

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHAN E. GAVIT, SCOTT A. DYE and ROBERT E. LEONARD

Appeal No. 2001-2268
Application 08/922,581

ON BRIEF

Before JERRY SMITH, BARRETT and SAADAT, 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 final rejection of claims 1, 3-6, 9-29, 36, 37 and 43. Claims 2 and 30-35 had been cancelled. Claims 7, 8 and 38-42 were not rejected. A first amendment after final rejection was filed on April 3, 2000 and was entered by the examiner. This amendment cancelled claim 7. A second amendment after final rejection was filed on June 5, 2000 and was also

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entered by the examiner. In the examiner's answer, the examiner indicated the allowability of claims 12-15 and 36. Accordingly, this appeal is directed to the rejection of claims 1, 3-6, 9-11, 16-29, 37 and 43.

The disclosed invention pertains to a data storage and retrieval system that is operative to retrieve data stored on a recording medium, such as a magnetic tape recording medium, and is particularly directed to a media carousel changer that is adapted to receive a plurality of cassettes containing a recording medium and operative to mount said cassettes into a docking station on a recorder/reader and to demount the cassettes therefrom.

Representative claim 1 is reproduced as follows:

1. A media carousel changer adapted to receive a plurality of cassettes containing a recording medium and operative to mount said cassettes into a docking station on a recorder/reader and to demount the cassettes therefrom, comprising:

(a) a support frame;

(b) a turntable disposed on said support frame and journaled for rotation about a turntable axis;

(c) a plurality of cassette holders disposed about a periphery of said turntable, each said cassette holder for receiving a respective one of the plurality of cassettes containing the recording medium and being pivotally mounted to said turntable such that each said cassette holder is selectively pivotable between an extended position and a retracted position;

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(d) a rotary drive operative to rotate said turntable thereby to consecutively move each of said cassette holders into registration with said docking station; and

(e) a plunger arm linearly movable between a first advanced position and a withdrawn position, said plunger arm operative when advanced to pivot a registered one of said cassette holders into the extended position thereby to move the cassette received therein into the docking station and into a docked state with respect to said recorder/reader and operative when withdrawn to permit said registered one of said cassette holders to pivot into a retracted position thereby to demount the cassette received therein from the recorder/reader so that said cassette moves to a stored state.

The examiner relies on the following reference:

Foelkel et al. (Foelkel) 3,617,066 Nov. 2, 1971

Claims 24-28 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 3, 6, 10, 29, 37 and 43 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Foelkel. Claims 4, 5, 9, 11 and 16-23 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Foelkel taken alone.

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

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the prior art 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 supports the examiner's rejection of claims 1, 3, 6 and 37. We reach the opposite conclusion with respect to claims 4, 5, 9-11, 16-23, 29 and 43. We are also of the view that the rejection of claims 24-28 as being indefinite is in error. Accordingly, we affirm-in-part.

We consider first the rejection of claims 24-28 under 35 U.S.C. § 112, second paragraph, as being indefinite. As a result of a restriction requirement made early in the prosecution of this application, claims 24-28 were determined to be directed to a non-elected invention and were withdrawn from further consideration by the examiner. Despite the supposed withdrawal of these claims from further consideration, however, the examiner

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made this rejection of the claims in the final rejection. The basis for the rejection is that these claims are not directed to the elected invention. In other words, the examiner finds that because these claims are not directed to the elected subject matter, the metes and bounds of these claims cannot be ascertained, rendering the claims vague and indefinite [answer, page 3].

Appellants argue that the examiner's restriction requirement and the withdrawal of claims 24-28 from further consideration by the examiner were improper. Appellants assert that since the restriction requirement was improper, the rejection of the claims under 35 U.S.C. § 112 is also improper [brief, pages 36-40].

Since the examiner has made a rejection of claims 24-28 even though they were supposedly withdrawn from consideration as being directed to a non-elected invention, that rejection is before us. Thus, the claims are not withdrawn from consideration when the examiner has made a rejection of the claims. We will not sustain this rejection of claims 24-28 because the examiner has not made a case for indefiniteness. The fact that a claim might be directed to a non-elected invention is totally unrelated to the question of whether that claim particularly points out and

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distinctly claims the invention of that claim. In other words, the scope of claims 24-28 can be perfectly clear regardless of whether or not these claims are directed to the elected invention. Therefore, the examiner's reasoning that these claims are vague and indefinite simply because they allegedly are not directed to the elected invention does not establish a prima facie case of unpatentability. The question of whether the restriction requirement was properly made does not fall within our jurisdiction. The propriety of a restriction requirement is reviewable by petition under 37 CFR § 1.144.

We now consider the rejection of claims 1, 3, 6, 10, 29, 37 and 43 under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Foelkel. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

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The examiner indicates how he reads the invention of these claims on the disclosure of Foelkel [answer, pages 3-4]. With respect to claim 1, appellants argue that Foelkel fails to disclose a plunger arm that is linearly movable between a first advanced position and a withdrawn position. Appellants also argue that Foelkel does not disclose a plurality of cassette holders disposed about a periphery of the turntable as claimed [brief, pages 17-18]. The examiner responds that Foelkel does disclose the plunger arm as indicated in the rejection. The examiner also responds that the star arrangement of Foelkel does have the cassette holders disposed about the periphery of the turntable as claimed [answer, pages 9-10]. Appellants respond that because the planes of the cassettes in Foelkel contain the rotational axis of the turntable, the cassette holders are not disposed about the periphery of the turntable as claimed [reply brief, page 2].

We will sustain the examiner's rejection of claim 1 for essentially the reasons identified by the examiner. Specifically, we agree with the examiner that the claimed plunger arm can be read on cam 12. We disagree with appellants' position that cam 12 cannot reasonably be considered a plunger arm. Appellants have offered no definition in the specification which

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would preclude the cam 12 of Foelkel from being considered a plunger arm. We also disagree with appellants' position regarding the disposition of the cassette holders about the periphery in Foelkel. Specifically, claim 1 recites nothing about the plane or the orientation of the cassette holders. Even though the cassette holders in Foelkel are directed inwardly from the periphery, the edges are still disposed about the periphery of the turntable within the meaning of the claim language.

With respect to claim 6, appellants additionally argue that Foelkel fails to disclose a driver operative to selectively reciprocate the plunger arm between the first advanced position and the withdrawn position [brief, pages 18-19]. The examiner responds that motor 16 is a driver within the meaning of claim 6 [answer, page 11].

We will sustain the rejection of claim 6 because we agree with the examiner that motor 16 of Foelkel drives the plunger arm (cam 12) between an advanced position and a withdrawn position as claimed.

With respect to claim 10, appellants argue that Foelkel fails to disclose an intermediate position of the cassette holders, and the ability to move a second cassette holder to an intermediate position when the plunger arm is in a second

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advanced position [brief, pages 19-20]. The examiner responds that the cassette holders of Foelkel must translate through an intermediate position when moving between the advanced position and the withdrawn position [answer, page 11]. Appellants respond that Foelkel does not disclose an intermediate position of a second cassette holder as claimed [reply brief, pages 2-3].

We will not sustain the examiner's rejection of claim 10 because the examiner has not identified any structure in Foelkel which moves a second cassette holder to an intermediate position when the plunger arm is in a second advanced position as claimed.

With respect to claim 29, appellants argue that Foelkel fails to disclose an actuator linearly movable radially of the turntable axis between an advanced position and a withdrawn position as claimed. Specifically, appellants argue that neither cam 12 nor lever 20 of Foelkel moves radially of the turntable axis [brief, pages 21-22]. The examiner responds that claim 29 does not preclude the axis about which disc 5 rotates and that radii extending from that axis would run horizontally left and right as well as into and out of the page [answer, page 12]. Appellants respond that cam 12 and lever 20 both move parallel to the turntable axis [reply brief, page 3].

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We will not sustain the examiner's rejection of claim 29 because we agree with appellants that cam 12 and lever 20 of Foelkel do not move radially of the turntable axis as claimed. Cam 12 and lever 20 both move parallel to the turntable axis.

With respect to claim 43, appellants argue that Foelkel fails to disclose that an actuator/plunger arm can engage a catch when withdrawn such that the actuator/plunger arm physically moves the registered one of the cassette holders from the extended position and its respective cassettes out of the docked state. Specifically, appellants argue that the cassette holders in Foelkel are moved as a result of spring tension acting on the holder rather than by physical engagement [brief, pages 22-24]. The examiner does not respond to this argument.

We will not sustain the examiner's rejection of claim 43 for reasons argued by appellants in the main brief.

In summary, we have sustained the rejection of claims 1 and 6, but we have not sustained the rejection of claims 10, 29 and 43. Claim 3 was indicated to stand or fall with claim 1 so that the rejection of claim 3 is also sustained. We can find no arguments in appellants' briefs directed to the rejection of claim 37. Since claim 37 depends from claim 6, we also sustain the rejection of claim 37.

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We now consider the rejection of claims 4, 5, 9, 11 and 16-23 under 35 U.S.C. § 103 based on the teachings of Foelkel taken alone. 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 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.

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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 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 appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellants [see 37 CFR § 1.192(a)].

The examiner indicates how he finds the invention of these claims to be obvious [answer, pages 5-9]. It is noted that the examiner acknowledges that several of the features of these claims are missing from the disclosure of Foelkel, but the examiner dismisses these differences as being obvious to the artisan based on various rationales put forth by the examiner including the taking of Official Notice that several of the claimed elements were well known in the art.

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Appellants argue generally that the examiner has failed to establish a prima facie case of obviousness because the examiner has not supported the rejection with evidence when challenged by appellants. Appellants also argue that there is no motivation to combine the knowledge generally available in the art with the teachings of Foelkel as proposed by the examiner. Appellants also argue the various claims individually, and appellants explain why each of the claim limitations dismissed by the examiner would not have been obvious to the artisan [brief, pages 24-36]. The examiner responds that he sees no reason why prior art must be furnished in support of his position that the claimed invention would have been obvious to the artisan [answer, pages 12-16]. Appellants respond that the examiner has provided no evidence to support the rejection and there is no motivation to modify Foelkel in the manner proposed by the examiner [reply brief].

We will not sustain the examiner's rejection under 35 U.S.C. § 103 with respect to any of the claims on appeal because the examiner has failed to establish a prima facie case of obviousness. As noted above, the examiner has the burden of initially presenting a prima facie case of obviousness. The examiner cannot satisfy this burden by simply dismissing

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differences between the claimed invention and the teachings of the prior art as being obvious. The examiner must present us with an evidentiary record which supports the finding of obviousness. It does not matter how strong the examiner's convictions are that the claimed invention would have been obvious, or whether we might have an intuitive belief that the claimed invention would have been obvious within the meaning of 35 U.S.C. § 103. Neither circumstance is a substitute for evidence lacking in the record. Whether there is prior art available which would render these appealed claims unpatentable we cannot say. We can say, however, that the record presently before us does not support the rejection as formulated by the examiner.

In summary, we have not sustained the rejection of claims 24-28 under 35 U.S.C. § 112. The rejection of claims 1, 3, 6, 10, 29, 37 and 43 under 35 U.S.C. § 102(b) has been sustained with respect to claims 1, 3, 6 and 37, but has not been sustained with respect to claims 10, 29 and 43. The rejection of claims 4, 5, 9, 11 and 16-23 under 35 U.S.C. § 103 has not been sustained. Therefore, the decision of the examiner rejecting claims 1, 3-6, 9-11, 16-29, 37 and 43 is affirmed-in-part.

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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

JERRY SMITH)	
Administrative Patent Judge)	
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LEE E. BARRETT)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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MAHSHID D. SAADAT)	
Administrative Patent Judge)	

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Timothy J. Martin
9250 W. 5th Avenue
Suite 200
Lakewood, CO 80226