of the unique evidentiary considerations surrounding the rejection of claims 1-15 under 35 U.S.C. § 103 as being obvious over Ceshkovsky in view of Maeda, we have noted that the examiner should consider the institution of new rejections within 35 U.S.C. § 103. Therefore, since we have not sustained rejections encompassing all claims on appeal, the decision of the examiner is affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

James D. Thomas)	
Administrative Patent Judge)	
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Jerry Smith)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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