

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NIRO NAKAMICHI

Appeal No. 1997-3980
Application 08/253,887

ON BRIEF¹

Before THOMAS, DIXON and BARRY, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 1, 8, 13 and 15. Claims 9-12 and 17 have been allowed, and the examiner has objected to claims 2-7, 14 and 16.

¹ Inasmuch as the panel has only recently received this appeal for decision, we note initially that the examiner's communication on April 21, 2000, indicated that appellant's request for oral hearing was not filed in a timely manner. Therefore, this decision is rendered on brief.

Representative claim 1 is reproduced below:

1. A disk player for storing disks, each having a spindle hole, and playing a selected disk of the disks, comprising:

a magazine having holding means for holding disks;

a playback position;

means for reading said selected disk, of said disks, when said selected disk is moved to said playback position;

means for transporting said selected disk between said playback position and a store position within said magazine;

a first shaft extending into said magazine, through said spindle hole of at least one of said disks in said magazine and having an end in said magazine at a first position;

a second shaft extending into said magazine, coaxially aligned with and opposing said first shaft;

said second shaft extending through said spindle hole of at least another of said disks held in said magazine and having an end in said magazine at a second position; and

said first and second position defining a gap, aligned in a common plane with said playback position, said selected disk passing through said gap when said means for transporting said selected disk transports said selected disk between said store position in said magazine and said playback position.

The following reference is relied on by the examiner:

Noguchi et al. (Noguchi)

5,210,728

May 11, 1993

Claim 13 stands rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Noguchi. Claims 1, 8 and 15 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Noguchi alone.

Rather than repeat the positions of the appellant and the examiner, reference is made to the brief² and the answer for the respective details thereof.

OPINION

We reverse both rejections of the claims on appeal.

With respect to the rejection under 35 U.S.C. § 102, appellant asserts that Noguchi does not teach two clauses of claim 13 on appeal: the first being “a shaft extending through said spindle holes of said disks to secure said disks in said magazine;” and the second being “said shaft being sized to keep said disks in held positions that insure proper withdrawal and insertion of said single disk.”

As to this rejection, the examiner does not set forth any details with respect to the manner in which all details, including the just noted portions of claim 13, Noguchi meets within 35 U.S.C. § 102 the subject matter of claim 13 on appeal. It appears from page 6 of the answer that the examiner argues the correspondence of the two noted clauses argued

² In the communication from the examiner on April 21, 2000, the examiner has not entered the reply brief. As such, we have not considered it in our deliberations.

by appellant in the same manner and with respect to the same figures as the examiner urges with respect to the rejection under 35 U.S.C. § 103.

The examiner urges that when the shaft 95 in Figure 10(e) is in the aperture of a disk, “it secures the disk by way of not allowing it to move horizontally out of the magazine.” In this broad sense, we agree with the examiner's view that the shaft 95 broadly secures or otherwise keeps the disk within the magazine such that it is not allowed to move out of it. However, we part company with the examiner's view that shaft 95 is “sized to keep said disks in held positions that ensure proper withdrawal and insertion of said single disk.” These latter limitations require much more than merely keeping the disk positioned in the magazine so that the disk may be either removed or inserted into the magazine. The claim requires that the shaft must be so-sized as to “keep” the disks in “held” positions. This feature is not taught within Noguchi.

The discussion of the shaft in the abstract between lines 2 and 10, and particularly in lines 8 through 10, indicate that the shaft has a smaller diameter than the central opening of the disk when received within the stacker. A similar feature is recited in the summary of the invention at column 2, lines 43 through 47. The corresponding discussion of Figure 10 at column 9, line 19 through column 10, line 8 also indicates that the attached nut 96 fixing the bottom of the stacker 90 and in engagement

with the threaded shaft 95 has a smaller diameter than the central aperture 101 of the disk itself.

Therefore, we are persuaded by the appellant's position that the two clauses taken as a whole are not met by the teachings in Noguchi. The claim requires that the disks be in "held" position, which feature is not met by the examiner's reasoning since the shaft would permit what we surmise is a substantial lateral movement of the disk even when the shaft protrudes through it. The functional requirement of the actual language of the claim is much more restrictive than merely "keeping" the disks positioned within the magazine as asserted by the examiner. Keeping the disks in "held" positions requires necessarily that the diameter of the shaft be much larger than would be allowed according to the teachings and showings in Noguchi. Note by careful study, the size relationships of the Noguchi shaft 95 in Figures 1b, 2a, 3b and 10a-d. Therefore, we reverse the rejection of claim 13 under 35 U.S.C. § 102.

We also reverse the rejection of claims 1, 8 and 15 under 35 U.S.C. § 103. The examiner's position at page 4 of the answer indicates that Noguchi does not teach the claimed second shaft extending into a magazine. As we see it, the issue is more complex than merely duplicating, that is, providing another shaft in addition to the shaft 95 shown in representative Figures 10a-e of Noguchi. We do not agree initially with the examiner's motivation rationale that it would have been obvious for the artisan to have

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provided such an additional shaft since doing so “would further secure the disks in the upper portion of the magazine 90.” The overall teachings of Noguchi as a whole indicate that the disks are relatively secure within the magazine anyway. Therefore, the artisan would have had no need to further secure them. We also do not agree with the examiner's rationale that the shafts essentially have the same claimed purpose. There are significant functional limitations relating to the recitations in representative independent claim 1 on appeal, for example, relating to the first shaft and the second shaft and their relationship to each other in their respective positions, such that in these first and second positions they define a gap. The examiner's reasoning provides no rationale how the examiner proposes the artisan would have arrived at the claimed gap in an alignment with the common plane of the playback position. The examiner's position as to the motivation to modify Noguchi is conclusory and speculative.

Therefore, we reverse the rejection of independent claims 1 and 15 and dependent claim 8 under 35 U.S.C. § 103.

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In view of the foregoing, we have reversed the examiner's rejection of claim 13 under 35 U.S.C. § 102 and the rejection of claims 1, 8 and 15 under 35 U.S.C. § 103. Therefore, the decision of the examiner is reversed.

REVERSED

James D. Thomas)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
Joseph L. Dixon)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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Lance Leonard Barry)	
Administrative Patent Judge)	

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