

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD K. DRISCOLL,
ARTHUR R. NIGRO
and THOMAS D. FILLIO

Appeal No. 1999-1498
Application 08/547,604¹

ON BRIEF

Before CALVERT, COHEN, and GONZALES, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 22, 24 and 28 to 31, all the claims remaining in the application.

¹ Application for patent filed October 24, 1995. According to the appellants, the application is a continuation of Application 08/191,039, filed February 3, 1994, now Patent No. 5,490,723, issued February 13, 1996, which is a division of Application 08/080,310, filed June 24, 1993, now Patent No. 5,343,357, issued August 30, 1994, which is a division of Application 07/935,110, filed August 26, 1992, now Patent No. 5,247,427, issued September 21, 1993.

Appeal No. 1999-1498
Application 08/547,604

The claims on appeal are drawn to a frame for holding a disk drive, and are reproduced in the appendix of appellants' brief.

The references applied in the final rejection are:

Good et al. (Good)	5,571,256	Nov. 5, 1996
-----------------------	-----------	--------------

Deneke (German Patent)	489,592	Jan. 18, 1930 ²
---------------------------	---------	----------------------------

The appealed claims stand finally rejected on the following grounds:

(1) Claims 22, 28 and 29, anticipated by Deneke, under 35 U.S.C. § 102(b);

(2) Claims 24, 30 and 31, unpatentable over Deneke in view of Good, under 35 U.S.C. § 103.

Considering first rejection (1) with regard to claim 22, it is well settled that "[t]o 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 argue that (brief, page 5):

² In evaluating this reference, we have relied on the translation filed by appellants on November 12, 1996. Any references herein to Deneke by page and line are to page and line of the translation.

Claim 22 is not anticipated by Deneke for at least the following reasons: First, Deneke fails to disclose a frame that is a unitary structure. Second, Deneke fails to disclose a frame that includes a T-bar extending longitudinally along its bottom wall. Third, Deneke fails to disclose a frame that includes a detent included in said T-bar.

First, with regard to whether Deneke's frame 4 is "unitary", the examiner states on page 4 of the final rejection³ that "the Deneke device is a single unit and therefore unitary", and on page 3 of the answer that "The term 'integral' has a meaning different from 'unitary'." However, although a structure made up of a number of pieces may be "integral", it is not necessarily "unitary." As indicated in the quote on page 6 of appellant's brief from In re Morris, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), "integral" has been interpreted as being a broader term than "unitary". Also, in In re Heltzel, 137 F.2d 113, 115, 58 USPQ 556, 557 (CCPA 1943), it was held that a unitary structure is

³ References herein to the final rejection are to Paper No. 16 (erroneously numbered 14)(October 9, 1997).

not one which is "bolted, clamped, screwed, or tied together". Since Deneke's frame 4 is made of several pieces, as shown in Fig. 2, we are doubtful that it can be considered "unitary". However, it is unnecessary to resolve this issue, since we agree with appellants' second and third arguments, supra.

As for the second argument, the examiner identifies Deneke's elements 19 and 21 as the claimed T-bar. We do not consider this to be correct because only element 19 is a bar "extending longitudinally along [the] bottom wall [of the frame]" as claimed, and it is rectangular in cross-section, not T-shaped. Items 21 and 22 are supports for bar 19, rather than part of the bar. Also, the bottom wall 23 of Deneke's frame is not "shaped to include" the bar, as recited in claim 22.

The third argument concerns the recitation "said T-bar . . . including a detent." Deneke's specification does not expressly disclose a detent, but the examiner, noting the ball bearings disclosed by Deneke between tracks 18 and 19 (Fig. 4), seems to take the position in the final rejection that a detent would be inherent in Deneke because "Detents are a

commonly used and well known means of retaining bearings in a guide member where bearings are present" (page 4). Then, in the answer the examiner goes further and states that Deneke's drawings "show detents in which the bearings are guided" (page 4; emphasis added).

The definition of "detent" is "a catch or lever in a mechanism which initiates or locks movement of a part";⁴ thus, in appellants' disclosed apparatus, element 65 is a detent because it locks the module 33 in place on plate 35 (page 11, lines 7 to 14). Contrary to the examiner's statement, supra, we are not aware of the use of a "detent" to hold ball bearings in place, nor has the examiner provided any evidence thereof. Deneke does not expressly disclose a detent per se, but the examiner seemingly has construed the C-shaped structure holding the balls around bar 19 in Fig. 4 of Deneke as a "detent". In our view, this structure is not a detent, but rather appears to be a cage, as is normally used for holding ball bearings. Consequently, we do not consider that

⁴ McGraw-Hill Dictionary of Scientific and Technical Terms (2d Ed., 1978).

Appeal No. 1999-1498
Application 08/547,604

Deneke shows a detent at bar 19, nor that a detent would inherently be present there.

Accordingly, since Deneke does not disclose at least the T-bar and detent as recited in claim 22, we will not sustain the rejection of claim 22, nor of claims 28 and 29 dependent therefrom.

Turning to rejection (2), the secondary reference, Good, does not supply the deficiencies discussed above. Rejection (2) therefore will not be sustained.

Conclusion

The examiner's decision to reject claims 22, 24 and 28 to 31 is reversed.

REVERSED

Appeal No. 1999-1498
Application 08/547,604

IAN A. CALVERT)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
)	
IRWIN CHARLES COHEN)	APPEALS AND
Administrative Patent Judge)	
)	INTERFERENCES
)	
)	
)	
JOHN F. GONZALES)	
Administrative Patent Judge)	

IAC/kis
Irving M. Kriesgsman
883 Edgell Road
Suite 100
Framingham, MA 01701