

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 KAI WU, TAMON KASAJIMA,
MASASHI SHIRAISHI, and PING SHANG

Appeal No. 2007-0936
Application No. 10/455,507
Technology Center 2600

Decided: June 19, 2007

Before JAMES D. THOMAS, LEE E. BARRETT, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's Final Rejection of claims 10-21. We have jurisdiction under 35 U.S.C. § 6(b) (2002). Claims 1-9 have been cancelled.

We AFFIRM.

ISSUE

The principal issue before us is whether Appellants have shown the Examiner erred in rejecting claims 10-21 based on anticipation. More particularly, we decide the following issue we have determined is dispositive in deciding this appeal:

The sole issue in dispute with respect to independent claims 10 and 16 is whether Imamura discloses “*a load beam having a rigid body, a proximal and a distal end, and a spring region between the proximal end and the rigid body*” (disputed claim language shown in italics).

STATEMENT OF LAW (Anticipation)

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharm.*, 432 F.3d 1368, 1375-76, 77 USPQ2d 1321, 1325-26 (Fed. Cir. 2005) (citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992)).

Arguments and Rejection

Appellants note that the Examiner has read the claimed “load beam” on Imamura’s “carriage 5” (*see* Imamura, Figs. 3 and 4A). Appellants assert that “carriage 5” of Imamura is not a “load beam” (Br. 4). Appellants further note the Examiner has read the claimed “spring region” on Imamura’s “access arm 2” [i.e., the area on each side of the trapezoidal region, as shown in Figs. 3 and 4A] (Br. 5). Appellants contend the area on each side of “access arm 2” is not a spring region. Appellants argue there is

no mention in Imamura of the trapezoidal area (i.e., the area of “access arm 2”), or any equivalent as having spring-like capabilities (Br. 6).

The Examiner disagrees. The Examiner argues that the Webster’s Dictionary definition of the word “spring” supports the rejection (i.e., where the dictionary definition of “spring” broadly corresponds to “elasticity” or “resilience”). The Examiner argues that Imamura’s trapezoidal-hole region inherently exhibits the property of “resilience” and thus has spring-like capabilities. The Examiner notes that the amount of resilience contained in the claimed “spring region” is not defined in the Specification nor depicted in the instant drawings. Therefore, the Examiner concludes that the language of the claim broadly encompasses Imamura’s trapezoidal-hole area when the recited “spring region” is properly construed in light of the Specification (Answer 6).

In the Reply Brief, Appellants argue that the dictionary definition of the term “spring” is not relevant to the instant invention. Instead, Appellants note that the claims expressly recite a “spring region,” as described in embodiments of the instant invention. Appellants specifically disagree with the Examiner’s assertion that any material with properties of resilience is the equivalent of a “spring region,” as claimed. Instead, Appellants submit that the term “spring region” is “easily understood by one of ordinary skill in the art, and therefore requires no further clarification” (Reply Br. 2-3).

ANALYSIS

We begin our analysis by construing the claim term “spring region” by applying the broadest reasonable interpretation consistent with the Specification. *See In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664,

1667 (Fed. Cir. 2000) (“during examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.”). However, in the instant case, when we look to the Specification for *context*, we find no express or implied definition for the claimed “spring region.” Instead, Appellants broadly disclose “[t]he proximal end of the load beam includes a base plate and a *spring region* nearby on the load beam” (Specification 4, ll. 12-13, emphasis added). In describing the related art, Appellants reveal that prior art disk drives have “a spring region near the base plate on the load beam, the thickness of which is thinner than that of other areas, producing a force to help maintain the flying SLD [slider] stability” (Specification 2, ll. 2-4).

After carefully considering the evidence before us, we agree with the Examiner that “*a load beam having a rigid body, a proximal and a distal end, and a spring region between the proximal end and the rigid body*” broadly but reasonably reads on the Imamura reference. We agree with the Examiner that the amount of resilience contained in the claimed “spring region” is not defined in the Specification nor depicted in the instant drawings. In particular, we find Appellants have disavowed that any material with resilient properties is the equivalent of a “spring region” (*see* Reply Br. 2, i.e., “Just because a material may display resilience does not mean it is the equivalent of a spring region as described in embodiments of the present application”). While Appellants have argued that the term “spring region” is “easily understood by one of ordinary skill in the art,” we nevertheless find Appellants have failed to provide sufficient evidence in the record to conclusively establish the plain meaning of the disputed term (*see* Reply Br. 3, ¶ 2).

We acknowledge that Appellants have disclosed prior art disk drives having “a spring region near the base plate on the load beam, *the thickness of which is thinner than that of other areas*, producing a force to help maintain the flying SLD [slider] stability” (*see* Specification 2, ll. 2-4, emphasis added). However, we decline to read limitations associated with the *prior art* into the instant claims. We note that patentability is based upon the claims. “It is the claims that measure the invention.” *SRI Int’l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fed. Cir. 1985) (en banc).

Here, we find the claimed “load beam” broadly but reasonably reads on the substantially similar structure of “carriage 5,” as shown in Imamura’s Figs. 3 and 4A. Specifically, we find that Imamura’s “carriage 5” has a rigid body section (i.e., between the trapezoidal hole and the side that attaches to support spring 3), a proximal end near “shaft 6,” and a distal end at the “carriage 5” end that attaches to “support spring 3” (*see* Imamura, Figs. 3 and 4A).

We further agree with the Examiner that the instant claimed “spring region” broadly but reasonably reads on the substantially similar structure of “access arm 2,” as shown in Imamura’s Figs. 3 and 4A. Indeed, when we again look to the Specification for *context*, we find that Appellants “radius or spring region 22” (Fig. 4.1) is located in the same region as Imamura’s “access arm 2” (Fig. 3), i.e., adjacent to the sides of the hole shown in both Appellants’ Fig. 4.1 and Imamura’s Fig. 3. We further note that Appellants disclose the “rigid body 23” portion of “load beam 30” is located between the hole section and “distal end 25” (*see* instant Fig. 4.1). That is, the region defined by the hole in Inamura is arguably a “spring region” for the same reason the region defined by the hole in Appellants’ invention is a spring

region because the hole reduces the stiffness of the load beam in that region. Therefore, we agree with the Examiner that Imamura discloses an equivalent structure (as clearly shown in Figs. 3 and 4A). Because we find that Imamura discloses a “spring region between the proximal end and the rigid body [of the load beam],” we will affirm the rejection of independent claims 10 and 16.

Dependent claims 11-15 and 17-21

We note that Appellants have not presented any substantive arguments directed separately to the patentability of dependent claims 11-15 and 17-21. In the absence of a separate argument with respect to the dependent claims, those claims stand or fall with the representative independent claim. *See In re Young*, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). Therefore, we will affirm the Examiner’s rejection of claims 11-15 and 17-21 as being anticipated by Imamura for the same reasons discussed *supra* with respect to independent claims 10 and 16.

CONCLUSION

The rejection of claims 10-21 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)(1)(iv).

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AFFIRMED

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