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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID H. F. HARPER and HUGO E. ROTHUIZEN¹

Appeal 2018-004923
Application 15/215,501
Technology Center 2600

Before CARL W. WHITEHEAD JR., MICHAEL J. STRAUSS, and
JEREMY J. CURCURI, *Administrative Patent Judges*.

STRAUSS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ According to Appellants, the real party in interest is International Business Machines Corporation. *See* App. Br. 2.

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a rejection of claims 1–4, 6–8, 11–14, 16–18, and 20. Claims 5, 9, 15, and 19 are indicated to be allowable if rewritten in independent form. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.²

THE INVENTION

The claims are directed to a tape drive motor having reduced runtime disturbances. Spec. ¶ 1. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. An apparatus, comprising:
a motor having:
a rotor;
a magnet; and
a damping layer positioned between the rotor and the magnet;
wherein the damping layer is constructed of a material characterized by converting kinetic energy into heat.

REFERENCES

The following prior art is relied upon by the Examiner in rejecting the claims on appeal:

Landin	US 6,191,510 B1	Feb. 20, 2001
Saito	US 6,445,096 B1	Sept. 03, 2002
Cherubini	US 7,876,521 B2	Jan. 25, 2011

² We refer to the Specification, filed July 20, 2016 (“Spec.”); the Final Office Action, mailed June 27, 2017 (“Final Act.”); the Appeal Brief, filed November 27, 2017 (“App. Br.”); and the Examiner’s Answer, mailed February 8, 2018 (“Ans.”). The Reply Brief filed April 9, 2018 is noted but it is not cited herein.

REJECTIONS

The Examiner made the following rejections³:

Claims 1–4 and 6–8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Saito and Landin. Final Act. 6–8.

Claim 10–14, 16–18, and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Saito, Landin, and Cherubini. Final Act. 8–12.

APPELLANTS' CONTENTION

Appellants contend the Examiner failed to provide sufficient reasoning for concluding it would have been obvious to form the unitary rotor of the prior art instead as two pieces, i.e. a damping layer separate from a rotor. App. Br. 6–9.

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants' arguments that the Examiner has erred in rejecting independent claims 1 and 11 under 35 U.S.C. § 103(a). We agree with Appellants' conclusions as to this rejection of the claims.

The Examiner finds Saito discloses all of the elements of claim 1 including a rotor with a damping layer. Final Act. 6. "However, Saito . . . shows the damping layer to be integral with the rotor itself, and not two separate pieces as claimed." *Id.* To address this distinction, the Examiner concludes

It would have been obvious to one of ordinary skill in the art at the time the invention was made to choose to form the damping layer and the rotor of two separate pieces, instead of the integral

³ The rejections of claims 1–14, 16–18, and 20 on grounds of nonstatutory double patenting have been withdrawn. Ans. 2.

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piece as shown in Saito et al., since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art.

Final Act. 6 (citing *Nerwin v. Erlichman*, 168 USPQ 177, 179 (PTO Bd. of Int. 1969)).

Appellants argue the Examiner's reliance on *Nerwin* is insufficient as lacking "persuasive articulated reasoning based on rational underpinning for modifying the reference as proposed." App. Br. 7. In support of their position Appellants cite to the decision in *Ex parte John C. S. Koo*, Appeal 2012-009263, 2014 WL 4925559 (Patent Tr. & App. Bd.) (non-precedential). Appellants argue that, in that decision, the "Patent Trial and Appeal Board found that the 'Examiner has not provided any findings that Keen recognized a problem with the attachment points/fingers 112. Without persuasive articulated reasoning based on rational underpinning for modifying the reference as proposed, the Examiner's rejection appears to be the result of hindsight analysis.'" App. Br. 8 (citing *Koo* at 5–6). The Examiner responds, noting *Koo* is a non-precedential case directed to different subject matter and a different fact situation. Ans. 4. According to the Examiner, the necessary motivation for making the modification to the reference is well and long established in case law and, in contrast, Appellants have provided no reason prohibiting the modification. *Id.*

We agree with Appellants the Examiner erred because the record as a whole does not support the Examiner's conclusion of obviousness. Put another way, the evidence before us provides a reason for not making the modification asserted by the Examiner, and we find this evidence more persuasive than the Examiner's naked assertions based on case precedent but lacking substantive reasoning. *See Saito* col 4, ll. 40–42. Although *Ex Parte*

Koo is not precedential and therefore not binding, for the reasons explained below, we agree the Examiner erred by failing to provide a reason for modifying the prior art in formulating the rejection.

Nerwin is not good legal authority for the proposition relied on by the Examiner, i.e., that constructing a formerly integral structure in various elements involves only routine skill in the art. See *Ex Parte Kawano*, 2013 WL 603839, at *4 (PTAB) (*Nerwin* does not establish that it is per se obvious to separate a single component into two components). “The examiner’s reliance on and citation of *Nerwin v. Erlichman*, 168 USPQ 177, 179 (BPAI 1969), which according to the examiner held that ‘constructing a formerly integral structure in various elements involves only routine skill in the art,’ appears to us to be misplaced. We find no such ‘holding’ in *Nerwin v. Erlichman*” *Ex Parte Gruden*, 1997 WL 1883962, at *3 (BPAI).⁴

Although the predecessor to our reviewing court has found, under somewhat analogous circumstances, that merely taking something that was permanently attached and making it separable is obvious and could be accomplished by anyone having ordinary skill, that case does not establish a per se rule. *In re Dulberg*, 289 F.2d 522, 523 (CCPA 1961). In particular, although *Dulberg* establishes there are situations in which it would have been obvious to modify an integral part to be a separable part because to do so is nothing more than an application of ordinary skill, it is important to note that a factually supportable reason for making the particular modification was still required. *Id.* at 523. In that case, the facts showed

⁴ See also MPEP § 2144: “When considering obviousness, Office personnel are cautioned against treating any line of reasoning [such as making separable] as a per se rule.” That is, such rationales should not be treated as per se rules, but rather must be explained and shown to apply to the facts at hand. *Id.*

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there was a known desire to be able to gain access to the space covered by the integrally connected cap to allow the remnant of the old lipstick to be pushed out of the carrier. *Id.* In other words, even when a modification simply requires changing an integral part to a separable part, *Dulberg* still required a reason with a rational underpinning to explain why a skilled artisan would have made that particular modification. The Examiner has not satisfied this requirement.

Although the Examiner states, “it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art” (Final Act 6 (citing *Nerwin* 168 USPQ at 179), this does not explain sufficiently why a skilled artisan would have selected and separated the rotor of Saito into separate rotor and damping layer components and positioned the damping layer between the separated rotor and magnet. To the contrary, as argued by Appellants, Saito discloses that “the rotor as shown in FIGS. 1 and 2 (relied upon in the rejection) must be integrally formed in order to ‘prevent[] the eccentricity accuracy from deteriorating due to accumulated parts inaccuracies.’” App. Br. 16 (citing Saito col 4, ll. 40–42). Thus, rather than provide a reason for making the modification, the evidence before us provides a reason for not making the modification asserted by the Examiner.

For the reason discussed above, the Examiner has not explained sufficiently why it would have been desirable at the time of the invention to segment the rotor and damping layer components from Saito’s device and place the separate components into the claimed physical configuration. Therefore, we do not sustain the Examiner’s rejections of independent claims 1 and 11 or the rejections of dependent claims 2–4, 6–8, 12–14, 16–18, and 20.

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DECISION

We reverse the Examiner's decision to reject claims 1–4, 6–8, 11–14, 16–18, and 20 under 35 U.S.C. § 103(a).

REVERSED