

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT W. LUFFEL, PAUL COFFIN, and DANIEL R. DAUNER

Appeal No. 1999-2278
Application No. 08/641,442

ON BRIEF

Before FLEMING, DIXON, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-10, which are all of the claims pending in this application. An amendment (Paper No. 11, filed April 9, 1998) submitted subsequent to the final rejection was denied entry by the examiner (Paper No. 13, mailed April 17, 1998). However, the examiner states (id.) that appellants' response has overcome the rejections under 35 U.S.C. § 112, first and second paragraphs. The examiner additionally states (answer, page 3) that the

rejection of claims 3-7 has been withdrawn. Appellants assert (brief, page 2) that the rejection of claim 9 is not being appealed because the proposed amendment to claim 9 has not been entered by the examiner. Appellants additionally assert (*id.*) that claim 10 is allowable if written in independent form because claim 10 was only rejected under 35 U.S.C. § 112, second paragraph, and that this rejection has been withdrawn by the examiner¹.

We observe that the only claims rejected by the examiner in the answer are claims 1, 2, and 8, which stand rejected under 35 U.S.C. § 102(b). In sum, the rejection of claims 3-7 and 10 has been withdrawn by the examiner, the appeal is dismissed as to claim 9, and rejected claims 1, 2, and 8 remain before us for decision on appeal.

BACKGROUND

¹ Appellants state (brief, page 2) that the amendment to claim 10 is assumed to have been entered in view of the examiner's withdrawal of the rejection of claim 10 under 35 U.S.C. § 112, second paragraph. As to whether or not the amendment to claim 10 has been entered, or whether the examiner determined that claim 10 was definite without the amendment, we consider to be a formal matter to be resolved by the examiner and appellants subsequent to this appeal. We do not address this rejection of claim 10 under 35 U.S.C. § 112, second paragraph in this decision.

Appellant's invention relates to a picker for handling data cartridges. An understanding of the invention can be derived from a reading of exemplary claims 1 and 8, which are reproduced as follows:

1. A picker for extracting a data cartridge from a storage location, comprising:

a sleeve;

a thumb, adapted for movement relative to the sleeve;

a finger mounted on the thumb;

a post on the finger;

a first track in the sleeve, the first track adapted to receive the post, wherein when the post is in the first track the finger is positioned to grip the data cartridge;

a second track in the sleeve, the second track adapted to receive the post, wherein when the post is in the second track, the finger is positioned to release the data cartridge;
and

a gate, spring loaded between the first track and the second track, wherein when the post is in the first track and the thumb is moved to a first predetermined position, the post deflects the gate, enabling the post to move past the gate into the second track, even when no data cartridge is being gripped.

8. A picker for extracting a data cartridge from a drive mechanism, the drive mechanism including a handle, the picker comprising:

a thumb having a first extension and a second extension;

wherein when the thumb is positioned so that the handle is between the first extension and the second extension, the thumb is moved in a first direction causing the first extension to contact the handle and to move the handle from an unlatched position to a latched position or the thumb is moved in a second direction causing the second extension to contact the handle and to move the handle from the latched position to the unlatched position.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Wanger et al. (Wanger) 5,014,255 May 7, 1991

Claims 1, 2, and 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Wanger.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 17, mailed November 24, 1998) for the examiner's complete reasoning in support of the rejection, and to appellants' brief (Paper No. 16, filed August 19, 1998) and reply brief (Paper No. 18, filed February 1, 1999) for appellants' arguments thereagainst. Only those arguments actually made by appellants have been considered in this decision. Arguments

which appellants could have made but chose not to make in the briefs have not been considered. See 37 CFR 1.192(a).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejection advanced by the examiner, and the evidence of anticipation relied upon by the examiner as support for the rejection. 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 rejection and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we reverse, for the reasons set forth by appellants.

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

Appellants note (brief, page 10), at the outset, that as

discussed in appellants' specification, Wanger discloses a two-fingered picker in which the state of the pickers is changed from a gripping state to a splayed state only if a cartridge is present. Appellants' specification states that the improvement over Wanger is that the state of the gripper can be changed from a gripping state to a splayed state without requiring a cartridge to be present (specification, pages 11 and 12). Appellants specification states (id.) that Wanger does not disclose "enabling the post to move past the gate into the second track, even when no data cartridge is being gripped" as required by claim 1. The examiner's position (answer, pages 3 and 5) is that this limitation is met by Wanger, and that Wanger discloses that the post is deflected by the gate (col. 7, lines 39-45; col. 8, line 67 to col. 9, line 31, and figures 8-10). Appellants disagree with the examiner's interpretation of Wanger (brief, pages 10-14), and note (id., page 14) that claim 1 does not recite that the gate deflects the post, but rather that the post deflects the gate.

From our review of Wanger, we are in agreement with appellants, for the reasons set forth in the brief (pages 10-

14) that Wagner does not disclose that "the post deflects the gate, enabling the post to move past the gate into the second track, even when no data cartridge is being gripped" as required by claim 1. In Wanger, four operating modes: "go-get;" "retrieve;" "put," and "return" are discussed. Wanger discloses (col. 3, lines 39-49) that:

The cartridge engaging means has a "go-get" operating mode, FIGS. 8-12, wherein the engaging means 18 moves forwardly 24 without a cartridge in engagement therewith; a "retrieve" operating mode, FIGS. 12, 13 and 1, wherein said engaging means 18 moves rearwardly 26 with an engaged cartridge; a "put" operating mode. FIGS. 14 and 15, wherein said engaging means moves forwardly 24 with an engaged cartridge; and a "return" operating mode, FIGS. 15, 6, and 14, wherein the engaging means 18 moves rearwardly without a cartridge in engagement therewith.

The only mode in which the gate is deflected by the post is the "retrieve" mode, where lower stud 88 moves along a lower stud path 312 including channel portion 164, gate surfaces 192, 194, channel portion 156, as shown in figure 13 (col. 9, lines 32-43). However, in the "retrieve mode," the cartridge is gripped. In the "go-get" mode and the "return" mode, the cartridge is not gripped. However, the post does not deflect the gate in either of these modes. In the "go-get" mode, the

lower stud 88 of latch member 74 moves along a first path 310 including channel portions 152, 154, and 164, as best shown in figures 10 (col. 9, lines 12-14). In the "go-get" mode, the gate is not deflected by the stud. In the "return" mode, lower stud 88 follows path 316 including channel portion 160, gate surface portion 196, channel portion 156, as best shown in figure 14 (col. 9, lines 60-64). In the "return" mode, the lower stud 88 goes past surface 196 of the gate, but does not deflect the gate and move from channel 154 to channel 156. The post 88 is already in channel 160 and is moving past surface 196 of the gate as post 88 moves to channel 156. Thus, the gate surface 196 deflects the post 88, and is not deflected by the post as required by claim 1. We have reviewed the portions of Wanger relied upon by the examiner, but we find no teaching of post 88 deflecting the gate and moving from the first channel to the second channel when no cartridge is being gripped.

Accordingly, we find that Wanger does not anticipate claim 1 as advanced by the examiner. The rejection of claim 1, and claim 2 which depends therefrom, is therefore reversed.

We turn next to independent claim 8. Appellants note (brief, page 16) that "[c]laim 8 specifies that the picker has a thumb with first and second extensions suitable for manipulating a handle on a drive from a latched position to an unlatched position and vice-versa." Appellants assert (id.) that figure 2 of Wagner illustrates a picker positioned relative to a storage location, but that Wanger does "not discuss drives or drive handles, much less manipulation of a drive handle with the picker."

The examiner's position (final rejection, pages 7 and 8) is that Wanger discloses in figures 10 and 11, two extension portions located between numeral 74 and handle 18, and that Wanger discloses that the extension portions contact the handle 18 whenever the handle is moved. Appellants assert (brief, page 16) that in Wanger, reference numeral 18 refers to the picker engaging assembly, and that numeral 74 refers to one of the two fingers mounted on the picker engaging assembly. Appellants argue (id.) that in "claim 8, the drive handle is not part of the picker. The drive handle is a separate item being manipulated by the picker."

Claim 8 recites "A picker for extracting a data cartridge from a drive mechanism, the drive mechanism including a handle, the picker comprising:" We find that claim 8 is drawn to a picker. The handle assembly is not part of the picker, but rather is part of a drive mechanism which includes a data cartridge, which is extracted by the picker. We do not agree with the examiner that numeral 18 of Wanger can be construed as a handle of a drive mechanism, because reference numeral 18 of Wanger represents the cartridge engaging assembly (col. 3, lines 31 and 32) which includes latch members or picker fingers 72, 74 (col. 3, line 59). Since the cartridge engaging assembly includes the picker fingers, it cannot be construed as a handle of a drive mechanism from which the cartridge is extracted by the picker. In addition, claim 8 further recites that:

the thumb is moved in a first direction causing the first extension to contact the handle and to move the handle from an unlatched position to a latched position or the thumb is moved in a second direction causing the second extension to contact the handle and to move the handle from the latched position to the unlatched position.

The examiner states that the extension portions contact the handle 18 whenever the handle is moved. However, the examiner

points to no showing in Wanger, and we are not aware of any teaching, of the thumb moving in a first direction to contact the handle and move the handle from an unlatched position to a latched position, and vice versa. We therefore find that the examiner has failed to establish a **prima facie** case of anticipation of claim 8 by Wanger. Accordingly, the rejection of claim 8 under 35 U.S.C. § 102(b) is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, and 8 under 35 U.S.C. § 102(b) is reversed.

REVERSED

MICHAEL R. FLEMING)	
Administrative Patent Judge)	
)	
)	
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)	BOARD OF PATENT
JOSEPH L. DIXON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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STUART S. LEVY)	
Administrative Patent Judge)	

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APPEAL NO. 1999-2278 - JUDGE LEVY
APPLICATION NO. 08/641,442

APJ LEVY

APJ DIXON

APJ FLEMING

DECISION: **REVERSED**

Prepared By: GJH

DRAFT TYPED: 20 Aug 02

FINAL TYPED: