

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(2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* HIROSHI KORIYAMA, NORIO TAGAWA, KENJI ITOH,  
MISA IWAMOTO, and TAKAHIRO SUZUKI

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Appeal No. 1998-0453  
Application No. 08/381,306

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ON BRIEF

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Before THOMAS, BARRETT, and DIXON, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 13 and 16,  
which are all of the claims pending in this application.

We REVERSE.

## BACKGROUND

The appellants' invention relates to a magnetic disk drive having means for reducing disk deformation. An understanding of the invention can be derived from a reading of exemplary claim 13, which is reproduced below.

13. A clamping structure for clamping  $n$  disks, wherein  $n$  is greater than 3, comprising:

a spindle hub for receiving said disks and having a flange at a first end thereof, said flange having a first protruding portion, said disks being stacked on said first protruding portion;

$n-1$  spacers interposed between adjacent ones of said  $n$  disks, said  $n-1$  spacers including an uppermost spacer and a lowermost spacer; and

a clamp ring fixed to a second end of said spindle hub, said clamp ring having a second protruding portion for biasing said disks toward said flange of said spindle hub,

wherein only an outer circumference of said uppermost spacer and an outer circumference [sic: of] said lowermost spacer include an annular groove.

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

Brooks et al. (Brooks)	5,006,942	Apr. 09, 1991
Brue et al. (Brue)	5,267,106	Nov. 30, 1993

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Claims 13 and 16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Brue or Brooks.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer<sup>1</sup> (Paper No. 16, mailed May 5, 1997) and the supplemental examiner's answer (Paper No. 20, mailed Oct. 2, 1997) for the examiner's reasoning in support of the rejections, and to the appellants' brief (Paper No. 15, filed Jan. 24, 1997), reply brief (Paper No. 19, filed Jul. 3, 1997), and supplemental reply brief (Paper No. 21, filed Nov. 14, 1997) for the appellants' arguments thereagainst.

### **OPINION**

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

"Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed

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<sup>1</sup> We note that in the answer, the examiner made a new grounds of rejection over Brooks and maintained the prior rejection over Brue.

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invention." **RCA Corp. v. Applied Digital Data Systems. Inc.**, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

It is well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office (PTO). **See In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). After the PTO establishes a *prima facie* case of anticipation based on inherency, the burden shifts to the appellant to prove that the subject matter shown to be in the prior art does not possess the characteristics of the claimed invention. **See In re Thorpe**, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); **In re King**, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986). Hence, appellants' burden before the PTO is to prove that the applied prior art reference does not perform the functions defined in the claims. The appellants have not come forward with any evidence to satisfy that burden. Compare **In re Best**, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); **In re Ludtke**, 441 F.2d 660, 664, 169 USPQ 563, 566-67 (CCPA 1971).

#### **BRUE**

Appellants argue that the structure shown in Figures 3 and 4 of Brue is a ring with indentations and pads but does not disclose a "an annular groove" in only an outer circumference of said uppermost spacer and an outer circumference said lowermost

spacer. (See brief at page 5.) Appellants argue that the claimed annular groove in the outer circumference defines that the groove is formed in the entire outer circumference of the spacer. (See brief at page 6.) We agree with appellants. The examiner relies upon the teaching of Brue with respect to element 32A shown in Fig. 4. (See answer at page 5.) We disagree with the examiner. The cross section of Figure 2 is shown in Figure 4 and the specification of Brue, at column 3, describes element 32A as one of three pads. Appellants argue that the small "L" shaped surface of Brue is not a groove in the circumference as claimed. (See brief at page 7.) We agree with appellants. In our view of Brue, if there are three distinct pads then the groove that the examiner relies upon would not traverse the circumference of the spacer. If there is not a pad at a location, then there cannot be a groove formed thereby. At most Brue teaches plural slots around the circumference formed by the pads being recessed from the edge of the spacer. In our view, using the examiner's definition for annular as "forming or shaped like a ring," it is clear that the distinct indentations or recesses at the pads cannot form a ring which would connote a continuous circular groove present between the distinct pads of Brue. Since Brue does not disclose the use of an annular groove, we cannot sustain the rejection of claim 13 and its dependent claim 16.

## **BROOKS**

Appellants argue that Brooks does teach the use of an annular groove in spacers 13, and that Brooks does not teach that the groove is only present on the uppermost and lowermost spacers. (See reply brief, pages 7 and 8.) We agree with appellants. The examiner rebuts this argument by referring to specific portions of columns 2 and 3 which state that more than 3 disks are present and that the grooved spacers overcome the tendency of the disks at the axial ends of the stack to distort due to the forces. (See supplemental answer at page 3.) Appellants refer to different portions of Brooks and conclude that every spacer will have the grooves. We agree with appellants. From reading the entire disclosure of Brooks, as a whole, and the uniform usage of “spacers” throughout and further the discussion of the distribution of the load as it moves from the axial ends to the middle, it is clear that Brooks does not clearly disclose two different spacers and their use at different locations along the axis. Moreover, claim 1 of Brooks states that a spacer is between and separates each adjoining pair of disks and each spacer has an annular groove extending radially inward from the outer cylindrical surface. (See Brooks at columns 3-4.) In light of the disclosure of Brooks, it would be merely speculation on our part to say that the spacers

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with grooves are only at the axial ends. Therefore, we find that the examiner has not set forth a *prima facie* case of anticipation, and we cannot sustain the rejection of claims 13 and 16.

**CONCLUSION**

To summarize, the decision of the examiner to reject claims 13 and 16 under 35 U.S.C. § 102 is reversed.

REVERSED

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
LEE E. BARRETT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JOSEPH L. DIXON	)	
Administrative Patent Judge	)	

jld/vsh

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