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MAY 16 1997

PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

This opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES T. DOTY

Appeal No. 94-4126
Application No. 07/933,090¹

ON BRIEF

Before THOMAS, BARRETT and FLEMING, Administrative Patent Judges.
THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 1 to 5 and 7 to 10. The examiner has allowed claim 6.

Representative claim 1 is reproduced below:

1. An erasure preventing device for tape carriages wherein the cartridge includes a housing having a front wall and a boss,

¹ Application for patent filed August 21, 1992.

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wherein the front wall has an opening which is interactable with a cartridge drive system and the erasure preventing device is located in the front wall and comprises a cylindrical thumbwheel which is rotatable in the opening, wherein the thumbwheel comprises:

a larger diameter central portion which is exposed through the opening;

a first smaller diameter end portion located on one axial end of the central portion and which is rotatably received in the boss;

a flat section disposed on the central portion and corresponding in size and shape to the opening such that when the thumbwheel is rotated so the flat section registers with the opening, the cartridge is write-protected and when the thumbwheel is rotated so the flat section does not register with the opening, the cartridge is write-enabled;

a non-flat section disposed on the central portion; and

a circumferential ridged gripping portion located at one axial edge of the central portion and extending around only the non-flat cylindrical section of the thumbwheel to facilitate rotating the thumbwheel and permitting intentional rotation of the thumbwheel from the write-enabled position to the write-protected position, wherein the ridged gripping portion stops at the ends of the flat section that serve as the border between the flat section and the non-flat section to inhibit inadvertent rotation of the thumbwheel.

The following references are relied on by the examiner:

Saito	4,012,011	Mar. 15, 1977
Larson et al. (Larson)	4,320,421	Mar. 16, 1982

Claims 1 to 5 and 7 to 10 stand rejected under 35 U.S.C.

§ 103. As evidence of obviousness, the examiner relies upon Saito alone as to claims 1 to 3 and 5, with the addition of Larson as to claims 4 and 7 to 10.

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Rather than repeat the positions of the appellant and the examiner, reference is made to the brief and the answer for the respective details thereof.

OPINION

We reverse both rejections.

At the outset, we observe that Figure 39 of Saito appears to be substantially identical to appellant's prior art Figure 1 of the specification. The examiner's position is to modify Figure 39 of Saito in view of Figure 38 of that same reference. However, to reason "engineering design choice" as a basis for the modification, in our view, falls far short of a reasoned art or artisan-based analysis as to why the artisan would have modified Figure 39 in view of Figure 38 in Saito to arrive at what independent claims 1 and 7 recite, which is essentially what Figure 3 of the specification depicts. The examiner's further analysis of the obviousness of the modification being based upon the advantage of decreasing the thickness of the thumbwheel and the gripping portion at pages 4 and 7 of the answer appears to us to put the cart before the horse. We can discern no reasoning within the teachings and suggestions in Saito or any line of reasoning within the answer for the artisan to have been

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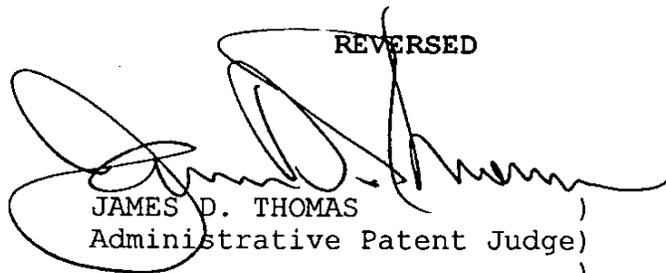
motivated or otherwise to have found it desirable to have any reason to have decreased the thickness in the manner argued by the examiner.

The description of Figures 38 and 39 at column 10, lines 42 to 51 of Saito does not explicitly describe the purpose of the knurled region 108c in Figure 39. Knurling is commonly done to enhance finger gripping of an item. The apparent, but unexpressed, purpose of this knurled 108c region is to aid the intentional rotation of the lug 108 from a write-protected to a read-enabled position, essentially as expressed in the beginning portions of the last clause of representative claim 1 on appeal. However, we cannot discern why the artisan would have wanted to limit the gripping portion of knurled region 108c in Figure 39 of Saito. We are unable to conclude that the artisan would have had any basis within 35 U.S.C. § 103 from the teachings, suggestions and inferences that the artisan would have derived from Saito to have extended the claimed circumferential ridged gripping portion around only the non-flat cylindrical section of the thumbwheel of representative claim 1 on appeal for the functional purpose "to inhibit inadvertent rotation of the thumbwheel" as expressed at the end of independent claims 1 and 7 on appeal.

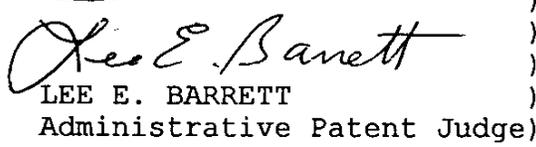
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On the basis of this analysis, we reverse the rejection of claims 1 to 3 and 5 under 35 U.S.C. § 103 over Saito alone and the additional rejection of the remaining claims on appeal in light of the collective teachings of Saito and Larson. Therefore, the decision of the examiner rejecting claims 1 to 5 and 7 to 10 under 35 U.S.C. § 103 is reversed.

REVERSED



JAMES D. THOMAS
Administrative Patent Judge)



LEE E. BARRETT
Administrative Patent Judge)

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MICHAEL R. FLEMING
Administrative Patent Judge)

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