

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NATHANIEL BOYD WILSON,
REED DAVID HANSON,
and TIMOTHY FRANCIS ELLIS

Appeal 2008-0668
Application 10/302,445
Technology Center 2600

Decided: August 19, 2008

Before KENNETH W. HAIRSTON, ROBERT E. NAPPI,
and KARL D. EASTHOM, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 1, 2, 4-15, 17, and 18. Claims 19 and 20 have been allowed. Claims 3 and 16 have been indicated as being allowable but objected to as

depending from a rejected base claim. (*See* Office Action, mailed Sept. 21, 2006). We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Appellants' claimed invention relates to a method for identifying servo sector patterns by relating them to a reference servo sector pattern. (Spec. 9-10).

Claim 1 is illustrative of the invention and reads as follows:

1. A method comprising:

writing to a first recording surface a reference servo sector pattern;

writing to a second recording surface multiple interleaved sets of servo sector patterns;

identifying a selected one of the multiple interleaved sets of servo sector patterns on the second recording surface that provides a desired angular alignment with the reference servo sector pattern.

The Examiner relies on the following prior art reference to show unpatentability:

Sompel

US 5,553,086

Sept. 3, 1996

Claim 10 stands rejected under 35 U.S.C. 112 1st ¶ as lacking in scope of enablement.

Claims 1, 2, 4-11, 13-15, 17, and 18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sompel.

Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sompel in view of Applicants' admitted prior art (AAPA).

PRINCIPLES OF LAW

LACK OF ENABLEMENT

A single means element in a means plus function claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112 1st ¶. *In re Hyatt*, 708 F.2d 712, 714-715 (Fed. Cir. 1983).

ANTICIPATION

It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). “Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is

anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

OBVIOUSNESS

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore,

“there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

35 U.S.C. § 112 1st ¶ REJECTION

With respect to the 35 U.S.C. § 112, 1st ¶ rejection, the Examiner asserts that “[c]laim 10 is in the form of a single means claim and therefore covers every conceivable means for accomplishing the stated purpose. . . .”

(Ans. 3) (citing *In re Hyatt*). Appellants argue that claim 10 is not in means plus function format, so that it is not a single means claim. (Reply Br. 5).

The Examiner responds that “claim 10 is rejected not based on whether it is means plus function. Claim 10 is rejected because it is a single means claim.” (Ans. 8). Appellants respond, in turn, that “*In re Hyatt* and MPEP 2164.08(a) explicitly define a single means claim as being a claim in means plus function form but reciting only a single element instead of a combination.” (Reply. Br. 6).

We agree with Appellants. For the issue at hand, *In re Hyatt* applies to single element claims in means plus function format. In other words, the MPEP and the decision of *In re Hyatt* references to “single means” claims are simply short-hand for “means plus function” claims having only one element:

The final paragraph of § 112 saves *combination* claims drafted using means-plus-function format from this problem by providing a construction of that format narrow enough to avoid the problem of undue breadth as forbidden by the first paragraph. But no provision saves a claim drafted in means-plus-function format which is not drawn to a combination, i.e., a single means claim.

Id., at 715.

As the Examiner acknowledges that claim 10 is not in “means plus function” form, and we determine that the Examiner is correct in that regard, it follows that claim 10 is not a “single means” claim. Accordingly, as the Examiner bases the rejection on the determination that claim 10 is a “single

means” claim, the Examiner has failed to establish a prima facie case of lack of enablement or undue breadth.¹

35 U.S.C. § 102(b) REJECTION

With respect to the 35 U.S.C. § 102(b) rejection of independent claim 1 based on Sompel, Appellants dispute the Examiner’s determination that Sompel discloses “*identifying a selected one of the multiple interleaved sets . . . that provides a desired angular alignment with the reference servo sector pattern.*” (Reply. Br. 9). The Examiner determined that Sompel discloses such alignment, stating:

The written servo sector patterns on each disc surfaces are formed into cylinder which are *vertically aligned*, supported and positioned by an actuator structure (see column 5 lines 37-43). The concept of cylinder teaches identifying a selected one of the multiple interleaved sets of servo sector patterns on the second recording surface that provides a desired alignment with the reference servo sector pattern as claimed.

(Ans. 9, emphasis added).

In other words, the Examiner equates the teaching of vertically aligned cylinders with the claimed identification of an angular alignment. However, in accordance with Appellants’ argument (Reply Br. 9-10), we see no basis for interpreting the claimed angular alignment as being met by Sompel’s vertical alignment. Moreover,

¹ We do not imply that only single means claims can run afoul of the scope of enablement prohibition.

the passage upon which the Examiner relies in Sompel relates to *head* alignment, as opposed to servo sector alignment:

Thus, during the servo writing operation, the actuator structure 18 may be controllably positioned at each one of a multiplicity of concentric “cylinder” locations (“*cylinder*” referring to the *vertically aligned track positions of all heads of the head stack* supported and positioned by the actuator structure 18).

(Sompel, col. 5, ll. 37-43, emphasis added).

In view of the above discussion, since all of the claim limitations are not present in the disclosure of Sompel, we will not sustain the Examiner’s 35 U.S.C. § 102(b) rejection of independent claim 1. Since claim 10 recites a similar limitation involving the same issue in dispute, we also will not sustain the Examiner’s 35 U.S.C. § 102(b) rejection of claim 10. Since claims 2, 4-9, 11, 13-15, 17, and 18 ultimately depend from either claims 1 or 10, we also will not sustain the Examiner’s 35 U.S.C. § 102(b) rejection of those claims.

35 U.S.C. § 103(a) REJECTION

We also will not sustain the Examiner’s obviousness rejection of claim 12, which depends from claim 10, based on the teaching of Sompel and Applicants’ admitted prior art (AAPA). The Examiner does not assert that the AAPA cures the deficiencies we found above in Sompel regarding the angular alignment as set forth in claim 10. (*See* Ans. 10).

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CONCLUSION

In summary, we will not sustain the Examiner's rejections of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1, 2, 4-15, 17, and 18 is reversed.

REVERSED

KIS

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