

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. 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 CARL F. ADAMS and CURTIS A. TRAMMELL

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Appeal No. 2002-1234  
Application No. 09/546,466

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HEARD: MARCH 19, 2003

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

DECISION ON APPEAL

This is an appeal from the final rejection of claim 15. In an Amendment After Final (paper number 9), claim 15 was amended.

The disclosed invention relates to a means for transferring heat from an electrical coil to an E-block of an disc drive actuator assembly.

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Claim 15 is the only claim on appeal, and it reads as follows:

15. An actuator assembly for a disc drive, wherein the disc drive has a magnet assembly which interacts with the actuator assembly to position the actuator assembly, the actuator assembly comprising:

an E-block supported by the disc drive;

an electrical coil supported by the E-block and disposed adjacent the magnet assembly ; and

means for transferring heat from the electrical coil to the E-block.

The reference relied on by the examiner is:

Adams et al. (Adams)	6,078,477	June 20, 2000
Sendoda <sup>1</sup> (Japanese patent application)	02-168474	June 28, 1990

Claim 15 stands rejected under the judicially created doctrine of double patenting based upon claims 1 through 10 of the patent to Adams.

Claim 15 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Sendoda.

Reference is made to the briefs (paper numbers 12 and 16) and the answer (paper number 15) for the respective positions of the appellants and the examiner.

#### OPINION

We have carefully considered the entire record before us, and we will sustain the double patenting rejection and reverse the anticipation rejection.

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<sup>1</sup> A copy of the translation of this reference is attached.

Inasmuch as the two rejections of record involve the importation of limitations from the specification into the claim due to the presence of a means-plus-function limitation in the claim, we will consider the two rejections of claim 15 together.

According to the examiner (answer, page 5), the double patenting rejection applies because:

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows, for instance:

An actuator assembly for a disc drive, wherein the disc drive has a magnet assembly which interacts with the actuator assembly to position the actuator assembly, the actuator assembly comprising an E-block supported by the disc drive, an electrical coil supported by the E-block and disposed adjacent the magnet assembly, and means for transferring heat from the electrical coil to the E-block.

With respect to the anticipation rejection, the examiner states (answer, page 6) that “Sentoda [sic, Sendoda] teaches an actuator assembly for a disc drive, wherein the disc drive has a magnet assembly (includes 54) which interacts with the actuator assembly to position the actuator assembly, the actuator assembly comprising an E-block (includes 53) supported by the disc drive, an electrical coil (55) supported by the E-block and disposed adjacent the magnet assembly, and means for transferring heat (includes 1 in at least an equivalent structural sense) from the electrical coil to the E-block . . . .”

Appellants argue (brief, pages 12 and 13) that the double patenting rejection is inappropriate because extension of the subject application beyond the life of the parent can not occur because “the patent terms for both the parent ‘477 patent and a patent issuing from the present application will both run for 20 years from the filing date of the parent.”

In response to the anticipation rejection, appellants argue (brief, page 6) that:

In the present case, the recited function of claim 15, “transferring heat from the electrical coil to the E-block,” is carried out by the heat transfer plate 170 which extends in a contacting, planar fashion adjacent an actuator coil. The plate includes an upstanding portion 172 that pressingly engages the E-block 174, and leg members 186 which extend from the portion 172 between an inner coil portion 182 and an outer coil portion 184 to efficiently draw heat from the interior of the coil. The heat transfer plate 170 is formed from a thermally conductive material, such as aluminum. See FIGS. 3-4 and the discussion at page 7, line 14 to page 9, line 11 . . . .

Appellants admit (brief, page 8) that the structure of Sendoda appears to carry out the claimed function of “transferring heat from the electrical coil to the E-block,” but nevertheless conclude that “the disclosed plate 1 [used by Sendoda] fails to meet the requirements of a structural equivalent . . . .” Appellants argue (brief, page 9) that:

In the present case, the plate 1 of Sentoda [sic, Sendoda] apparently fails to disclose, teach or suggest dividing the coil into inner and outer portions and inserting leg members 186 therebetween down into the coil and the Examiner has failed [to] assert otherwise. Thus, while heat is conducted from the coil 55, it is done so in a substantially different way; unlike the claimed invention where heat internal to the coil is drawn out by the leg members, the plate 1 simply lies in a plane adjacent the top (and bottom) of the coil 55. Heat internal to the coil is therefore radiated inwardly or outwardly and must either pass through the ambient air or through adjacent coil turns in order to reach the plate. The absence of the leg portions prevents the plate 1 of Sentoda [sic, Sendoda] from being considered an equivalent under § 112, ¶6.

Although the claims in the subject application and the patent may expire on the same future date, the examiner explains (answer, page 7) that the double patenting rejection “will in fact serve to ‘prevent possible harassment by multiple assignees’ . . . .” In response to appellants’ arguments concerning the prior art teachings of Sendoda, the examiner states (answer, page 6) that the means 1

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for transferring the heat in Sendoda “is an equivalent of the claimed means for transferring heat as the means for transferring heat of Sentoda [sic, Sendoda] includes the minimal amount of structure necessary for performing the identical claimed function (i.e., heat transfer), in substantially the same way (i.e., E-block/electrical coil coupling), with substantially the same result (i.e., ‘transferring heat from the electrical coil to the E-block’) . . . .”

We agree with the examiner’s double patenting reasoning, but disagree with the examiner’s equivalence rationale in the prior art rejection.

As a result of appellants’ direction to import the detailed structure and the placement of the heat transfer plate 170 and its leg members 186 between the inner and outer coil portions into the claim on appeal to describe how the corresponding structure carries out the recited function in the claim, we find that such structure and placement of the heat transfer means would have been obvious based upon the claims found in the patent to Adams. Thus, the double patenting rejection is sustained. MPEP § 804.02VI buttresses the examiner’s reason (i.e., the harassment of potential infringers) for maintaining the double patenting rejection, and explains why a terminal disclaimer is needed to overcome this rejection. This section of the MPEP explains that the terminal disclaimer is needed to ensure that “any patent granted on that application be enforceable only for and during the period that the patent is commonly owned with the . . . patent which formed the basis for the rejection . . . to avoid the potential for harassment of an accused infringer by multiple parties with patents covering the same patentable invention . . . ,” and because appellants may make a request “for patent term extension based upon prosecution delays during the application process.”

Although we agree with the examiner that the heat transfer means 1 in Sendoda performs the claimed function of transferring heat from the coil to yield the same result of heat transfer, we do not, however, agree with the examiner that Sendoda performs the noted function “in substantially the same way.” As argued by appellants, the claimed “means for transferring heat,” when considered under the sixth paragraph of 35 U.S.C. § 112, includes a heat transfer plate embedded in the coils with legs members extending out of the coils as opposed to the metal plate 1 in Sendoda that relies on outside contact with the coils for heat transfer. If the claimed invention is removing heat from the interior of the coil, and Sendoda is removing heat from the surface of the coil, then the two heat transfer means do not perform the heat transfer task “in substantially the same way.” Thus, the 35 U.S.C. § 102(b) rejection is reversed because the teachings of Sendoda do not anticipate the incorporated limitations<sup>2</sup> of claim 15.

#### DECISION

The double patenting rejection of claim 15 is affirmed, and the anticipation rejection of claim 15 is reversed.

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<sup>2</sup> At oral hearing, appellants’ counsel suggested that maybe the specification should be amended to fully delineate the exact structure that is needed to perform the function of broadly recited claim 15. From the standpoint of notice to the public as to what is covered by such a broad claim, this panel certainly agrees with the suggestion. We note to the examiner that any amendment to identify the structure corresponding to the means-plus-function limitation would not constitute new matter.

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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
	)	
	)	
	)	
MAHSHID D. SAADAT	)	
Administrative Patent Judge	)	

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