

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MARK A SMITH, DANIEL R. DAUNER and ROBERT W. LUFFEL

Appeal No. 2004-0334
Application No. 08/853,608

ON BRIEF

Before STAAB, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 15, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates generally to the field of data cartridge storage and handling systems, and more particularly to a portable carrying case or caddy for handling data cartridges. In particular, the appellants' invention provides a method and apparatus to enable a cartridge handling mechanism to reference a data cartridge to a data cartridge caddy within an autochanger storage rack in order to return the data cartridge to the data cartridge caddy after the autochanger has finished using the data cartridge (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Porter	5,576,911	Nov. 19, 1996
Fukazawa et al. (Fukazawa)	JP 6-251474 ¹	Sept. 9, 1994

Claims 1 to 10 and 13 to 15 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Porter.

¹ In determining the teachings of Fukazawa, we will rely on the translation provided by the USPTO. A copy of the translation is attached for the appellants' convenience.

Claims 11 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Porter in view of Fukazawa.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 15, mailed July 18, 2000) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 14, filed May 8, 2000) and reply brief (Paper No. 17, filed August 28, 2000) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The anticipation rejection

We will not sustain the rejection of claims 1 to 10 and 13 to 15 under 35 U.S.C. § 102(e).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

In this case, claims 1 and 6 (the independent claims on appeal) are not anticipated by Porter for the reasons set forth on pages 16-22 and 26-31 of the brief and pages 6-9 of the reply brief. Specifically, Porter does not disclose the following structural limitations of claim 1:

(1) "Z referencing means on a sleeve attached to said autochanger storage rack, providing preliminary, intermediate and final Z direction referencing between said data cartridge and said data cartridge caddy during installation of said data cartridge into said data cartridge caddy by said data cartridge handling mechanism of said

autochanger, wherein said Z referencing means is a mechanical limit physically attached to said sleeve;" and

(2) "Y referencing means on said sleeve attached to said autochanger storage rack, providing preliminary, intermediate and final Y direction referencing between said data cartridge and said data cartridge caddy during installation of said data cartridge into said data cartridge caddy by said data cartridge handling mechanism of said autochanger, wherein said Y referencing means is a mechanical limit physically attached to said sleeve." Likewise, Porter does not disclose the following method limitations of claim 6:

(1) "providing a sleeve attached to said storage rack;"

(2) "providing a first referencing mechanism on said sleeve;"

(3) "providing a second referencing mechanism on said sleeve;"

(4) "locating said data cartridge caddy adjacent said sleeve;"

(5) "aligning said data cartridge with said data cartridge caddy in a second direction which is transverse to said first direction by contacting said data cartridge with said first referencing mechanism;" and

(6) "aligning said data cartridge with said data cartridge caddy in a third direction which is transverse to said first direction and said second direction by contacting said data cartridge with said second referencing mechanism."

In the answer (pp. 3-10), the examiner states that the above-noted limitations of claims 1 and 6 are disclosed in Porter. However, the examiner is incorrect for the reasons set forth in the briefs before us in this appeal. In a nutshell, the claims recite, inter alia, a sleeve attached to a storage rack of an autochanger; a data cartridge insertable into a data cartridge caddy in the storage rack; a first referencing means/mechanism on the sleeve to align the data cartridge with data cartridge caddy in one direction; and a second referencing means/mechanism on the sleeve to align the data cartridge with the data cartridge caddy in a another direction which is transverse to the one direction. Porter provides means to align the data cartridge caddy with the storage rack. Porter does not provide any means to align the data cartridge with the data cartridge caddy let only the specific structure/steps set forth in claims 1 and 6.

For the reasons set forth above, claims 1 and 6 are not anticipated by Porter. Accordingly, the decision of the examiner to reject claims 1 and 6, and claim 2 to 5, 7 to 10 and 13 to 15 dependent thereon, under 35 U.S.C. § 102(e) is reversed.

The obviousness rejection

We will not sustain the rejection of claims 11 and 12 under 35 U.S.C. § 103. We have reviewed the Japanese reference to Fukazawa additionally applied in the rejection of claims 11 and 12 (indirectly or directly dependent on claim 6) but find nothing therein

which makes up for the deficiencies of Porter discussed above regarding claim 6.
Accordingly, the decision of the examiner to reject claims 11 and 12 under 35 U.S.C.
§ 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 10 and 13 to 15
under 35 U.S.C. § 102(e) is reversed and the decision of the examiner to reject claims
11 and 12 under 35 U.S.C. § 103 is reversed.

REVERSED

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
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JEFFREY V. NASE)	
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Appeal No. 2004-0334
Application No. 08/853,608

Page 8

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