

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT W. LUFFEL, DAVID P. JONES, CURTIS C. BALLARD and
NICOLAS D. THAYER

Appeal No. 2006-1853
Application No. 10/051,573
Technology Center 3600

ON BRIEF

Before FRANKFORT, BAHR and HORNER, *Administrative Patent Judges*.
HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the examiner's final rejection of claims 1-21, all of the claims pending in the application.

We reverse in part and affirm in part.

BACKGROUND

The appellants' invention relates to a rack-mount storage system (10) including an equipment cabinet (12) sized to receive one or more devices (16, 36). The devices (16, 36) are supported within equipment cabinet (12) by a support spar (20) that extends between first and second sides (28, 30) of the cabinet (12). The devices (16, 36) are provided with a chassis (48, 79) for holding components within the devices. Device (16) may be provided with a first channel member (56) therein which, together with the bottom surface (24) of the chassis (48), defines a first mounting pathway (18). The first mounting pathway (18) is sized to slidably receive the support spar (20). Similarly, the second device (36) may have a similar channel member (58) therein, which together with a bottom surface (82) of the chassis (79), defines a second mounting pathway (38). Independent claims 1 and 14-16 are representative of the subject matter on appeal, and a copy of these claims can be found in the appendix to the appellants' brief.

The examiner relies upon the following as evidence of unpatentability:

Robertson <i>et al.</i> (Robertson)	5,788,091	Aug. 04, 1998
Whiten <i>et al.</i> (Whiten)	5,806,417	Sep. 15, 1998

The following rejections are before us for review:

1. The examiner has rejected claims 1-21 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

2. The examiner has rejected claims 1-4, 7-9, 11-19, and 21 under 35 U.S.C. § 102(b) as being anticipated by Whiten.¹
3. The examiner has rejected claims 5, 6, 10, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Whiten, as applied to claims 1-4, 7-9, 11-19, and 21, in view of Robertson.

Rather than reiterate in detail the conflicting viewpoints advanced by the examiner and the appellants regarding this appeal, we make reference to the examiner's answer (mailed June 4, 2004) for the examiner's complete reasoning in support of the rejections and to the appellants' brief (filed October 2, 2003) for the appellants' arguments.

OPINION

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

I. Rejection under 35 U.S.C. § 112, second paragraph

The examiner has rejected claims 1-21 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly

¹ The final office action also included a rejection of claims 1, 9, 11, and 13-16 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,191,436 to Cherry. The examiner subsequently withdrew this rejection. (Examiner's Answer, p. 3).

claim the subject matter applicants regard as the invention. In particular, the examiner states that claims 1, 14, 15, and 16 are vague and indefinite because it appears that these claims are setting forth the same disclosed structure multiple times under different name terminologies. Specifically, the examiner asserts that the reference numbers 16 and 48 for “device” and “chassis” each point to the same rectangular housing structure that has a recessed channel defining the mounting pathway, and thus, the claims improperly include duplicate recitations of the same disclosed element. (Examiner’s Answer, p. 4).

We disagree with the examiner’s rejection.

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986) (citations omitted). The specification clearly explains the difference between device (16) and chassis (48). For example, on page 5, line 27 – page 6, line 8, the specification states,

Regardless of the particular function of the device 16, device 16 may be provided with a housing or chassis 48 suitable for holding the various systems and components (not shown) that may be contained within the first device 16. By way of example, in the embodiment shown and described herein, the chassis 48 comprises a generally rectangularly shaped structure having a top surface 22, a bottom surface 24 and two opposed sides or surfaces 21 and 23. . . The chassis 48 may also be provided with a first channel member 56 therein which, together with the

bottom surface 24 of the chassis 48, defines the first mounting pathway 18.

It is our opinion that this description in the specification would clearly indicate to those skilled in the art that the “chassis” is a housing that holds or otherwise supports the components of the device, and the “device” is the combination of the chassis and the components (not shown) therein. As such, we reverse the examiner’s rejection of claims 1-21 under 35 U.S.C. § 112, second paragraph.

With respect to claim 15, the examiner noted in the final office action, “the function for the ‘cabinet means’ and ‘housing means’ have not been properly set forth,” because the word “defining” does not recite a proper function. As such, the examiner read these elements as being merely a “cabinet” and a “housing.” (Final Office Action, p. 2). The examiner did not, however, reiterate this interpretation in his answer on appeal. Because the interpretation of the claims under 35 U.S.C. § 112, sixth paragraph, affects the scope of the claims for purposes of the ensuing rejections, we address the interpretation of the “means for” elements of claim 15.

We agree with the examiner that the recitations of “cabinet means” and “housing means” do not properly invoke 35 U.S.C. § 112, sixth paragraph. We also find that the “device means” recitation does not properly invoke 35 U.S.C. § 112, sixth paragraph for the reasons set forth below. We base our interpretation, however, on different grounds than the examiner.

A claim limitation will be interpreted to invoke 35 U.S.C. § 112, sixth paragraph, if it meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase “means for” or “step for;”
- (B) the “means for” or “step for” must be modified by functional language;
and
- (C) the phrase “means for” or “step for” must not be modified by sufficient structure, material or acts for achieving the specified function.

M.P.E.P. § 2181, 8th ed. (August 2001).

The “equipment cabinet means,” “housing means,” and “device means” elements of claim 15 fail the third prong of this test, because each element contains a recitation of the structure for performing the recited function. Specifically, “equipment cabinet means” recites the structure of an “equipment cabinet” that performs the recited function of “defining at least one device opening therein.” Similarly, “housing means” recites the structure of a “housing” that performs the recited function of “housing at least one component of said device means.” And, “device means” recites the structure of a “device” that performs the recited function of “defining at least one mounting pathway therein.” See *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 531, 41 USPQ2d 1001, 1006 (Fed. Cir. 1996) (holding “perforation means . . . for tearing” does not invoke 35 U.S.C. 112, sixth paragraph, because the claim describes the structure supporting the tearing function (i.e., perforation)).

We find that the recitation of “support means for engaging said at least one mounting pathway” properly invokes 35 U.S.C. § 112, sixth paragraph. For

purposes of the prior art rejection that follows, we give “support means” its broadest reasonable interpretation taking into account the corresponding structure described in the specification for performing the recited function and equivalents thereof. *In re Donaldson Co.*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994). As such, we interpret “support means” to be the supporting spar (20), as described in the specification, and equivalents thereof, because the specification discloses that the supporting spar (20) performs the functions of engaging the mounting pathway, engaging the equipment cabinet, and it extends transversely between the sides of the equipment cabinet.

Although we reverse the examiner’s rejection of claims 1-21 under 35 U.S.C. § 112, second paragraph, for the reasons provided above, we nonetheless agree with the examiner’s interpretation of the “means for” elements in claim 15 for purposes of our discussion of the following rejections.

II. Rejection under 35 U.S.C. § 102(b)

The examiner has rejected claims 1-4, 7-9, 11-19, and 21 under 35 U.S.C. § 102(b) as being anticipated by Whiten. With respect to independent claims 1, 14, and 16, the examiner has determined that Whiten discloses an equipment cabinet having a first side (14) and a second side (10) and defining an opening therein, a first device (58, B) sized to be received by the device opening, the first device defining a first mounting pathway therein, the first device including a chassis (58) sized to receive a component (B) of the first device where at least a portion of the chassis defines at least a portion of the first mounting pathway. The examiner has

also determined that Whiten further discloses a support spar (54) sized to be received by the first mounting pathway and the equipment cabinet and extending substantially transversely between the first and second sides of the equipment cabinet to support the first device therein. (Examiner's Answer, p. 5). The examiner has further determined that Whiten discloses the equipment cabinet means, device means having a housing means, and the support means of claim 15. (Examiner's Answer, p. 7).

The appellants argue that claims 1-4, 7-9, 11-19, and 21 are patentable because the tracks (58) in Whiten are not "devices" and they do not have a "chassis that is sized to receive at least one component of said first device." The appellants further argue that the tracks (58) of Whiten do not include "housing means for housing at least one component of said device means," as recited in claim 15. (Appellants' Brief, p. 12). We sustain the examiner's rejection of claims 1, 7-9, 11, 13-18, and 21. We reverse the examiner's rejection of claims 2-4, 12, and 19.

To sustain the rejection of these claims, we must interpret the terms "device," "chassis," and "component." We determine the scope of the claims in patent applications "not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction 'in light of the specification as it would be interpreted by one of ordinary skill in the art.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (quoting *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004)).

With regard to the “device” that is the subject of the invention, the specification states, “the first device 16 utilized in one preferred embodiment of the present invention may comprise a tape autochanger device of the type known in the art, although other devices may also be used.” (Specification, page 5, lines 23-27). Similarly, on page 9 of the appellants’ brief, they argue, “the term ‘device’ requires no specific structure because none is set forth in the claims at issue. As described in the specification, the device 16 may comprise any of a wide range of systems or components that may be mounted within the storage system 10.” It is clear from the specification that the appellants did not ascribe any special meaning to, or otherwise limit, the scope of the term “device.” As such, we give the term “device” its broadest reasonable interpretation in light of the common meaning as understood by one skilled in the art and in light of the specification to mean a piece of equipment designed to serve a special purpose or perform a special function.²

Similarly, the specification on page 5, lines 30-31 describes that the “components” are “contained within the first device 16” and on page 18, lines 3-4 describes that the “components” are “contained within the second device 36.” As such, we give the term “component” its broadest reasonable interpretation in light of the specification to mean a constituent part of the device.³

² The general dictionary definition of “device” is “a piece of equipment or a mechanism designed to serve a special purpose or perform a special function.” Webster’s Third International Dictionary, unabridged, G. & C. Merriam Co., 1971, p. 618.

³ The general dictionary definition of “component” is “a constituent part.” Webster’s Third International Dictionary, unabridged, G. & C. Merriam Co., 1971, p. 466.

With regard to the term “chassis,” the specification describes the chassis (48) as “a generally rectangularly shaped structure having a top surface 22, a bottom surface 24 and two opposed sides or surfaces 21 and 23.” (Specification, page 5, line 32 – page 6, line 2). The common meaning of “chassis” is “the frame upon which is mounted the body (as of an automobile or airplane), the working parts (as of a radio or other electronic device), the barrel and other recoiling parts (of a cannon), or the roof, walls, floors, and facing (as of a building).”⁴ In the context of the specification, it appears that the appellants intended the “chassis” to refer to a frame or housing, for example having top, bottom and side surfaces, which is used to hold the components of the device. The generally accepted dictionary definition of “housing” is “something that covers or protects” or “a case or enclosure esp. for a machine or part, an instrument, a lamp.”⁵ In light of the description provided in the specification, the “housing” is a case or enclosure, for example a top surface, bottom surface and two opposed sides or surfaces, that surrounds the components of the device.

Taking the broadest reasonable interpretation of the claims in view of the specification, we agree with the Examiner that the elements of independent claims 1, 14, 15, 16 are disclosed in Whiten. Specifically, we agree that Whiten discloses an equipment cabinet having a first side (14) and a second side (10) and defining an opening therein. Whiten further discloses a first device (58, B) sized to be received by the device opening, the first device defining a first mounting pathway

⁴ Webster's Third International Dictionary, unabridged, G. & C. Merriam Co., 1971, p. 379.

⁵ Id. at 1097.

in the form of apertures therein. (Whiten, column 5, lines 5-7). The first device includes a chassis (58) sized to receive a component (B) of the first device where at least a portion of the chassis defines at least a portion of the first mounting pathway. Whiten further discloses a support spar or support means (54) sized to be received by the first mounting pathway and to engage the equipment cabinet and extending substantially transversely between the first and second sides of the equipment cabinet to support the first device therein. (Whiten, Figure 1 and column 5, lines 7-12). The appellants on page 12 of their Brief make a conclusory statement that Whiten's tracks (58) do not have a chassis that is sized to receive a component of a device, but they fail to explain why the combination of track (58) and bottle (B) would not constitute a device, with track (58) being the chassis and bottle (B) being a component received within the track (58).

We also sustain the examiner's rejection of dependent claim 7, which depends from claim 1 and further requires that the support spar engage the first and second sides of the equipment cabinet. As shown clearly in Figures 1 and 2 of Whiten, the support spar (54) engages the sides (10, 14) of the equipment cabinet via the adapter (40) and front and rear uprights (20, 22). The claim does not require that the support spar "directly" engage the sides of the equipment cabinet. It is reasonable to interpret "engage" within the context of the specification as allowing for indirect engagement of the spar with the sides, because the specification discloses such an embodiment. The specification describes that the support spar abuts first and second mounting rails (32, 34) and can be held against

the rails by side tabs (75) and/or by a pair of fasteners (78). (Specification, page 7, lines 21-26).

We also sustain the examiner's rejection of dependent claim 8, which depends from claim 7 and further requires that the support spar engage first and second mounting rails of the equipment cabinet. As explained above, Figures 1 and 2 of Whiten show the support spar (54) engaging the sides (10, 14) of the equipment cabinet via the adapter (40) and front and rear uprights (20, 22). We find that the adapters (40) are mounting rails, because they are used to mount display shelf (16) on uprights (20, 22) and run along the sides (10, 14) of the cabinet to function as rails. (Whiten, column 5, lines 57-59 and column 5, line 65 – column 6, line 3).

We also sustain the examiner's rejection of dependent claim 9, which depends from claim 1 and further requires that the device have a width that is less than the distance between the sides of the device opening. Despite the appellants' position that this claim is independently patentable, the appellants do not separately argue the reasons for patentability of this dependent claim. Rather, they rely on their arguments for patentability of independent claim 1.⁶ For the reasons provided above for sustaining the examiner's rejection of claim 1, we also affirm the rejection of claim 9.

We also sustain the examiner's rejection of dependent claim 11, which depends from claim 9 and further requires that the system include a second device

⁶ 37 C.F.R. § 1.192(c)(7) requires that the appellant explain why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

having a second mounting pathway and a second chassis sized to receive at least one component of the second device, the second device being mounted adjacent the first device. Despite the appellants' position that this claim is independently patentable, the appellants do not separately argue the reasons for patentability of this dependent claim. Rather, they rely on their arguments for patentability of independent claim 1. For the reasons provided above for sustaining the examiner's rejection of claims 1 and 9, we also affirm the rejection of claim 11.

We also sustain the examiner's rejection of dependent claim 13, which depends from claim 11 and further requires that the second mounting pathway is substantially aligned with the first mounting pathway. The appellants argue that Whiten does not disclose a device having a chassis and also fails to disclose a second device having a second mounting pathway. (Appellants' Brief, p. 14). For the reasons provided above for claim 1, we disagree with the appellants' position that Whiten does not disclose a device having a chassis. We further find that Whiten discloses, as shown in Figure 1, a second device (58, B) having a second chassis (58) and situated adjacent the first device (58, B), where the adjacent devices each have mounting pathways that are substantially aligned with each other.

We also sustain the examiner's rejection of dependent claim 17, which depends from claim 16 and further requires that the first mounting pathway is located in the chassis so that the support spar does not extend downwardly beyond a bottom surface of the first device. We find that the support spar (54) in Whiten,

as shown in Figure 1, is located so that it does not extend downwardly beyond a bottom surface of the first device (58, B), *i.e.*, the bottom surface of bottle (B).

We also sustain the examiner's rejection of dependent claim 18, which depends from claim 16 and further requires that the first mounting pathway is located in the chassis so that the support spar does not extend upwardly beyond a top surface of the first device. We find that the support spar (54) in Whiten, as shown in Figure 1, is located so that it does not extend upwardly beyond a top surface of the first device (58, B), *i.e.*, the top wall (62) of track (58).

Finally, we sustain the examiner's rejection of dependent claim 21, which depends from claim 16 and further requires that the first device has a width that is less than the distance between the sides of the equipment cabinet and where the system further includes a second device having a second chassis sized to receive at least one component of the second device, a portion of the chassis defining at least a second mounting pathway and the second device being mounted adjacent the first device and engaging the support spar. The appellants argue that Whiten does not disclose a device having a chassis and thus cannot be said to disclose the arrangement of claim 21 wherein the first and second devices are mounted adjacent to one another within the device opening. (Appellants' Brief, p. 15). For the reasons provided above for claim 16, we disagree with the appellants' position that Whiten does not disclose a device having a chassis. We further find that Whiten discloses, as shown in Figure 1, a second device (58, B) having a second chassis (58) and situated adjacent the first device (58, B) within the device opening, where the adjacent devices each have mounting pathways.

We reverse the examiner's rejection of claim 2 and 3, because the Examiner has failed to show where Whiten discloses a "channel member." The specification defines the channel members (56, 58) as being structures separate from the chassis (48, 79), and which, together with a bottom surface of the chassis, define the mounting pathways (18, 38). (See Specification, page 14, line 21 – page 15, line 19 and page 19, lines 2-20). The examiner has not pointed to any disclosure in Whiten for the teaching of such a separate structure that is provided in the chassis.

We reverse the examiner's rejection of claims 4 and 19, because the Examiner has failed to show where Whiten discloses the first mounting pathway being located about the fore-to-aft center of gravity location. It is not clear from the figures where the fore-to-aft center of gravity would be located, and the location would shift depending on the number of bottles held in the tracks. Further, the Examiner did not point to any specific disclosure in Whiten about locating the first mounting pathway at about the fore-to-aft center of gravity location.

We reverse the examiner's rejection of claim 12, because the examiner has failed to show where Whiten discloses the first and second devices secured to one another. The examiner contends that the devices are secured to one another via the support spar. We disagree with this reading of Whiten. Although it teaches in column 4, lines 40-42 that the tracks (58) are "interconnected" through the support spars (54, 56), Whiten fails to disclose whether the tracks (58) are attached to the support spars (54, 56). As such, there is no explicit teaching in Whiten that the tracks (58) are "secured" to one another via the support spars (54, 56). Further,

Figure 1 of Whiten clearly shows a space between adjacent tracks (58) such that there is no teaching of two devices secured directly to one another.

III. Rejection under 35 U.S.C. § 103(a)

The examiner rejected claims 5, 6, 10, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Whiten, as applied to claims 1-4, 7-9, 11-19, and 21, in view of Robertson. In response to this rejection, the appellants argue that because the devices in Whiten and Robertson are presumably effective and functional for their intended purposes, there is no need, and thus no suggestion or incentive, to combine them. (Appellants' Brief, p. 18).

With regard to claim 5, which depends from claim 1, the examiner stated that aluminum is a well-known and commercially available material known for its lightweight properties. (Examiner's Answer, p. 8). We sustain the examiner's rejection of claim 5. Whiten discloses, "the front and rear cross members 54 and 56 are of a rectangular tube structure formed of metal or plastic" (Whiten, column 5, lines 13-14). We find that Whiten teaches a support spar made out of metal and having a rectangular cross section. The appellants do not provide any reason why the selection of aluminum is a patentable feature of the claim. The selection of aluminum, a known material with known properties, based on suitability for its intended use would have been obvious to one skilled in the art at the time of the invention.⁷ See *Sinclair & Carroll Co. v. Interchemical Corp.*, 325

⁷ We note that the examiner does not appear to have relied on any teaching from Robertson in his rejection of claim 5. As such, we affirm the rejection of claim 5 based on the teachings of Whiten alone.

U.S. 327, 65 USPQ 297 (1945) (holding that to select a known compound to meet known requirements is not a patentable invention).

We reverse the examiner's rejection of claim 6 because the Examiner has not shown where Robertson discloses that the support spar is curved such that the center of the support spar is higher than its first and second ends. The examiner points to Figures 1 and 2 of Robertson for support for his position, but we fail to see where a "curved" support spar is shown in these figures. Thus, even if the teachings of Whiten and Robertson are combined, the combination fails to show all of the limitations of claim 6.

We also reverse the examiner's rejection of claims 10 and 20, which depend from claims 9 and 16, respectively, and which recite that the system further comprises a spacer sleeve that is sized to be received over the support spar and that extends between the first device and a side of the device opening and holds the first device against the other side of the device opening. The examiner relied on Robertson for the teaching of a support spar (46, 48) having a spacer sleeve (52) that is sized to fit over the center of the support spar (48). Although we agree with the examiner that Robertson teaches a spacer sleeve that is sized to be received over a support spar, the examiner fails to explain where Robertson teaches using the spacer sleeve between a first device and a side of the device opening to hold the first device against the other side of the device opening, as recited in the claims.

Robertson teaches a merchandising device having display units as shown in partial view in Figure 1. The display units include tracks (88, 90) and support

spars (26, 28) with spacer sleeves (52) that snap over the support spars. Robertson teaches that the sleeves (52) are located on opposite sides of each track and have an outer diameter substantially greater than the diameter of the apertures (40, 44) so that the sleeves (52) function as spacers for maintaining proper space between the tracks (88, 90) as well as means for locking the tracks (88, 90) at proper positions on the transverse members (26, 28). (Robertson, column 5, lines 15-26). There is no teaching in Robertson to locate the spacer sleeve between a track and a side of the device opening to hold the track against the other side of the device opening. Thus, even if the teachings of Whiten and Robertson are combined, the combination fails to show all of the limitations of claims 10 and 20.

Accordingly, we sustain the examiner's rejection of claim 5, and we reverse the examiner's rejection of claims 6, 10, and 20 under 35 U.S.C. § 103(a).

CONCLUSION

To summarize, for the reasons set forth above, we reverse the rejection of claims 1-21 under 35 U.S.C. § 112, second paragraph, we sustain the examiner's rejection of claims 1, 7-9, 11, 13-18, and 21 under 35 U.S.C. § 102(b) as being anticipated by Whiten, we reverse the examiner's rejection of claims 2-4, 12, and 19 under 35 U.S.C. § 102(b) as being anticipated by Whiten, and we sustain the examiner's rejection of claim 5 and reverse the examiner's rejection of claims 6, 10, and 20 under 35 U.S.C. § 103(a) as being obvious over Whiten in view of Robertson.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED IN PART, AFFIRMED IN PART

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