

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NAOTO IKEDA and KENJI ENOMOTO

Appeal No. 2000-1320
Application No. 08/796,737

ON BRIEF

Before KRASS, DIXON, and BLANKENSHIP, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 5-8, 11, and 16. Claims 9, 10 and 12-15 are withdrawn from consideration as directed to non-elected inventions.

We REVERSE.

BACKGROUND

The appellants' invention relates to a floating-type magnetic head with straddle-mounted string-type flexure with pivot projection. An understanding of the invention can be derived from a reading of exemplary claim 5, which is reproduced below.

5. A floating magnetic head having an arm which is positioned slidably along a radial direction of a disc, a slider which is attached to said arm and which floats above a surface of the disc due to a movement of air produced by rotation of the disc, a magnet mounted on the slider, and a holder by which said slider is attached displaceably to the arm, comprising:

a straddle-mounted spring displacement portion which is formed on said holder, said straddle-mounted spring displacement portion being separate from said arm; and

a projection extending from one of said displacement portion and said arm, said projection being in contact with the other of said displacement portion and said arm and providing a pivot for said displacement portion.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

| | | |
|------------------------|-----------|---------------|
| Yumura et al. (Yumura) | 5,079,660 | Jan. 7, 1992 |
| Mizuno et al. (Mizuno) | 5,299,080 | Mar. 29, 1994 |

Appellants' Admitted Prior Art (AAPA) at pages 1, 3, 4 and Figures 1, 5, 6

Appeal No. 2000-1320
Application No. 08/796,737

Claims 5-8 and 16 stand rejected under 35 U.S.C. § 102 as being clearly anticipated by Yumura. Claim 11 stands rejected under 35 U.S.C. § 103 as being unpatentable over AAPA in view of Mizuno.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 32, mailed Oct. 1, 1999) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 31, filed Aug. 24, 1999) and reply brief (Paper No. 33, filed Nov. 29, 1999) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

35 U.S.C. § 102

The examiner maintains that Yumura clearly anticipates independent claim 5 with no discussion of the correspondence of the reference to the recited claim limitations at page 3 of the answer and then states at page 5 of the answer that "[i]t is curious situation that appellants state that a prima facie case [has not been made] when appellants have had no difficulty identifying and correlating the elements of Yumura et al with applicants claimed invention." We disagree with the examiner, and

we find it immaterial whether the appellants can understand what the examiner intended as the corresponding elements even if the examiner did not specifically recite the elements. It is material that the examiner was clearly incorrect in the application of the prior art. Here, we find that the examiner was clearly in error in applying the prior art of Yumura to the invention recited in independent claim 5.

Appellants argue that the examiner did not provide any explanation of the rejected claims and how the claims are construed to read on the Yumura reference. (See brief at page 8.) Appellants argue that the structure, shape and design of the assembly disclosed by Yumura are substantially different from that of appellants' claims. (See brief at page 8.) We agree with appellants. Appellants argue that independent claims 5 and 7 recite a "straddle-mounted spring displacement portion" which is not taught by Yumura. Additionally, appellants argue that Yumura is directed to a cantilever type spring rather than a straddle-mounted spring. (See brief at pages 9-10.) Appellants identify the structural differences between the two types in the specification at pages 2-4 and Figures 2-4 and 5-6 in the discussion of the conventional two types. We agree with appellants that Yumura is not directed to a straddle-mounted spring as shown and described in the conventional prior art in Figure 5. Therefore, we find that Yumura does not teach "a straddle-mounted spring displacement portion which is formed on said holder," and we cannot sustain the rejection of independent claims 5

and 7 under 35 U.S.C. § 102.¹ Therefore, we cannot sustain the examiner's rejection of dependent claims 6, 8 and 16.

35 U.S.C. § 103

The examiner relies upon the teachings of the AAPA which teaches a conventional straddle-mounted spring in view of Mizuno which teaches the use of a dimple on the arm as pivot. Again, we disagree with the examiner since the examiner has not addressed the invention as recited in the language of the claim. The examiner maintains that it would have been obvious to one of ordinary skill in the art at the time of the invention to include a dimple on the arm to further stabilize the slider. (See answer at page 5.) But the examiner does not address the fact that the prior art straddle-mounted spring is integral with the arm and that a dimple formed on the arm would not "support a midpoint of the displacement portion or provide a fulcrum about which the displacement portion 33 is tiltable." (See brief at pages 13-14.) Therefore, the combination applied by the examiner does not teach or fairly suggest the invention as recited in independent claim 11. Therefore, we cannot sustain the rejection of independent claim 11.

CONCLUSION

¹ Additionally, we note that the examiner did not apply the admitted prior art in Figure 5 which clearly teaches a "straddle-mounted spring displacement portion," but we further note that the conventional spring is integral with the arm and not "separate from said arm" as required by the language of independent claims 5 and 7.

Appeal No. 2000-1320
Application No. 08/796,737

To summarize, the decision of the examiner to reject claims 5-8 and 16 under 35 U.S.C. § 102, and the decision of the examiner to reject claim 11 under 35 U.S.C. § 103 is reversed.

REVERSED

| | | |
|-----------------------------|---|-----------------|
| ERROL A. KRASS |) | |
| Administrative Patent Judge |) | |
| |) | |
| |) | |
| |) | |
| |) | BOARD OF PATENT |
| JOSEPH L. DIXON |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
| |) | |
| |) | |
| |) | |
| HOWARD B. BLANKENSHIP |) | |
| Administrative Patent Judge |) | |

JD/RWK

Appeal No. 2000-1320
Application No. 08/796,737

RONALD P. KANANEN
RADER, FISHMAN & GRAUER
1233 20TH STREET NW
SUITE 501
WASHINGTON, DC 20036