

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte NICHOLAS D. THAYER, ROBERT W. LUFFEL,
DAVID P. JONES, and MARK A. SMITH

Appeal No. 2002-1744
Application No. 09/179,793

ON BRIEF

Before RUGGIERO, BARRY, and LEVY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claim 36. The appellants appeal therefrom under 35 U.S.C. § 134(a). We reverse.

BACKGROUND

The invention at issue on appeal concerns removal and replacement of data cartridges, such as optical disks or magnetic tapes, contained in a "juke box." A juke box is used to store and access many data cartridges. A typical juke box includes a "magazine" offering storage locations for the data cartridges. (Spec. at 1.) A "picker" transports cartridges between the magazine and a read/write device. (*Id.* at 1-2.)

An operator of a juke box must periodically access the data cartridges contained therein. For example, he may need to replace a cartridge that has been filled with data to be archived at another location. (*Id.* at 2.)

To satisfy the aforementioned need, the inventive juke box 12 features drawers 16 that can be moved between a closed position and an opened position. Drawer stop indices 78 are coupled to each drawer so as to move along with the associated drawer. A lock 80 can be moved between a locked position and an unlocked position. When locked, it engages a drawer stop index to prevent the associated drawer from being withdrawn further. (Appeal Br. at 2.)

A further understanding of the invention can be achieved by reading the following claim.

36. A mail slot data cartridge exchange system for a data storage system, comprising:

a drawer mounted to the data storage system so that said drawer can be moved between a retracted position and a plurality of extended positions; and

drawer extension regulator means operatively associated with said drawer for allowing said drawer to be manually extended to a selected one of said plurality of extended positions and no further, while allowing said drawer to be manually returned to the retracted position without requiring additional actuation of said drawer extension regulator means.

Claim 36 stands rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 5,940,354 ("Inoue").

OPINION

Rather than reiterate the positions of the examiner or the appellants *in toto*, we address the main point of contention therebetween. The examiner asserts, "Inoue . . . teaches in column 14, lines 52-62 that when the extended drawer is left unattended for a given period, the drawer is automatically withdrawn back into the device, thus requiring no additional actuation of the drawer extension regulation means."

(Examiner's Answer at 5.) "What [the] appellants have argued, and continue to argue, is that Inoue simply does not teach a system wherein the drawer, once extended, *can be manually returned to the retracted position without requiring additional actuation of the drawer extension regulator.*" (Reply Br. at 4.)

"Analysis begins with a key legal question -- *what is the invention claimed?*" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "the Board must give claims their broadest reasonable construction. . . ." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000).

Here, claim 36 specifies in pertinent part the following limitations: "drawer extension regulator means operatively associated with said drawer for . . . allowing said drawer to be manually returned to the retracted position without requiring additional actuation of said drawer extension regulator means." Giving the claim its broadest, reasonable construction, the limitations require manually closing a drawer without actuating a regulator used to open the drawer manually.

"Having construed the claim limitations at issue, we now compare the claims to the prior art to determine if the prior art anticipates those claims." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002). "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.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (citing *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 715, 223 USPQ 1264, 1270 (Fed. Cir. 1984); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983); *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983)). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986).

Here, Inoue discloses "a library apparatus having a mail slot mode in which the tray is opened selectively to a mail slot access position for manual insertion of a single cartridge medium into the mail slot or manual removal thereof from the mail slot. . . ."

Col. 1, ll. 12-15. "[T]he medium is conveyed between the mail slot and a respective storage slot, controlled by corresponding move commands from the host computer. . . ."

Id. at ll. 16-19. The passage of the reference cited by the examiner explains, "[w]hen the operation of the ejection switch 24 is not detected even after a predetermined time has elapsed, namely, when the operator leaves the tray 20 in an open state, an error is reported to the host computer 16 and, after that, a recovering process to close the tray 20 and to return to an initial state is executed." Col. 14, ll. 52-57. "The recovering process can be executed by closing the tray 20 by the operation of the ejection switch 24, by again generating the moving command in which the movement source is set to the slot #35 from the host computer 16, or by issuing the tray closing command."

Id. at ll. 57-62.

Although Inoue's recovering process closes its tray, we are unpersuaded that it does so without actuating a regulator used to open the tray manually. To the contrary, the reference's tray is opened and closed by the same regulator, viz., a microprocessor unit ("MPU"). Specifically, Inoue explains that its "accessor controller 38 has an MPU 52 functioning as a logic controller and executes a mode setting control, a

medium insertion control, a medium ejection control, and a read/write medium conveyance control, by corresponding program controls of the MPU 52." Col. 12, l. 66 - col. 13, l. 3. Under such control of the MPU, "a **tray opening/closing** control for each of the medium insertion, medium ejection, and medium read/write conveyances **are executed.**" Col. 13, ll. 4-6 (emphases added).

The reference's use of the same MPU to close and open its tray negates anticipation. Therefore, we reverse the anticipation rejection of claim 36.

CONCLUSION

In summary, the rejection of claim 36 under § 102(e) is reversed.

REVERSED

JOSEPH F. RUGGIERO
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

STUART S. LEVY
Administrative Patent Judge

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APPLICATION NO. 09/179,793

APJ BARRY - **2 copies**

APJ RUGGIERO

APJ LEVY

After signing, please return to Barry for disk.

After Barry provides disk, please forward to Team 3
for entering changes and mailing.

Prepared By: APJ BARRY

DRAFT SUBMITTED: 31 Dec 03

FINAL TYPED:

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