

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROBERT J. McPHERSON, GLEN D. KAPPEL and NIGEL STREET

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Appeal No. 1999-0503  
Application 08/744,207

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ON BRIEF

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Before THOMAS, HAIRSTON and JERRY SMITH, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1, 4, 6, 9-13, 15, 16 and 20, which constitute all the claims remaining in the application. An amendment after appeal was filed on March 20, 2001 and was entered by the examiner.

The disclosed invention pertains to a data media storage library for storing and accessing storage media.

Representative claim 1 is reproduced as follows:

1. A data media storage library for storing and accessing storage media, the library comprising:
  - (a) a housing;
  - (b) a storage array within the housing, the storage array having a number of storage locations;
  - (c) a plurality of media storage elements adapted to hold the storage media;
  - (d) a plurality of data transfer elements adapted to read and write information on the storage media;
  - (e) a media transport element within the housing adapted to move the storage media between the media storage element and data transfer element;
  - (f) a store guide within the storage array and wherein the storage locations are slots arranged in the store guide;
  - (g) a media storage element adapter engaging the store guide slot and the media storage element for holding the media storage element in the slot and allowing the media storage element to be removed from the slot; and
  - (h) a data transfer element adapter engaging the store guide slot and the data transfer element for holding the data transfer element in the slot and allowing the data transfer element to be removed from the slot, the data transfer element adapter further comprising a mounting plate and a spring-loaded latching mechanism for engaging the data transfer

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element,

wherein each storage location may engage one of the media storage elements and the data transfer elements, thereby allowing the interchangeability of media storage elements with data transfer elements within the storage array,

wherein the data transfer element can be removed from the slot while power is supplied to the data library.

The examiner relies on the following references:

Hanson	4,912,580	Mar. 27, 1990
Baxter et al. (Baxter)	5,206,845	Apr. 27, 1993
Deki	JP 5-282764	Oct. 29, 1993

Claims 1, 4, 6, 9-13, 15, 16 and 20 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Baxter in view of Hanson and Deki with respect to claims 1, 4, 6, 9, 16 and 20, Baxter in view of Deki with respect to claims 10, 11 and 15, and Baxter in view of Deki and further in view of Hanson with respect to claims 12 and 13.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

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We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the 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 answer.

It is our view, after consideration of the record before us, 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 as set forth in claims 1, 4, 6, 9-13, 15, 16 and 20. Accordingly, we reverse.

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 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

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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. 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). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d

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1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

We consider first the rejection of claims 1, 4, 6, 9, 16 and 20 based on the teachings of Baxter in view of Hanson and Deki. Although appellants have nominally indicated that the claims do not stand or fall together [brief, page 3], they have not specifically argued the limitations of each of the claims. Simply pointing out that claims differ in scope with no attempt to point out how the claims additionally patentably distinguish over the prior art does not amount to a separate argument for patentability. In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). To the extent that appellants have properly argued the reasons for

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independent patentability of specific claims, we will consider such claims individually for patentability. To the extent that appellants have made no separate arguments with respect to some of the claims, such claims will stand or fall with the claims from which they depend. Note *In re King*, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); *In re Sernaker*, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). For purposes of the rejection before us, claims 4, 6, 9 and 16 will stand or fall with claim 1 while claim 20 will be separately considered.

With respect to representative, independent claim 1, the examiner reads a substantial portion of the claim on the disclosure of Baxter [answer, pages 4-5]. According to the examiner, Baxter discloses all the features of claim 1 except for the spring loaded latching mechanism and the data transfer element being removable while power is supplied to the data storage library. The examiner cites Hanson and Deki, respectively, as teaching these two features of claim 1. The

examiner explains why it would have been obvious to the artisan to combine these features from Hanson and Deki with the storage library of Baxter [id., pages 5-6].

Appellants argue that the elements 46 and 47 of Baxter, which the examiner identified as the media storage element adapter, are merely the top and bottom walls of a data cell and, therefore, form part of the data cell. Appellants further argue that elements 46 and 47 do not meet the conventional definition of adapter [brief, pages 4-5]. The examiner responds that the word "adapter" is very broad, and when the word is given its broadest reasonable interpretation, elements 46 and 47 of Baxter function as a media storage element adapter [answer, pages 7-10]. Appellants reiterate their position that elements 46 and 47 are not adapters as claimed, and appellants further argue that elements 46 and 47 do not "engage" storage cells 27 and 28 within the ordinary meaning of that term [reply brief].

As noted, this particular argument of appellants hinges on whether elements 46 and 47 of Baxter form a media storage element adapter and whether these elements engage the store guide slot and the media storage element as recited in

claim 1. The examiner has identified cells 27 or 28 of Baxter as the media storage elements of the claimed invention. These storage elements resemble cubes having a top portion, a bottom portion and three side portions [see Figures 6-9]. The remaining face of the cube is open and is considered the front of the cube for allowing the data storage media to be inserted and removed from the cube or cell 27. As noted by appellants, elements 46 and 47 of Baxter represent the top and bottom faces of the cell 27 which means that they are an integral part of the cell 27 and are not adapters for engaging the store guide slot and the cell 27 as required by claim 1.

The examiner notes that the top and bottom faces of cell 27 engage slots 39 (36?) for holding cells 27 and 28 to the plate 29. The examiner notes that the recitations of claim 1 do not preclude the integral connection or association of the media storage elements (27 or 28) with the element adapter (46 and 47). After a careful review of the record in this case, we agree with appellants that the examiner's interpretation of the claimed invention is not reasonable. We agree with appellants that the integral walls or faces of the cubes 27 in Baxter cannot also be considered

to be adapters which engage the cubes 27. Clause (g) of claim 1 recites that the media storage element adapter engages the store guide slot and the media storage element for holding the media storage element in the slot and allowing the media storage element to be removed from the slot. While we could agree with the examiner that top and bottom portions 46 and 47 of cell 27 do engage slots 39 (36?) of the back plate, we cannot agree with the examiner that these two faces of the storage cell also engage the storage cell as recited in claim 1. For two elements to be engaged normally requires that the two elements be brought together and interlocked or meshed in some manner. Top and bottom portions 46 and 47 of Baxter are not engaged with cell 27. Thus, without deciding the exact definition to be attached to the word "adapter" in claim 1, we find that Baxter does not teach an adapter engaging the store guide slot and the media storage element as recited in the claim.

We have considered alternative interpretations of Baxter, but we are unable to find any reading of Baxter which meets the recitations of clauses (g) and (h) of claim 1.

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Although appellants' additional arguments in the briefs with respect to Hanson and Deki are not convincing, the examiner's failure to properly interpret the recitation in clause (g) of claim 1 results in the failure to establish a prima facie case of obviousness. We note that a similar recitation appears in independent claim 16. Therefore, we do not sustain the rejection of claims 1, 4, 6, 9 and 16 as set forth by the examiner. Since separately argued claim 20 depends from claim 1, we also do not sustain the rejection of claim 20.

We now consider the rejection of claims 10-13 and 15. Independent claim 10 has a similar recitation to the recitation of claim 1 considered above. Therefore, the examiner's rejection of these claims suffers the same problems discussed above. Accordingly, we do not sustain the examiner's rejection of claims 10-13 and 15.

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In summary, we have not sustained any of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1, 4, 6, 9-13, 15, 16 and 20 is reversed.

REVERSED

	JAMES D. THOMAS	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	
	KENNETH W. HAIRSTON	)	BOARD OF
PATENT	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
		)	
	JERRY SMITH	)	
	Administrative Patent Judge	)	

JS/ki

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