

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUYOSHI KOBAYASHI,
KENJI IKEDA AND
MASAYUKI FUJIMOTO

Appeal 2006-2449
Application 10/221,869
Technology Center 1700

Decided: October 31, 2007

Before BRADLEY R. GARRIS, CHUNG K. PAK, and
CATHERINE Q. TIMM, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 3-11 and 28-35. We have jurisdiction under 35 U.S.C. § 6.

We AFFIRM.

Appellants claim a granular magnetic thin film of non-oxidized magnetic metal grains enclosed by insulating material. Appellants also claim a method of manufacturing such a film.

Representative claims 3, 4, and 9 read as follows:

3. A granular magnetic thin film characterized in that an insulating material is present around grain boundaries so as to enclose magnetic grains, and that said magnetic grains are grains of non-oxidized magnetic metal.

4. A granular magnetic thin film characterized in that an insulating material is present around grain boundaries so as to enclose magnetic grains of a magnetic metal of a nature such that a spectral peak of an oxide of said magnetic metal is not observable by a measurement made by an X-ray photoelectron spectroscopy.

9. A method of manufacturing a granular magnetic thin film characterized by the steps of preparing a magnetic metal target and an insulating material target, respectively, sputtering said targets simultaneously in a nonoxidizing atmosphere, and forming on a substrate a thin film in which an insulating material is present around grain boundaries so as to enclose magnetic grains.

The references set forth below are relied upon by the Examiner as evidence of unpatentability.

Akinaga (as translated)	JP 2000-340425	Aug. 12, 2000
Funayama	6,606,225 B1	Aug. 12, 2003
Litvinov	6,630,255 B1	Oct. 7, 2003

Claims 3 and 28 are rejected under 35 U.S.C. § 102(b) as being anticipated by Akinaga or under 35 U.S.C. § 102(e) as being anticipated by Litvinov.

Claims 3, 9-11, and 28 are rejected under 35 U.S.C. § 102(e) as being anticipated by Funayama.

Claims 4-7, 29-32, 34, and 35 are rejected under 35 U.S.C. § 102(e) as being anticipated by, or alternatively under 35 U.S.C. § 103(a) as being obvious over, Funayama.

Finally, claims 8 and 33 are rejected under 35 U.S.C. § 103(a) as being obvious over Funayama.

The dispositive issue in this appeal is whether Appellants have established error on the Examiner's part in finding that each of Akinaga, Litvinov and Funayama anticipatorily discloses magnetic thin films which include non-oxidized magnetic metal grains and a method for manufacturing such thin films.

As correctly found by the Examiner, all of the aforementioned references expressly teach specific magnetic metal compounds which do not include oxygen as a component thereof (Akinaga: Abstract, claim 4; Litvinov: col. 3, ll. 21-23 and claim 7; Funayama: col. 7, ll. 41-64). We are unpersuaded by Appellants' argument for novelty (Br. 5) because it is based on the legally erroneous proposition that the references must expressly describe their magnetic compounds with the "non-oxidized" adjective recited in, for example, claim 3. It is well settled that a reference does not fail as an anticipation merely because it does not contain a description of the subject matter of the appealed claims in *ipsissimis verbis*. *In re May*, 574 F.2d 1082, 1089 (CCPA 1978).

For the above stated reasons, we fully agree with the Examiner's finding that claims 3 and 28 are anticipated by each of Akinaga, Litvinov, and Funayama.

We also agree with the Examiner's finding that method claim 9 is anticipated by Funayama. Although Appellants may be correct that

Funayama discloses embodiments wherein oxygen may be present in the sputtering atmosphere, this does not negate the embodiments wherein oxygen is not in the sputtering atmosphere (col. 7, ll. 41-64).

For the above stated reasons, we hereby sustain the Examiner's § 102 rejections of claims 3 and 28 are being anticipated by either Akinaga or Litvinov and of claims 3, 9-11, and 28 as being anticipated by Funayama.

We additionally sustain the § 102 and § 103 rejections of claims 4-7, 29-32, 34, and 35 over Funayama. There is no persuasive merit in Appellants' argument that Funayama's process does not necessarily produce non-oxidized grains and accordingly does not inherently produce such grains wherein the spectral peak of an oxide of the magnetic metal is not observable as recited by claims 4 and 29. As explained previously, Funayama expressly discloses embodiments wherein the magnetic grain compounds contain no oxygen. Under these circumstances, it is reasonable to require that Appellants prove Funayama's afore-noted compounds do not necessarily or inherently possess the non-oxidized and spectral peak features of the here rejected claims. *See In re Best*, 562 F. 2d 1252, 1255-56 (Fed. Cir. 1996). On this record, Appellants have proffered no such proof.

Finally, the § 103 rejection of claims 8 and 33 over Funayama will be sustained since the only arguments advanced against this rejection are those considered above and determined to be unpersuasive (Br. 11).

Appeal 2006-2449
Application 10/221,869

The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(vi)(effective Sept. 13, 2004).

AFFIRMED

cam

MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096