

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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 JOHN W. MEADOWS

---

Appeal No. 1997-2032  
Application 08/229,278<sup>1</sup>

---

ON BRIEF

---

Before COHEN, FRANKFORT and GONZALES, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 14, which are all of the claims in this application. Upon reconsideration (answer, page 1), the examiner has allowed claims 1 through 6, therefore, the appeal as to those claims is dismissed. Only claims 7 through

---

<sup>1</sup> Application for patent filed April 18, 1994.

Appeal No. 1997-2032  
Application 08/229,278

14 remain for our consideration in this appeal.

Appellant's invention relates to a frame assembly for a data storage and retrieval system. Claims 7 and 11 are representative of the subject matter on appeal and a copy of those claims can be found in Appendix A of appellant's brief.

The prior art references relied upon by the examiner as evidence of obviousness of the claimed subject matter are:

1964	Scotti	3,120,413	Feb. 4,
1985	Otema	4,560,257	Dec. 24,
1991	Jones et al. (Jones)	5,040,161	Aug. 13,
1992	Hug et al. (Hug)	5,128,912	July 7,
1993	Baxter et al. (Baxter)	5,206,845	Apr. 27,

Claims 7, 9 through 11, 13 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Baxter in view of Hug, Scotti and Otema.

Claims 8 and 12 stand rejected under 35 U.S.C. § 103 as

Appeal No. 1997-2032  
Application 08/229,278

being unpatentable over Baxter in view of Hug, Scotti and Otema as applied above, and further in view of Jones.

Reference is made to the examiner's answer (Paper No. 13) and supplemental examiner's answers (Paper Nos. 15 and 17) for the examiner's reasoning in support of these rejections and to appellant's brief (Paper No. 12), reply brief (Paper No. 14) and various supplemental reply briefs (Paper Nos. 16 and 18) for the arguments thereagainst.

After carefully reviewing the obviousness issues raised in this appeal in light of appellant's specification and claims, the teachings of the applied prior art references, and the respective viewpoints presented by appellant and the examiner, it is our determination that the rejections of appealed claims 7 through 14 posited by the examiner are not well founded. Accordingly, those rejections will not be sustained. Our reasoning for this determination follows.

OPINION

Appeal No. 1997-2032  
Application 08/229,278

When the teachings of Baxter, Hug, Scotti and Otema are considered collectively, it does not appear to us that they would have in any way fairly suggested their combination to one having ordinary skill in the art, as proposed by the examiner, so as to arrive at the frame assembly defined in appellant's independent claims 7 and 11 on appeal. While we fully appreciate the examiner's evaluation of the applied patents, and have ourselves considered such references with an eye towards the level of skill that is presumed on the part of those practicing in the art at issue, we must agree with appellant that in this particular instance the combination proposed by the examiner is based on what appellant teaches and not on what the prior art references would have fairly taught or suggested to one of ordinary skill in the art at the time of appellant's invention.

As appellant has pointed out in the brief and various reply briefs, the modular storage and data retrieval system of Baxter includes self-contained, unitary, modular cartridge cells and drive cells (27, 28 and 31, respectively) which are assembled together with a back plate (29) of a cabinet (21) by

mounting screws (40). The back plate additionally includes a pair of registration pins (42) for each of the modular cartridge cells and drive cells so as to assure accurate alignment of the cells and the cartridges and drives associated therewith. The registration pins project from the front face of the back plate and are received in sockets (e.g., 58, 67) on the back sides of the cells. The cells are symmetrical with regard to the way they mount, and thus can be oriented in two different positions, e.g., with the cartridges/drives turned horizontally or vertically. In contrast with appellant's claimed frame assembly as defined in the claims before us on appeal, Baxter has no disclosure of, and no apparent need for, a plurality of divider plates, crossbars extending across the front portions of the divider plates, bezel strips or bezel plates extending along front portions of the crossbars and interfitted therewith, and screws extending between the bezel strips or bezel plates and the back plate for holding the assembly together.

Hug discloses a frame assembly (e.g., 12 in Fig. 1) for a data storage and retrieval system wherein the frame assembly

Appeal No. 1997-2032  
Application 08/229,278

appears to be formed of a plurality of vertical members and a plurality of horizontal members joined together so as to define a plurality of storage compartments (16) for storing information-containing discs (18) and at least one drive compartment (20) for storing a disc drive (22). Hug provides no details whatsoever concerning the unnumbered vertical and horizontal members seen in the frame assembly (12) of Figure 1 and no disclosure as to exactly how those members are assembled together so as to define the plurality of disc storage and drive compartments therein.

Scotti discloses a multiple drawer box (Fig. 1) wherein the compartments which receive the drawers (15) are formed by interengaging panels (11, 12) that the examiner characterizes as being spaced apart divider plates (11) and crossbars (12) providing an "egg crate" construction (Fig. 2). In Otema, the examiner views the upper and lower frames (34, 36) of the mirror cube (20) as being bezel strips, and notes that such "strips" include slots on the rear side thereof in which the front portions of the frame members (24, 26, 28, 30) are received. The examiner also points to the screw (42) of Otema and urges that such screw "extends from the bezel strip to a back plane (44) for holding the assembly together" (answer, page 5).

While the examiner believes that it would have been obvious to one of ordinary skill in the art to 1) provide the modular assembly of Baxter with a plurality of divider plates and crossbars as shown in Hug, because such is a better system; 2) create the divider plates and crossbars of Baxter as modified by Hug to have interlocking notches of an egg-crate construction as in Scotti, because such is a well known

Appeal No. 1997-2032  
Application 08/229,278

method for creating a sturdy grid-like structure; and 3) provide the assembly of Baxter as modified by Hug and Scotti with bezel strips/plates and screws for holding the assembly together as in Otema, because such is a well known practice in the shelving and cabinetry art; we see nothing in the teachings of the relied upon prior art references which would have suggested the desirability, and thus the obviousness, of the examiner's various modifications of the modular data storage and retrieval system in Baxter. In this regard, we agree with appellant that it is only by impermissible hindsight and reliance on appellant's own disclosure that the examiner (acting as one of ordinary skill in the art) would have possibly been led to extensively reconstruct the modular system in Baxter so as to derive the claimed frame assembly from the applied teachings.

A rejection based on § 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the examiner has the initial duty of supplying the factual basis for the rejection he advances. He

Appeal No. 1997-2032  
Application 08/229,278

may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967), cert denied, 389 U.S. 1057 (1968). As our Court of review indicated in In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992), it is impermissible, as the examiner has done here, to use the claimed invention as an instruction manual or "template" to piece together isolated disclosures and teachings of the prior art so that the claimed invention may be rendered obvious. Since we perceive no factual basis in the prior art relied upon which supports the examiner's proposed combinations thereof, and have determined that the examiner's conclusion of obviousness is based on a hindsight reconstruction of the claimed invention from isolated, disparate teachings in the prior art and reliance upon appellant's own disclosure, we will not sustain the examiner's rejection of claims 7, 9 through 11, 13 and 14 on appeal under 35 U.S.C.

§ 103.

Appeal No. 1997-2032  
Application 08/229,278

The Jones patent additionally relied upon by the examiner in rejecting dependent claims 8 and 12 has also been carefully reviewed, however, we find nothing therein which would overcome or supply that which is lacking in the basic combination of the other applied prior art noted above. Accordingly, the examiner's

Appeal No. 1997-2032  
Application 08/229,278

rejection of claims 8 and 12 under 35 U.S.C. § 103 as being unpatentable over Baxter in view of Hug, Scotti, Otema and Jones will likewise not be sustained.

As a result of the foregoing, it is apparent that the decision of the examiner rejecting claims 7 through 14 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
	)	
	)	
	)	
JOHN F. GONZALES	)	
Administrative Patent Judge	)	

Appeal No. 1997-2032  
Application 08/229,278

CEF:dal

EDWARD S. WRIGHT  
FLEHR, HOHBACH, TEST,  
ALBRITTON & HERBERT  
STE. 3400  
FOUR EMBARCADERO CENTER  
SAN FRANCISCO, CA 94111