

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RICHARD MANSUETO

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Appeal No. 2002-0670  
Application 09/416,547

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ON BRIEF

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Before FRANKFORT, PATE, and NASE, Administrative Patent Judges.  
PATE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 3, 6, 7, 14, 16, 18 and 19, and the examiner's refusal to allow claims 23 through 25, 28, 29, 36, 38, 40 and 41 as amended after final rejection. Claims 4, 5, 8 through 11, 15, 17, 20 through 22, 26, 27, 30 through 33, 37, 39 and 42 through 64 stand withdrawn from consideration as directed to a nonelected invention. Claims 12, 13, 34 and 35 have been canceled. These are all the claims in the application.

Appeal No. 2002-0670  
Application 09/416,547

It is noted that there was confusion between the appellant and the examiner as to the status of claims 10, 31 and 32 on appeal. Paper No. 5, an amendment filed after final rejection, amended claim 10, 31 and 32, although claims 10 and 32 had been indicated as drawn to a nonelected invention and withdrawn from consideration. Finally, in paper No. 14 mailed after the examiner's answer, the examiner indicated that claims 10 and 32 are indeed withdrawn from consideration. Since the examiner did not comment on the status of claim 31, appellant stated in the supplemental brief that claim 31 was on appeal. Inasmuch as claim 31 depends from claim 30, a claim in and of itself withdrawn from consideration, we hold that claim 31 must be, as per the examiner, withdrawn from consideration and not subject to this appeal.

The claimed invention is directed to a device retention assembly for retaining a device. The specification mentions that the device may be a computer drive or the like.

A further understanding of the claimed subject matter may be had with reference to claim 1, reproduced below:

1. A device retention assembly, comprising:  
a guide;  
a guide channel;

Appeal No. 2002-0670  
Application 09/416,547

a retention mechanism;

wherein the guide is disposed on a device so that the guide is capable of slidably moving along the guide channel so that the retention mechanism may engage the guide therein providing a restraining force and electrical ground for the device.

The references of record relied upon by the examiner as evidence of anticipation are:

Steadman	1,527,282	Feb. 24, 1925
Juvet	1,563,864	Dec. 1, 1925

#### The Rejections

Claims 1 through 3, 6, 7, 14, 16, 18, 19, 23 through 25, 28, 29, 36, 38, 40 and 41 stand rejected under 35 U.S.C. § 102 as anticipated by Juvet.

Claims 1 through 3, 6, 7, 23 through 25, 28 and 29 stand rejected under 35 U.S.C. § 102 as anticipated by Steadman.

#### Opinion

We have carefully reviewed the record in this appealed application. As a result of this review, we have determined that the applied prior art establishes the lack of novelty of the claims on appeal. However, inasmuch as the examiner has failed to properly explain the rejection to the applicant in any of the office actions or, indeed, in the examiner's answer, we are denominating our decision as a rejection under 37 CFR § 1.196(b). Our reasoning follows.

Appeal No. 2002-0670  
Application 09/416,547

Juvet discloses a device retention assembly for use in the dashboard of an automobile. Juvet discloses a casing 10 of sheet metal. Page 1, line 80. The casing includes a guide channel 30. A device 11, including cover 14, is moved in and out of the casing, and the device's movement is controlled by guide pin 37 which moves in the guide channel 30. A restraining means 40 in the form of a leaf spring with an arcuate end is provided as a retention mechanism. The arcuate portion at the free end of the spring 40 is formed in this shape to aid in flexing the retention mechanism by camming it away from the guide both in engaging and in disengaging directions. Inasmuch as the casing 10 is disclosed as a sheet metal, and the rest of the device is crosshatched as a metal, it is clear to us that the device retention assembly acts as a ground for the device 11,14.

It is our view that the reference to Juvet provides a prima facie case of anticipation based on inherency of the claimed subject matter on appeal. See In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 139 (Fed. Cir. 1986). As such the burden has shifted to the appellant to prove that the structure in Juvet does not provide the functional attributes called for in the claims.

Appeal No. 2002-0670  
Application 09/416,547

Note for claims 14 through 19 that the guide in Juvet is a pin 37 with head 38 to prevent detachment of the pin from the casing. Note that this pin can be considered a post and is substantially rounded and substantially circular. The pin 37 can be said to be inserted in the hole formed by the rolled sheet 36.

Turning to a consideration of Steadman, Steadman discloses a guide 8 with a guide channel 10 and a retention means 12, 13 thereon. Note that the retention means 12, 13 has a spring bias, and pin 13 engages hole 9 in the guide 8. The crosshatching in Steadman's figures indicates that the material of Steadman is metallic. Accordingly, it is our finding under the principle of inherency that Steadman anticipates claims 1 through 3, 6, 7, 23 through 25, 28 and 29.

In essence, we agree with the examiner that the two references cited anticipate the claimed subject matter. However, during prosecution of the application, the appellant repeatedly called on the examiner to explain how the references anticipated appellant's claimed subject matter. We note that even in the examiner's answer, the examiner did not state that he was relying on the inherent properties of Juvet and Steadman. The closest the examiner went was to state in one sentence that as long as a disclosed structure is capable of providing the claimed function,

Appeal No. 2002-0670  
Application 09/416,547

rejection under § 102 is proper. Inasmuch as the examiner did not fully explain to the appellant that the rejection was an anticipation rejection based on inherent properties of the references, we believe that appellant has not been given clear notice of the basis of the rejection. Accordingly, the rejections of the examiner are reversed and we will enter new rejections on the same references under 37 CFR § 1.196(b).

Claims 1 through 3, 6, 7, 14, 16, 18, 19, 23 through 25, 28, 29, 36, 38, 40 and 41 are rejected under 35 U.S.C. § 102(b) as anticipated by Juvet. See our above findings of fact for the statements of this rejection.

Claims 1 through 3, 6, 7, 23 through 25, 28 and 29 are rejected under 35 U.S.C. § 102(b) as clearly anticipated by Steadman. Again, see our findings of facts made above for an explanation of how the prior art anticipates these claims.

In summary, the rejections by the examiner of the claims on appeal are reversed.

Pursuant to our authority under 37 CFR § 1.196(b), we have entered new rejections of claims 1 through 3, 6, 7, 14, 16, 18, 19, 23 through 25, 28, 29, 36, 38, 40 and 41.

Appeal No. 2002-0670  
Application 09/416,547

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Appeal No. 2002-0670  
Application 09/416,547

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

Reversed 37 CFR § 1.196(b)

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
WILLIAM F. PATE III	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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Appeal No. 2002-0670  
Application 09/416,547

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