Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte VICTOR W. SHUM and RANDALL G SIMMONS

Appeal No. 2001-2628
Application No. 09/259,888

ON BRIEF

Before JEFFREY T. SMITH, PAWLIKOWSKI, and MOORE, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 18, which are all the claims pending in this application.

The subject matter on appeal is represented by claim 1, set forth below:

1. A method for manufacturing an integrated lead suspension for a hard disk drive, comprising:
   (a) providing a metal support layer, a dielectric layer, and a conductor layer;
   (b) forming a void in the dielectric layer; then
   (c) laminating the dielectric layer between the support layer and the conductor layer to form a laminate;
   (d) etching the conductor layer of the laminate of step (c) to form an extension portion

which extends beyond the void, defining a recess between the conductor layer and the support layer; and then, in operation:

(e) limiting flexing movement of the support layer toward the conductor layer by contact with the extension portion, wherein the support layer is allowed some range flexing motion by the void.

Claims 1 through 18 stand rejected under 35 U.S.C. § 112, first paragraph (enablement).

OPINION

For the reasons set forth in the brief, and below, we reverse the above-noted rejection.

On page 3 of the answer, the examiner states that claims 1 through 18 are rejected because the specification, while being enabling for a laminated integrated lead suspension comprising stainless steel, polyimide, and copper, does not reasonably provide enablement for a laminated integrated lead suspension made of a metal support layer, a dielectric layer, and a conductive layer. The examiner states that the specification does not enable one of ordinary skill in the art to make the invention commensurate in scope with the claims.

On pages 6 through 7 of the brief, appellants point out that original claims 1, 8, and 12 provide support for a lead suspension comprising a metal support layer, a dielectric layer, and a conductor layer. Also, at the bottom of page 7 of the brief, appellants state that the examiner entered an amendment to the specification which reads "For example, as set forth in the appended claims, the layers of the integrated lead suspension may comprise a metal support layer, a dielectric layer, and a conductor layer." See page 6, lines 16 through 18 of the specification. Appellants

state that support for this amendment can be found in the original claims.

In response, on pages 7 through 8 of the answer, the examiner argues that although claims 1, 8, and 12 are part of the original application, appellants have failed to support these claims in the specification. The examiner states that appellants have failed to amend the specification so as to make the original claims 1, 8, and 12 commensurate with the specification. The examiner states that appellants argue that the amendment added after the last sentence on page 6, line 17 of the specification cites examples of possible materials for possible use in an integrated lead suspension, but the examiner states that appellants' amendment does not change the scope of the disclosure which cites specific embodiments with specific materials that are to be used as the support, dielectric, and conductor layer, namely stainless steel, polyimide, and copper.

We disagree with the examiner's comments regarding the amendment made to the specification as described at the bottom of page 7 of appellants' brief. As agreed by appellants and the examiner, the subject matter finds support in original claims 1, 8, and 12. Hence, the specification does support the claims.

Furthermore, the first paragraph of 35 U.S.C. § 112, with regard to enablement, requires that the specification enable a person having ordinary skill in the art to make and use the claimed invention. Also, enablement requires that the specification teach those having ordinary skill in the art to make and use the invention without "undue experimentation." In re Vaeck, 947 F.2d 488, 495-96, 20 USPQ2d 1438, 1444-45 (Fed. Cir. 1991).

Also, it is well settled that the examiner has the burden of providing a reasonable explanation, supported by the record as a whole, why the assertions as to the scope of objective enablement set forth in the specification are in doubt, including reasons why the description of the invention in the specification would not have enabled one of ordinary skill in this art to practice the claimed invention without undue experimentation, in order to establish a prima facie case under the enablement requirement of the first paragraph of § 112. In re Wright, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); In re Marzocchi, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971).

Here, the examiner does not explain why the description of the invention as set forth in the specification would not have enabled one of ordinary skill in the art to practice the claimed invention without undue experimentation.

We therefore determine that the examiner has not met the required burden as described above.

We therefore reverse the rejection of claims 1 through 18 under 35 U.S.C. §112, first paragraph (enablement).

REVERSED

JEFFREY T. SMITH Administrative Patent Judge	)
BEVERLY A. PAWLIKOWSKI Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JAMES T. MOORE Administrative Patent Judge	)

BAP/cam/dem

Andrew J. Dillon
Felsman, Bradley, Vaden, Gunter & Dillon
Lakewood on the Park 360
7600B North Capital of Texas Highway
Austin, TX 78731