

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** AKIHIKO OKAMOTO

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Appeal No. 1998-0996  
Application No. 08/498,385

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HEARD: March 16, 2004

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Before BARRETT, DIXON, 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 1 through 25, which are all of the claims pending in this application.

Appellant's invention relates to an optical disc holder the cover of which filters out specific wavelengths of ambient light, thereby preventing them from passing through the cover, and allows visible light to pass through the cover. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. An optical disc holder, comprising:  
a body;

Appeal No. 1998-0996  
Application No. 08/498,385

a cover;

at least one of said body and said cover filtering specific wavelengths of ambient light, thereby preventing the specific wavelengths of ambient light from passing therethrough and reaching an interior of said optical disc holder while allowing light having visible wavelengths to pass therethrough.

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

Inaba	4,455,642	Jun. 19, 1984
Mori	4,560,252	Dec. 24, 1985

Kirk-Othmer, 23 *Encyclopedia of Chemical Technology* 615-27  
(3d ed., John Wiley & Sons) (Kirk-Othmer)

Appellant's admitted prior art, disclosed at pages 1 and 2 of the specification and shown in Figure 7. (AAPA)

Claims 1, 2, 6, 7, and 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Inaba.

Claims 3 through 5, 8 through 20, and 22 through 25 stand rejected under 35 U.S.C. § 103 as being unpatentable. As evidence of obviousness, the examiner applies Inaba alone against claim 8, adds Mori for claims 3 through 5, 9, 14 through 17, and 22 through 25, and further adds Kirk-Othmer for claim 10. The examiner applies Inaba in view of AAPA for claims 11 through 13 and 18 and adds Mori for claims 19 and 20.

Appeal No. 1998-0996  
Application No. 08/498,385

Reference is made to the Examiner's Answer (Paper No. 16, mailed September 3, 1997) for the examiner's complete reasoning in support of the rejections, and to appellant's Brief (Paper No. 15, filed July 3, 1997) and Reply Brief (Paper No. 17, filed October 20, 1997) for appellant's arguments thereagainst.

**OPINION**

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellant and the examiner. As a consequence of our review, we will reverse the anticipation rejection of claims 1, 2, 6, 7, and 21 and also the obviousness rejections of claims 3 through 5, 8 through 20, and 22 through 25.

Independent claim 1 recites that at least one of the body and the cover "filter[s] specific wavelengths of ambient light, thereby preventing the specific wavelengths of ambient light from passing therethrough . . . while allowing light having visible wavelengths to pass therethrough." Claim 21 includes a similar recitation. Thus, claims 1 and 21 require that the body or the cover passes visible light and filters out (prevents from passing) certain other wavelengths of light.

Inaba discloses (column 6, lines 1-21) that direct sunlight may heat and deform the disc within the disc case because the

Appeal No. 1998-0996  
Application No. 08/498,385

disc case is made from a semitransparent material. Inaba solves the problem by mixing titanium particles in the main body material "in order to reflect light" (see column 6, lines 9-10). The titanium particles reflect all wavelengths of light, thereby attenuating the light that passes through the disc case. Inaba makes no mention of filtering out specific wavelengths other than visible light. Therefore, contrary to the examiner's assertions (Answer, pages 4-5 and 11-12), Inaba fails to disclose the claimed filtering. Accordingly, Inaba does not anticipate claims 1 and 21 and their dependents, claims 2, 6, and 7.

For claim 8 the examiner contends (Answer, page 6) that the particular colors claimed are merely a matter of routine experimentation. The examiner adds no evidence or convincing line of reasoning to overcome the deficiencies of Inaba noted *supra* as to filtering of specific wavelengths. Therefore, we cannot sustain the obviousness rejection of claim 8.

The examiner (Answer, pages 6-7) includes Mori to reject claims 3 through 5, 9, 14 through 17 and 22 through 25. Of these claims, claim 15 is independent, with claims 16, 17, and 24 dependent therefrom; claim 25 depends from independent claim 18 which the examiner rejects over Inaba and AAPA (Answer, page 9); and the rest depend from claims 1 and 21. Both claims 15 and 18,

Appeal No. 1998-0996  
Application No. 08/498,385

like claim 1, recite that at least one of the body and the cover filter specific wavelengths while allowing visible light to pass through, but claim 15 specifies that the wavelengths are in the ultraviolet range.

The examiner argues (Answer, page 7) that Mori discloses "an optical filter assembly which reflects and absorbs an ultraviolet and/or infrared light while transmitting a visible light due to the ultraviolet light and infrared light being undesirable wavelengths." The examiner concludes that it would have been obvious to modify Inaba's cover or body to include an optical filter which reflects and absorbs ultraviolet and/or infrared light while transmitting visible light "to have avoided any damage to the material on the other side of the light path."

We agree with the examiner that Mori discloses an optical filter which reflects ultraviolet and/or infrared rays. However, Mori teaches (column 1, lines 34-40, and column 3, lines 1-10) that the filter is used because ultraviolet and infrared rays are harmful **for photosynthetic reactions**. As the content of Inaba's disc case is not involved in photosynthetic reactions, we find it difficult to understand how the skilled artisan would obtain from Mori's disclosure motivation to use an ultraviolet and/or infrared filter to protect Inaba's disc. Thus, Mori fails to

Appeal No. 1998-0996  
Application No. 08/498,385

cure the deficiencies of Inaba discussed *supra*, and we cannot sustain the obviousness rejection of claims 3 through 5, 9, 14 through 17 and 22 through 25.

Claim 10 depends from claim 9 and further recites specific materials for the ultraviolet ray shading material. The examiner (Answer, pages 8-9) cites Kirk-Othmer's section on UV stabilizers asserting that it would have been obvious "to provide the disc cartridge holder of Inaba '642 with an ultraviolet shading material being selected from the . . . [claimed] compounds as shown by 'Ultraviolet Absorbers' in order to avoided [sic] the degradation of a polymer compound of which the absorber is a part."

Although Kirk-Othmer does teach that sunlight and other sources of ultraviolet light degrade polymers and light sensitive materials, the examiner has not established that the disc holders of Inaba (which are made of synthetic resin) are exposed to such radiation and would, therefore, require protection from such radiation. Furthermore, the examiner has failed to explain why the skilled artisan would have selected the particular compounds claimed. Merely that Kirk-Othmer discloses that such materials may be used for ultraviolet filtering is insufficient motivation

Appeal No. 1998-0996  
Application No. 08/498,385

for selecting those materials. Therefore, we cannot sustain the obviousness rejection of claim 10.

Claims 11 through 13 and 18 recite the structure of the optical disc cartridge in addition to the limitations of claim 1. The examiner combines AAPA, which describes and illustrates the claimed structure, with Inaba. Since AAPA does not disclose filtering predetermined wavelengths and passing visible wavelengths, AAPA fails to overcome the deficiencies of Inaba. Consequently, we cannot sustain the rejection of claims 11 through 13 and 18.

For claims 19 and 20, the examiner adds Mori to Inaba and AAPA to teach filtering ultraviolet wavelengths. However, as discussed *supra*, the teachings of Mori are inapplicable to a disc holder. Therefore, Mori fails to remedy the shortcomings of the primary combination, and we cannot sustain the rejection of claims 19 and 20.

Appeal No. 1998-0996  
Application No. 08/498,385

**CONCLUSION**

The decision of the examiner rejecting claims 1, 2, 6, 7, and 21 under 35 U.S.C. § 102(b) and also claims 3 through 5, 8 through 20, and 22 through 25 under 35 U.S.C. § 103 is reversed.

**REVERSED**

LEE E. BARRETT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JOSEPH L. DIXON	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
ANITA PELLMAN GROSS	)	
Administrative Patent Judge	)	

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Appeal No. 1998-0996  
Application No. 08/498,385

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