

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 THOMAS DAVID BENSON and CURTIS C. BALLARD

Appeal No. 2006-3329
Application No. 10/637,989

ON BRIEF

Before RUGGIERO, DIXON, and BLANKENSHIP, Administrative Patent Judges.
BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claim 7.

We reverse.

BACKGROUND

The invention relates to storage systems for data cartridges. Claim 7 is reproduced below.

7. A method of transporting data cartridges between cartridge libraries, comprising:

receiving a data cartridge stored in a first cartridge library;

pivoting the data cartridge; and

ejecting the data cartridge to a cartridge sleeve of a second cartridge library.

The examiner relies on the following reference:

Owens et al. (Owens)

US 6,693,759 B2

Feb. 17, 2004
(filed Jun. 29, 2001)

Claim 7 stands rejected under 35 U.S.C. § 102 as being anticipated by Owens.

Claims 1-6 stand allowed.

We refer to the Final Rejection (mailed May 31, 2005) and the Examiner's Answer (mailed Jan. 25, 2006) for a statement of the examiner's position and to the Brief (filed Nov. 2, 2005) and the Reply Brief (filed Mar. 30, 2006) for appellants' position with respect to the claims which stand rejected.

OPINION

The examiner reads instant claim 7 on Owens in the manner set out at page 4 of the Answer. Appellants contend that structures 103 and 104 (Fig. 1A) in Owens would

Appeal No. 2006-3329
Application No. 10/637,989

not be considered “cartridge libraries” to the ordinary artisan, notwithstanding the examiner’s statement of the rejection. We are in substantial agreement with appellants’ position in the briefs.

Owens refers to structures 103, 104 as tape cartridge transport magazines, described as part of autoloader/library system 100 (e.g., col. 5, ll. 10-19). The Owens reference indicates, at column 1, lines 20 through 30, that tape cartridge libraries store and manage multiple tape cartridges, and typically include a plurality of fixed tape cartridge storage locations, at least one read/write tape drive, and a cartridge picker. The reference that is applied against the claims, itself, draws a distinction between cartridge libraries and cartridge transport magazines, and thus indicates that the artisan would not regard a “tape cartridge transport magazine” to be synonymous with a “cartridge library.”

We agree with the examiner to the extent that the instant specification does not define the recitation in controversy in terms of what a cartridge library must include or must not include. However, on this record we agree with appellants that the burden is on the examiner to provide evidence in support of the examiner’s claim interpretation, rather than on appellants to provide extrinsic evidence in support of their arguments, as a consequence of the instant allocation of burdens. The examiner bears the initial burden of presenting a prima facie case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant. After evidence or argument is submitted by the applicant in response, patentability is

Appeal No. 2006-3329
Application No. 10/637,989

determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The examiner suggests, at page 5 of the Answer, there is no art recognized definition for the term cartridge library because the examiner has never found a conclusive definition as to what a cartridge library is in the art. The allegation seems to relate to an inability to determine the scope of the claim (i.e., 35 U.S.C. § 112, second paragraph), rather than to how the prior art may be applied against the claim. Moreover, the allegation is in the form of an irrebuttable presumption. The rejection has not provided any evidence in support of the position, which evidence might be evaluated by appellants for arguments or evidence in rebuttal. Although the examiner may have personal knowledge of one or more references that would tend to show that the examiner's claim interpretation is appropriate, the only proper evidence we have for the artisan's understanding of the recitation in controversy consists of the instant specification and Owens, which provide better support for appellants' position than the examiner's.

As such, because we make our determinations based on the record that the examiner and appellants have provided us, we conclude that the rejection fails to set forth a case for prima facie anticipation of the subject matter of instant claim 7. The rejection is thus not sustained.

Appeal No. 2006-3329
Application No. 10/637,989

CONCLUSION

The rejection of claim 7 under 35 U.S.C. § 102 as being anticipated by Owens is reversed.

REVERSED

JOSEPH F. RUGGIERO
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)

Appeal No. 2006-3329
Application No. 10/637,989

HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400