

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

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte KI-OOK PARK, IN-EUNG KIM
IN-SEOP JEONG and TAE-SEOK PARK

Appeal 2007-0112
Reissue Application 09/892,790¹
Patent 5,917,679
Technology Center 2600

Oral Argument: None²
Decided: February 12, 2007

Before: FRED E. MCKELVEY, *Senior Administrative Patent Judge*, and HOWARD B. BLANKENSHIP and ALLEN R. MacDONALD, *Administrative Patent Judges*.

McKELVEY, Senior Administrative Patent Judge.

¹ Reissue application filed 28 June 2001 seeking to reissue U.S. Patent 5,917,679, granted 29 June 1999, based on application 08/915,342 filed 22 August 1997. The real party in interest is SamSung Electronics Co., Ltd.

² Oral argument was scheduled for 21 February 2007. In preparing for oral argument, it became apparent that further action by the Examiner was required. Accordingly, oral argument was cancelled, counsel for Appellants being notified by phone 6 February 2007 of the cancellation.

1 **MEMORANDUM OPINION and ORDER**
2 **Limited Remand**
3

4 **A. Statement of the case**

5 The appeal is from a decision of the Examiner rejecting claims 21,
6 30-32 and 41 under 35 U.S.C. § 102 as being “clearly anticipated” by
7 Nepela, U.S. Patent 5,568,981, issued 29 October 1996 based on an
8 application filed 10 April 1995.

9 Nepela is prior art under 35 U.S.C. § 102(a) and 35 U.S.C. § 102(e).

10 In the answer, the Examiner states (page 4):

11 Note figure 5c. NEPELA et al shows a negative pressure
12 slider with a U-shaped air bearing platform (108) defining a
13 negative pressure cavity (not numbered—the area between the
14 two rear extending legs of the U), the U-shaped air bearing
15 platform having a cross rail portion (not numbered) and not
16 more than two separate air bearing platforms (not numbered—
17 the rear extending legs) which terminate before the rear edge of
18 the slider, the not more than two separate air bearing platforms
19 have side wall portions (not numbered), and a centered rear air
20 bearing platform (120) which mounts a transducer.
21

22 **B. Discussion**

23 We start out with the observation that it is not readily apparent to us
24 how claims 21, 30-32 and 41 are “clearly anticipated” by Nepela. Nor are
25 we sure if there is a difference is between “clearly anticipated” and
26 “anticipated.”

27 The Examiner, however, believes the claims on appeal are anticipated.
28 The Examiner no doubt is considerably more knowledgeable about the art
29 than we are. Furthermore, because of that knowledge, the Examiner may
30 have been inclined to make justified assumptions about the scope and
31 content of Nepela which we are unable to appreciate.

1 We would appreciate further input from the Examiner on precisely
2 how the Examiner sees the claims on appeal to be anticipated. Most
3 respectfully, we ask the Examiner to reproduce each of the claims on appeal
4 and after each claim limitation insert a reference to the drawing element and
5 specification (by column and lines) so that we can better appreciate how the
6 Examiner believes that all the limitations of the claims are described by
7 Nepela.

8 We call the Examiner's attention to *Ex parte Braeken*, 54 USPQ2d
9 1110 (Bd. Pat. App. & Int. 1999), for a suggested format to be followed.
10 With respect to claim 21 on appeal, the Examiner may use the following
11 format:

12 21. A negative pressure air bearing slider (col. __, line __;
13 Fig. __, element __) having a negative pressure cavity (col. __,
14 line __; Fig. __, element __), comprising:
15
16 a body with a principal surface (col. __, line __; Fig. __,
17 element __) disposed to confront a recording surface (col. __,
18 line __; Fig. __, element __) of a recording medium (col. __, line
19 __; Fig. __, element __), said principal surface having a lead
20 portion (col. __, line __; Fig. __, element __) and a rear portion
21 (col. __, line __; Fig. __, element __), said lead portion being
22 spaced upstream from said rear portion relative to a rotational
23 direction (col. __, line __; Fig. __, element __) of any recording
24 medium confronted by said slider, said lead portion having a
25 front edge (col. __, line __; Fig. __, element __), said rear portion
26 having a rear edge (col. __, line __; Fig. __, element __), said
27 front edge and said rear edge together defining boundaries (col.
28 __, line __; Fig. __, element __) of said principal surface in a
29 longitudinal direction (col. __, line __; Fig. __, element __) of
30 said slider body; and
31

1 a U-shaped air bearing platform (col. __, line __; Fig. __,
2 element __) defining a negative pressure cavity (col. __, line __;
3 Fig. __, element __) on said principal surface (col. __, line __;
4 Fig. __, element __), said U-shaped air bearing platform
5 comprising not more than two separate air bearing platforms
6 (col. __, line __; Fig. __, element __) each extending rearwardly
7 (col. __, line __; Fig. __, element __) toward said rear portion of
8 said principal surface and respectively terminating (col. __, line __;
9 Fig. __, element __) at a first rear termination (col. __, line __;
10 Fig. __, element __) and a second rear termination (col. __, line __;
11 Fig. __, element __), at least one of said not more than two
12 separate air bearing platforms including a side wall portion (col.
13 __, line __; Fig. __, element __);
14

15 at least one of said first rear termination and said second
16 rear termination not coinciding (col. __, line __; Fig. __, element __)
17 with said rear edge, and being disposed upstream (col. __,
18 line __; Fig. __, element __) of said rear edge relative to said
19 rotational direction (col. __, line __; Fig. __, element __) of said
20 recording medium.

21
22 The Examiner may use a similar format for the other four claims on
23 appeal. Based on the Examiner's discussion in the answer, it may be that
24 certain elements of the claims on appeal are not numbered in the drawings.
25 The Examiner should feel free to reproduce a copy of any relevant figure of
26 the drawings and add numbers to elements not otherwise numbered and
27 include a copy of the drawing with the response to this remand.

28 We appreciate the fact that this remand is the second remand to the
29 Examiner, the first having to do with a recapture rejection which the
30 Examiner has withdrawn. However, where possible, a proper decision on
31 the merits is to be achieved and we are confident we will be able to better

Appeal 2007-0112
Application 09/892,790

1 appreciate how Nepela is believed to anticipate the claims after we receive
2 what we expect will be valuable input from the Examiner.

3

4 **C. Order**

5 Upon consideration of the record on appeal, and for the reasons given,
6 it is

7 ORDERED that the appeal is remanded to the Examiner for
8 action not inconsistent with views expressed in this opinion.

9 FURTHER ORDERED that except as otherwise expressly
10 provided herein, the Board retains jurisdiction over the appeal.

11 FURTHER ORDERED that within **one (1) month** of the date
12 the Examiner enters a response to this remand, Appellants may file a paper
13 (not to exceed 10 pages) addressing the Examiner's response.

14 FURTHER ORDERED that oral argument scheduled for
15 21 February 2007 is cancelled and will be reset in due course.

16 FURTHER ORDERED that, unless otherwise ordered, the
17 provisions of 37 C.F.R. § 1.136(a) (2006) are not applicable to further
18 proceedings involving the application on appeal.

19
20 McK/lp

21
22 cc (via First Class Mail):

23
24 Robert E. Bushnell, Esq.
25 1522 "K" Street, N.W., Suite 300
26 Washington, D.C. 20005
27
28 Tel: 202-408-9040