

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASATSUGU SUWABE

Appeal No. 96-3961
Application No. 08/295,268¹

ON BRIEF

Before HAIRSTON, KRASS and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-8, all of the claims pending in the present application. An amendment after final rejection was filed November 13, 1995 and was entered by the Examiner.

¹ Application for patent filed August 24, 1994.

Appeal No. 96-3961
Application No. 08/295,268

The claimed invention relates to an optical disk recording medium having a hub portion provided on one side of a single layer disk substrate and a reinforcing plate provided on the opposite side of the substrate.

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

1. An optical disk recording medium comprising:

a single layer disk substrate, information data being writable in a data read/write side thereof, said substrate further having an opening formed therethrough at a central portion thereof;

a hub portion provided on one side of said disk and covering said opening, said hub portion including a circular magnetic plate having a centering opening provided at a position corresponding to a center of said disk;

a reinforcing plate provided on a side of said substrate opposite said one side on which said hub portion is provided, said reinforcing plate also covering said opening of said substrate and having a center opening formed therethrough.

The Examiner relies on the following references:

Ommori et al. (Ommori) 1987	4,694,370	Sep. 15,
Kikuchi 1990	4,944,982	Jul. 31,
Ota et al. (Ota) 1993	5,265,086	Nov. 23,
Naito 1987	62-80240	May 22,

Appeal No. 96-3961
Application No. 08/295,268

(Japanese Patent Publication)²

The rejections of the appealed claims are set forth by the Examiner as follows:

1. Claims 1-3 stand finally rejected under 35 U.S.C. § 103 as being unpatentable over Japanese patent '240³ in view of Ota.

2. Claims 4 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Japanese patent '240 in view of Ota and further in view of Ommori.

3. Claims 6-8 stand finally rejected under 35 U.S.C. § 103 as being unpatentable over Japanese patent '240 in view of Kikuchi.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Brief and Answer for the respective details.

OPINION

² A copy of the translation provided by the U. S. Patent and Trademark Office, June 8, 1999, is included and relied upon for this decision.

³ Since both Appellant and the Examiner refer to the Japanese patent publication by patent number rather than the inventor's name, we will do so also in this decision to maintain consistency.

Appeal No. 96-3961
Application No. 08/295,268

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Brief along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer. It is our view, after consideration of the record before us, that the collective evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-8. Accordingly, we reverse.

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, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual

Appeal No. 96-3961
Application No. 08/295,268

determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part

Appeal No. 96-3961
Application No. 08/295,268

of complying with the burden of presenting a prima facie case
of

obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24

USPQ2d

1443, 1444 (Fed. Cir. 1992).

With respect to independent claim 1, the Examiner, as the basis for the obviousness rejection, seeks to modify Japanese patent '240 by relying on Ota to supply the missing teaching of a reinforcing plate provided on the opposite side of a substrate from a hub portion. In the Examiner's view, the desire to increase stability of the hub arrangement of Japanese patent '240 would serve as a motivating factor to one of ordinary skill to add a reinforcing plate as taught by Ota.

In response, Appellant attacks the Examiner's characterization of the Figure 9 hub 31 of Ota as a reinforcing plate. Additionally, Appellant contends that Ota's hub arrangement does not include a reinforcing plate on the opposite side of a substrate from a hub portion.

Upon careful review of the cited references, we agree with both of the above assertions of Appellant. In our opinion, there is nothing in the disclosure of Ota to suggest that the

Appeal No. 96-3961
Application No. 08/295,268

hub 31 serves to reinforce the substrate in any manner. Further, there is no reasonable interpretation of the hub construction illustrated in Figure 9 that would support a finding that a reinforcing plate is provided on opposite sides of a substrate from a hub portion as claimed. We further agree with Appellant's stated position (Brief, page 7) as to the Examiner's failure to establish proper motivation for the proposed combination of references. It is our view that, even assuming arguendo that the hub structure of Ota could be considered to include a reinforcing plate situated on the opposite side of a substrate from a hub portion, no motivation exists for modifying the Japanese patent '240 in the manner suggested by the Examiner. There is nothing in the disclosure of Japanese patent '240 to indicate that lack of stability was ever a problem. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The only basis for applying Ota's teachings to the Japanese patent '240 device comes from an improper attempt to reconstruct Appellant's

Appeal No. 96-3961
Application No. 08/295,268

invention in hindsight. Accordingly, we can not sustain the Examiner's obviousness rejection of independent claim 1. Since all of the limitations of independent claim 1 are not suggested by the applied prior art, we can also not sustain the Examiner's rejection of appealed claims 2 and 3 which depend therefrom.

With respect to dependent claims 4 and 5, the Examiner adds Ommori to the combination of Japanese patent '240 and Ota solely to meet the reinforcing plate "groove" limitation. Ommori, however, does not overcome the innate deficiencies of the combination of Japanese patent '240 and Ota and, therefore, we do not sustain the rejection of dependent claims 4 and 5 under 35 U.S.C. § 103.

We now turn to the Examiner's obviousness rejection of independent claim 6 based on the combination of Japanese patent '240 and Kikuchi. Appellant has argued that Kikuchi suffers from similar deficiencies as Ota with regard to the claimed reinforcement plate arrangement. We agree. In our opinion, there is nothing in Kikuchi to suggest that either of the hubs 78a, 78b, reinforce the substrates 73a, 73b or, in any case,

Appeal No. 96-3961
Application No. 08/295,268

that any such reinforcement plate is on the opposite side of a single substrate from a hub portion. Accordingly, since all the limitations of independent claim 6 are not suggested by the applied prior art, we cannot sustain the Examiner's rejection of independent claim 6 and claims 7 and 8 which depend therefrom under 35 U.S.C. § 103.

In summary, we have not sustained any of the Examiner's rejections of appealed claims 1-8. Therefore, the decision of the Examiner rejecting claims 1-8 is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
ERROL A. KRASS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	

jrg

Appeal No. 96-3961
Application No. 08/295,268

Philip M. Shaw, Jr.
Limbach and Limbach
2001 Ferry Building
San Francisco, CA 94111

Appeal No. 96-3961
Application No. 08/295,268