

127 F.3d 1048, 44 U.S.P.Q.2d 1023  
**(Cite as: 127 F.3d 1048)**



United States Court of Appeals,  
 Federal Circuit.  
 In re Charles P. MORRIS, Kenneth L. Pottebaum, and  
 John D. Stricklin.

No. 96-1425.

Decided Sept. 10, 1997.

Rehearing Granted with no change in result and in  
 banc suggestion declined Sept. 22, 1997.

Applicant appealed from decision of the Board of Patent Appeals and Interferences denying its application for a patent for a disc drive acoustic isolator. The Court of Appeals, [Plager](#), Circuit Judge, held that: (1) Patent and Trademark Office (PTO) was not required to interpret claims in patent application in same manner as courts were required to during infringement proceedings, and (2) claim was anticipated by prior art.

Affirmed.

West Headnotes

**[1] Patents 291 🔑101(2)**

291 Patents

291IV Applications and Proceedings Thereon

291k101 Claims

291k101(2) k. Construction in general. [Most Cited Cases](#)

Patent and Trademark Office (PTO) was not required to interpret claims in patent application in same manner as courts were required to during infringement proceedings; PTO could give claimed language its broadest reasonable interpretation during prosecution.

35 U.S.C.A. §§ 131, 282.

**[2] Patents 291 🔑101(2)**

291 Patents

291IV Applications and Proceedings Thereon

291k101 Claims

291k101(2) k. Construction in general. [Most Cited Cases](#)

As initial matter, Patent and Trademark Office (PTO) applies to verbiage of proposed patent claims broadest reasonable meaning of words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by written description contained in applicant's specification. 35 U.S.C.A. §§ 131, 282.

**[3] Patents 291 🔑113(7)**

291 Patents

291IV Applications and Proceedings Thereon

291k113 Appeals from Decisions of Commissioner of Patents

291k113(7) k. Presumption as to correctness of decision below. [Most Cited Cases](#)

Once Patent and Trademark Office (PTO) has made initial determination that specified claims are not patentable, burden of production falls upon applicant to establish entitlement to patent.

**[4] Patents 291 🔑99**

291 Patents

291IV Applications and Proceedings Thereon


291k99 k. Description of invention in specification. [Most Cited Cases](#)

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(Formerly 291k97)

Public notice is important objective of patent prosecution before Patent and Trademark Office (PTO).

**[5] Patents 291  101(2)**


**291 Patents**

**291IV Applications and Proceedings Thereon**

**291k101 Claims**

**291k101(2) k. Construction in general. [Most Cited Cases](#)**

Claim language in patent application for a disc drive acoustic isolator, requiring “compliance area” to be “integrally formed as a portion of” the housing, did not require the compliance area to be fused together with the housing; accordingly, claim was anticipated by prior art patent for device that had compliance area fixedly attached to support member. [35 U.S.C.A. §§ 131, 282](#).

**[6] Patents 291  99**

**291 Patents**

**291IV Applications and Proceedings Thereon**

**291k99 k. Description of invention in specification. [Most Cited Cases](#)**

Patent and Trademark Office (PTO) was obligated to reject claim in patent application when applicants failed precisely to define in written description the disputed language, and there was reasonable alternative definition. [35 U.S.C.A. §§ 131, 282](#).

**\*1049** [Richard H. Stern](#), Ablondi, Foster, Sobin & Davidow, Washington, DC, for appellants. Of counsel are [Bill D. McCarthy](#), [Randall K. McCarthy](#), [Phillip L. Free, Jr.](#), McCarthy & Associates, Inc., Oklahoma City, OK, and [Edward P. Heller, III](#), Seagate Technology, Inc., Scotts Valley, CA.

Nancy J. Linck, Solicitor, Patent and Trademark Office, U.S. Department of Commerce, Arlington, VA, for appellee. Of counsel are Albin F. Drost, Deputy Solicitor, [Kenneth R. Corsello](#) and David J. Ball, Jr., Associate Solicitors.

*ORDER*

Appellants Morris *et al.* petition for rehearing of the decision of this court issued under date of August 18, 1997. Appellants point to several statements in the issued opinion which, in their view, entitle them to rehearing of their appeal. After thorough review of the petition, the court grants the petition for rehearing for the limited purpose of laying to rest any doubts about the court's views as expressed in the opinion; the judgment affirming the decision of the Board is reaffirmed.

SO ORDERED.

Before [PLAGER](#), [CLEVINGER](#), and [BRYSON](#),  
Circuit Judges.

REVISED OPINION

[PLAGER](#), Circuit Judge.

Appellants Morris, Pottebaum, and Stricklin appeal from a decision of the Board of Patent Appeals and Interferences in Application Ser. No. 07/673,967, dated March 28, 1996. In that decision the Board affirmed a rejection of appellants' claims 1, 5 and 20 under [35 U.S.C. § 102\(b\)](#). Because the Board did not err in its reading of appellants' claims, we affirm.

BACKGROUND

On March 22, 1991, appellants filed a patent application entitled “Acoustic Isolator for a Disc Drive Assembly.” The application was assigned Ser. No. 07/673,967 by the United States Patent and Trademark Office **\*1050** (“PTO”) and prosecution of the application proceeded.

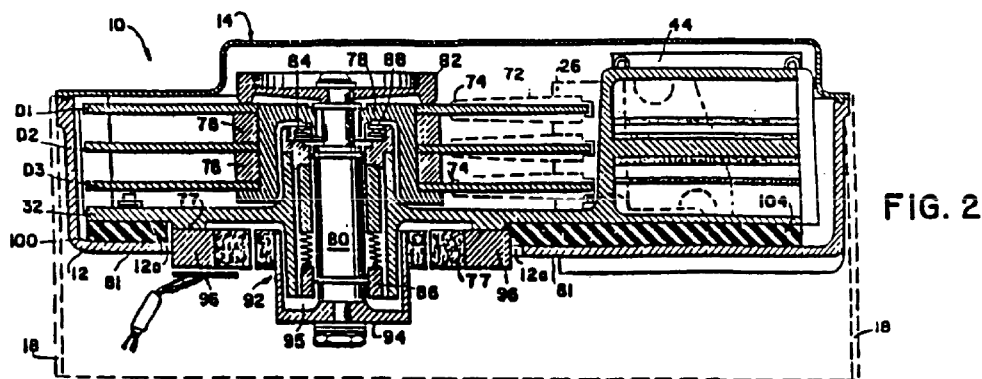
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The problem addressed in the application was the acoustic noise generated by a disc drive as a result of the physical movement of the internal motors. According to the application, modern disc drives such as used in personal computers include two motors, also referred to as “excitation sources.” The first is a spindle motor that spins the magnetic discs upon which data is stored. The second is an actuator motor that moves a read/write head across the discs to access specific locations or “tracks” on the discs. These motors are mounted in a disc housing. The housing is typically comprised of an upper and a lower housing cover that mate together to enclose the entire disc drive. The problem described in the application is that any vibration of the motors is transmitted to the housing by virtue of the connection of the motors to the housing. This causes the housing to vibrate in

sympathy with the motors, particularly if the resonant frequency of the motor corresponds to the natural frequency of either of the housing covers.

Prior art solutions addressed this problem by adding an isolator between the motors and the housing. For example, [United States Patent No. 4,491,888](#) (the “Brown” patent) taught the use of an annular elastomeric pad to absorb the vibrations. As described and shown in Brown, the “elastomeric member or pad 100 is engaged between the base plate [32] and lower casing [12] ... to assist in dampening actuator-induced vibrations.” Brown, Col. 7, lines 32-47. Figure 2 of Brown, showing a cross-section of the pad 100 and surrounding housing 12, is reproduced below.



The disadvantage of Brown, according to appellants, was that it required an additional part. This may not seem significant to those unfamiliar with the disc drive industry, but, in the cost-sensitive and constantly miniaturizing world of disc drive manufacturers, additional pieces of equipment add to the cost of the disc drive and consume valuable real estate in the drive.

Appellants' approach was different from the approach taken in Brown. Instead of adding an additional part, appellants thinned down a portion of the motor casing in the area where the motor attached to the casing. This thinned-down area, referred to as a “compliance area,” absorbs most of the kinetic energy

produced by the motor because of its reduced thickness, without radiating that energy outward to the remainder of the housing. Appellants maintained in their application that acoustic noise can be significantly reduced using this approach, and without additional parts.

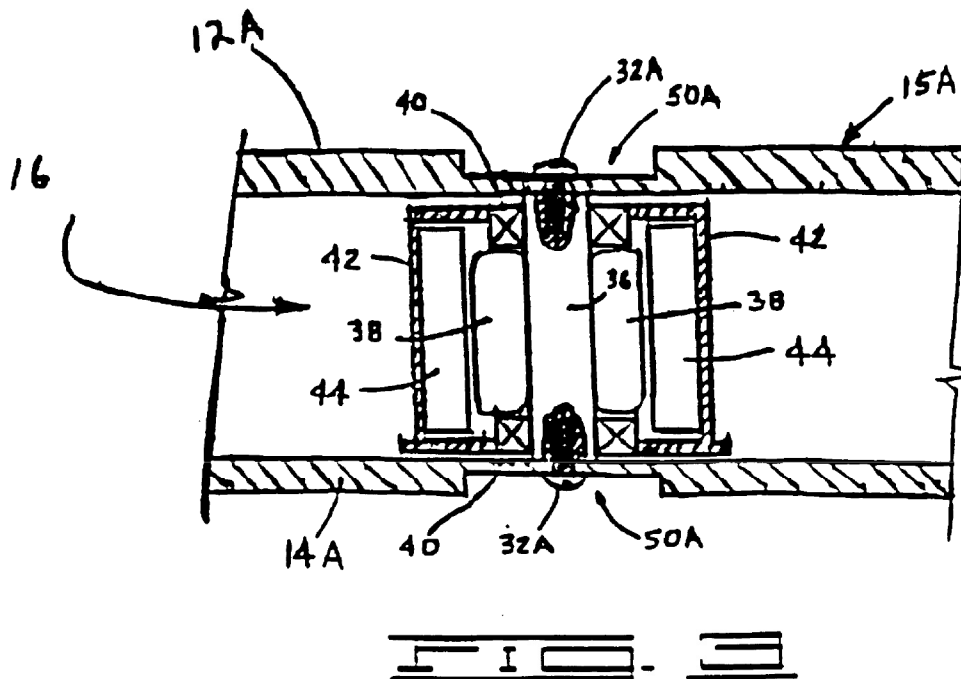
Figure 3 of the appellants' application, reproduced below, shows a partially detailed cross-sectional view of a disc drive according to their invention. The disc drive includes a top housing cover 12A and a bottom housing cover 14A. A motor 16 is attached to the top and bottom covers by screws 32A. A portion of the top and bottom covers 50A is thinned-down in an area extending radially away from the screws 32A. This

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“compliance area,” \*1051 due to its reduced thickness relative to the remaining housing, achieves the acous-

tic noise reduction of the applicants claimed invention.



Brown.<sup>FN1</sup> The admitted prior art was essentially identical to applicant's Figure 3, shown above, but the “compliance area” amounted to a counter-sink hole simply big enough to receive the head of the screw 32A.

The application included 22 claims. Original claim 1 read:

1. An improved acoustic isolation apparatus for reducing the acoustic noise produced by a system having at least one excitation source disposed so as to impart vibrations to a structure member coupled thereto, the acoustic isolation apparatus comprising:

at least one acoustic isolator providing determined compliance of the structure member in a selected area of compliance disposed to impede coupling of the vibrations of the excitation source and the structure member.

In a first office action, claim 1 was rejected as being anticipated under 35 U.S.C. § 102(b) in view of appellants' admitted prior art and also in view of

<sup>FN1</sup>. All of the other claims were also rejected on the same grounds. Because all of the appealed claims stand or fall with claim 1, we will confine our discussion to the prosecution history of claim 1.

In response to this rejection, appellants amended claim 1 as follows, with language removed enclosed in square brackets and language added underlined:

1. (Amended) An improved acoustic isolation apparatus for reducing the acoustic noise produced by a system having at least one excitation source disposed so as to impart vibrations to a [structure] support member coupled thereto, the acoustic isolation apparatus comprising:

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at least one acoustic [isolator providing determined compliance of the structure member in] compliance area integrally formed on a selected area of [compliance disposed] the support member so as to impede coupling of the vibrations of the excitation source [and] to the [structure] support member.

\*1052 In addition, appellants argued that Brown is distinguishable because it “does not teach or suggest an acoustic isolator apparatus which is integrally formed as part of the housing.” The appellants then went on to describe Brown in general terms and concluded that “it is clear that the base plate and housing arrangement disclosed in Brown '888 is completely different in structure than the acoustic isolator apparatus recited in Applicants' claims 1-22, as amended.”

In response to appellants' amendment and related arguments, the examiner entered a new ground of rejection. Claim 1 was rejected under the same section of the statute, [Section 102\(b\)](#), but using a different reference, Biermeier et al., [U.S. Patent No. 4,780,777](#). Biermeier showed a thin, substantially horse-shoe shaped resilient section adjacent the spindle of the drive shaft in a disc drive housing to provide a support for the spindle of a disc and to achieve bearing pre-load. Biermeier, Col. 4, lines 53-68. According to the examiner, Biermeier showed “a resilient wall region 15 integrally formed on the housing 1 which would impede coupling of vibrations of the excitation source 38 to the support member 1 while maintaining rigidity of the housing assembly.” The examiner further stressed that Biermeier does show “an acoustic isolator apparatus which is *integrally formed* as part of the housing.”

The appellants responded by once again amending their claim and by attempting to distinguish the cited reference. Claim 1 after this second amendment read:

1. (Twice Amended) An improved acoustic isolation apparatus for reducing the acoustic noise produced by a system having at least one excitation source [disposed so as to impart vibrations] attached at a contact point to a support member, the acoustic isolation apparatus comprising:

at least one acoustic compliance area integrally formed on a selected area of the support member so as to impede selected frequencies of acoustic noise resulting from the coupling of the vibrations of the excitation source to the support member, the acoustic compliance area formed on the support member such that increased compliance is provided to the support member substantially surrounding the contact point.

Appellants vigorously contested the examiner's assertion that the Biermeier resilient section achieved any acoustic reduction. If Biermeier achieved any acoustic reduction, according to appellants, “it was pure happenstance.”

After considering the amendment and related arguments, the examiner shifted back to his original ground for rejection-Brown. In a third office action, the examiner again rejected claim 1 as being anticipated by Brown under [Section 102\(b\)](#). According to the examiner, “Brown et al show an acoustic compliance area 100 integrally formed *on* a selected area of the support member 12 so as to impede selected frequencies of acoustic noise resulting from the coupling of the vibrations of the excitation source 92 to the support member 12.” The examiner considered the appellants' arguments with respect to Biermeier moot in view of the new ground of rejection.

A third amendment to claim 1 followed. The amended claim 1 now read:

1. (Thrice Amended) An improved acoustic iso-

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