



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO., EXAMINER, ART UNIT, PAPER NUMBER, NOTIFICATION DATE, DELIVERY MODE. Includes application details for Peter Martino and examiner POLO, GUSTAVO D.

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@choate.com
jnease@choate.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PETER MARTINO

Appeal 2015-001825
Application 12/817,614
Technology Center 2600

Before JASON V. MORGAN, BRUCE R. WINSOR, and JUSTIN BUSCH,
Administrative Patent Judges.

WINSOR, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1–14, which constitute all the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

¹ The real party in interest identified by Appellant is Teradyne, Inc. App. Br. 1.

STATEMENT OF THE CASE

The Invention

Appellant’s disclosed invention “relates to damping vibrations in storage device testing systems.” Spec. 1:2. Claim 1, which is illustrative, reads as follows:

1. A storage device test slot comprising:
 - a housing defining a test compartment for receiving a storage device for testing; and
 - one or more tuned mass dampers connected to the housing, the one or more tuned mass dampers being configured to inhibit vibration of the housing at one or more predetermined frequencies.

The Rejections

Claims 1–5 and 11–14 stand rejected under 35 U.S.C. §§ 102(a) and 102(e) as being anticipated by Slocum III (US 2009/0297328 A1; Dec. 3, 2009) (herein, “Slocum”).² See Final Act. 2–4.

Claims 6–10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Slocum and Gamble et al. (US 6,166,901; Dec. 26, 2000) (herein, “Gamble”). See Final Act. 4–5.

The Record

Rather than repeat the arguments here, we refer to the Briefs (“App. Br.”³ filed May 28, 2014; “Reply Br.” filed Nov. 12, 2014) and the Specification (“Spec.” filed June 17, 2010) for the positions of Appellant

² All rejections are under the provisions of 35 U.S.C. in effect prior to the effective date of the America Invents Act of 2011. Final Act 2.

³ The pages of the Appeal Brief are unnumbered. We refer to the nine pages of the Appeal Brief consecutively with page 1 being the caption pages, page 7 being the signature page, and pages 8 and 9 being the Claims Appendix.

and the Final Office Action (“Final Act.” mailed Dec. 16, 2013) and Answer (“Ans.” mailed Sept. 12, 2014) for the reasoning, findings, and conclusions of the Examiner.

Appellant cites the following as evidence, copies of which are found in the record, in support of the appeal:⁴

Tuned Mass Damper Systems, Chapter 4, ConCh04v2.fm, July 11, 2002 at ‘https://engineering.purdue.edu/~ce573/Documents/Intro%20to%20Structural%20Motion%20Control_Chapter4.pdf, pp. 217-285 (herein “Purdue”).

S. V. Bakre and R. S. Jangid, “Optimum parameters of tuned mass damper for damped main system,” *Structural Control and Health Monitoring*, 2007; 14:448-470 (Published Online 27 April 2006) (herein “Bakre”).

ISSUE

The dispositive issue presented by Appellant’s arguments is whether the Examiner errs in finding Slocum discloses “one or more tuned mass dampers connected to the housing [defining a test compartment], the one or more tuned mass dampers being configured to inhibit vibration of the housing at one or more predetermined frequencies” (the “tuned mass damper limitation”) as recited in claim 1.

⁴ Appellant additionally cites “Tuned Mass Damper,” *Wikipedia.com*, Wikipedia, n.d. Web. 13 May 2014, http://en.wikipedia.org/wiki/Tuned_mass_damper, in support of the appeal. However, the Wikipedia reference was not found in the record nor was a copy included in an evidence appendix to either of Appellant’s Briefs. *See* 37 C.F.R. §§ 1.116, 41.37(2). Accordingly, the Wikipedia reference is not properly before us, and we have not considered it.

ANALYSIS

The Examiner finds Slocum discloses the tuned mass damper limitation. Final Act. 2–3 (citing Slocum ¶¶ 48–49). Appellant contends that Slocum’s clamping mechanism is not a tuned mass damper as that term is used in Appellant’s Specification and understood by those of ordinary skill in the art. *See* App. Br. 4–6; Reply Br. 1–2. The Examiner responds as follows:

Appellant admits that Slocum teaches a storage device transporter (Slocum: Fig. 5, 550) that functions in a manner as to reduce vibrations (Appeal Brief p. 4 of 9). The examiner does not understand how a distinction can be drawn between a device that reduces vibrations, as described in Slocum, and a tuned damper. Appellant offers various definitions which easily fit both vibration reduction and tuned damping. For example, on page 5 of the Appeal Brief Appellant gives various descriptions of the functioning of a tuned damper such as “attenuate” and “dissipating vibration energy.” Such descriptions are equally accurate for a device that reduces vibrations. In fact, one of Appellant’s descriptions uses the terms “reduce . . . vibrations” (Appeal Brief p. 5 of 9). Appellant also argues that Slocum merely limits vibrations only by limiting the motion of the disk drive transporter relative to the housing. However, this function is sufficient to meet the limitation “one or more tuned mass dampers.”

Ans. 2 (ellipsis in original).

We agree with Appellant for the reasons stated by Appellant. Contrary to the Examiner’s reasoning, claim 1 does not merely recite the function of “inhibit[ing] vibration of the housing at one or more predetermined frequencies.” Rather, one of ordinary skill in the art would understand the claim to recite using a specific structure to perform the function, i.e., “one or more tuned mass dampers connected to the housing [defining a test compartment].” Appellant’s written description discloses a

device designed to accept vibration energy at one or more *specific frequencies* and then dissipate the energy” (Spec. 8:1–2 (emphases added)) and describes such a device as a “*tuned mass damper 522* to attenuate one or more of vibration modes of the test slot 500 by absorbing and dissipating vibration energy” (Spec. 8:3–5 (emphasis added)). This is consistent with the ordinary meaning of the term as understood by those of ordinary skill in the art:

A tuned mass damper (TMD) is a device consisting of a mass, a spring, and a damper that is attached to a structure in order to reduce the dynamic response of the structure. The frequency of the damper is tuned to a particular structural frequency so that when that frequency is excited, the damper will resonate out of phase with the structural motion. Energy is dissipated by the damper inertia force acting on the structure.

Purdue at 217 (§ 4.1). “A tuned mass damper (TMD) is a device consisting of small damped spring-mass system attached to a vibrating main system in order to attenuate any undesirable vibrations.” Bakre at 448. Accordinally, one of ordinary skill in the art would understand “tuned mass damper” to refer to a specific structure.

The Examiner has not shown, nor do we find, that Slocum discloses the tuned mass damper structure recited in claim 1. Indeed, the Examiner states that “[t]he [E]xaminer does not understand how a distinction can be drawn between a device that reduces vibrations, as described in Slocum, and a tuned damper” (Ans. 2), making it clear that the Examiner’s rejection is based on Slocum disclosing the *function* of reducing vibration, rather on than on Slocum disclosing the *specific structure*, i.e., one or more tuned mass dampers, recited in the claim.

Appeal 2015-001825
Application 12/817,614

Regarding claim 1, the Examiner has not established that “each and every element as set forth in the claim is found [in Slocum], either expressly or inherently described,” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987), “in as complete detail as is contained in the . . . claim,” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989), “arranged as in the claim,” *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990). Accordingly, we do not sustain the rejection for anticipation by Slocum of claim 1 and claims 2–14, which depend, directly or indirectly, from claim 1.

DECISION

The decision of the Examiner to reject claims 1–14 is reversed.

REVERSED