

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WARREN COON, ALI POURDASTAN and AMANULLAH KHAN

Appeal No. 2002-1216
Application No. 09/034,466¹

ON BRIEF

Before HAIRSTON, KRASS and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1, 2, 4-7, 8 and 9-11. Claims 3 and 8 have been canceled.

We affirm-in-part.

BACKGROUND

Appellants' invention is directed generally to disk drives and more specifically, to a suspension load beam having a beam

¹ Application for patent filed March 4, 1998, which claims the filing priority benefit under 35 U.S.C. § 119 of Provisional Application No. 60/072,129, filed January 22, 1998.

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portion and a spring portion that is attached to an actuator. The junctions of the spring portion and the beam portion at the load beam perimeter has a specific shape for distributing the stress of bending the load beam.

Representative independent claim 1 is reproduced as follows:

1. A unitary load beam for a disk drive suspension, said load beam having a spring portion providing predetermined gram force properties to said load beam, said spring portion being normally bent beyond its nominal range in the course of its installation into a disk drive with adverse effect on said spring portion and a lessening of the gram force properties exerted thereby, said load beam having a perimeter and comprising a base portion unitary with the proximate end of said spring portion, and an elongated beam portion extending in a plane and wider than and unitary with the distal end of said spring portion, said beam portion having left and right edge rails, said base portion being adapted to provide a mounting surface for mounting the load beam to an actuator, the left and right junctions of said spring portion and said beam portion at said load beam perimeter having a straight portion normal to said left and right edge rails, respectively, and a radiused portion inward of said straight portion, said straight portion having a lateral extent in the plane of said beam portion that is greater than the lateral extent of said radiused portion in said plane, said radiused portion subtending an oblique angle between said beam portion and said spring portion, whereby the stress of bending said load beam spring portion beyond its nominal range is distributed such that the peak value of the stress force is less than that at which plastic deformation of the load beam spring portion occurs.

The prior art reference of record relied upon by the Examiner in rejecting the appealed claims is:

Budde

H1424

Apr. 4, 1995

Claims 9 and 10 stand rejected under 35 U.S.C. § 112, second paragraph, for being indefinite.

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Claims 1, 4, 6 and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Budde.

Claims 2, 5, 7, 10 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Budde.

We make reference to the answer (Paper No. 23, mailed June 18, 2001) for the Examiner's complete reasoning, and to the appeal brief (Paper No. 22, filed May 2, 2001) for Appellants' arguments thereagainst.

OPINION

With respect to the 35 U.S.C. § 112 rejection of claims 9 and 10², we note that the Examiner's denial to enter an amendment relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not review the issue of the entry of the amendment to claims 9 and 10³ (brief, page 11) and will sustain the 35 U.S.C. § 112 rejection pro forma.

² Claim 9 depends upon the canceled claim 8 whereas claim 10 is dependant on claim 9. Appellants in an amendment to the claims (Paper No. 19, filed February 15, 2001) have attempted to correct the dependency of claims 9 and 10 by amending them to depend on claim 7. The Examiner has denied entry of the amendment to these claims and has indicated, as noted in the advisory action (Paper No. 20, mailed February 20, 2001), that the amendment raises new issue.

³ Notwithstanding the Examiner's denial to enter the amendment to claims 9 and 10, we observe that the amendment merely makes the claims broader in scope than their original form, but does not add limitations that have not been previously presented to and considered by the Examiner.

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With respect to the 35 U.S.C. § 102 rejection of claims 1, 4, 6 and 9, the Examiner relies on Figures 1A and 1B of Budde and asserts that the shape and proportions of the connecting portion between load beam spring 12 and proximate end 14 presents the claimed "oblique angle" and lateral extent of the straight and the radiused portions (answer, pages 9 & 10). The Examiner, further provides enlarged copies of the shape of the connecting portion, apparently obtained from Figure 1B, as exhibits A and B (attached to the answer), to show the angle and the proportions of the lateral extent.

A rejection for anticipation under section 102 requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. See Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Appellants argue that there is no relevant text in Budde to describe the claimed features or the advantages of one kind of radius over another (brief, pages 11 & 12). We agree with Appellants since when the reference does not specify that the

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drawings are to scale and is silent as to dimensions, the particular claimed proportions of the radiused portion cannot be established. See Hockerson-Halberstadt, Inc. v. Avia Group Int'l, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (The disclosure gave no indication that the drawings were drawn to scale. "[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue."). See also In re Olson, 212 F.2d 590, 592, 101 USPQ 401, 402 (CCPA 1954) ("Ordinarily drawings which accompany an application for a patent are merely illustrative of the principles embodied in the alleged invention claimed therein and do not define the precise proportions of elements relied upon to endow the claims with patentability"); Manual of Patent Examining Procedure, Section 2125, eighth edition, revision 1, Feb. 2003.

There is no indication in Budde that any particular shape of the radiused portion is intended or its proportions are drawn to scale. The examiner's conclusion is based merely on speculation with respect to the shape and proportions of the connecting portion between load beam spring 12 and proximate end 14 and therefore, fails to establish a prima facie case of anticipation.

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Accordingly, the rejection of claims 1, 4, 6 and 9 under 35 U.S.C. § 102 over Budde cannot be sustained.

Regarding the 35 U.S.C. § 103 rejection of claim 5, we note the Examiner's failure to provide any teachings or suggestions for modification to overcome the deficiencies of Budde discussed above. Based on our determination that Budde does not teach the invention of base claims 1 and 6, the rejection of their dependent claims based on modifying Budde cannot be proper. Accordingly, we do not sustain the § 103 rejection of claims 2, 5, 7, 10 and 11 over Budde.

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CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 9 and 10 under 35 U.S.C. § 112, second paragraph, is affirmed but reversed with respect to the 35 U.S.C. § 102(b) rejection of claims 1, 4, 6 and 9 and the 35 U.S.C. § 103(a) rejection of claims 2, 5, 7, 10 and 11.

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
ERROL A. KRASS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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