

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROSHI SHIBUYA, ICIRO SAKUMA,
and TATSUYA OHMIDO

Appeal No. 1997-1503
Application No. 08/422,649

HEARD: February 8, 2000

Before BARRETT, FLEMING, and BARRY, Administrative Patent
Judges.

BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the final rejection of claims 1, 2, 9, 10, and 18-28. We reverse.

Appeal No. 1997-1503
Application No. 08/422,649

BACKGROUND

The invention at issue in this appeal relates to magnetic tape libraries. A magnetic tape library is a type of external storage used with a computer. A cell unit of the library comprises many cells; each cell can receive a magnetic tape cartridge. Unfortunately, it takes considerable time to store a large number of cartridges into such a cell unit.

The inventive magnetic tape library features a door that permits a large number of cartridges to be directly entered, all at once, into the cells of a cell column in a cell unit. In addition, the inventive library automatically detects the faulty entry of a cartridge into one cell of the cell column.

Claim 18, which is representative for our purposes, follows:

Claim 18. A library apparatus comprising:

a housing;

a cell unit within said housing having a plurality of cell columns each including a plurality of cells, each cell for accommodating a recording medium cartridge;

a recording medium drive unit within said housing for writing and reading data to and from a recording medium cartridge;

an accessor for automatically switching recording medium cartridges between said cell unit and said recording medium drive unit;

a door attached swingingly on said housing adjacent to said cell unit, said door being configured to allow a large number of recording medium cartridges to directly enter, all at once, into the cells of a selected cell column in said cell unit; and

automatic faulty cartridge entry detection means proximate to said cell unit for automatically monitoring the placement of the recording medium cartridges in all of the cells of said selected column and for automatically detecting faulty entry of a recording medium cartridge into any cell of said selected cell column into which recording medium cartridges are allowed to enter through said door.

The references relied on in rejecting the claims follow:

Jenkins et al. (Jenkins) 2, 1981	4,271,440	Jun.
Lind et al. (Lind) 1988	4,779,151	Oct. 18,
Tatsuta, ¹ (Japanese Published Patent Application)	02-25816	Dec. 12, 1991.

¹ A copy of the translation prepared by the U.S. Patent and Trademark Office is included and relied upon for this decision. We will refer to the translation by page number in this opinion.

Claim 18 stands rejected under 35 U.S.C. § 103 as obvious over Jenkins. Claims 1 and 22 stand rejected under 35 U.S.C. § 103 as obvious over Lind in view of Jenkins. Claims 2, 9, 10, 23-26, and 28 stand rejected under 35 U.S.C. § 103 as obvious over Lind in view of Jenkins further in view of Tatsuta. Rather than repeat the arguments of the appellants or examiner in toto, we refer the reader to the brief² and answer for the respective details thereof.

OPINION

In reaching our decision in this appeal, we considered the subject matter on appeal and the rejections advanced by the examiner. Furthermore, we duly considered the arguments and evidence from the appellants and examiner. After considering the totality of the record, we are persuaded that the examiner erred in rejecting claims 1, 2, 9, 10, and 18-28. Accordingly, we reverse.

²The reply brief filed on September 30, 1996 was denied entry. (Paper No. 27 at 2.)

We begin by noting the following principles from In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. Id. "A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

With these in mind, we analyze the appellants' argument.

The appellants argue, "Jenkins et al. teach a two step process for loading the cartridges into the cells of the cell drum, not a direct entry" (Appeal Br. at 8-9.) The examiner's reply follows.

Clearly, figure 11 of Jenkins et al. depicts part of the cell unit, shute [sic] (36), which does satisfy the claimed "direct entry feature." Appellant [sic] also, argues that Jenkins et al. does not teach a door configured "to allow a large number of

recording medium cartridges to directly enter" the cell unit. Clearly, element (236) disclosed by Jenkins et al. satisfies this limitation. (Examiner's Answer at 5.)

We agree with the appellants.

Claims 1, 2, 9, 10, and 18-28 each specifies in pertinent part the following limitations.

a cell unit . . . having a plurality of cell columns each including a plurality of cells, each cell for accommodating a recording medium cartridge;

. . .
a door . . . to allow a large number of recording medium cartridges to directly enter, all at once, into the cells of a selected cell column in said cell unit

We find that the limitations recite a door that permits a large number of cartridges to be directly entered, all at once, into the cells of a cell column in a cell unit.

The examiner fails to show a teaching or suggestion of the limitations in the prior art. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) (citing W.L. Gore & Assocs., Inc. v. Garlock,

Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)). The mere fact that prior art may be modified as proposed by an examiner does not make the modification obvious unless the prior art suggested the desirability thereof. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Here, the examiner admits, "Lind et al. does not teach the claimed door that allows a large amount of cartridges to be entered into the device" (Final Rejection at 3.) He does not pretend that Tatsuta teaches or suggests the feature. Instead, the examiner relies on Jenkins.

The examiner errs, however, in determining the content of the Jenkins reference. At the outset, he asserts that reference's "drums (40), stacks (44) and chute (36) are deemed to make up the claimed 'cell unit'" (Final Rejection

at 6.) We disagree. Jenkins teaches the use of "cartridge storage drums 40" Col. 5, l. 5. The reference further teaches, "each drum 40 has a cylindrical configuration with 512 cartridge storage compartments arranged in 16 columns about its circumference and in 32 vertically spaced rows along its axis. The drums are rotatably journaled in the frame about central shafts 48." Id. at ll. 25-30. Comparison of the claim language to these teachings evidences that the claimed "cell unit . . . having a plurality of cell columns each including a plurality of cells, each cell for accommodating a recording medium cartridge" reads on storage drum 40 of the reference alone rather than on the drums 40, stacks 44, and loading chute 36.

Although Jenkins teaches a cell unit, i.e., drum 40, it does not teach entering cartridges directly into the cells of the cell unit. To the contrary, the reference teaches that "human access is limited to placing cartridges in a loading chute and removing them from an unloading chute." Col. 3, ll. 27-29. More specifically, "cartridges 174 can be loaded

manually on the floor plate 230 through the front opening 238" of the loading chute 36. Col. 13, ll. 6-7.

Furthermore, the examiner has not identified anything in the prior art that would have suggested bypassing the loading chute 36 of Jenkins in favor of direct entry of cartridges into the drum unit 40. To the contrary, Jenkins aims to "mak[e] it impossible for anyone to be injured," col. 3, l. 30-31, by its tape library and to ensure that the library is "fool-proof and vandal free." Id. at l. 31. Specifically, the reference ensures that "no one can . . . place a cartridge directly in a drum where the computer control cannot find it." Col. 3, ll. 32-36. In view of these teachings, the examiner's conclusion amounts to impermissible reliance on the appellants' teachings or suggestions.

For the foregoing reasons, we are not persuaded that the prior art would have suggested a door that permits a large number of cartridges to be directly entered, all at once, into the cells of a cell column in a cell unit as claimed. The examiner has not established a prima facie case of

obviousness. Therefore, we reverse the rejections of claims
1, 2, 9, 10, and 18-28 under
35 U.S.C. § 103.

CONCLUSION

To summarize, the examiner's rejections of claims 1, 2, 9, 10, and 18-28 under 35 U.S.C. § 103 is reversed.

REVERSED

LEE E. BARRETT)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
LANCE LEONARD BARRY)	
Administrative Patent Judge)	

LLB/sld

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BARRY

APPEAL NO. 1997-1503 - JUDGE

APPLICATION NO. 08/422,649

APJ BARRY

APJ FLEMING

APJ BARRETT

DECISION: ?ED

Prepared by:

DRAFT TYPED: 13 Oct 00

FINAL TYPED:

Team 3, please note the following instructions:

Do NOT change style of citations.

Do insert full names of all inventors

Do insert reference(s).

Do add a mailing address

Do check quotations and citations.

Do proofread.

Thank you.