

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JERRY E. HURST, JR. et al.

Appeal No. 2002-1255
Application No. 09/271,440

ON BRIEF

Before ABRAMS, FRANKFORT, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 86, 87, 89, 93 to 96, 101 to 103 and 105 to 126. Claims 88 and 104, the only other claims pending in this application, have been withdrawn from consideration.

We REVERSE.

BACKGROUND

The appellants' invention relates to the use of micro-machined elements in optical data storage systems (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Horie et al. (Horie)	5,245,491	Sep. 14, 1993
Makigaki	JP 6-150362 ¹	May 31, 1994

Claims 86, 87, 89, 93 to 96, 101 to 103 and 105 to 126 stand rejected under 35 U.S.C. § 103 as being unpatentable over Horie in view of Makigaki.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 26, mailed February 5, 2002) for the examiner's complete reasoning in support of the rejection, and to the supplemental brief (Paper No. 25, filed December

¹ In determining the teachings of Makigaki, we will rely on the translation provided by the USPTO. A copy of the translation is attached for the appellants' convenience.

18, 2001) and reply brief (Paper No. 27, filed April 5, 2002) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 86, 87, 89, 93 to 96, 101 to 103 and 105 to 126 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

In the rejection (answer, pp. 2-4) under 35 U.S.C. § 103 before us in this appeal, the examiner (1) stated that "[t]he primary reference [Horie] discloses the use of a magneto optical disk recording and reproducing apparatus comprising: a light source 21, means for directing the light beam to the disk fig[.] 7 elements 22-29, a micro[-] machine[d] steerable mirror [assembly] for fine tracking control 35, and an optical fiber 26;" (2) ascertained² that the primary reference to Horie does not disclose the use of an arm (flying type head) as claimed; (3) stated that "[t]he use of an optical flying type head is shown in the secondary reference [Makigaki] as an alternative equivalence (see fig[.] 2 (flying type)) to a linear type (fig[.] 4) optical head depending on the head positioning path being straight or accurate;" and (4) concluded that "it would have been obvious to one skilled in the art at the time the invention was made to use the teaching of the secondary reference [Makigaki] and modify the primary reference [Horie]."

The appellants argue (supplemental brief, pp. 37-40) that Horie does not disclose a steerable mirror assembly as recited in the independent claims on appeal (i.e., claims 86, 89, 96, 102, 111, 113, 117 and 119) and therefore the examiner's proposed modification to Horie based on the teachings of Makigaki would not arrive at the claimed invention. We agree.

² After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Horie discloses a reflection-type azimuth rotator 35. The examiner believes that the claimed steerable mirror assembly reads on Horie's reflection-type azimuth rotator 35. We do not agree since Horie does not disclose or suggest that the reflection-type azimuth rotator 35 illustrated in Figures 7 and 8 provides any sort of steering. In that regard, the reflection-type azimuth rotator 35 of Horie is not disclosed as being movable independently with respect to the linearly movable portion 30. The disclosure in column 8, lines 47-54 of Horie merely points out that the reflection-type azimuth rotator 35 "serves as a tracking control mirror" which in our view only implies that it directs the beam of light from optical fiber 26 towards the focusing lens 29. Accordingly, we conclude that the examiner's determination that the mirror (i.e., the reflection-type azimuth rotator) 35 shown in Figures 7 and 8 of Horie provides fine tracking control (i.e., is steerable) is not supported by the evidence of record in this appeal (i.e., the applied prior art of Horie and Makigaki).

The appellants also argue (supplemental brief, p. 40) that Horie does not disclose electrodes to steer the mirror as recited in the dependent claims 103 and 110³ and therefore the examiner's proposed modification to Horie based on the teachings of Makigaki would not arrive at the claimed invention. We agree. The examiner's position (answer, pp. 4 and 5) that electrodes to move the mirror must be used (i.e., are

³ Claims 120 and 126 also recite this feature.

inherently present in Horie) is not supported by the evidence of record in this appeal. The examiner's broad conclusory statement that electrodes must be used to move the mirror, standing alone, is not "evidence." See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002). See also In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

The appellants also argue (supplemental brief, p. 41) that independent claims 111, 113, 117 and 119 recite "a steerable mirror assembly means...for positioning...." and that the examiner has not treated the means-plus-function recitations in the manner required by 35 U.S.C. § 112, sixth paragraph. As explained in In re Donaldson, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848-49 (Fed. Cir. 1994), the USPTO is not exempt from following the statutory mandate of 35 U.S.C. § 112, paragraph 6, which reads:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Accordingly, the USPTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.

Horie clearly fails to teach the steerable mirror assembly means disclosed in the present application. The examiner has not set forth any basis as to why Horie's

reflection-type azimuth rotator 35 would be equivalent to the steerable mirror assembly means disclosed in the present application. Therefore the examiner's proposed modification to Horie based on the teachings of Makigaki would not arrive at the claimed invention as set forth in independent claims 111, 113, 117 and 119 and claims dependent thereon.

For the reasons set forth above, the decision of the examiner to reject claims 86, 87, 89, 93 to 96, 101 to 103 and 105 to 126 under 35 U.S.C. § 103 as being unpatentable over Horie in view of Makigaki is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 86, 87, 89, 93 to 96, 101 to 103 and 105 to 126 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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