

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH P. FALACE,
JOSEPH P. MANES,
and
DANIEL J. PLUTT

Appeal No. 2000-1811
Application 08/879,638

ON BRIEF

Before BARRETT, RUGGIERO, and DIXON, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants request that we reconsider that portion of our decision of July 31, 2002 wherein we sustained the Examiner's 35 U.S.C. § 102(b) rejection of claims 1, 2, 9, 10, 14, and 17 based on Semmlow, as well as the 35 U.S.C. § 103(a) rejection of claims 3, 6, 7, 11, and 12 based on Semmlow alone, the 35 U.S.C. § 103(a) rejection of claim 13 based on Semmlow and Burke, and

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the 35 U.S.C. § 103(a) rejection of claims 15 and 16 based on Semmlow and Woodruff.

Initially, with respect to the Examiner's 35 U.S.C. § 102(b) rejection of claims 1, 2, 9, 10, 14, and 17, Appellants argue that our original decision erred in relying on the Examiner's interpretation of the end of the cylindrical shaped guide pin 14 of Semmlow as having vertical and horizontal tapered surfaces since the cylindrical pin terminates at a point. In Appellants' view, other possibilities exist for the actual shape of the guide pin end in Semmlow, rendering the Examiner's interpretation not necessarily correct.

We find no error, however, in our original decision which found that the Examiner's reasonable interpretation of the guide pin structure of Semmlow established a prima facie case of anticipation. That is, with all the structural elements present in the single prior art reference to Semmlow, and in view of Semmlow's illustrated configuration of the guide pin end, it is proper to assume that the prior art structure inherently possesses Appellants' functionally defined claim limitation of aligning a cartridge retrieval mechanism in at least two dimensions. Upon the Examiner's determination that the prior art structure met the functional limitation of the claim, the burden

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shifted to Appellants to show that the prior art structure did not do so. Appellants have presented no persuasive evidence to rebut the assumption that the guide pin structure disclosed by Semmlow functioned to perform alignment in at least two dimensions. See In re Schreiber, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997); In re King, 801 F.2d 1324, 1327, 231 USPO 136, 138-39 (Fed. Cir. 1986); In re Best, 562 F.2d 1252, 1254-55, 195 USPO 430, 433 (CAPA 1976); In re Ludtke, 441 F.2d 660, 664, 169 USPO 563, 566-67 (CAPA 1971).

In a further argument related to the guide pin structure disclosed by Semmlow, Appellants now assert that the existence of the intervening (unnumbered) sleeve between the tapered end and the cylindrical shaped body of the guide pin in Semmlow provides an indication that the guide pin end is attached to the cylindrical body through the intervening sleeve. In Appellants' view (Request, page 3), this raises the possibility that Semmlow's guide pin end and cylindrical portion are two separate pieces.

In reviewing this argument, we make the observation that any arguments related to the existence of an intervening connecting sleeve in Semmlow were not made in the Brief before us on appeal. An argument not timely made is an argument waived. Since

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Appellants never raised this factual question with the Examiner, we do not have the benefit of the Examiner's position on this question of fact. A new argument advanced in such a manner has not afforded the Examiner an opportunity to respond to the new argument. It is a requirement of 37 CFR §§ 192 that Appellants submit arguments in the Brief(s) specifying all of the errors made by the Examiner in the rejection. See Ex Parte Hindersinn, 177 USPO 78, 80 (Bd. App. 1971). Consequently, we will not consider this new argument of fact as a basis for changing our prior decision in this case. We do note as a general observation that, in considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPO 342, 344 (CAPA 1968).

With respect to the Examiner's obviousness rejections of dependent claim 13 based on Semmlow and Burke and of dependent claims 15 and 16 based on Semmlow and Woodruff, Appellants' assertion of error in our original decision relies on arguments made with respect to the Examiner's interpretation of Semmlow as applied against appealed claim 1. For all the reasons discussed

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supra, we find no error in our affirmance of the Examiner's 35 U.S.C. § 103(a) rejection of claims 13, 15, and 16.

Turning to a consideration of Appellants' arguments directed to the Examiner's 35 U.S.C. § 103(a) rejection of claims 3, 6, 7, 11, and 12 based on Semmlow alone, we find ourselves in agreement with Appellants that the Examiner improperly relied on statements in Appellants' own disclosure to establish a basis for the obviousness rejection. The Examiner has provided no evidence, outside of Appellants' own disclosure, that would support the conclusion that the skilled artisan would have been motivated and found it obvious to arrive at the particular docking feature details set forth in appealed claims 3, 6, 7, 11, and 12. The Examiner must not only make requisite findings, based on the evidence of record, but must also explain the reasoning by which the findings are deemed to support the asserted conclusion. See In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002).

CONCLUSION

Appellants' request for rehearing is granted to the extent that we have reconsidered our prior decision in light of Appellants' arguments. The Examiner's 35 U.S.C. § 103(a) rejection of claims 3, 6, 7, 11, and 12 is hereby reversed, but

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we are not otherwise persuaded of any errors in our opinion and maintain the rejections of claims 1, 2, 9, 10 and 13-17. Thus, the request for rehearing is GRANTED-IN-PART.

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

REHEARING/GRANTED-IN-PART

LEE E. BARRETT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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)	
JOSEPH L. DIXON)	
Administrative Patent Judge)	

JFR:svt

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