

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHINJI FURUICHI and TAKEO SASAKI

Appeal No. 2001-2407
Application No. 09/154,703

ON BRIEF

Before KRASS, RUGGIERO and BLANKENSHIP, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-3 and 7-18.

The invention is directed to a slider and head assembly for a magnetic storage device. In particular, the invention is directed to a slider having a stepped portion which accommodates

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an actuator, resulting in a reduced thickness for the assembly joining together the slider and the actuator.

Representative independent claim 1 is reproduced as follows:

1. A slider having an actuator, comprising:

a flying surface; and

a stepped surface on a side of said slider opposite said flying surface, the stepped surface having a lower surface on which the actuator is mounted.

The examiner relies on the following references:

Yamaguchi et al. (Yamaguchi)	5,243,482	Sep. 7, 1993
Mizuno et al. (Mizuno)	5,299,080	Mar. 29, 1994

In addition, the examiner relies on admitted prior art (APA) depicted in Figures 14 and 15 of the instant application.

Claims 10-13 and 18 stand rejected under 35 U.S.C. 112, first paragraph, as relying on a nonenabling disclosure.

Claim 17 stands rejected under 35 U.S.C. 112, first and second paragraphs, as relying on a nonenabling disclosure and failing to particularly point out and distinctly claim the subject matter appellants regard as their invention.

Claims 1-3 and 7-18 stand rejected under 35 U.S.C. 103 as unpatentable over APA in view of either one of Mizuno or

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Yamaguchi.

Reference is made to the brief and answer for the respective positions of appellants and the examiner.

OPINION

Turning, first, to the rejection of claim 17 under 35 U.S.C. 112, first and second paragraphs, it is the examiner's position that it is unclear what constitutes the "integrating structure" in this claim. Moreover, the examiner refers to the Figure 3 embodiment and states that this embodiment shows an actuator attached to the suspension using adhesive. Accordingly, the examiner contends that there is no disclosure of utilizing some additional structure between the actuator and suspension. Thus, the examiner contends that there is no disclosure, within the meaning of 35 U.S.C. 112, first paragraph, for some structure other than an adhesive between actuator and suspension. Alternatively, the examiner argues, the claim is indefinite under 35 U.S.C. 112, second paragraph, for failing to clearly indicate the structure used between the actuator and suspension.

The inquiry under 35 U.S.C. 112, second paragraph, is whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and

particularity. It is here where the definiteness of the language employed must be analyzed-not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary skill in the pertinent art. In re Moore, 439 F2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

Clearly, in view of the instant disclosure, the claimed "integrating structure" is the structure 25 in Figures 12A and 12B. It "integrates" the actuator and suspension, as indicated at lines 3-6 of page 29 of the specification. Since the claimed term is consistent with the specification and the specification clearly defines what is meant by an "integrated structure," we find nothing indefinite about this term.

Further, it is also clear that the structure is adequately disclosed in Figures 12A and 12B and amply described in the specification so that there is clear support and an enabling disclosure of and for the claimed "integrated structure."

From the arguments of appellants and the examiner, it appears that there is some dispute about what claims are included in the elected species pursuant to a restriction requirement. We leave this matter to be worked out between appellants and the examiner as the propriety of a restriction requirement and the

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claims included in an elected species are petitionable, rather than appealable, matters. But, as far as definiteness of the claim language and an enabling disclosure for the claim language, "integrated structure," in claim 17, we find no problem either under 35 U.S.C. 112, second paragraph, or under 35 U.S.C. 112, first paragraph.

The examiner's rejection of claim 17 under 35 U.S.C. 112, first and second paragraphs, is not sustained.

We turn now to the rejection of claims 10-13 and 18 under 35 U.S.C. 112, first paragraph, as relying on a nonenabling disclosure.

The examiner's position is that there is no adequate disclosure of using a separate "positioning member" in the species of Figure 3, the only "positioning member" being for the species of Figure 10A, with a flat back surface.

With regard to claim 11, the examiner contends that there is no adequate disclosure of how a conductive adhesive is configured or applied to enable the skilled artisan to make and use this embodiment.

With regard to claims 12 and 18, the examiner contends there is no adequate disclosure of structural details for the listed alternative actuators.

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With regard to claim 13, the examiner contends there is no adequate disclosure of how the listed dimensions are provided.

To the extent appellants and the examiner are arguing the propriety of a restriction requirement and the claims included in the elected species pursuant to the restriction requirement, again, we leave this petitionable matter between appellants and the examiner. It has no place on appeal to this Board.

However, as to the merits of the rejections, our view is as follows:

With regard to claim 10, this claim requires *both* a step formed in the slider *and* a positioning member mounted on a flat surface of the slider. It is our view, that the examiner has established a reasonable basis for an enablement rejection based on no disclosed embodiment showing *both* a step and a positioning member.

Appellants are correct in their assessment that Figure 10A clearly shows a positioning member (133). However, this embodiment of the invention does not show a step and it is unclear how an artisan would make and use an embodiment of the invention wherein the slider has a flat surface upon which a positioning member is located while, at the same time, including a step in the slider. Since no disclosed embodiment depicts

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these claimed features together and appellants have only pointed to Figure 10A for a disclosure of a positioning member, but not together with a step, we agree with the examiner that the artisan would not have been enabled, from the instant disclosure, to make and use the claimed subject matter.¹

Accordingly, we will sustain the rejection of claim 10 under 35 U.S.C. 112, first paragraph. We will also sustain the rejection of claim 11/10, as it depends from claim 10, claim 13/10, as it depends from claim 10, or of claim 18, which depends from claim 10, for the reasons set forth supra, with regard to claim 10.

We will not, however, sustain the rejection of claims 11/9, or of claims 12 and 13/9 under 35 U.S.C. 112, first paragraph.

With regard to claim 11, not only does page 8, lines 15-18, of the instant specification, disclose the use of a conductive adhesive between the actuator and the slider, but, clearly, the artisan would have been enabled by the claim language itself, to place a conductive adhesive between these two elements.

With regard to claim 12, although the examiner contends that

¹There is also a question of whether there is support for an embodiment having both a step and a positioning member, within the written description requirement of 35 U.S.C. 112, but that issue is not before us.

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there is no disclosure of structural details for an actuator driven by either electrostatic force or electromagnetic force, the specification does describe the actuator structure including a drive portion and a movable portion, along with electrodes to supply current to the coil. See page 8, line 22-page 9, line 1, page 12, lines 21-23 and page 23, line 20-page 24, line 4. The artisan would have understood from this disclosure that the actuator would be driven by either electrostatic force or electromagnetic force and would further have understood how to perform these tasks. Moreover, such actuators were known to skilled artisans and, as the examiner states, at page 6 of the answer, the rejection would be withdrawn if the actuators were known. It is clear to us that the actuators, per se, were known. The instant inventive features are directed, not to the actuators, but to the slider structure upon which the actuator rests.

With regard to claim 13/9, the examiner states that although the claim recites a range of thickness for the slider and actuator assembly, and appellants cite several passages in the disclosure, enabling the listed dimensions, the cited passages "merely state the dimensions listed in the claims. The entire disclosure is simply schematic in nature. There is no showing of

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real structural details, or of actual methods of making these components...The mere statement that an element is of a certain size is not enabling" [answer-page 7].

We do not view the examiner's position as being reasonable. If the disclosure teaches the claimed dimensions of the structure, and the drawings show the structure, we do not understand the examiner's position that the making of the claimed and disclosed structure is not enabling, within the meaning of 35 U.S.C. 112. There is no requirement, within 35 U.S.C. 112, that the patent disclosure must be a detailed blueprint. It need only disclose as much as the skilled artisan would need to make and use the claimed invention without undue experimentation. It is our view, that, with regard to claims 11/9, 12, and 13/9, the disclosure is clearly enabling.

The examiner's rejection of claims 10, 11/10, 13/10 and 18 under 35 U.S.C. 112, first paragraph, is sustained but the rejection of claims 10, 11/10, 13/10 and 18 under 35 U.S.C. 112, first paragraph, is not sustained.

Finally, we turn to the rejection of claims 1-3 and 7-18 under 35 U.S.C. 103.

It is the examiner's position that APA differs from the instant claimed subject matter only in not having the claimed

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"step" on the back side of the slider. The examiner uses either one of Yamaguchi or Mizuno to show the back side of a slider having a step. The examiner then concludes that it would have been obvious to utilize the step configuration for the back side of the slider of APA since "this is a well known configuration that clearly reduces the mass and height" (answer-page 6).

It appears that Mizuno does not disclose an actuator mounted on the slider. Moreover, the stepped portion of the slider 2 in Mizuno allows the slider to float up a little before contacting convex surface 10b. The stepped portion of Mizuno has no relation to mounting an actuator therein as in the instant claimed invention. Accordingly, we find no nexus which would have led the artisan, in any way, to form a step within APA for the purpose of mounting an actuator therein.

In Yamaguchi, the stepped portion relied on by the examiner is the step, or indented, portion of gimbal 5, but there is no indication within Yamaguchi that this stepped portion is for the purpose of mounting an actuator, as claimed.

The examiner urges, at page 10 of the answer, that both Mizuno and Yamaguchi have flat planar areas on the lower "stepped" surface to accommodate a microactuator but the examiner points to no section within either reference which suggests this

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and we remain unconvinced that either of these references intends the "stepped" portion cited by the examiner as a mount for an actuator.

Accordingly, we find no reason for the artisan to have combined either of Mizuno or Yamaguchi with APA in any manner which would have resulted in the instant claimed subject matter. It appears to us that the only evidence of record for forming a stepped portion in the slider for mounting an actuator comes from appellants' own disclosure. Such hindsight is not a proper basis for a rejection under 35 U.S.C. 103.

The examiner's rejection of claims 1-3 and 7-18 under 35 U.S.C. 103 is not sustained.

CONCLUSION

We have not sustained the rejection of claims 1-3 and 7-18 under 35 U.S.C. 103 and we have not sustained the rejection of claims 11/9, 12, 13/9 and 17 under 35 U.S.C. 112. We have, however, sustained the rejection of claims 10, 11/10, 13/10 and 18 under 35 U.S.C. 112, first paragraph.

Accordingly, the examiner's decision is affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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Administrative Patent Judge)	
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JOSEPH F. RUGGIERO)	BOARD OF PATENT
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