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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SERGEY KHRUSHCHEV, UWE RESCHKE,
and STEFAN KIMMELMANN

Appeal 2016-001083
Application 12/737,885
Technology Center 2600

Before JOSEPH L. DIXON, KAMRAN JIVANI, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Final Rejection of claims 1–9. Claim 14 has been canceled. The Examiner indicates that claims 10–13 are allowable over the prior art if rewritten in independent form including all the limitations of the base claims and any intervening claims. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

The claims are directed to a compatible optical recording medium. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A recordable optical recording medium with at least a recording layer with a single continuous recordable area which does not have any embossed structures and is sensitive to a wavelength of a recording light beam for recording data, and a single continuous guide structure for tracking, which does only extend over one or a few track spirals or concentric tracks, wherein the single continuous guide structure is located outside the single continuous recordable area.

REFERENCE

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Takazawa et al. US 2006/0188819 A1 Aug. 24, 2006

REJECTIONS

The Examiner made the following rejections:

Claims 1, 3, 4, and 6–9 stand rejected under pre-AIA 35 U.S.C. § 102(b) as being anticipated by Takazawa.

Claims 2 and 5 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Takazawa.

ANALYSIS

In this decision, we have considered only those arguments actually made by Appellants. Arguments that Appellants could have made but did not make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

Appellants have the opportunity on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985–86 (Fed. Cir. 2006).

Appellants present arguments to the claims together. App. Br. 7. Therefore, we select independent claim 1 as the representative claim for the group and address Appellants’ arguments thereto.

Appellants present general arguments to the prior art and a general discussion of the test for obviousness. App. Br. 7–9. But, we note that the rejection of representative independent claim 1 is based upon anticipation, not obviousness. Appellants contend that:

Takazawa is fails to disclose or suggest the subject matter of at least claim 1. For purposes of this Appeal, Appellant submits that at the very least, the subject matter of independent claim 1 is patentable and non-obvious in view of the teachings of Kim (sic, Takazawa).

App. Br. 8. Appellants further recognize that the Examiner relies upon Figure 37C and its corresponding description in the rejection of independent claim 1. App. Br. 10 (“[T]he Examiner specifically rejects these claims under 35 U.S.C. 102 based on FIG. 37c and the corresponding description.”). We find Appellants’ discussion of Figure 37C to be lacking and Appellants address Figures 31–35, rather than specifically address Figure 37C. App. Br. 10–11. While Figure 35 discloses an embossed structure as a guide structure for tracking, Figure 37C does not contain the same embossed structure, as the Examiner maintains. Ans. 4–5.

Consequently, Appellants’ discussion of the non-applied prior art Figures does not show error in the Examiner’s finding of anticipation based upon Figure 37C. The Examiner further clarifies that Figure 37C was relied upon in the Examiner’s finding of anticipation and Appellants’ argument does not specifically address the specific finding by the Examiner. Ans. 4–5.

Appellants do not file a Reply Brief to further address Figure 37C or further respond to the Examiner’s clarifications. As a result, Appellants do not show error in the Examiner’s finding of anticipation of representative

independent claim 1. Consequently, we sustain the anticipation rejection of representative independent 1, independent claims 4 and 8, and dependent claims 3, 6, 7, and 9, which have not been separately argued.

Obviousness

With respect to dependent claims 2 and 5, Appellants do not set forth separate arguments for patentability with regard to the obviousness rejection. App. Br. 14–15. As a result, we sustain the rejection for the same reasons addressed above with respect to representative independent claim 1.

CONCLUSIONS

The Examiner did not err in rejecting claims 1, 3, 4, and 6–9 based upon anticipation. The Examiner did not err in rejecting claims 2 and 5 based upon obviousness.

DECISION

For the above reasons, we sustain the Examiner’s rejections of claims 1–9.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED