

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHANNES HENDRIKUS MARIA SPRUIT, JOHAN CORNELIS TALSTRA,
ROBERT ALBERTUS BRONDIJK and RONALD REINDERT DRENTEN

Appeal No. 2004-0779
Application No. 09/790,185

ON BRIEF

Before HAIRSTON, DIXON, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection¹ of claims 1-7², which are all of the claims pending in this application.

¹ The examiner (answer, page 2) indicates that the rejections identified by appellants as issue numbers 3-6, 8 and 11 (brief, pages 4 and 5) are moot as these rejections have been withdrawn.

² In an amendment (Paper No. 10, filed October 15, 2002) filed subsequent to the final rejection (Paper No. 9, mailed August 22, 2002), appellants canceled claim 6. The amendment was entered by the examiner (Paper No. 11, mailed October 22, 2002).

BACKGROUND

Appellants' invention relates to a rewritable data storage medium having erasable identification marks. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced as follows:

1. A data storage medium, comprising:

a rewritable recording layer provided with a tracking structure having tracks, said layer having a data recording area; and

an erasable identification mark which is present in an identification mark area other than the data recording area and which extends over a radial width of several tracks of the tracking structure in the data recording area, wherein the data recording area has a first tracking structure, and wherein the identification mark area has a second tracking structure substantially different from the first tracking structure.

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

Satoh et al. (Satoh)	4,535,439	Aug. 13, 1985
Oshima et al. (Oshima('551))	5,805,551	Sep. 8, 1998
Aoki	5,999,504	Dec. 7, 1999
Oshima et al. (Oshima('299))	6,266,299	July 24, 2001
		(filed May 20, 1999)
Oshima, Japanese Patent Document	WO98/27553	June 25, 1998

Claims 1 and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Oshima ('299)³.

Claims 2-4⁴⁵ stand rejected under 35 U.S.C. § 102(b) as being anticipated by Oshima ('299), or in the alternative, as being obvious over Oshima ('299) in view of Satoh and Aoki.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Oshima ('299) in view of Oshima ('511).

³ The examiner rejects claims 1 and 7 under 35 U.S.C. § 102(b) as being anticipated by WO98/27533 (answer, page 3). In the subsequent sentence, the examiner asserts that U.S. Patent 6,266,299 is equivalent to the WO document, listed supra. In the rejection, the examiner goes on to rely upon the U.S. Patent to support the rejection. As appellants do not dispute that the U.S. Patent is equivalent to WO98/27553, we also rely upon U.S. Patent 6,266,299.

⁴ Although the examiner additionally lists claim 6 as being rejected (answer, pages 3 and 4), as noted by appellants (reply brief, page 9), claim 6 has been canceled.

⁵ In the answer (pages 4 and 7), the examiner additionally relies upon additional references to Satoh and Aoki to support the examiner's taking of Official Notice. However, these references have not been included in the statement of the rejection. If the examiner wants the references to be considered, the reference should be listed in the statement of the rejection. "Where a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of rejection." In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). Here, although the examiner cites Satoh and Aoki, (answer, pages 4 and 7), he fails to positively include the references in the statement of the rejection. However, we consider the failure to positively recite Satoh and Aoki to be an oversight by the examiner, and will consider these references. See Ex parte Raske, 28 USPQ2d 1304, 1305 (Bd. Pat. App. & Int. 1993).

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 14, mailed April 21, 2003) for the examiner's complete reasoning in support of the rejections, and to appellants' brief (Paper No. 13, filed January 28, 2003) and reply brief (Paper No. 15, filed June 17, 2003) for appellants' arguments thereagainst⁶. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the

⁶ Appellants arguments (brief, pages 4-10) regarding the examiner's objections to the title, drawings and formalities in the specification are misplaced as these issues are petitionable and not appealable. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not review these issues raised by the appellants.

briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we reverse, essentially for the reasons set forth by appellants, and add a New Ground of Rejection of claims 1-5 and 7 under 37 CFR § 41.50(b). We begin with the rejection of claims 1 and 7 under 35 U.S.C. § 102(b) as being anticipated by Oshima ('299).

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgirg v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939))

(internal citations omitted):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Appellants assert (brief, page 15) that the examiner's rejection does not specifically state why the oblong stripes/marks satisfy

the ultimate language of claim 1. It is argued, (id.) that the identification marks are non-reversibly recorded, and therefore, are not erasable. Appellants further assert (brief, page 17) that Oshima does not teach a rewritable recording layer, but rather discloses a method of storing "write-once" information. It is noted by appellants that the phrase "write once" appears approximately 132 times in the disclosure of Oshima. Appellants further assert (brief, page 18) that Oshima does not teach "wherein the identification mark area is *substantially free* from a tracking structure."

The examiner's position (answer, page 3) is that:

As far as the examiner can determine, the Oshima et al system is a re-write able medium having an erasable identification mark-see the discussion with respect to the oblong stripes/marks-as discussed on col. 2 line 42 to col. 12 line 33. As further noted in figs. 7-11, these marks satisfy the ultimate language of claim 1.

Before we begin our analysis of the examiner's rejection, we note that for the reasons, to be set forth, infra, we find independent claims 1 and 7 to be indefinite under 35 U.S.C. § 112, second paragraph. In addressing the rejection of the claims over the prior art, we construe the claims to mean that the identification mark is largely located in the identification

mark area, and that a small portion of the identification mark is located in the data recording area.

Turning to the rejection of claims 1 and 7 as being anticipated by Oshima ('299), we note at the outset that the examiner's broad reference to columns 2-12 of Oshima is not helpful in determining the exact basis for the examiner's holding of anticipation. From our review of Oshima, we find (col. 2, lines 30-41) that:

It is an object of the present invention to solve the problems of the prior art. It is a further object of the present invention to provide an optical disk comprising write-once information that can be used for copyright protection, for example for copy-protection or protection from unauthorized use of software, a method for recording write-once information on an optical disk, a method for reproducing write-once information from an optical disk, an apparatus for reproducing optical disks, an apparatus for recording and reproducing optical disks, an apparatus for recording write-once information on optical disks, and an apparatus for recording on optical disks.

We also note the disclosure of Oshima (col. 4, lines 16-20); (col. 10, lines 36-38); (col. 21, lines 32-35), and (col. 22, lines 14-18) that:

It is preferable that in the optical disk according to the first configuration, the recording layer undergoes a reversible phase change between a crystalline phase and an amorphous phase.

In a first configuration of an apparatus for recording and reproducing optical disks whereon information can be recorded, erased and reproduced.

[A] recording layer **303** of a phase-changeable material that can reversibly change between a crystal phase and an amorphous phase is formed on top of the dielectric layer **302**.

When an optical disk has a recording layer consisting of a thin film that can be reversibly changed between these two optically detectable states, it can be used as a high-density rewritable exchangeable medium, for example a DVD-RAM.

From this disclosure of Oshima, we find a suggestion that the recording layer may be rewritable. However, from the disclosure of Oshima (col. 4, line 63 through col. 5, line 2) that:

[T]he write-once information is recorded by partially removing the reflective layer.

It is preferable that in the optical disk according to the third configuration, the main information and the write-once information are recorded by partially changing a reflection coefficient of a reflective layer.

From this disclosure of Oshima that the write-once information is recorded by partially removing the reflective layer, we find that in Oshima, the recording layer is "write-only" and is not rewritable. However, even assuming arguendo that we are incorrect in our understanding of the disclosure of Oshima, and Oshima teaches a rewritable recording layer, claim 1 is still not

met by Oshima as the reference fails to disclose that the identification mark is erasable. Oshima discloses (col. 22, lines 19-33) that:

The recording method for identifying information (write-once information) according to this embodiment can be almost the same as in the first and the second embodiment. That is, using a high-power laser, for example a YAG laser, and a unidirectional convergence focusing lens such as a cylindrical lens, a laser beam is focused on the recording layer **303** as oblong stripes. BCA portion **310** are recorded in the circumferential direction of the disk. When a laser beam with higher power than for the recording of information in the recording layer **303** is irradiated on the optical disk of this embodiment, an excessive structural change due to crystallization by phase transition occurs. Thus, it becomes possible to non-reversibly record the BCA portions **310**. It is preferable that the BCA portions **310** are recorded as non-reversible crystal phases.

From the disclosure of Oshima regarding the use of a laser (with a higher power than for recording of information on recording layer 303) for irradiating the optical disk to produce an excessive structural change due to crystallization, in order to non-reversibly record the BCA portions 310, we find that Oshima does not disclose the marks 310 to be reversibly recorded.

We are not persuaded by the examiner's assertion (answer, page 6) that Oshima's disclosure (col. 30, lines 23-34) of preventing the stripes from being destroyed, is a teaching of destroying the stripes/marks, and hence a teaching of erasing the

marks. Preventing destruction of the Marks is not a teaching of destroying the marks. In addition, even if Oshima discloses destroying the stripes/marks, we find no disclosure of erasure of the marks as a means of destroying them.

From all of the above, we find that the examiner has failed to establish a prima facie case of anticipation of claim 1. Accordingly, the rejection of claim 1 under 35 U.S.C. § 102(b) is reversed. As claim 7 also recites that the identification mark is erasable, the rejection of claim 7 under 35 U.S.C. § 102(b) is reversed.

We turn next to the rejection of claims 2-4 under 35 U.S.C. § 102(b) as being anticipated by Oshima, or in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Oshima ('299) in view of Satoh and Aoki. At the outset, we reverse the rejection of claims 2-4 under 35 U.S.C. § 102(b) as being anticipated based upon our findings, supra, with respect to claim 1, from which claims 2-4 depend. Turning to the 35 U.S.C. § 103(a) rejection, the examiner relies upon Satoh (claims 2 and 4) to support the examiner's taking of Official Notice that the use of spiral and concentric tracks are old and well known. The examiner additionally relies upon Aoki (claim 4) to support the examiner's assertion (answer, page 4) that:

[T]he ability of having address information as part of any track format is also considered well known and if not inherent in Oshima et al certain[ly] obvious over such well known formatting techniques.

We reverse the rejection of claims 2-4 because the examiner has not shown the obviousness of making the recording layer rewritable in Oshima, nor has the examiner shown that it would have been obvious to make the identification mark erasable. Satoh and Aoki fail to make up for these basic deficiencies of Oshima with respect to claim 1, from which claims 2-4 depend. In addition, of note is that although we agree with the examiner that Satoh teaches that it is old and well known that tracks can be in the form of spiral or concentric grooves, claim 2 requires more. The claim additionally recites that the spiral groove is interrupted in at least one location. We fail to find any teaching of this limitation, which the examiner has failed to address, and which has been argued by appellants. Accordingly, from all of the above, the rejection of claims 2-4 under 35 U.S.C. § 103(a) is reversed.

We turn next to the rejection of claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Oshima ('299) in view of Oshima ('551). We reverse the rejection of claim 5 as Oshima ('551) fails to make up for the basic deficiencies of Oshima ('299).

NEW GROUND OF REJECTION UNDER 37 CFR § 41.50(b).

Claims 1-5 and 7 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Claims 1 and 7 recite that an erasable identification mark is present in an identification mark area other than the data recording area. The claim goes on to recite that the erasable identification mark extends over a radial width of several tracks of the tracking structure in the data recording area. It is unclear as to how the mark can be in an area other than the data recording area and can extend in the data recording area. Accordingly, we find claims 1-5 and 7 to be indefinite within the meaning of 35 U.S.C. § 112, second paragraph. Note that claims 2-5 are indefinite based on their dependency from claim 1.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 and 7 under 35 U.S.C. § 102(b) is reversed. The decision of the examiner to reject claims 2-4 under 35 U.S.C. § 102(b) or in the alternative under 35 U.S.C. § 103(a) is reversed. The decision of the examiner to reject claim 5 under 35 U.S.C. § 103(a) is reversed. A New Ground of Rejection of claims 1-5 and 7 under 35 U.S.C. § 112, second paragraph, has been entered under 37 CFR 41.50(b). 37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

REVERSED; 37 CFR 41.50(b)

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH L. DIXON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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