

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH A. ABOAF, EDWARD V. DENISON,
JULES D. FRIEDMAN, and VINCENT N. KAHWATY

Appeal No. 1998-0261
Application No. 08/438,319

ON BRIEF

Before HAIRSTON, JERRY SMITH, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of Claims 1-8, all the claims in the application.

We affirm-in-part.

BACKGROUND

The invention is directed to a thin-film magneto-resistive magnetic recording head. Claim 1 is reproduced below.

1. A multi-element read-write magnetic recording head for recording information on a magnetic tape and for reading recorded information therefrom, said recording head comprising an equal number of associated read elements and write elements to form a two-gap recording head comprising pairs of read and write elements, said two-gap recording head further comprising a first module and a second module, said first and second modules each comprising a plurality of read and write head elements, with a first group of read and write heads configured to perform in a forward direction of movement of said magnetic tape and with a second group of read and write heads configured to perform in a reverse direction of movement of said magnetic tape, one of said modules containing an equal number of forward read heads and reverse write heads and the other of said modules containing an equal number of reverse read heads and forward write heads, to provide decoupling of reading and writing functions and to enable servoing by a given read element of a write element associated therewith.

The examiner relies on the following reference:

Schwarz	5,331,493	Jul. 19, 1994 (filed Aug. 21, 1992)
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Claims 1 and 5-8 stand rejected under 35 U.S.C. § 102 as being anticipated by Schwarz.

Claims 2-4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Schwarz.

We refer to the Final Rejection (Paper No. 6) and the Examiner's Answer (Paper No. 14) for a statement of the examiner's position and to the Brief¹ (Paper No. 13) and the Reply Brief (Paper No. 15) for appellants' position.

¹ We have not considered an initial brief filed January 23, 1997 that was determined to lack compliance with 37 CFR § 1.192(c).

OPINION

Section 102 rejection

“Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention.” RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Claims 1 and 5-8 have been rejected under 35 U.S.C. § 102 as being anticipated by Schwarz. The examiner contends that the claims read on the Schwarz embodiment of Figure 7. (See Answer, pages 2 and 3.) Appellants’ main concern with the rejection, as set forth in the Brief and Reply Brief, appears to be that the way appellants’ disclosed read and write heads are organized into “modules” is not disclosed by Schwarz.

As detailed on page 3 of the Answer, the examiner considers the claims to be anticipated because, inter alia: “One module of head assembly 80 as shown in figure 7 is read heads 82 and write heads 86. The other module in head assembly 80 is read heads 88 and write heads 84.”

The word “module” is a broad and non-specific term, generally defined with respect to electronic apparatus as “a usu. packaged functional assembly of electronic components for use with other such assemblies.” Webster’s Ninth New Collegiate Dictionary, 1990. Appellants use the term “module” in the sense of “a grouping of elements.” (See Brief, page 5.)

Appeal No. 1998-0261
Application No. 08/438,319

Claims are to be given their broadest reasonable interpretation during prosecution, and the scope of a claim cannot be narrowed by reading disclosed limitations into the claim. See In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969).

While an applicant may be his own lexicographer, during prosecution words are interpreted using their common, ordinary meanings unless the applicant has clearly defined them differently. See In re Paulsen, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994)(repeating the principle that where an inventor chooses to be his own lexicographer and gives terms uncommon meanings, he must set out the uncommon definition in the patent disclosure). See also Beachcombers Int'l, Inc. v. WildeWood Creative Prods., Inc., 31 F.3d 1154, 1158, 31 USPQ2d 1653, 1656 (Fed. Cir. 1994)("As we have repeatedly said, a patentee can be his own lexicographer provided the patentee's definition, to the extent it differs from the conventional definition, is clearly set forth in the specification."); Zletz, 893 F.2d at 321, 13 USPQ2d at 1322, "[D]uring patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed."

In the instant case, although appellants' specification refers to a particular arrangement of read and write heads in disclosed embodiments as making up particular "modules," the claims are not so

specific. As the examiner aptly notes in the Answer, the claims define the contents of the first and second module in terms of read and write head elements; the arrangement of elements as broadly claimed is no different from that found in the reference.

The non-specificity of the word “module” is underscored by comparing the disclosure of Schwarz with appellants’ arguments. Schwarz, in the description of the relevant embodiment at column 7, line 36 through column 8, line 26, refers to “read module 82” and “write module 84” depicted in Figure 7. Appellants prefer to interpret the reference as disclosing “module” 120 (see Brief, page 5), while Schwarz describes structure 120 as “head 120.”

For the foregoing reasons, we are not persuaded that the use of the word “module” in the claims distinguishes over the apparatus of Schwarz. Appellants submit another argument that refers to the last function recited in Claim 1. “Schwarz says nothing about the servoing ability of his configuration depicted in figure 7.” (Brief, page 5.)

That Schwarz says nothing about “servoing ability” is not dispositive. For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference, but this is not an “ipsissimis verbis” test. In re Bond, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). Appellants claim an apparatus; how the claim language regarding “servoing ability” may limit the structure making up the apparatus is the relevant issue. According to appellants, “same gap servoing” is permitted by improvement of the signal-to-noise ratio,

Appeal No. 1998-0261
Application No. 08/438,319

which in turn is improved by “asymmetry of the leads 22, 24 [which] minimizes both inductive and capacitive feedthrough into adjacent readers.” (Brief, page 3.) The claims at issue in the instant anticipation rejection, however, do not recite anything about “asymmetry” of leads. As such, the arguments are more specific than the claim requirements. The Claim 1 recitation “to enable servoing by a given read element of a write element associated therewith” may be interpreted as merely requiring that the recited heads are capable of having “asymmetrical” leads connected thereto.

Appellants’ specification may suggest another structural limitation related to the recited function in Claim 1. As succinctly drawn at the bottom of page 1 of the specification, the “ability to servo” may also be related to “writing with the center of read elements separated from the center of write elements.” As disclosed by Schwarz, the center of the read elements are separated from the center of the write elements in each respective set of read and write elements, in the arrangement of elements as pointed out in the examiner’s rejection. The prior art structure of Schwarz thus enables “servoing by a given read element of a write element associated therewith.”

Since appellants have not shown the examiner’s finding of anticipation to be in error, we sustain the rejection. Since appellants have not argued the limitations of dependent claims separately (see 37 CFR § 1.192(c)(7)), we sustain the Section 102 rejection of Claims 1 and 5 through 8.

Section 103 rejection

Appeal No. 1998-0261
Application No. 08/438,319

The rejection of Claims 2 through 4 under 35 U.S.C. § 103 over Schwarz is set forth on pages 4 and 5 of the Answer. Appellants contend that the examiner has used impermissible hindsight, in particular in failing to show how one skilled in the art would have been motivated to provide “asymmetrically” offset leads. (See Brief, pages 10 and 11.)

The “asymmetric” design of the leads is described at, for example, the second paragraph of page 5 of appellants’ specification. As appellants point out, “the Examiner has not cited any reference that discloses or illustrates magnetic heads with leads from the read and write elements.” (Brief, page 10.) We agree with appellants that the evidence provided by Schwarz alone is not sufficient to establish a case of prima facie obviousness of the subject matter of Claim 2. Since Claims 3 and 4 depend from Claim 2, we do not sustain the Section 103 rejection of Claims 2 through 4.

CONCLUSION

The rejection of Claims 1 and 5-8 is affirmed.

The rejection of Claims 2-4 is reversed.

Appeal No. 1998-0261
Application No. 08/438,319

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

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JERRY SMITH)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
HOWARD B. BLANKENSHIP)	
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HBB/jg

Appeal No. 1998-0261
Application No. 08/438,319

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