

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT W. LUFFEL and DAVID P. JONES

Appeal 2007-3124
Application 09/371,708
Technology Center 2600

Decided: April 16, 2008

Before JOSEPH F. RUGGIERO, MAHSHID D. SAADAT,
and SCOTT R. BOALICK, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 1, 3-13, and 15-23. Claims 2 and 14 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' invention relates to a modular data storage system for handling and storing data cartridges which includes a cartridge access device and at least two laterally adjacent modular units. The modular units include a plurality of cartridge receiving devices and a plurality of elongate gear racks aligned along a displacement path. A translation apparatus, which includes a plurality of drive pinions mounted to the cartridge access device and engaging the elongate gear racks, is provided for moving the cartridge access device along the displacement path. (Specification 6:5-23).

Claim 1 is illustrative of the invention and reads as follows:

1. A modular data storage system for handling and storing data cartridges, comprising:
 - a) a cartridge access device;
 - b) at least two laterally adjacent modular units, each of said modular units comprising:
 - i) a plurality of cartridge receiving devices;
 - ii) a first elongate gear rack having first and second ends and aligned along a displacement path;
 - iii) a first elongate guide member integral with said first elongate gear rack and extending along the displacement path substantially between the first and second ends of said first elongate gear rack;
 - iv) a first bearing mounted to the cartridge access device, said first bearing engaging said first elongate guide member;
 - v) a second elongate gear rack aligned along said displacement path and positioned in spaced-apart relation to said first elongate gear rack; and

- vi) wherein the first elongate gear racks of said laterally adjacent modular units are substantially in alignment with one another, and the second elongate gear racks of said laterally adjacent modular units are substantially in alignment with one another, such that said cartridge access device may be translated among said laterally adjacent modular units;
- c) a translation apparatus for moving a cartridge access device along a displacement path, comprising:
 - i) a first drive pinion mounted to the cartridge access device, said first drive pinion engaging said first elongate gear rack;
 - ii) a second drive pinion mounted to the cartridge access device, said second drive pinion engaging said second elongate gear rack; and
 - iii) a pinion drive apparatus operatively associated with said first and second drive pinions, said pinion drive apparatus rotating said first and second drive pinions to move the cartridge access device among the first and second elongate gear racks of said laterally adjacent modular units.

The Examiner relies on the following references to show unpatentability:

Tadokoro	US 6,166,877	Dec. 26, 2000 (filed Dec. 19, 1996)
Luffel ¹	US 7,027,367 B1	Apr. 11, 2006 (filed Jun. 22, 1999)

¹ Luffel is the issued patent resulting from parent application Serial No. 09/337,802 which is the basis for the Examiner's stated obviousness-type double patenting rejection

Claims 1, 3-7, 10-13, 15-19, 22, and 23 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Tadokoro.

Claims 1, 3-13, and 15-23, all of the appealed claims, stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the issued claims (claims 1-18) of application Serial No. 09/337,802, now U.S. Patent No. 7,027,367.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs and Answer for the respective details. 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 Briefs have not been considered and are deemed to be waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

ISSUES

- (i) Under 35 U.S.C § 102(e), does Tadokoro have a disclosure which anticipates the invention set forth in appealed claims 1, 3-7, 10-13, 15-19, 22, and 23?
- (ii) Under the judicially created doctrine of non-statutory obviousness-type double patenting, are appealed claims 1, 3-13, and 15-23 merely an obvious variation of the invention set forth in claims 1-18 of U.S. Patent No. 7,027,367?

PRINCIPLES OF LAW

Anticipation

It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim. *See In re King*,

801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

Nonstatutory Obviousness-type Double Patenting

A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046 (Fed. Cir. 1993); and *In re Longi*, 759 F.2d 887 (Fed. Cir. 1985). In determining whether a nonstatutory basis exists for a double patenting rejection, the first

question to be asked is - does any claim in the application define an invention that is anticipated by, or is merely an obvious variation of, an invention claimed in the patent? If the answer is yes, then an "obviousness-type" nonstatutory double patenting rejection may be appropriate.

Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is **not patentably distinct** from the subject matter claimed in a commonly owned patent, or a non-commonly owned patent but subject to a joint research agreement as set forth in 35 U.S.C. § 103 (c)(2) and (3), when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. See *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955 (Fed. Cir. 2001).

ANALYSIS

I. 35 U.S.C. § 102(e) rejection

Claims 1, 11, 12, and 23

With respect to the 35 U.S.C. § 102(e) rejection of independent claims 1, 11, and 23 based on the Tadokoro reference, the Examiner indicates (Ans. 3-4) how the various limitations are read on the disclosure of Tadokoro. In particular, the Examiner directs attention to the illustrations in Figures 19-22 of Tadokoro as well as the accompanying description beginning at column 13, line 55 of Tadokoro.

Appellants' arguments in response assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Tadokoro so as to establish a prima facie case of anticipation. Appellants' arguments focus on the contention that, in contrast to the claimed invention, Tadokoro does not disclose a modular data storage system having an elongate guide member which is "integral" with an elongate gear rack.

According to Appellants (App Br. 22-23; Reply Br. 3-5), Tadokoro discloses separate gear rack and guide members, 32 and 8, respectively, as illustrated in Tadokoro's Figures 20 and 22 and described at column 14, lines 9-13 of Tadokoro.

After reviewing the disclosure of Tadokoro in light of the arguments of record, however, we are in general agreement with the Examiner's position as stated in the Answer. In particular, as asserted by the Examiner (Ans. 4-6), our reviewing court on more than one occasion has interpreted the term "integral" to cover more than a unitary construction. *See, e.g., In re Morris*, 127 F.3d 1048, 1055-56 (Fed. Cir. 1997), *Advanced Cardiovascular Sys. v. Scimed Life Sys.*, 887 F.2d 1070, 1074 (Fed. Cir. 1989), *In re Kohno*, 391 F.2d 959 (CCPA 1968), *In re Dike*, 394 F.2d 584 (CCPA 1968), *In re Larson*, 340 F.2d 965 (CCPA 1965).

We do not disagree with Appellants' contention (Reply Br. 4) that court rulings support the position that an inventor's definition and explanation of the meaning of a term as evidenced by the Specification, controls the interpretation of that term. *See, e.g., Phillips v. AWH Corp.*, 415 F.3d 1303, 1319 (Fed. Cir. 2005) (en banc) where the court reaffirmed the view that the specification "is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term."

It is noteworthy, however, that, although Appellants urge in the Briefs that the claim term "integral" must be interpreted in light of the Specification, the Specification fails to set forth the definition sought by Appellants. In particular, the claimed term "integral" never appears in the Specification, nor do the terms "one piece" and "formed from the same

member,” terms which Appellants assert define their usage of the term “integral.” In our view, the Examiner’s interpretation of the claimed term “integral” as corresponding to Tadokoro’s “engaged” gear rack and guide member is not unreasonable when Appellants sole description of the guide member and gear rack construction is that the guide member, in a non-limiting preferred embodiment, takes the form of a turned up edge of the gear rack.

In view of the above discussion, since all of the claimed limitations are present in the disclosure of Tadokoro, the Examiner’s 35 U.S.C. § 102(e) rejection of independent claims 1, 11, and 23, as well as claim 12 not separately argued by Appellants, is sustained.

Dependent claims 3-7 and 15-19

We do not sustain the Examiner’s anticipation rejection of dependent claims 3-7 and 15-19 based on the Tadokoro reference. In addressing the language of dependent claims 3 and 15, each of which requires that a bearing on the cartridge access “slidably engages” opposed bearing surfaces on the guide member, the Examiner directs attention (Ans. 4 and 6) to Tadokoro’s cartridge access device rollers 33 (which the Examiner likens to “bearings”) which move along the surface of guide member 8.

It is our view, however, that, to whatever extent the rollers 33 of Tadokoro may broadly be considered to be bearings, they do not slide along the bearing surfaces of the guide member 8 as claimed but, rather, as their name suggests, they “roll” along the guide member surface. We agree with Appellants (Reply Br. 6) that the Examiner’s interpretation of the operation of the rollers 33 of Tadokoro would have merit only if the rollers were

locked against movement and, as a result, skidded along the surface of the guide member, an operation which is the opposite of what a “roller” is designed to do.

In view of the above discussion, since all of the claim limitations are not present in the disclosure of Tadokoro, we do not sustain the Examiner’s 35 U.S.C. § 102(e) rejection of dependent claims 3 and 15, nor of claims 4-7 and 16-19 which are ultimately dependent, respectively, on claims 3 and 15.

Dependent claims 10 and 22

We also do not sustain the Examiner’s 35 U.S.C. § 102(e) rejection, based on Tadokoro, of dependent claims 10 and 22 which are directed to the structure of the pinion drive in which a motor shaft mounted worm is attached to the pinion drive worm gear. We agree with Appellants (App. Br. 26 and 30) that Tadokoro does not disclose a worm gear mounted to engage a worm which is mounted to the shaft of the motor as claimed but, rather, uses a drive belt 36 and drive pulley 37 to transmit drive from motor 34 to pinion drive shaft 38 and pinion drive gear 39.

Dependent claim 13

The Examiner’s anticipation rejection of dependent claim 13 based on Tadokoro is not sustained as well. We agree with Appellants (App. Br. 28; Reply Br. 8), that Tadokoro does not provide an anticipatory disclosure of a master module power supply to which slave modules are connected as presently claimed. As argued by Appellants, while Tadokoro identifies element 3 as a power supply at column 9, line 48, other portions of Tadokoro identify element 3 as a “control box.” Further, while Tadokoro states (col. 9, ll. 47-48) that the power supply 3 is for the shuttle body of the

tape transfer mechanism, there is no clear disclosure in Tadokoro that any of the modular portions B, C, and D of Tadokoro's system are connected to this referenced power supply as asserted by the Examiner. Further, we agree with Appellants (*id.*) that Tadokoro's disclosure leads away from the conclusion that the power supply 3 in master console A is connected to slave consoles B, C, and D since Figure 1 of Tadokoro illustrates console D as being connected to its own box labeled as element 3.

II. Nonstatutory Obviousness-type Double Patenting Rejection

We have reviewed Appellants' arguments (App. Br. 20; Reply Br. 8-9) directed against the Examiner's obviousness-type double patenting rejection and find nothing which convinces us of any error in the Examiner's stated conclusion. In fact, the only argument directed to the merits of the Examiner's position (Reply Br. 9) is that the allegedly narrower nature of claims 1-18 of the issued U.S. Patent No. 7,027,367 (the '367 patent), based on the parent application Serial No. 09/337,802, cannot form the basis for a double patenting rejection of the allegedly broader claims of the instant application. We do not find this persuasive.

A review of the record before us reveals that, on a comparison of the appealed claims 1, 3-13, and 15-23 with claims 1-18 of the '367 patent, the appealed claims essentially differ from the patent claims only in that the instant appealed claims add additional ("at least two") modular gear rack and guide member structures to extend the capacity of the modular data storage system. It is well settled that, absent any evidence of any new or unexpected result, the mere duplication of parts has no patentable significance. *See In re Harza*, 274 F.2d 669 (CCPA 1960), *St. Regis Paper Co. v. Bemis Co., Inc.* 193 USPQ 8 (7th Cir. 1977).

In view of the above discussion, the Examiner's nonstatutory obviousness-type double patenting rejection of claims 1, 3-13, and 15-23 based on claims 1-18 of the '367 patent is sustained.²

CONCLUSION

In summary, with respect to the Examiner's 35 U.S.C. § 102(e) rejection of appealed claims 1, 3-7, 10-13, 15-19, 22, and 23 based on the Tadokoro reference, we have sustained the rejection of claims 1, 11, 12, and 23, but have not sustained the rejection of claims 3-7, 10, 13, 15-19, and 22. We have, however, sustained the Examiner's nonstatutory obviousness-type double patenting rejection of claims 1, 3-13, and 15-23, all of the claims on appeal, based on claims 1-18 of U.S. Patent No. 7,027,367. Therefore, the decision of the Examiner rejecting claims 1, 3-13, and 15-23 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED

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² At page 20 the Brief, Appellants have expressed on the record their willingness to file a terminal disclaimer to overcome the obviousness-type double patenting rejection.