

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
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8 *Ex parte* STEPHANE LELONG and PIERRE RIEUVERNET  
9

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11 Appeal 2007-2890  
12 Application 10/211,985  
13 Technology Center 3600  
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16 Decided: November 30, 2007  
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19 *Before:* WILLIAM F. PATE, III, HUBERT C. LORIN, and DAVID B.  
20 WALKER, *Administrative Patent Judges.*

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22 PATE, III, *Administrative Patent Judge.*  
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25 DECISION ON APPEAL

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27 STATEMENT OF CASE

28 The Appellants appeal under 35 U.S.C. § 134 (2002) from a final  
29 rejection of claims 1, 3-7, 11-14, 56, and 59-69, claim 68 having been  
30 amended after the final rejection. We have jurisdiction under 35 U.S.C.  
31 § 6(b) (2002).

32 The Appellants claim a housing for a computer sub-assembly having a  
33 keeper that retains the sub-assembly in a position within the housing.

1 Independent claims 1 and 11 under appeal read as follows:

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1. A housing for a computer sub-assembly having a releasable keeper operative to retain the sub-assembly in a position within the housing, wherein the keeper is provided with a resilient biasing element operative to urge the sub-assembly towards the position, wherein a proximal end of the keeper is pivotally engaged with the housing.

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11. A housing for a computer sub-assembly having a releasable keeper operative to retain the computer sub-assembly in position within the housing, wherein a distal part of the keeper is provided with a releasable attachment element co-operable with an attachment formation associated with the housing, and wherein the releasable attachment element is resilient, deformation thereof being required to release the element from the attachment formation of the housing.

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The prior art relied upon by the Examiner in rejecting the claims on appeal is:

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Behl	US 6,193,339 B1	Feb. 27, 2001
Münch	US 6,418,762 B1	July 16, 2002

Claims 1, 3-7, and 56 were rejected under 35 U.S.C. § 102(e) as anticipated by Behl.

Claims 11-14 and 63-69 were rejected under 35 U.S.C. § 102(e) as anticipated by Münch.

Claims 59-62 were rejected under 35 U.S.C. § 103(a) as unpatentable over Behl.

We REVERSE.

1 ISSUES

2 1. Whether the Appellants have shown that the Examiner erred in  
3 rejecting claims 1, 3-7, and 56 as anticipated by Behl.

4 2. Whether the Appellants have shown that the Examiner erred in  
5 rejecting claims 11-14 and 63-69 as anticipated by Münch.

6 3. Whether the Appellants have shown that the Examiner erred in  
7 rejecting claims 59-62 as unpatentable in view of Behl.

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9 FINDINGS OF FACT

10 The record supports the following findings of fact (FF) by a  
11 preponderance of the evidence.

12 1. Behl discloses a docking adapter 10 with a rack 14 for housing a  
13 hard disk drive, the docking adapter including a releasable keeper 16  
14 operative to retain the hard disk drive (Figs. 2-10; Col. 3, ll. 19-35).

15 2. The keeper of Behl includes a resilient biasing element 34 (Fig. 3;  
16 Col. 3, l. 54-Col. 4, l. 3).

17 3. The docking adapter of Behl includes a hinge pin 36 that allows  
18 the keeper to pivot (Col. 3, ll. 54-60).

19 4. Münch discloses a closing device including a housing 10 and a  
20 keeper 20 (Fig. 4; Col. 2, ll. 17-34).

21 5. The keeper disclosed in Münch includes an attachment element  
22 20.1 at a distal part of the keeper which cooperates with an attachment  
23 formation 10.24 to close the closing device (Fig. 4; Col. 3, ll. 20-34).

24 6. Münch discloses that release of the attachment element is attained  
25 by using a locking element 50 to displace a bolt 10.7 on which the  
26 attachment formation is provided (Fig. 4; Col. 3, ll. 34-40).

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## PRINCIPLES OF LAW

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“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. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. 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. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

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In addition, 35 U.S.C. § 103 “forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The Court stated that obvious analysis “should be made explicit.” *Id.* at 1740-41, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).

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ANALYSIS

Claims 1, 3-7, and 56

In rejecting independent claim 1 as anticipated by Behl, the Examiner found that the recited keeper and biasing element limitations are disclosed by the pivoting cover 16 and the cantilever 34 of Behl (FFs 1-3). The Examiner further asserted that the recited housing of claim 1 lacked novelty over a combination of various parts of the docking adapter of Behl, including a part of the carrier 12 engaging the rails 32 (identified by letter “C” in App. Br. at 5) and part of the carrier to which the cover is pivotally attached (identified by letter “D” in App. Br. at 5) (Final Office Action 4; Ans. 3, ll. 10-19; Ans. 5, l. 12- Ans. 6, l. 16). Thus, the Examiner asserts that Behl discloses each and every limitation of the claim including the limitation “wherein a proximal end of the keeper is pivotally engaged with the housing.” We disagree.

As the Examiner notes, claim 1 does not require the housing to be a “single” entity (Ans. 6, ll. 5-8). However, it is our opinion that the Examiner’s construction of the claim limitation “housing” to include structure that are clearly a part of the sub-assembly retained within the housing is unreasonable. In view of the Appellants’ Specification, one of ordinary skill in the art would understand claim 1 to require the housing to be the structure within which the sub-assembly is retained by the keeper, not a part of the retained sub-assembly itself (Figs. 5 and 6; Spec. 8, l. 18-Spec. 9, l. 4; App. Br. 6, ll. 1-14; Reply Br., 2, l. 22-Reply Br. 5, l. 9). Hence, Behl fails to disclose a keeper that is “pivotally engaged with the housing” as recited in claim 1. Therefore, the Appellants have shown that the

1 Examiner erred in rejecting claim 1, as well as claims 2, 3-7, and 56, which  
2 ultimately depend from claim 1.

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4 Claims 11-14 and 63-69

5 In rejecting independent claim 11 as anticipated by Münch, the  
6 Examiner asserts that deformation of the shoulder 20.1 would most likely  
7 occur to allow release of the shoulder from the receiver 10.24 (FFs 4 and 5;  
8 Ans. 8, ll. 3-11). Thus, the Examiner asserts that Münch satisfies the  
9 limitation “wherein the releasable attachment element is resilient,  
10 deformation thereof being required to release the element from the  
11 attachment formation of the housing,” recited in claim 11. We disagree.

12 As the Appellants note, the Examiner failed to established how  
13 Münch supports the assertion that the shoulder of the handle is deformable  
14 (App. Br. 9, ll. 2-12; Reply Br. 6, ll. 16-23). Münch specifically teaches the  
15 release of the shoulder 20.1 from the receiver 10.24 by displacing the bolt  
16 10.7 on which the receiver is provided (FF 6; App. Br. 9, ll. 2-12; Münch,  
17 Col. 3, ll. 20-40). This teaching of Münch is inconsistent with the  
18 Examiner’s assertion. We agree with the Appellants that because the  
19 shoulder 20.1 is released from the receiver 10.24 by the displacement of the  
20 bolt 10.7, there is no requirement that the shoulder be deformable (App. Br.  
21 8, ll. 6-15). Moreover, if the shoulder of Münch is deformable as the  
22 Examiner asserts, the locking feature of the closing device of Münch would  
23 not function as intended because the closing device could then be opened by  
24 merely pulling on the handle 20 even when locked (Reply Br. 7, ll. 1-13).

1           Thus, the Appellants have shown that the Examiner erred in rejecting  
2 independent claim 11, as well as claims 12-14, and 63-69, which ultimately  
3 depend from claim 11.

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5           Claims 59-62

6           Claims 59-62 are ultimately dependent on independent claim 1 and  
7 were rejected as obvious in view of Behl. While inferences and creative  
8 steps that a person of ordinary skill in the art would employ can be  
9 considered in determining obviousness, the Examiner should provide  
10 articulated reasoning with rational underpinnings in support of finding  
11 obviousness. *See KSR*, 127 S.Ct. at 1740-41. Mere conclusory statements  
12 are insufficient. *Id.* We find that the Examiner's proffered statements as to  
13 why these claims would be obvious are merely conclusory, lacking in  
14 rational underpinnings. Therefore, the Appellants have shown that the  
15 Examiner erred in rejecting claims 59-62.

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SUMMARY

18           1. The Appellants have shown that the Examiner erred in rejecting  
19 claims 1, 3-7, and 56 as anticipated by Behl.

20           2. The Appellants have shown that the Examiner erred in rejecting  
21 claims 11-14 and 63-69 as anticipated by Münch.

22           3. The Appellants have shown that the Examiner erred in rejecting  
23 claims 59-62 as obvious in view of Behl.

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1 ORDER

2 The Examiner's rejections of claims 1, 3-7, 11-14, 56, and 59-69 are  
3 REVERSED.

4 REVERSED

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