

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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VICTOR WING-CHUN SHUM
and RANDALL GEORGE SIMMONS

Appeal No. 2001-1760
Application No. 09/259,890

ON BRIEF

Before PAK, DELMENDO, and NAGUMO, Administrative Patent Judges.
PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 13, which are all the claims pending in the above-identified application.

Claim 1 is representative of the subject matter on appeal and reads as follows:

1. A method for manufacturing an integrated lead suspension for a hard disk drive, comprising:
 - (a) providing a metal support layer, a pair of dielectric layers, and a pair of conductor layers;
 - (b) forming a void in at least one of the dielectric layers; then
 - (c) laminating each of the layers together to form a laminate such that the support layer and the conductor layers are separated from one another by at least one of the dielectric layers;
 - (d) etching at least one of the conductor layers of the laminate of step (c) to form traces; and then
 - (e) deforming at least one of the traces through said void toward and into contact with one of the support layer and the other of the conductor layers to form a shunt therebetween.

Claims 1 through 13 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking an enabling disclosure for the subject matter presently claimed.

We reverse.

Under 35 U.S.C. § 112, first paragraph, the examiner has the initial “burden of giving reasons, supported by the record as a whole, why the specification is not enabling... Showing that the disclosure entails *undue* experimentation is part of the PTO’s initial burden...” *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976). In determining whether any given disclosure would require undue experimentation, the examiner must consider not just the breadth of the claims, but also the quantity of experimentation necessary, the amount of direction or guidance presented, the presence or absence of working examples, the nature of the invention, the state of the prior art,

the relative skill of those in the art and the predictability or unpredictability of the art. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988), *citing Ex parte Forman*, 230 USPQ 546, 547 (Bd. Pat. App. & Int. 1986).

Here, the examiner has not demonstrated that one of ordinary skill in the art would not be able to practice the claimed invention, without undue experimentation, based on the guidance provided in the specification and the information known in the art (the state of the art). *See also In re Stephens*, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976)(the test of enablement is whether one skilled in the art could make or use the claimed invention from the disclosure coupled with information known in the art without undue experimentation). The examiner not only ignores the state of the art in his analysis, but also does not explain why undue experimentation would be required.¹ See the Answer in its entirety. Moreover, the examiner's focus on the disclosure of a limited number of specific embodiments in the specification does not render claims to a broader invention non-enabling. The specification is "not required to disclose every species [every embodiment] encompassed by their claims..." *Angstadt*, 537 F.2d at 503, 190 USPQ at 218; *see also In re Howarth*, 654 F.2d 103, 105, 210 USPQ 689, 691 (CCPA 1981)("An inventor need not, however, explain every detail since he is speaking to those skilled in the art. What is conventional knowledge will be read into the disclosure.") Absent a showing of undue experimentation, the

¹ To the extent that the examiner's allegations regarding unpredictability and criticality of the claimed invention relate to "undue" experimentation (Answer, pages 3, 6 and 7), we do not find them persuasive since they are not supported by any objective evidence.

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claims drawn to a broader invention than the specific embodiments described in the specification would not violate the enablement requirement of the first paragraph of 35 U.S.C. 112. *See, e.g., In re Dinh-Nguyen*, 492 F.2d 856, 858-59, 181 USPQ 46, 48 (CCPA 1974).

In view of the foregoing, the examiner, on this record, has not established a *prima facie* case of unpatentability under 35 U.S.C. § 112, first paragraph. Therefore, we reverse the examiner's decision rejecting claims 1 through 13 under 35 U.S.C. § 112, first paragraph.

REVERSED

CHUNG K. PAK)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
ROMULO H. DELMENDO)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
MARK NAGUMO)	
Administrative Patent Judge)	

CKP/lp
FELSMAN BRADLEY VADEN GUNTER & DILLON
LAKEWOOD ON THE PARK #350
7600 B NORTH CAPITAL OF TEXAS HIGHWAY

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AUSTIN, TX 787331