

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte STEPHEN R. GENHEIMER,  
KENNETH L. POTTEBAUM, JON P. BAKER  
and JOHN D. STRICKLIN

---

Appeal No. 2000-1232  
Application 09/114,954

---

ON BRIEF

---

Before THOMAS, BARRETT and LALL, Administrative Patent Judges.  
THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 18-24. Of these claims, the examiner has indicated the allowability of claims 18-23 at pages 2 and 5 of the answer. Therefore, only claim 24 remains for our consideration on appeal.

Appeal No. 2000-1232  
Application 09/114,954

Claim 24 is reproduced below:

24. A disc drive, comprising:

a rotatable disc; and

limit means for limiting deflection of the disc in response to application of a non-operational shock to the disc drive.

The reference relied upon by the examiner is:

Alt	5,422,770	June 6, 1995
-----	-----------	--------------

The most recent prosecution history of claim 24 is problematic. Page 3 of the final rejection included a rejection of claim 24 under 35 U.S.C. § 102(e) as being anticipated by Alt. In a responsive amendment filed under 37 CFR § 1.116 on June 11, 1999, appellants attempted to cancel claim 24. This amendment contains a handwritten notation to the left-center portion of page 1 from the examiner indicating that the amendment would be entered upon a filing of a Notice of Appeal and an appeal brief. The substance of the Advisory Action mailed on June 21, 1999, in Paper No. 11 is consistent with this handwritten notation, further indicating that only claims 18-23 remained for purposes of appeal. As explained at the top of page 4 of the brief, appellants consider that the examiner has refused entry of the

Appeal No. 2000-1232  
Application 09/114,954

amendment under 37 CFR § 1.116. Although the answer makes clear that the examiner has reconsidered the rejection of claims 18-23 such as to indicate at the time of the answer that these claims were considered allowable, the examiner correspondingly maintained the position that claim 24 was still rejected under 35 U.S.C. § 102. Since both the examiner and appellants consider claim 24 to remain active, we will treat it as the only claim in this appeal.

Rather than repeat the positions of the appellants and the examiner, reference is made to the brief and answer for their respective positions.

#### OPINION

For the reasons generally set forth by the examiner at page 3 of the final rejection as amplified beginning at page 3 of the answer, we sustain the rejection of claim 24 under 35 U.S.C. § 102 as being anticipated by Alt.

Page 6 of the brief indicates that all claims that appellants consider to be on appeal, including claims 18-24, to stand or fall together. On the other hand, however, appellants

Appeal No. 2000-1232  
Application 09/114,954

have directed no arguments to the specific features of claim 24 in the arguments portion of the brief beginning at the bottom of page 6. Whereas independent claims 18 and 21 on appeal recite specifically "a disc snubber," claim 24 more broadly recites a "limit means." The disc snubber of independent claims 18 and 21 further requires a layer of material over-molded onto a portion of the rigid actuator arm recited earlier in these claims such that the snubber performs the function of limiting deflection of the disc resulting from application of a non-operational shock to the disc drive. Without reciting any of these intermediate structural features and relationships and without reciting a corresponding rigid actuator arm, claim 24 only more broadly recites the same limiting function.

Although we noted earlier that appellants have presented no specific arguments as to independent claim 24 on appeal, the focus of the arguments relies upon the claimed disc snubber which appears only in independent claims 18 and 21 on appeal. On the other hand, appellants recognize that the teachings in Alt indicate that a shock bumper 124 absorbs forces resulting from non-operational shock inflicted upon a computer disc drive.

Appeal No. 2000-1232  
Application 09/114,954

In accordance with the arguments between pages 9 and 10 of the brief, while appellants recognize that Alt discloses attaching a shock bumper 124 to a flexible load arm, they assert that the claimed invention requires a disc snubber over a portion of a rigid actuator arm. Again, it is noted that neither of these features are recited in independent claim 24 on appeal.

On balance, therefore, we consider the arguments presented by the examiner to substantiate the rejection beginning at page 3 of the answer to be well-taken. The examiner has showed equivalent structural means and function in Alt to correspond to the limit means set forth in broad form in independent claim 24 on appeal. Thus, the examiner has set forth a prima facie case of anticipation that has not been successfully rebutted by appellants' arguments in the brief and in the absence of a filing of a reply brief to the contrary. Therefore, the rejection of claim 24 under 35 U.S.C. § 102 is affirmed.

Appeal No. 2000-1232  
Application 09/114,954

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

AFFIRMED

James D. Thomas	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
Lee E. Barrett	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
Parshotam S. Lall	)	
Administrative Patent Judge	)	

JDT/cam

Bill D. McCarthy  
Crow & Dunlevy  
1800 Mid-America Tower  
20 N. Broadway  
Oklahoma City, OK 73102-8273