

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TATSUJI EDA

Appeal 2007-2462
Application 10/150,933¹
Technology Center 2600

Decided: January 30, 2008

Before ANITA PELLMAN GROSS, ROBERT E. NAPPI, and MARC S. HOFF, *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a Final Rejection of claims 1-16. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellant's invention relates to an optical pickup. A plurality of laser light emitting elements are provided for reading different types of optical media. A photodetector receives the light from the light-emitting elements

¹ Application filed May 21, 2002. The real party in interest is Sony Corporation.

and monitors the received laser light power. A plurality of adjusters are included for adjusting the power of the light emitting elements. Finally, a switch is provided for selecting one of the plurality of adjusters (Specification 3-4).

Claim 1 is exemplary:

1. An optical pickup comprising:

a plurality of laser light-emitting elements;

a photodetector for receiving laser light radiated from the plurality of laser light-emitting elements and monitoring the power of the radiated laser light;

a plurality of adjusters for adjusting the power of the radiated laser light from the plurality of laser light-emitting elements via the photodetector; and

a switch for selecting one of the plurality of adjusters.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Appellant's Figure 3, admitted as prior art (hereafter "Figure 3").

Claims 1- 16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Figure 3. Because the date of Appellant's admitted prior art is not present in the record, however, we will treat these claims as being rejected under 35 U.S.C. § 102(a).

Appellant contends that the Examiner erred in his rejection because the switch depicted in Figure 3 is not shown on the so-called "optical pickup side," but rather on the "apparatus board side," and that therefore the Examiner erred in stating that Figure 3 teaches an optical pickup having a

switch as claimed. The Examiner argues that the claims are properly rejected because Figure 3 teaches a switch connected as the claims require.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the Briefs and the Answer for their respective details.

Only those arguments actually made by Appellant have been considered in this decision. Arguments that Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived.

See 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

The principal issue in the appeal before us is whether the Examiner erred in holding that Figure 3 teaches an optical pickup comprising a switch for selecting one of the plurality of adjusters.

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by substantial evidence.

The Invention

1. According to Appellant, he has invented an optical pickup including a plurality of laser light-emitting elements provided for reading different types of optical media (Specification 3-4).

2. A photodetector receives the light from the light-emitting elements and monitors the received laser light power (Specification 4).

3. A plurality of adjusters are included for adjusting the power of the light-emitting elements (Specification 4).

4. The optical pickup includes a switch (124) for selecting one of the plurality of adjusters (Specification 4).

5. Appellant distinguishes his invention from admitted prior art Figure 3 by noting that switch 124 is located on the “optical pickup side” (Specification 7), whereas in the prior art Figure, switch 34 is located on the “apparatus board side” (Specification 3).

Appellant’s Admitted Prior Art Figure 3

6. Figure 3 teaches an optical pickup including the claimed plurality of laser light-emitting elements, photodetector, and plurality of adjusters, interconnected as the claims require.

7. Figure 3 further teaches a switch (34) for selecting one of the plurality of adjusters. The switch is located on the part of the drawing labeled “apparatus board side,” whereas the other circuit elements are located on the part of the drawing labeled “optical pickup side.”

PRINCIPLES OF LAW

Anticipation is established when a single prior art reference discloses expressly or under the principles of inherency each and every limitation of the claimed invention. *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

“While the preamble is not normally considered part of the claim, it is deemed part of the claims where necessary to breathe “life and meaning” into the claims.” *In re Burke, Inc.*, 786 F. Supp. 1537, 1541 (S.D. Cal. 1992) (quoting *Corning Glass Works v. Sumitomo Electric U.S.A.*, 868 F.2d 1251 (Fed. Cir. 1989)). “The effect preamble language should be given can

be resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim.” *Id.*

ANALYSIS

Claims 1 and 16

Appellant argues that the Examiner erred in rejecting claims 1-16 as being anticipated by Figure 3, because “[t]he claims recite a switch as part of an optical pickup side” (Br. 4), a feature not taught or suggested in Figure 3. Because Figure 3 contains a vertical line B, to the left of which is labeled “Optical Pickup Side” and to the right of which is labeled “Apparatus Board Side,” Appellant argues that because switch 34 is drawn on the Apparatus Board Side, it is not part of the optical pickup shown in Figure 3, and therefore Figure 3 cannot anticipate the claims (Br. 4). In maintaining the rejection, the Examiner argues that “[t]he switch clearly is part of the pickup ... because it is connected directly to the pickup through the board” (Ans. 5).

Without adopting the Examiner’s specific rationale, we disagree with Appellant and agree with the Examiner. Contrary to Appellant’s assertion, the phrase “optical pickup side” appears nowhere in Appellant’s claims. Each of independent claims 1, 6, and 11 recites merely “an optical pickup comprising ...” in the preamble. No independent claim contains any limitation requiring the switch to be located on an “optical pickup side” and not an “apparatus board side,” as Appellant argues (see Br. 5). Further, the phrase “optical pickup” appears *only* in the preamble of the claims. We find therefore that the preamble is not necessary to breathe life and meaning into the claims, and we decline to give weight to the preamble in this context.

Admitted Prior Art Figure 3 teaches a switch (34) for selecting one of the plurality of adjusters (20, 22), as required by each independent claim (FF 7). Giving the claims their broadest reasonable interpretation, there is no claim language prohibiting the Examiner from construing the claimed “optical pickup” as encompassing all the elements on the so-called “optical pickup side” of line B in Figure 3, and further encompassing switch 34.

With regard to independent claim 6, although the claim calls for “an optical pickup used with an apparatus board . . .”, there is no limitation in the claim prohibiting the Examiner from construing the “optical pickup” of Figure 3 as including switch 34.

Independent claim 11 recites “an apparatus comprising an optical pickup comprising . . .”, but is otherwise identical to claim 1. We perceive no difference in meaning between the two claims, relative to Prior Art Figure 3. Our analysis of claim 11 is therefore the same as for claim 1.

We therefore affirm the rejection of independent claims 1, 6, and 11 under 35 U.S.C. § 102, as well as the rejection of claims 2-5, 7-10, and 12-16, dependent therefrom and not separately argued.

CONCLUSION OF LAW

We conclude that Appellant has not shown that the Examiner erred in rejecting claims 1-16. Claims 1-16 are unpatentable.

DECISION

The Examiner’s rejection of claims 1-16 is affirmed.

Appeal 2007-2462
Application 10/150,933

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

tdl/gw

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314