

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD W. SELG,
JOHN F. FAIRCHILD, STEVEN E. TURCH,
and WALTER J. HALBERG

Appeal No. 1997-3482
Application No. 08/431,779

ON BRIEF

Before KRASS, JERRY SMITH, and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-11, all of the claims pending in the present

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application. An amendment after final rejection filed September 9, 1996 was denied entry by the Examiner.

The claimed invention relates to a cartridge for a disk-shaped storage medium, the cartridge having partition walls formed by ribs which extend from the interior surface of each half of the cartridge shell. More particularly, when the cartridge half shells are assembled together, a protrusion in one rib mates with a complementary shaped groove in the other rib. The ribs, which do not meet but rather define a small gap between them, are aligned to form a rib wall creating a compartment which separates the disk-shaped storage medium from the rest of the cartridge interior. Appellants assert at page 4 of the specification that this rib wall serves to prevent debris from entering the media storage compartment.

Claim 1 is illustrative of the invention and read as follows:

1. A cartridge for a disk-shaped storage medium, comprising:

a first cartridge shell having a first rib on an interior surface thereof, the first rib having a top having a groove therein extending along the length of the first rib; and

a second cartridge shell having a second rib on an interior surface thereof, the second rib having a

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top having a protrusion therefrom extending along the
length of the second rib;

wherein the first and second cartridge shells are assembled together with their interior surfaces facing each other, wherein the two ribs are aligned with each other so that the protrusion from the second rib is aligned with and extends into the groove in the first rib, and wherein the tops of the first and second ribs define a gap between them so that the two ribs are not secured to each other.

The Examiner relies on the following prior art:

Weavers et al. (Weavers)	4,564,878	Jan. 14, 1986
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Claims 1-5 and 7-9 stand finally rejected under 35 U.S.C. § 102(b) as being anticipated by Weavers. Claims 6, 10, and 11 stand finally rejected under 35 U.S.C. § 103 as being unpatentable over Weavers.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs¹ and Answers for the respective details thereof.

OPINION

¹ The Appeal Brief was filed December 13, 1996. In response to the Examiner's Answer dated January 27, 1997, a Reply Brief was filed February 25, 1997. The Examiner entered the Reply Brief and submitted a supplemental Examiner's Answer dated April 11, 1997.

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We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, the arguments in support of the rejections and the evidence of anticipation and obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answers.

It is our view, after consideration of the record before us, that the disclosure of Weavers fully meets the invention as recited in claims 1-5 and 8. We reach the opposite conclusion, however, with respect to claims 7 and 9. We are also of the view that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention set forth in claims 6, 10, and 11. Accordingly, we affirm-in-part.

We consider first the rejection of claims 1-5 and 7-9 under 35 U.S.C. § 102(b) as anticipated by Weavers. Anticipation is established only when a single prior art

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reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to independent claims 1 and 8, the Examiner has indicated how the various limitations are read on the disclosure of Weavers (Answer, page 4). In particular, the Examiner points to Weavers' Figure 5 illustration and accompanying description at column 2, line 61 to column 3, line 4. In the Examiner's interpretation of Weavers, the opening 56 extending along the length of rib extension 54 in first cartridge shell 52 corresponds to the claimed "groove," and the element 62 extending from second shell 58 inclusive of a protrusion 60 extending along its length corresponds to the "second rib having a top having a protrusion..." as claimed.

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In response, Appellants attack (Brief, page 8) the Examiner's characterization of Weavers' opening 56 and mating extension 60 as a "groove" and "rib," respectively. After careful review of the Weavers' reference in light of the arguments of record, we are in agreement with the Examiner's position as stated in the Answer. In our view, the Examiner's interpretation of "groove" and "rib," buttressed by the dictionary definitions supplied by the Examiner, is in accordance with the accepted meaning of those terms. As pointed out by the Examiner (Supplemental Answer, page 4), Appellants have provided no definition in the specification for the terms in question that would lead to an interpretation other than their plain accepted meaning. When not defined in the specification, the words of a claim must be given their plain meaning, i.e., they must be read as they would be interpreted by those of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

We also find Appellants' arguments directed to the alleged frictional fit of Weavers' rib tab 60 into rib chamber 56 to be unpersuasive. We agree with the Examiner that, in

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the completed structure of Weavers' cassette, the tab 60 and chamber 56 are mated in a "near" friction fit resulting in the creation of a gap and, thereby, in the words of claim 1, "not secured to each other."

For the above reasons, the Examiner's 35 U.S.C. § 102(b) rejection of independent claims 1 and 8 is sustained.

Dependent claims 2-5 have not been separately argued by Appellants and, accordingly, these claims will be treated as falling with their parent claims. See In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987); and In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978). Thus, it follows that the examiner's rejection of claims 2-5 under 35 U.S.C. § 102(b) is also sustained.

We next consider the Examiner's rejection of dependent claims 7 and 9 as anticipated by Weavers. Unlike independent claims 1 and 8 discussed supra, claims 7 and 9 include a positive recitation of a disk-shaped storage medium included in a cartridge shell. Claims 7 and 9 further recite:

wherein the two ribs form a rib wall defining a compartment which separates the disk-shaped

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storage medium from other portions of the
cartridge interior, ...

In concluding that Weavers discloses these limitations,
the Examiner refers to a passage at column 1, lines 49-52 of
Weavers which states:

[t]he invention also can be used for the breakout
tab of any recording cassette, cartridge or
magazine, all of which are below called "cassette".

We agree with Appellants, however (Brief, page 10), that
this minimal disclosure of Weavers does not contemplate the
"disk-shaped storage medium" of claims 7 and 9 and most
certainly not the explicitly stated compartmental rib wall
separating structure limitations. Accordingly, the Examiner's
35 U.S.C.

§ 102(b) rejection of dependent claims 7 and 9 is not
sustained.

Turning to the obviousness rejection of claims 6, 10, and
11, we note that in rejecting claims under 35 U.S.C. § 103, it
is incumbent upon the Examiner to establish a factual basis
to
support the legal conclusion of obviousness. See In re Fine,
837
F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so

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doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed.

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Cir. 1984). These showings by the Examiner are an essential part

of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

At the outset, we note that each of the dependent claims 6, 10, and 11 recites that the gap between the first and second ribs has a specific dimension, i.e., about 0.2 mm or 0.1 mm. As the basis for the obviousness rejection, the Examiner asserts (Answer, page 8) the obviousness to the skilled artisan to provide a gap width, in Weavers, of the presently claimed dimensions "through routine optimization and experimentation."

After reviewing the arguments in response, we are in agreement with Appellants that the Examiner has not established a prima facie case of obviousness. Appellants' specification at page 6 describes the importance of the

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particular claimed rib gap dimensions, i.e., prevention of dust and debris from entering the interior of the cartridge and harming the storage disk. We find no explicit disclosure or any inference taken from the disclosure of Weavers that any such problem existed in the system of Weavers. Further, the Examiner has not provided any evidence or specific findings that the Weavers reference as applied suggests modifying the rib gap dimensions to obtain Appellants' invention. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F. 2d 1260, 1266 n. 14, 23 USPQ2d 1780, 1783-84 n. 14 (Fed. Cir. 1992). Thus, the Examiner's 35 U.S.C. § 103 rejection of claims 6, 10, and 11 is not sustained.

In conclusion, we have not sustained the rejection of claims 7 and 9 under 35 U.S.C. § 102(b) nor the rejection of claims 6, 10, and 11 under 35 U.S.C. § 103, but we have sustained the rejection of claims 1-5 and 8 under 35 U.S.C. § 102(b). Accordingly, the decision of the Examiner rejecting claims 1-11 is affirmed-in-part.

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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-IN-PART

	Errol A. Krass)	
	Administrative Patent Judge)	
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)	
	Jerry Smith)	BOARD OF
PATENT)	
	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
	Joseph F. Ruggiero)	
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