

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ZINE-EDDINE BOUTAGHOU

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Appeal No. 98-0592  
Application 08/463,168<sup>1</sup>

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ON BRIEF

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Before McKELVEY, Senior Administrative Patent Judge, and  
SCHAFFER and LEE, Administrative Patent Judges.

LEE, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 13-15. Claims 1-12 and 16-27 have been canceled. No claim has been allowed. The real party in interest is International Business Machines Corporation.

**References relied on by the Examiner**

Elliot et al. (Elliot)      5,251,082      October 5, 1993

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<sup>1</sup> Application for patent filed June 5, 1995. According to the appellant, it is a division of application 08/321,935, filed October 12, 1994,

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Rubey

4,068,613

January 17, 1978

**The Rejections on Appeal**

Claims 13-15 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Elliot and Rubey.

**The Invention**

The claimed invention is directed to a disk drive including a shock sensitive sensor. Claim 13 is the only independent claim and is reproduced below:

13. A disk drive comprising:

a base;

at least one disk rotatably attached to said base;

an actuator attached to said base, said actuator further including a transducer located proximate one end of the actuator, said actuator positioning the transducer over said at least one disk in transducing relationship with said at least one disk;

a cover attached to said base to form an enclosure for said at least one disk and said transducer, one of said cover and said base further including a window for viewing inside the enclosure; and

a shock sensitive sensor attached to one of said cover and said base within said enclosure so that said shock sensitive sensor is viewable through said window, said shock sensitive sensor changing from one state to another state when the disk drive has

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been subjected to a shock of a predetermined amount.

The appellant has argued all claims 13-15 together as a single group. See Brief at page 3.

#### Opinion

The rejection of claims 13-15 cannot be sustained.

A reversal of the rejection on appeal should not be construed as an affirmative indication that the appellant's claims are patentable over prior art. We address only the positions and rationale as set forth by the examiner and on which the examiner's rejection of the claims on appeal is based.

According to claim 13, the disk drive includes a base, at least one disk attached to the base, an actuator also attached to the base, which actuator includes a transducer positioned over the at least one disk, **a cover attached to the base to form an enclosure for the at least one disk and the transducer**, and a shock sensitive sensor. Further according to claim 13, the cover or the base includes **"a window for viewing inside the enclosure,"** and the shock sensitive sensor is **"attached to one of said cover and said base within said**

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**enclosure so that said shock sensitive sensor is viewable through said window."** The shock sensitive sensor changes from one state to another when the disk drive has been subjected to a shock of a predetermined amount.

Elliot discloses a disk drive 10 having a base 50, cover 52, disk 12, actuator 30, and transducer 28. The examiner finds that Elliott's disk drive does not include any window on the cover or base for viewing inside an enclosure or any shock sensitive sensor capable of changing from one state to another and attached to either the cover or the base, which is viewable through a window on the cover or base. (Answer at 4). However, the examiner is of the view that the deficiencies of Elliott are made up from the teachings of Rubey when they are applied in combination with the teachings of Elliott.

Central to this appeal is an issue of claim interpretation. As the Federal Circuit has stated, "the name of the game is the claim." In re Hiniker Co., 150 F.3d 1367, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). The examiner and the appellant apparently disagree as to whether claim 13 requires the shock sensitive sensor to be located within an enclosure formed by the cover and the base and encompassing or

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enclosing the at least one disk and transducer. We agree with the appellant that it does.

In pertinent part, claim 13 recites: "a cover attached to said base to form an enclosure for said at least one disk and said transducer" (Emphasis added). In our view, it is unreasonable, in this context, to read the word "for" so broad as to be met by any possible relationship between an enclosure on the one hand and the disk and the transducer on the other. That is not consistent with the ordinary and plain reading of the English language. Of course, if the appellant had intended the term "for" to take on such an extraordinary meaning, he can, by specially defining the term in his specification. However, no such special definition can be found in the specification. On this record, the examiner has cited no reasonable basis to construe the claim limitation at issue so broadly.

On page 19, the specification describes that the shock watch sensor 111 is housed within the disk drive 10 and has a transparent cover 115 which is in either the cover 14 or the base 12 of the disk drive. That is entirely consistent with reading the claim limitation plainly and straight forwardly so

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as to have the disk and the transducer enclosed by the enclosure formed by the attachment of the cover to the base of the disk drive. That is how we construe the claim feature at issue.

Because the enclosure formed by attachment of the cover and the base must enclose the disk and the transducer, the shock sensitive sensor must be located within the enclosure that encloses the disk and the transducer. In that regard, claim 13 recites: "a shock sensitive sensor attached to one of said cover and said base **within said enclosure** so that said shock sensitive sensor is viewable through said window" (Emphasis added).

Based on our claim construction, we find that contrary to the examiner's view, Rubey does not make up for the deficiencies of Elliott. First, Rubey discloses a shock sensitive sensor 13 that is located on the exterior of a disk cartridge device 11, external to the enclosure which encloses a disk. See Figures 1 and 2. Rubey's sensor is not located within the enclosure enclosing the disk, as is required by the appellant's claims. Furthermore, the transparent section 35 on the shock detection device 13 is not a window on the

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cover or base of the disk cartridge 11 for viewing inside the enclosure that encloses the disk within the disk cartridge. While appellant's claim 13 does not require the disk to be viewable through the window on the cover or base, it does require the inside of the enclosure enclosing the disk to be viewable through the window. The transparent section 35 in Rubey does not make viewable the inside of the enclosure enclosing the disk in the cartridge device 11. It only makes viewable portions of the inside of the hollow tube 25.

The examiner has not articulated any reasonable suggestion stemming from the combination of Elliott and Rubey to render obvious the appellant's claimed invention. For the foregoing reasons, the rejection of claims 13-15 as being unpatentable over Elliott and Rubey is without merit and cannot be sustained.

#### **Conclusion**

The rejection of claims 13-15 under 35 U.S.C. § 103 as being unpatentable over Elliot and Rubey is reversed.

**REVERSED**

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FRED E. MCKELVEY, Senior	)	
Administrative Patent Judge	)	
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RICHARD E. SCHAFER	)	APPEALS AND
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JAMESON LEE	)	
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