

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TRACY D. HARMER and CURTIS H. BRUNER

Appeal No. 2002-0313
Application No. 09/302,106¹

ON BRIEF²

Before HAIRSTON, BARRETT and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-4, which are all of the claims pending in this application.

We affirm.

BACKGROUND

Appellants' invention relates to a housing for a hard disk drive to be connected to a host computer. According to Appellants, the conventional peripheral component interface (PCI)

¹ Application for patent filed April 29, 1999.

² A request for oral hearing was waived in a communication filed March 18, 2003.

Appeal No. 2002-0313
Application No. 09/302,106

printed circuit cards, which are used as the base for the disk-head assembly, are subject to vibration which reduces the accuracy of the actuator arm movement (specification, page 3). The housing of the present invention includes an apparatus that rigidly holds a hard disk drive assembly by positioning shock-absorbing material on the drive (specification, page 4). By engaging the shock-absorbing material, the hard disk drive assembly is no longer subject to vibration and the actuator arm becomes stabilized (specification, page 6).

Representative independent claim 1 is reproduced below:

1. An apparatus for connecting a peripheral device to a host computer; comprising:

an assembly including a disk for mounting said peripheral device;

a connection device for connecting said assembly and said disk to said host computer; and

a shock-absorbing material being positioned directly between said host computer and said assembly including said disk to absorb shock to said assembly and disk.

The Examiner relies on the following reference in rejecting the claims:

Gustafson et al. (Gustafson) 5,914,855 Jun. 22, 1999
(Filed Dec. 30, 1997)

Claims 1-4 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Gustafson.

Appeal No. 2002-0313
Application No. 09/302,106

Rather than reiterate the viewpoints of the Examiner and Appellants, we refer to the answer (Paper No. 15, mailed October 2, 2001) for the Examiner's complete reasoning in support of the rejection and to the brief (Paper No. 14, filed July 26, 2001) for Appellants' arguments thereagainst.

OPINION

At the outset, we note that Appellants indicate that the rejected claims do not stand or fall together (brief, page 3). However, Appellants have not in the arguments section of the brief provided separate arguments for each of claims 1-4, as required by 37 CFR § 1.192(c)(7) (July 1, 2001). Instead, Appellants have merely relied on the same arguments for all these claims. Therefore, we will consider Appellants' claims 1-4 as standing or falling together as one group and we will treat claim 1 as the representative claim of that group.

The focus of Appellants' arguments appears to be the absence of the shock-absorbing material positioned directly between the host computer and the assembly in the prior art (brief, page 3). Appellants assert that Gustafson, in Figure 2 and column 3, line 52, discloses that "the elastomeric layers 40 are positioned between the clips 38 and the printed circuit board 24" whereas "[t]he clips 38 are mounted on the circuit board" (id.).

Appeal No. 2002-0313
Application No. 09/302,106

Appellants further point out that Gustafson, in column 3, lines 1-5, discloses that "printed circuit board 24 is considered to be part of disk drive assembly 20" and therefor, provides no direct connection to the host computer (id.). Appellants conclude that Gustafson's printed circuit board is not directly connected to a host computer and disk and instead, is connected to the elastomeric layer (brief, page 4).

The Examiner responds to Appellants' arguments by stating that the shock-absorbing material 40 of Gustafson is positioned directly between the circuit board and the cage 54 which is, as depicted in Figure 3, secured to the computer chassis (answer, page 4). The Examiner adds that Gustafson's cage 54 is located within a computer chassis and must be "directly" touching the computer since some kind of connection is needed to secure these parts within the computer (id.). The Examiner further argues that Appellants' disclosure neither provides any particular definition for the "direct" connection nor specifically shows a "computer" (id.). Relying on the breadth of claim 1 and the extent of Appellants' disclosure, the Examiner asserts that Gustafson does teach a direct connection between the computer and the cage (answer, pages 4 & 5).

Appeal No. 2002-0313
Application No. 09/302,106

Before addressing the Examiner's rejection based on prior art, it is essential that we understand the claimed subject matter and determine its scope. Accordingly, as required by our reviewing court, we will initially direct our attention to Appellants' claim 1 in order to determine its scope. "[T]he name of the game is the claim." In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). While claim limitations should be interpreted as broadly as possible, the limitation of "positioned directly between said host computer and said assembly" should also be given its ordinary meaning consistent with the specification without reading disclosed terms into the claims, In re Etter, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985). Additionally, courts will give a claim term the full range of its ordinary meaning as understood by persons skilled in the relevant art, unless compelled otherwise. Texas Digital Systems Inc. v. Telegenix Inc., 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1818 (Fed. Cir. 2002). See also Rexnord Corp. v. Laitram Corp., 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001). As our reviewing court has further stated, although "the specification itself does not delimit the right to exclude," it should be relied upon to properly determine the meaning of terms used in the claims. Markman v. Westview Instruments, Inc.,

Appeal No. 2002-0313
Application No. 09/302,106

52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (in banc),
aff'd, 116 S. Ct. 1384 (1996).

Appellants' claim 1 requires that "an assembly including a disk for mounting said peripheral device" be connected to a host computer wherein "a shock absorbing material being positioned directly between said host computer and said assembly" absorbs shock to the assembly and the disk. Our review of the specification reveals no definition for the term "directly" that compels us to find the Examiner's position to be unreasonable. In fact, Appellants have depicted their claimed invention in Figure 3 by merely showing printed circuit board 314 serving as a base for the disk-head assembly 316 without showing a "host computer" (specification, page 6, lines 9-10). The only reference Appellants' have made to a "host computer," is provided in the description of printed circuit board 314 which is further shown to include connector 300 positioned in a downward direction "for connection to the host computer" (specification, page 6, lines 10-12).

Additionally, the only other elements that are apparently connected to the printed circuit board, are shown in Figure 3 as elements 310 and 312, but are not described in the specification. However, housing bracket 110 and connectors 112 in Figure 1 which

Appeal No. 2002-0313
Application No. 09/302,106

appear to be identical to those in Figure 3, merely represent elements for connecting the printed circuit board to a housing (specification, page 3, lines 18-21) again, without mentioning a "host computer." We also find that the shock absorbing material is shown as element 318 positioned between printed circuit board 314 and traversing arm 320 which engages the shock absorbing material (specification, page 6, lines 24-27). Similarly, Figure 4 depicts the shock absorbing material positioned between multiple printed circuit boards and a traversing arm or along the outer sides of the plurality of the printed circuit boards.

Appellants would have us require that the claimed shock absorbing material be positioned between the host computer and the printed circuit board without any intervening parts. We decline to attribute such limited meaning to claim 1 since the claim, as interpreted in light of the specification, does not preclude the recited direct connection to the host computer to be made through other intervening elements which are, in fact, considered as part of the host computer. In other words, Appellants do not disclose the type of direct connection in the specification that Appellants now argue is absent in the prior art and merely disclose the shock-absorbing material positioned between the assembly and other elements that are somehow

Appeal No. 2002-0313
Application No. 09/302,106

connected to the computer. Based on our review of the specification, we agree with the Examiner that Appellants' "direct" connection to the host computer may be through other parts such as a traversing arm, a housing bracket (elements 110 and 310 in Figs. 1 and 3, respectively) or Gustafson's card cage, which are all parts of the host computer.

As a general principle, a rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference. In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994), citing In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

After reviewing Gustafson, we agree with the Examiner that the claimed assembly reads on Gustafson's disk drive assembly 20 which includes circuit board 24 (Fig. 3) and disk 22 whereas the

Appeal No. 2002-0313
Application No. 09/302,106

claimed shock-absorbing material reads on elastomeric layer 40 which is positioned "directly between the host computer and said assembly." In particular, Gustafson shows in Figure 3 that the disk drive assembly is mounted within a cage structure 54 that is secured to a computer chassis (col. 4, lines 18-23). Thus, the Examiner has properly corresponded the claimed elements to those of the prior art and determined the position of Gustafson's elastomeric layer 40 as being directly between disk drive assembly 20 and the host computer through clip 38 and cage 54 which are, in turn, connected to the computer chassis.

In view of the analysis above, we find that the Examiner has met the burden of providing sufficient evidentiary support to establish a prima facie case of anticipation. In that regard, Gustafson teaches a shock-absorbing material positioned directly between the host computer and the disk drive assembly, as recited in Appellants' independent claim 1. Accordingly, we sustain the rejection of claims 1-4 under 35 U.S.C. § 102 over Gustafson.

Appeal No. 2002-0313
Application No. 09/302,106

CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1-4 under 35 U.S.C. § 102 is affirmed.

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

AFFIRMED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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MAHSHID D. SAADAT)	
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Appeal No. 2002-0313
Application No. 09/302,106

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