

**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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MARK E. WANGER, ROBERT D. PROCTOR  
and THOMAS C. OLIVER

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Appeal No. 95-2788  
Application 08/038,430<sup>1</sup>

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ON BRIEF

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Before KRASS, JERRY SMITH and FLEMING, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

**DECISION ON APPEAL**

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<sup>1</sup> Application for patent filed March 29, 1993. According to appellants, the application is a continuation of Application 07/629,305 filed December 18, 1990, now U.S. Patent No. 5,276,675 issued January 4, 1994.

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This is a decision on appeal from the final rejection of claims 21 through 39, all of the claims in the application.

The invention is directed to a disk storage cartridge assembly and, more particularly, to such an assembly having a casing with a wear factor associated with sliding contact with a door on the casing of less than  $100 \times 10^{-10}$  in<sup>3</sup>-min/ft-lb-hr.

Representative independent claim 21 is reproduced as follows:

21. A data storage cartridge assembly comprising:

a data storage medium for storing data thereon in machine readable form;

a casing for supporting said data storage medium therewithin and for shielding said data storage medium from physical contact with other objects; and

a door slideably mounted on said casing for selectively covering and uncovering an opening therein;

said casing having a wear factor associated with sliding contact with said door of less than  $100 \times 10^{-10}$  in<sup>3</sup>-min/ft-lb-hr; and

said casing being constructed from a thermoplastic material impregnated with a lubricating filler wherein said lubricating filler comprises at least 15% by weight of said casing.

No references are relied on by the examiner.

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Claims 21 through 39 stand rejected under 35 U.S.C. 112, first paragraph, as being based on a nonenabling disclosure.

Reference is made to the brief and answer for the respective positions of appellants and the examiner.

#### OPINION

At the outset, we note, in passing, that the recitation on line 20 of claim 26, of "less than  $350 \times 10^{10}$ ...", was probably meant to read --less than  $350 \times 10^{-10}$ ...--. We leave it to appellants and the examiner to make the necessary corrections.

In the final rejection of May 12, 1994 (Paper No. 11), the examiner holds the disclosure to be nonenabling for the claimed lower limit for the wear factor because

In the absence of a lower limit, the wear factor includes values approaching zero. Accordingly, the specification is non-enabling as to a wear factor as small as that encompassed by the limitation "less than  $10 \times 10^{-10}$  in<sup>3</sup>-min/ft-lb-hr" [FR-page 2].

The examiner also states, at page 3 of the final rejection,

...the specification does not disclose an upper limit for the amount of PTFE (at least 15%) or carbon fiber (at least 30%) comprising the data storage

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cartridge. In the absence of an upper limit, the composition includes values approaching and including 100%. Accordingly, the specification is non-enabling as to a data storage cartridge having a composition of PTFE or carbon fiber as large as that encompassed by the limitations "at least 15%" and "at least 30%".

We presume that the rejection directed to "at least 15%" and "at least 30%" still stands, even though the examiner says nothing about appellants' arguments directed thereto, since the examiner states, at page 3 of the answer, that the rejection "is set forth in the prior Office action paper number 11, paragraph nos. 2 and 3."

We will not sustain the rejection of claims 21 through 39 under the first paragraph of 35 U.S.C. 112 because it is our view that the examiner has not established a reasonable basis for challenging the sufficiency of the instant disclosure.

We point to appellants' arguments at pages 9-13 of the brief and adopt such as our own in reversing the rejection before us. In addition, we make the following amplifying comments.

The examiner does not question that there are disclosed and enabling embodiments for the claimed ranges. The examiner's problem appears to stem from the fact that the examiner can envision values within the claimed ranges which probably could

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not be achieved and, it follows, for which there are no enabling disclosures.

We agree with appellants [brief, pages 9-10] that it is not proper to reject a claim under 35 U.S.C. 112 on the basis of lack of enablement because the claim reads on subject matter that is inoperative only on the basis of unreasonable assumptions or without limitations that would be implied by one with ordinary skill in the art.

Further, appellants point out [brief, page 11], and the examiner does not deny, that the invention uses well known compounds with well known wear factor characteristics and that the invention does not lie in the production of the material used for the casing, citing the "Lubricomp" article as evidence of the general availability of such material. Since there is general availability of a material having the claimed characteristics and this is well known, the examiner's rejection based on nonenablement of the claimed subject matter does not appear to be well-founded.

With regard to appellants' reference to U.S. Patent No. 5,276,675 and the similarity of the claims therein to the claims now before us, while the mistakes of an examiner in a previous case does not bind the hands of a later examiner with similar claims if a proper rejection lies, in the instant case, it is,

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indeed, curious as to why the examiner here would take such a drastically different position with strikingly similar claimed subject matter, from that of the previous examiner.

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The examiner's decision rejecting claims 21 through 39  
under 35 U.S.C. 112, first paragraph, is reversed.

**REVERSED**

ERROL A. KRASS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
JERRY SMITH	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
MICHAEL R. FLEMING	)	
Administrative Patent Judge	)	

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