

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FUMISADA MAEDA and YOSHINORI MATSUMOTO

Appeal No. 1997-2852
Application No. 08/354,454

ON BRIEF¹

Before HAIRSTON, LALL, and GROSS, Administrative Patent Judges.
GROSS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 2 through 4, which are all of the claims pending in this application.

Appellants' invention relates to a magneto-optical disc apparatus in which the magnetic field generating means is

¹ We observe that on March 24, 2000 (paper no. 23), appellants filed a waiver of the oral hearing set for April 7, 2000.

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rotatable about an axis parallel to the magneto-optical disc and also moves in a direction perpendicular to the surface of the disc, thereby applying magnetic fields of varying intensities. Claim 4 is illustrative of the claimed invention, and it reads as follows:

4. A magneto-optical disc apparatus for use with plural discs requiring different magnetic field intensities, comprising:

a magnetic field generating source for applying a plurality of discrete magnetic field intensities individual to one of said discs to a magneto-optical disc during reading or writing, said magnetic field generating source being made freely rotatable about an axis substantially parallel to and overlying a surface of said magneto-optical disc to allow rotating said source to change the direction of the field generated by said source relative to said disc; and

means for changing a distance of said rotation central axis of said magnetic field generating source relative to said magneto-optical disc, to provide said plurality of magnetic field intensities at said disc.

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

Naito et al. (Naito) 1988	4,748,606	May 31,
Miyatake et al. (Miyatake) 1993	5,202,863	Apr. 13,

Claims 2 through 4 stand rejected under 35 U.S.C. § 112, first paragraph, as being non-enabled.

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Claims 2 through 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Miyatake in view of Naito.

Reference is made to the Examiner's Answer (Paper No. 20, mailed November 26, 1996) for the examiner's complete reasoning in support of the rejections, and to appellants' Brief (Paper No. 19, filed July 19, 1996) for appellants' arguments thereagainst.

OPINION

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellants and the examiner. As a consequence of our review, we will reverse both the enablement rejection and also the obviousness rejection of claims 2 through 4.

The examiner asserts (Answer, page 3) that "[m]echanisms for moving a base plate up and down are known in the art. However, mechanisms for moving a base plate up and down with a magnetic field generator that rotates are not known in the art." As appellants have provided no details in the specification as to the actual mechanism for changing the distance between the magnetic field generator and the magneto-optical disc, the examiner concludes that appellants "has

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[sic, have] not adequately taught how to make a rotating magnetic field generating source that changes it's [sic] position relative to the surface of the disc."

"A patent must contain a description that enables one skilled in the art to make and use the claimed invention." Atlas Powder Co. v. E.I. DuPont De Nemours and Co., 750 F.2d 1569, 1576, 224 USPQ 409, 411 (Fed. Cir. 1984). "An inventor need not, however, explain every detail since he is speaking to those skilled in the art." In re Howarth, 654 F.2d 103, 105, 210 USPQ 689, 691 (CCPA 1981). "A patent need not teach, and preferably omits, what is well known in the art." Spectra-Physics, Inc. v. Coherent, Inc., 827 F.2d 1524, 1534, 3 USPQ2d 1737, 1743 (Fed. Cir. 1987).

The examiner admits that mechanisms for adjusting the position of the base plate are known in the art. We see no reason why varying the position of a rotatable magnetic field generator would require any more than minor adaptations by a skilled artisan. The level of the skilled artisan should not be underestimated. See In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). The examiner relies (Answer, page 9) on appellants' statement in the Brief filed on June

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13, 1996, that rotation of Miyatake's magnetic field generators would be difficult if not impossible to accomplish, as evidence that the skilled artisan would need more guidance than is disclosed for how to move a rotatable magnetic field generator up and down. However, there is an enormous difference between making a single rotatable magnet move up and down and making the dual coil magnet of Miyatake rotatable. Although the former appears to be achievable by the skilled artisan, we agree with appellants that the latter is beyond the skilled artisan's ability. Accordingly, we must reverse the enablement rejection of claims 2 through 4.

Regarding the obviousness rejection, as pointed out by appellants (Brief, pages 6-7), the magnetic field generators of Miyatake do not change positions "to provide said plurality of magnetic field intensities," as required by claim 4. Instead the magnetic field generator in Miyatake's third embodiment, upon which the examiner relies, includes two coils, 37 and 43, to which current is selectively applied to vary the intensity of the magnetic field (see column 16, lines 14-42). The different intensities are obtained by switching the current from one coil to another. Therefore, contrary to

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the examiner's assertion (Answer, page 4), Miyatake fails to meet the limitation in the last paragraph of claim 4.

Furthermore, the examiner contends (Answer, page 5) that it would have been obvious to provide in Miyatake's device "the magnetic field generating means as taught by Naito et al in lieu of the magnetic field generating means of Miyatake." However, Naito does not address using varying magnetic field intensities like the two coil magnets in Miyatake. Therefore, it is unclear how the single rotatable magnet of Naito could replace the two coil magnetic field generating means of Miyatake. In other words, the examiner has failed to establish a prima facie case of obviousness. Consequently, we cannot sustain the obviousness rejection of claims 2 through 4.

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CONCLUSION

The decision of the examiner rejecting claims 2 through 4 under 35 U.S.C. § 112, first paragraph, is reversed. The decision of the examiner rejecting claims 2 through 4 under 35 U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
PARSHOTAM S. LALL)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
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ANITA PELLMAN GROSS)	
Administrative Patent Judge)	

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