

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HAROLD J. HAMILTON, ERIC N. ANDERFAAS, MICHAEL A. BALDWINSON, KEITH R. BERDING, MARK A. LAUER, and TIMOTHY W. MARTIN

Appeal No. 1999-2281
Application No. 08/621,521

ON BRIEF

Before LALL, DIXON, and GROSS, Administrative Patent Judges.
GROSS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 4 through 8, 11, 12, 17 through 20, 22, 26, and 28, which are all of the claims pending in this application.

Appellants' invention relates to a hard disk drive system having an elongated flexible beam holding a transducer in sliding contact with a magnetic disk during writing and reading. The transducer contacts a portion of the disk

Appeal No. 1999-2281
Application No. 08/621,521

traveling from adjacent the mounting end of the beam substantially along a lengthwise direction of the beam. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A device for reading or writing information on a spinning, rigid magnetic storage disk, comprising:

an elongate flexure beam extending between a mounting end and a free end and including a plurality of longitudinal conductors, and

an electromagnetic transducer composed of a plurality of adjoining layers, connected to said beam adjacent to said free end and coupled to said conductors, said transducer concurrently communicating with and contacting a portion of the disk traveling from adjacent said mounting end substantially along a lengthwise direction of said beam.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Matsuura et al. (Matsuura)	5,065,271	Nov. 12, 1991
		(filed Feb. 26, 1990)
Gill et al. (Gill)	5,561,570	Oct. 01, 1996
		(effectively filed Feb. 26, 1993)

Claims 1, 4, 11, 12, 20, 22, and 28 stand rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Gill.

Claims 5, 6, 8, 18, 19, and 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gill.

Appeal No. 1999-2281
Application No. 08/621,521

Claims 1, 4 through 8, 11, 12, 17 through 20, 22, 26, and 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Matsuura in view of Gill.¹

Reference is made to the Final Rejection (Paper No. 14, mailed December 10, 1997) and the Examiner's Answer (Paper No. 22, mailed September, 14, 1998) for the examiner's reasoning in support of the rejections, and to appellants' Brief (Paper No. 19, filed April 20, 1998) and Reply Brief (Paper No. 23, filed October 26, 1998) for appellants' arguments thereagainst.

OPINION

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellants and the examiner. As a consequence of our review, we will affirm the anticipation rejection of claims 1, 4, 11, 12, 20, 22, and 28, affirm the obviousness rejection of claims 1, 4, 7, 11, 12, 17, 20, 22, and 28, and reverse the obviousness rejections of claims 5, 6, 8, 18, 19, and 26.

¹ We note that the examiner states on page 2 of the Answer that the amendments after the Final Rejection have overcome the rejection of claims 20, 22, and 26 under 35 USC § 112, second paragraph. Accordingly, this rejection is considered withdrawn.

Appeal No. 1999-2281
Application No. 08/621,521

Appellants argue (Brief, page 5) that Gill does not qualify as prior art, since the claims rejected under 35 U.S.C. § 102 are fully supported by prior U.S. Patent No. 5,041,932 to Hamilton, back to which the present application claims priority. Appellants set forth no other arguments against the anticipation rejection. The examiner asserts (Answer, page 4) that Hamilton '932 fails to disclose the orientation of the longitudinal axis of the flexure beam as recited in claim 1. Therefore, the examiner concludes that appellants are not entitled to the benefit of the filing date of the Hamilton patent. Further, the

examiner (Answer, page 4) raises an issue as to whether there is an unbroken chain back to Hamilton '932, though the examiner appears to have failed to do the requisite fact finding to support such a conclusion.

There are four conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 120. First, the second application must be an application for a patent for an

Appeal No. 1999-2281
Application No. 08/621,521

invention which is also disclosed in the first application. Second, the second application must be copending with the first application. Third, the second application must contain a specific reference to the prior application in the specification. Last, the second application must be filed by an inventor or inventors named in the previously filed application. See MPEP § 201.11.

In the present case, Hamilton is a common inventor throughout the chain of applications. Thus, the fourth condition for priority is met. In addition, each application in the chain includes a specific reference in the specification to the prior application in the chain as listed in the USPTO electronic database. Accordingly, the third condition for priority is met.

However, Application Serial No. 08/191,967 was filed February 4, 1994, almost three months after November 6, 1993, the date of abandonment of Application Serial No. 07/919,302, the

application immediately prior to the '967 application in the chain. Also, U.S. Patent No. 5,174,012 was filed December 12, 1991, almost four months after August 20, 1991, the issue date

Appeal No. 1999-2281
Application No. 08/621,521

of U.S. Patent No. 5,041,932, the application immediately prior to the '012 patent in the chain. Consequently, as there are breaks in continuity in the chain, the second condition for priority is met only back to February 4, 1994, the filing date of Application Serial No. 08/191,967.

Last, although we agree with appellants that Figure 4 of Hamilton '932 shows the claimed orientation of the flexure beam, after a review of the disclosure of Application Serial No. 08/338,394, we find that the '394 application lacks the claimed subject matter. Therefore, at best, appellants are entitled to an effective filing date of September 15, 1995, the filing date of Application Serial No. 08/528,890, the application immediately after the '394 application in the chain. Since, Gill was filed prior to September 15, 1995, the reference is valid as prior art against the present application. As appellants have provided no further arguments against the anticipation rejection, we will sustain the rejection of claims 1, 4, 11, 12, 20, 22, and 28 under 35 USC § 102.

Appeal No. 1999-2281
Application No. 08/621,521

As to the obviousness rejection of claims 5, 6, 8, 18, 19, and 26 over Gill, appellants again assert (Brief, pages 10-11)

that Gill is not prior art. We have already found above that Gill is prior art. Appellants also argue (Brief, page 11) that the examiner's motivation for modifying Gill for the number of projections used on the face of the transducer, as recited in claims 6, 8, 18, and 19, and for the dimensions recited in claims 5 and 26 is improper. In particular, the examiner states (Final Rejection, page 6) that the motivation is that the claimed limitations "would have been the obvious result of routine experimentation and optimization." Although optimization of a result effective variable would have been obvious in accordance with *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), the examiner has not indicated that the variables at issue are result effective. The examiner has failed to provide any explanation as to why such optimization would have been obvious. Therefore, the examiner has failed to establish a *prima facie* case of obviousness. Consequently,

Appeal No. 1999-2281
Application No. 08/621,521

we cannot affirm the obviousness rejection of claims 5, 6, 8, 18, 19, and 26 over Gill.

Regarding the obviousness rejection of claims 1, 4 through 8, 11, 12, 17 through 20, 22, 26, and 28 over Matsuura in view of Gill, appellants (Brief, page 10) take issue with the examiner's statement that "various differences exist between these

references and the rejected claims, yet merely states that the differences would have been the obvious result of routine experimentation and optimization." This argument relates only to claims 5, 6, 8, 18, 19, and 26. As explained above, such reasoning is improper and fails to establish a *prima facie* case

of obviousness. Therefore, we will reverse the rejection of claims 5, 6, 8, 18, 19, and 26 over Matsuura in view of Gill.

For the remaining claims appellants merely contend (Brief, page 10) that neither Matsuura nor Gill is prior art to the present claims. As indicated above, Gill is prior art. Further, the filing date of Matsuura antedates appellants' earliest priority date of September 15, 1995. Therefore,

Appeal No. 1999-2281
Application No. 08/621,521

Matsuura is also prior art to the present claims.

Accordingly, we will sustain the rejection of claims 1, 4, 7, 11, 12, 17, 20, 22, and 28.

CONCLUSION

The decision of the examiner rejecting claims 1, 4, 11, 12, 20, 22, and 28 under 35 U.S.C. § 102 is affirmed. The decision of the examiner rejecting claims 1, 4 through 8, 11, 12, 17 through 20, 22, 26, and 28 under 35 U.S.C. § 103 is affirmed as to claims 1, 4, 7, 11, 12, 17, 20, 22, and 28 and reversed as to claims 5, 6, 8, 18, 19, and 26.

Appeal No. 1999-2281
Application No. 08/621,521

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

PARSHOTAM S. LALL)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH L. DIXON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
)	
ANITA PELLMAN GROSS)	
Administrative Patent Judge)	

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Appeal No. 1999-2281
Application No. 08/621,521

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