

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(2) is not binding precedent of the Board.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. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HARUKAZU MIYAMOTO, TOSHIO NIIHARA,  
MOTOYASU TERAU, NORIO OHTA and  
MASAAKI KUREBAYASHI

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Appeal No. 1996-3787  
Application 07/607,870

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HEARD: FEBRUARY 9, 2000

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Before PAK, WARREN, and WALTZ, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's  
refusal to allow claims 38, 39 and 41 through 47 which are all  
of the claims remaining in the application. Claims 41, 42 and  
43 were amended subsequent to the final Office action dated

Appeal No. 1996-3787  
Application No. 07/607,870

February 9, 1995. See Paper No. 25.

Claim 41 is representative of the subject matter on appeal and reads as follows:

41. A magneto-optical recording medium comprising a substrate and a multilayer magnetic film, wherein said multilayer magnetic film includes at least a recording layer and a supporting layer, and wherein said multilayer magnetic film exhibits a magneto-optical effect on reflected light of a laser beam irradiating the recording medium, characterized in that the recording layer has a higher Curie temperature than has the supporting layer and the recording layer has a greater coercive force than has the supporting layer at room temperature, the recording layer has a thickness of

10-50 nm, and the multilayer magnetic film has a thickness of 20-100 nm, the recording medium having properties that it can be overwritten, and read-out for verification can be performed immediately after overwriting, and wherein the recording medium further comprises a metal reflecting layer on the multilayer magnetic film.

As evidence of obviousness, the examiner relies on the following prior art:

Katayama et al. (Katayama)	4,645,722	Feb. 24, 1987
Osato et al. (Osato)	4,664,977	May 12, 1987 <sup>1</sup>

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<sup>1</sup> Although the examiner lists published European Patent Application 0 258 978 to Osato et al. as "Prior Art of Record" on pages 2-3 in the Answer, the examiner relies on Osato '977 (U.S. Patent No. 4,664,977) in the statement and body of rejection set forth in the final Office action dated February

Appeal No. 1996-3787  
Application No. 07/607,870

Claims 38, 39 and 41 through 47 stand rejected under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Katayama and Osato.

We reverse.

To a large extent, we agree with appellants' arguments on appeal. The examiner simply has not supplied any motivation for utilizing a magneto-optical recording medium having, *inter alia*, a magnetic recording layer having the claimed thickness, 10-50 nm, and the claimed properties. Although the examiner refers to Katayama to establish obviousness of the claimed recording layer of a magneto-optical recording medium, it only discloses a photo-thermo-magnetic recording medium having a magnetic recording layer having a thickness of about 1000 to 5000 angstrom (about 100 to 500 nm), a large coercive force

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9, 1995 and in the Answer. Appellants have also responded to the examiner's § 103 rejection as though it relies on Osato '977. See Brief, page 23. Accordingly, we will presume that the examiner's § 103 rejection is based on, *inter alia*, Osato '977 (U.S. Patent No. 4,664,977) rather than the published European Patent Application. If the examiner's intention is to rely on the published European Patent Application, he must set forth a new ground of rejection and reopen the prosecution of this application.

Appeal No. 1996-3787  
Application No. 07/607,870

and a suitable Curie temperature. See column 4, lines 6-12. Nowhere does it recognize the importance of utilizing, ***inter alia***, a magnetic recording layer having a thickness of 10-50 nm and a coercive force and Curie temperature higher than a magnetic supporting layer in a magneto-optical recording medium.

Moreover, the examiner has not supplied any motivation to utilize the reflective and phase modulating layer taught in Osato in the photo-thermo-magnetic recording medium of the type describe in Katayama. On this record, the examiner has failed to establish that the reflective and phase modulating (metallic) layer useful for imparting the so-called "enhancement of their readout properties, such Kerr rotation and C/N" to the particular magneto-optical recording medium taught in Osato is also useful for imparting the same to Katayama's photo-thermo-magnetic recording medium having a materially different multi-layered structure.

Accordingly, we conclude that the examiner has failed to establish a prima facie case of obviousness within the meaning of 35 U.S.C. § 103.

Appeal No. 1996-3787  
Application No. 07/607,870

The decision of the examiner is reversed.<sup>2</sup>

As a final point, we note that appellants describe some of the drawings as "prior art" at page 4 of the specification. Upon return of this application, both the examiner and appellants are advised to designate those drawings by a legend such as "Prior Art". MPEP § 608.02(g) (7th ed. July 1998).

REVERSED

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CHUNG K. PAK	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
CHARLES F. WARREN	)	
Administrative Patent Judge	)	APPEALS AND
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	)	INTERFERENCES
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<sup>2</sup> According to 37 CFR § 1.106 (c) (1994), "[i]n rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his command. When a reference . . . shows or describes inventions other than that claimed by the applicant, the particular part relied on **must be** designated as nearly as practicable (emphasis added)." However, the examiner has not referred to any particular part of the applied prior art, which he relied on to support his rejection. Although we could have remanded the application to the examiner on this basis, we have declined to do so since we disagree with the examiner on the merits of the § 103 rejection.

