

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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JAMES C. CATES  
and STEVEN TRABERT

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Appeal No. 2004-0530  
Application No. 09/696,557

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ON BRIEF

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Before HARISTON, PAK and JEFFREY T. SMITH, *Administrative Patent Judges*.  
JEFFREY T. SMITH, *Administrative Patent Judge*.

***DECISION ON APPEAL***

Appellants appeal the Examiner's final rejection of claims 1 to 19, all of the pending claims in the application.<sup>1</sup> We have jurisdiction under 35 U.S.C. § 134.

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<sup>1</sup> In rendering our decision, we have considered Appellants' arguments presented in the Brief, filed June 10, 2003 and the Reply Brief, filed September 25, 2003.

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***THE INVENTION***

Appellants' claimed invention relates to a magnetic tape head assembly comprising read elements, write elements and servo readers placed asymmetrically about the center of the tape head taken perpendicular to the direction of the tape motion. According to Appellants, the invention produces a tape head that is less complex than standard tape heads. (Brief, p. 3). Claim 1 which is representative of the subject matter on appeal is reproduced below:

1. A magnetic tape head assembly comprising:  
read elements;  
write elements; and  
servo readers placed asymmetrically about the center of the tape head taken perpendicular to the direction of tape motion.

As evidence of unpatentability, the Examiner relies on the following references:<sup>2</sup>

Dee et al. (Dee)	5,963,401	Oct. 5, 1999
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Appellants' admitted prior art represented by Figure 1 and the discussion thereof appearing in the specification, pages 5 to 7.

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<sup>2</sup> Several additional references have been cited in the Answer, pages 3-4; however, the Examiner has not included these references in the statement of the rejections or provided further discussion of the references in the Answer.

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### ***THE REJECTIONS***

The Examiner rejected claims 1-6, 8, 10-16 and 18 under 35 U.S.C. § 102(b) as anticipated by Appellants' admitted prior art represented by Figure 1 and the discussion thereof appearing in the specification, pages 5 to 7; and claims 7, 9, 17 and 19 under 35 U.S.C. § 103(a) as unpatentable over the combination of Dee and Appellants' admitted prior art represented by Figure 1 and the discussion thereof appearing in the specification, pages 5 to 7. (Answer, pp. 4-6).

### ***OPINION***

Upon careful review of the respective positions advanced by Appellants and the Examiner, we find that the Examiner has failed to carry the burden of establishing a *prima facie* case of anticipation or obviousness. Consequently, we will not affirm the rejection of the claims under §§ 102 and 103. Rather than reiterate the conflicting viewpoints advanced by the Examiner and Appellants concerning the above-noted rejections, we refer to the Answer and the Briefs. We will limit our discussion to claims 1, 10 and 15 which are the independent claims.

In order for a claimed invention to be anticipated under 35 U.S.C. § 102, all of the elements of the claim must be found in one reference. *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

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Claims 1, 10 and 15 require a magnetic tape head assembly comprising read elements, write elements and servo readers placed asymmetrically about the center of the tape head taken perpendicular to the direction of the tape motion. The Examiner asserts that the prior art servo readers described in Figure 1 are placed asymmetrically about the center of the tape head taken perpendicular to the direction of the tape motion. Specifically the Examiner states that the “AAPA shows a magnetic tape head assembly 107 comprising read elements 108; write elements 109; and servo readers (110, 113 are asymmetric and 111, 112 are asymmetric), respectively, placed asymmetrically about the center of the tape head taken perpendicular to the direction of the tape motion.” (Answer, p. 4).

The Examiner’s position is contrary to Appellants’ description of Figure 1 appearing in the specification. According to the specification, Figure 1 is illustrative of a tape head data track positioning system using servo tracts and symmetric readers. (Specification, p. 1). The specification, pages 6-7, discloses “the servo readers 110-113 [of Figure 1] are placed symmetrically about the write bumps containing write elements 109 and aligned on the read bumps containing read elements 108.”

The present record indicates that tape heads comprising a sufficient number of servo readers that would provide a symmetric arrangement are excluded by the claimed

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invention. (See Specification and Briefs generally). According to the Appellants, Figures 2 and 3 are illustrative of a tape head data track positioning system using servo tracts and asymmetric servo readers. (Specification, pp. 8-9).

To determine if the prior art magnetic tape head assembly of Figure 1 is the same as the claimed invention we must look at the arrangement of the servo readers on the tape head of the prior art magnetic tape head assembly. The claimed invention requires **all of the servo readers to be placed asymmetrically** about the center of the tape head taken perpendicular to the direction of the tape motion. Looking at the center of the tape head of Figure 1 taken perpendicular to the direction of the tape motion, we determine that servo readers are symmetric, i.e., 110 and 111 are symmetric to servo readers 112 and 113 respectively. The Examiner has not directed us to evidence that all of the servo readers 110-113 are arranged asymmetrically.

The Examiner's rejection under § 103 fails for the same reasons presented above. The addition of the Dee reference does not remedy the differences between the claimed invention and the prior art depicted by Figure 1.

We note that the Examiner has not rejected the independent claims 1, 10 and 15 under § 103 over the prior art depicted by Figure 1. The Examiner has failed to address whether it would have been obvious to exclude some of the servo readers and their

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attendant functions from the magnetic tape head assembly. Nor has the Examiner established that the arrangement of the servo readers is a result effective variable, the optimization of which is well within the ambit of one of ordinary skill in the art.

### ***CONCLUSION***

Based on our consideration of the totality of the record before us, we reverse the rejections for the lack of the presentation of a *prima facie* case of anticipation and obviousness.

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**REVERSED**

KENNETH W. HARISTON  
*Administrative Patent Judge*

CHUNG K. PAK  
*Administrative Patent Judge*

JEFFREY T. SMITH  
*Administrative Patent Judge*

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