

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROGER O. WILLIAMS, JIMMY D. GODWIN,
STEPHEN P. WILLIAMS, MARK E. STRYSKO,
ALTON B. OTIS and ANDREW M. ROSE

Appeal No. 96-0663
Application No. 08/253,618¹

ON BRIEF

Before THOMAS, KRASS and FLEMING, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

¹Application for patent filed June 3, 1994. According to appellants, this application is a continuation of Application 08/032,411, filed March 15, 1993, now abandoned; which is a division of Application 07/915,032, filed July 16, 1992, now abandoned; which is a continuation of Application 07/424,667, filed October 20, 1989, now abandoned.

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DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 14, 17 and 18. Claims 1 through 13, 15 and 16 have been canceled.

The invention pertains to a method for writing to very high track density as well as to conventional track density floppy disks.

Representative independent claim 14 is reproduced as follows:

14. A method for writing separated, concentric data tracks on a floppy disk with a magnetic core with a write element and no separate trim erasure elements, the method comprising:

determining whether a high-capacity floppy disk with optical servo tracks is present or a lower-capacity floppy disk without optical servo tracks is present, and if said high-capacity floppy disk is present, restricting the subsequent steps of positioning such that a subsequent step of reading or writing data is limited to data recording areas between said optical servo tracks;

positioning a magnetic core in a first radial position relative to a surface of a rotating floppy disk on a first revolution by use of both a stepper motor attached to a base carriage that carries said magnetic core on a fine position actuator attached to a voice coil motor, wherein a positioning sensor attached to said fine position actuator and a reflective pad attached to a shunt attached to a magnet that moves with said base carriage is utilized to control movement of said fine position actuator and when said fine position actuator moves relative to said reflective pad to reflect light emitted from said positioning sensor off said reflective pad to be collected by said positioning sensor and converted to a signal which controls movement of said fine position actuator, and wherein

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said reflective pad provides a linear reflectance signal over a range of approximately 0.075 inches;

creating a first erased region on said floppy disk surface by operating a write element of the magnetic core in an erase mode while the magnetic core remains in said first radial position and said floppy disk is rotated through at least part of one whole rotation of said floppy disk;

moving the magnetic core to a second radial position neighboring said first radial position on a second revolution of said floppy disk approximately two mils from said first position with said voice coil motor wherein said fine position actuator moves relative to said base carriage;

creating a second erased region longitudinally aligned with and radially displaced from said first erased region, by operating said write element in an erase mode while the magnetic core remains in said second radial position and said floppy disk is rotated through said revolution of said floppy disk;

moving the magnetic core to a third position on a third revolution of said floppy disk with said position sensor and said voice coil motor to position said fine position actuator relative to said base carriage, wherein said write element of the magnetic core is radially aligned midway between said first and second erased regions; and

writing a track of data longitudinally aligned with and between said first and second erased regions that overwrites a radial portion of both said first and second erased regions, wherein a pair of erased blank areas result on either radial side of said written data track that are each radially narrower than said written data track and separate said written data track from any adjacent data tracks.

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The examiner relies on the following references:

Bartlett et al. (Bartlett)	4,928,192	May 22, 1990 (filed Dec. 23, 1987)
Nigam	4,933,795	Jun. 12, 1990 (filed Dec. 7, 1987)
Williams et al. (Williams)	4,969,058	Nov. 6, 1990 (filed Nov. 10, 1988)

Claims 14, 17 and 18 stand rejected under 35 U.S.C. 103. As evidence of obviousness, the examiner cites Nigam, Williams and Bartlett.

Claims 14, 17 and 18 stand further rejected under obviousness-type double patenting over claim 22 of Williams in view of Nigam and Bartlett.

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

OPINION

We will not sustain the rejections in this case because it is clear to us that the examiner has failed to establish a prima facie case with respect either to obviousness or to obviousness-type double patenting.

The instant claims are drawn to fairly detailed methods. Yet the examiner has merely pointed to a few structural features of Nigam, without even pointing out to which instant claimed

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steps such features are intended to correspond, suggests that the only deficiency of Nigam is a failure to disclose magnetic recording with optical servo tracks or a dual actuator system or detecting whether a high density or low density disk is present and concludes that Williams' disclosure of an optical servo track, utilizing a dual actuator configuration, and that Bartlett's means to detect a type of disk resident in the disk drive, taken together with Nigam, would have made the subject matter of claims 14, 17 and 18 obvious, within the meaning of 35 U.S.C. 103.

Similarly, the examiner concludes that the combination of Nigam and Bartlett, taken together with claim 22 (which depends from claims 16 and 21) of Williams would have made the instant claimed subject matter obvious with regard to an obviousness-type double patenting rejection.

Appellants appear to argue that prior art describing structure cannot be properly applied against a method claim. If this is what appellants mean, we do not agree that this is always the case. There may very well be instances where the mere disclosure of a certain structure would clearly suggest a particular method. But, clearly, the instant case is not such an instance.

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Claims 14, 17 and 18 set forth, in great detail, particular methods for writing data tracks on a floppy disk. Without hereat repeating the many and varied steps included in the claimed methods, suffice it to say that in the face of such detailed method steps, the examiner may not point generally to prior art structure and conclude that the claimed methods would have been obvious. The burden, in the first instance, is with the examiner to establish a prima facie case of obviousness, whether it be with regard to 35 U.S.C. 103 or obviousness-type double patenting.

At the very least, and as a matter of fair play, the examiner should point out how he considers each and every step of the claimed methods to read on, or be suggested by, the applied references so that appellants are given an opportunity to understand the examiner's position and to respond thereto. The examiner has not done this and we will not speculate as to the correspondence between the claimed *steps* of appellants' methods and the *structure* of the applied references. The examiner has offered nothing in the way of pointing out how the prior art structures are deemed to perform the method steps, as claimed.

Even in the face of appellants' arguments in this regard, the examiner offers no response, save at page 6 of the answer,

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wherein the examiner states that he "believes the rejections should be maintained based solely on the rejections themselves as provided above."

We do not necessarily maintain that no prima facie case of obviousness under 35 U.S.C. 103 or obviousness-type double patenting of the instant claimed subject matter can be made in view of the disclosures of the applied references, only that the examiner has not done so.

Since the examiner has clearly fallen far short of making out a prima facie case of obviousness of the claimed subject matter by failing to address the specific steps of the claimed methods, we will not sustain either the rejection of claims 14, 17 and 18 under 35 U.S.C. 103 or the rejection of these claims under obviousness-type double patenting.

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The examiner's decision is reversed.

REVERSED

JAMES D. THOMAS)
Administrative Patent Judge)

ERROL A. KRASS)
Administrative Patent Judge)

MICHAEL R. FLEMING)
Administrative Patent Judge)

BOARD OF PATENT
APPEALS AND
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