

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte LANCE R. CARLSON,  
JEFFREY L. WHALEY and ROBERT L. METZ

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Appeal No. 2002-2009  
Application 09/843,631

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ON BRIEF

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Before THOMAS, HAIRSTON, and BARRETT, Administrative Patent Judges.  
THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 47-67.

The language in dispute common to independent claims 47 (and its dependent claims 48-62), 63, 64 and 65 relates to the following feature of these claims:

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a detection circuit that determines whether the head is within an acceptable flying height range in response to the first and second data patterns while the head is at a substantially constant flying height and independently of flying height data obtained from the disk drive at other than the substantially constant flying height.

Correspondingly, the subject matter of independent claims 66 and 67 in dispute relates to the following feature at the end of these independent claims on appeal:

a detection circuit that determines whether the head is within an acceptable flying height range in response to the first and second data patterns while the head is at a substantially constant flying height and independently of flying height data obtained from the disk drive at a predetermined flying height.

The distinctions between these common features of all these independent claims is found in the language at the end of the noted clauses relating to the disc drive head being "at other than the substantially constant flying height" and the language of the disc drive head being "at a predetermined flying height."

There are no references relied by the examiner.

Claims 47-67 stand rejected under the first paragraph of 35 U.S.C. § 112, since, in the examiner's view, the claimed subject matter was not described in the specification in such

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a manner as to reasonably convey to the artisan that the inventors, at the time the application was filed, had possession of the claimed invention.<sup>1</sup>

Rather than repeat the positions of the appellants and the examiner, reference is made to the briefs for the positions of the appellants, and to the final rejection and answer for the examiner's positions.

#### OPINION

We reverse.

The examiner's view that the appellants did not have possession of the presently claimed invention is based upon the written description requirement of 35 U.S.C. § 112, first paragraph. The manner in which the specification as filed meets the written description requirement is not material. The requirement may be met by either an express or an implicit disclosure. In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). It is permissible to add inherent properties or

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<sup>1</sup> Since the examiner has acknowledged at the top of page 5 of the answer that there is no rejection made between the so-called conflicting claims of the present application and another application, we have no jurisdiction before us to render any opinion on such a potential conflict.

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characteristics of the invention to the disclosure and claims. Kennecott Corp. v. Kyocera Int'l, Inc., 835 F.2d 1419, 1422, 5 USPQ2d 1194, 1197 (Fed. Cir. 1987), cert. denied, 486 U.S. 1008 (1988). An invention claimed need not be described in ipsis verbis in order to satisfy the written description requirement of 35 U.S.C. § 112, first paragraph. In re Lukach, 442 F.2d 967, 969, 169 USPQ 795, 796 (CCPA 1971). The question is not whether an added word was the word used in the specification as filed, but whether there is support in a specification for the employment of the word in the claims, that is, whether the concept is present in the original disclosure. See In re Anderson, 471 F.2d 1237, 1244, 176 USPQ 311, 336 (CCPA 1973).

The examiner's concerns focus upon the disputed language noted earlier at the end of each of the respective independent claims concerning the "other than the substantially constant flying height" feature of independent claims 47, 63, 64 and 65 as well as the "predetermined flying height" feature of independent claims 66 and 67. According to the embodiment shown in Figure 5, the resolution acceptability determination of the claims is made by a comparison to a threshold resolution value stored for example in memory. These stored threshold resolution values represent the resolution of the read signal at the maximum head

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flying height as noted by the examiner and discussed at pages 21 and 28 of the specification as filed. This comparison then is used to determine if the head is within a proper flying height.

Rather than being independent as required by each of the independent claims on appeal, the examiner takes the view that when determining if a flying height is within an acceptable range, the determination is therefore dependent upon known values that, according to the threshold or calibration approach, have been obtained from at least a maximum flying height. The examiner therefore concludes that the language in question in the independent claims on appeal is not supported by the written disclosure.

In reversing this rejection, we are persuaded by appellants' arguments beginning at page 6 of the brief on appeal, making particular note to the portions quoted from the specification at pages 6-8.

Based upon our study of the specification as filed, the language at the end of the first group of independent claims relating to "at other than the substantially constant flying height" and the corresponding language at the other set of independent claims relating to "at a predetermined flying height"

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is based upon the following teachings in the specification as  
filed:

wherein the determination unit does not  
require the movement of the head to a  
substantially different vertical distance  
to make the determination. [specification,  
page 4, line 25 to page 5, line 2]

...

wherein the determination does not include  
means for changing a current vertical  
distance between the head and the disk  
surface,... [specification, page 7, lines  
4-6].

We are thus in agreement with appellants' observations made  
at pages 8 and 9 of the brief which we reproduce here:

Thus, the specification makes abundantly  
clear that in this embodiment the flying  
height determination occurs while the head is  
at a substantially constant flying height by  
comparing a read signal resolution value,  
responsive to a ratio of read signals from  
the first and second data patterns, to a  
predetermined threshold resolution value  
stored in RAM. [Brief, bottom of page 8]

The specification does not somehow  
require that the predetermined threshold  
resolution value be flying height data  
obtained from the disk drive at another  
flying height, or be flying height data  
obtained from the disk drive at a  
predetermined flying height.

...

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Likewise, the specification does not somehow require that the calibration values discussed at page 28 be flying height data obtained from the disk drive at another flying height or a predetermined flying height. [Brief, top of page 9]

It is thus apparent to the reader that the functions attributed to the detection circuit at the end of the noted independent claims on appeal does perform its function independently. The appellants' observations at page 9 of the brief noted by the examiner at page 3 of the answer is misplaced to the extent the examiner takes the view that the claims must set forth language that limits the formulation or formation of threshold values during a manufacturing operation of the disk drive. Plainly, the artisan would not see that such would be a requirement of the claims when read in light of the specification as noted by us earlier in this opinion.

In view of the foregoing, the decision of the examiner rejecting claims 47-67 under 35 U.S.C. § 112, first paragraph, is reversed.

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The decision of the examiner is reversed.

REVERSED

James D. Thomas	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
Kenneth W. Hairston	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
Lee E. Barrett	)	
Administrative Patent Judge	)	

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