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(2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte SUBRAHMANYAN NAGARAJAN

_____

Appeal No. 1998-2486
Application No. 08/751,375

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ON BRIEF

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Before KRASS, DIXON and BARRY, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-21, all of the claims pending in the application.

The invention is directed to an electronic subassembly removable from a data processing system and which is inserted into an aperture in the data processing

system. More specifically, the electronic subassembly comprises a compressible shock absorbing material so that in an uncompressed state, the shock absorbing material, together with the subassembly, has a greater external dimension than a form factor defined by the aperture, while in a compressed state, the shock absorbing material, together with the subassembly, has an exterior dimension which conforms to the form factor so that the electronic subassembly, with the shock absorbing material thereon, fits properly within the aperture.

Representative independent claim 16 is reproduced as follows:

> 16. A method of manufacturing a removable electronic subassembly for placement into a data processing system which requires said removable electronic subassembly to fit into an aperture defining a selected form factor, the method comprising the steps of:
>
> enclosing interior components of said removable electronic subassembly within a rigid enclosure having exterior dimensions which are smaller than said selected form factor; and
>
> mounting a layer of resilient material onto at least a portion of said rigid enclosure so that said layer of resilient material and said rigid enclosure have at least one exterior dimension substantially exceeding said selected form factor in an uncompressed state, wherein said resilient material may be substantially compressed such that said at least one exterior dimension conforms to said selected form factor.

The examiner relies on the following reference:

Morehouse et al. (Morehouse)	5,161,770	Nov. 10, 1992

Claims 1-16 and 20 stand rejected under 35 U.S.C. § 102(b) as anticipated by Morehouse. Claims 17-19 and 21 stand rejected under 35 U.S.C. § 103 as unpatentable over Morehouse. Additionally, claims 17-19 and 21 stand rejected under 35 U.S.C. § 112, first paragraph, as relying on an inadequate written description.[1]

Reference is made to the brief and answer for the respective positions of appellant and the examiner.

OPINION

Turning first to the rejection of claims 17-19 and 21 under 35 U.S.C. § 112, first paragraph, as relying on an inadequate written description, the examiner contends that the original disclosure does not support compressing the resilient material "by at least approximately 50% of said uncompressed thickness," as is now claimed. Appellant does not dispute that this limitation was not part of the original claims nor was there a description in the specification, as originally filed. It is appellant's contention that the original drawings provide support for this claimed limitation.

[1]The examiner has not formally maintained the rejection under 35 U.S.C. § 112 since the rejection has not been repeated in the answer. Normally, we would treat the absence of the rejection as indicating that the rejection has been withdrawn by the examiner. However, in view of the record before us (appellant apparently thinks the rejection has been maintained, indicating it as one of the issues [page 7-brief]; appellant has argued it; the examiner has never withdrawn the rejection; the examiner states [answer-page 3] that appellant's statement of the issues is correct; and the examiner responds to appellant's arguments regarding this rejection), we think it is clear that the examiner intended to maintain the rejection under 35 U.S.C. § 112. Accordingly, we treat claims 17-19 and 21 as being rejected under 35 U.S.C. 112, first paragraph.

We agree with appellant's general assertion that the drawings can provide support for a claim just as can the specification. Proper support need not, necessarily, be found in word descriptions only. However, each case must be analyzed in accordance with the specifics of the individual case. In the instant case, our review of the drawings in the instant case finds no support for appellant's contention that original Figures 4 and 5 show that the compressed thickness (Figure 5) is "at least approximately 50%" of the uncompressed thickness (in Figure 4). The drawings, being of an informal nature as it is, do not shimmer with clarity. In particular, there is no way to tell from the drawings that the resilient material in Figure 4 has been compressed by "at least approximately 50%," the compressed state being shown in Figure 5. While at least some compression appears to have taken place in Figure 5, the quantitative amount of that compression is not apparent and cannot be determined, possibly due, at least in part, to the poor quality of the drawings. Even the inexact nature of the claimed recitation, i.e., "at least approximately," does not help in finding such support in the drawings. While it may be true that at least *some* compression can be seen in Figure 5, this is a far cry from finding that the compression depicted is "at least approximately 50%," as claimed. To say that "at least approximately 50%" is the percentage

supported by Figures 4 and 5, in our view, amounts to no more than mere speculation. This percentage cannot be determined from the drawings and there is no written description of the drawings in the specification which would support this conclusion. It does not appear to us that appellant was in possession of the subject matter now set forth in claims 17-19 and 21 at the time of filing the application.

Accordingly, we will sustain the examiner's rejection of claims 17-19 and 21 under 35 U.S.C. § 112, first paragraph.

We reach an opposite result with regard to the rejections of the claims over prior art.

Morehouse does, indeed, disclose a protective jacket for a removable electronic subassembly and that the protective jacket is made of a resilient material. The problem is that each of the instant claims requires that the resilient material and the rigid enclosure, together, "have at least one exterior dimension substantially exceeding said selected form factor in an uncompressed state, wherein said resilient material may be substantially compressed such that said at least one exterior dimension conforms to said selected form factor." Morehouse is silent on any compression of the resilient material.

Of course, it goes without saying that a "resilient" material is compressible to some extent and so the resilient jacket of Morehouse is "compressible." But there is no

teaching or suggestion by Morehouse that the jacket, together with the disk it protects has an exterior dimension that exceeds a selected form factor in an uncompressed state but conforms to the selected form factor in a compressed state. Figure 3 of Morehouse shows the disk drive with the resilient material therearound being inserted into a computer housing. The shape of this part of the computer housing would be the "selected form factor." While Morehouse provides the resilient material around the disk drive as a shock absorber in case the component is dropped, there is no indication that Morehouse employs the resilient material in such a way as to compress in order to conform to the form factor. If this inherently occurs, the teaching of Morehouse would be applicable against the claims under 35 U.S.C. § § 102/103. However, we find no such inherent compression of Morehouse's resilient material when inserted into the computer housing. In fact, Morehouse discloses, at column 3, lines 40-54, that the "respective heights of jacket **10** and fence **30** are essentially equal." Therefore, there would appear to be no compression of the resilient jacket when the disk drive is placed in the computer housing. Further, Morehouse discloses, in the cited portion, that a space is left between external surfaces of the drive 20 and the opposing surfaces of fence 30, computer housing 31 and the cover. The thickness of the resilient jacket fills that space but there is no indication that the jacket is compressed. In fact, since Morehouse discloses that the result is that the drive 20 is "loosely" but securely held in

the cavity [column 3, line 54], it would appear, again, that there is no compression of the resilient jacket in order to conform to the selected form factor, as claimed.

The examiner responds by identifying the resilient material of Morehouse as "foam rubber" which has "inherent characteristics of having different dimensions when compressed then uncompressed" [answer-page 5]. It is true that the resilient material of Morehouse is made of foam rubber which is compressible but the examiner has not identified, and cannot identify, any portion of Morehouse teaching or suggesting that the dimension of the disk/jacket combination exceeds the form factor in an uncompressed state but compresses to conform to that form factor. It may be fair to say that the disk/jacket combination of Morehouse does conform to the selected form factor, but no compression takes place in order to conform and the external dimension of the uncompressed combination does not exceed the form factor.

Accordingly, we will not sustain either the rejection of claims 1-16 and 20 under 35 U.S.C. § 102(b) or the rejection of claims 17-19 and 21 under 35 U.S.C. § 103.

Thus, we have sustained the rejection of claims 17-19 and 21 under 35 U.S.C. § 112, first paragraph, but we have not sustained the rejection of claims 1-16 and 20 under 35 U.S.C. § 102(b) or the rejection of claims 17-19 and 21 under 35 U.S.C. § 103.

Accordingly, the examiner's decision is affirmed-in-part.

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	)	
JOSEPH L. DIXON Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
LANCE LEONARD BARRY Administrative Patent Judge	)	

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