

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEISHI OHASHI

Appeal No. 95-0800
Application 07/840,276¹

ON BRIEF

Before and THOMAS, FLEMING and CARMICHAEL, ***Administrative Patent Judges***.

CARMICHAEL, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-10, which constitute all the claims remaining in the application.

¹ Application for patent filed February 24, 1992. According to appellant, this application is a continuation-in-part of Application 07/707,439 filed May 28, 1991, now abandoned, which is a continuation of Application 07/316,834 filed February 28, 1989.

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Claim 1 reads as follows:

1. A thin film magnetic head which comprises $2n$ (n being an integer of not less than 1) spiral patterns formed by a selective plating method, n spiral patterns out of the $2n$ spiral patterns being connected in series so that a first connecting terminal and an intermediate connecting terminal are formed to thus give a first coil, the remaining n spiral patterns out of the $2n$ spiral patterns being connected in series so that one end thereof is connected to the intermediate connecting terminal and the other end serves as a second connecting terminal to thus give a second coil, wherein the $2n$ spiral patterns are formed on n layers and each layer has two spiral patterns formed on the same layer, one of which is a component of the first coil and the other of which is a component of the second coil.

The Examiner's Answer cites the following prior art:

Romankiw et al. (Romankiw)	4,295,173	Oct. 13, 1981
Takahashi	4,416,056	Nov. 22, 1983
Jones, Jr. et al. (Jones)	4,713,711	Dec. 15, 1987

OPINION

The claims stand rejected under 35 U.S.C. § 102 as anticipated by Takahashi and under 35 U.S.C. § 103 as unpatentable over Jones in view of Romankiw.

Anticipation by Takahashi

Appellants argue that Takahashi does not have "two spiral patterns formed on the same layer" as recited in the claims. The examiner argues that one "layer" may be broadly interpreted to include multiple layers that are partially in the same plane. We agree with appellants.

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Claims undergoing examination are given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims. *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (in banc).

In the present case, the examiner's interpretation of "layer" is broader than is reasonable. Therefore, we will not sustain this rejection.

Obviousness over Jones in view of Romankiw

The examiner says that one of skill in the art would have been motivated by Romankiw to make each of Jones' coils bifilar to provide a more balanced center tap. However, Jones' center tap is between upper and lower windings, not within a single winding.

The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992).

In this case, we are not convinced that the examiner has established such a suggestion. Therefore, this rejection will not be sustained.

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NEW GROUNDS OF REJECTION UNDER 37 CFR § 1.196(B)

Claims 1, 3-5, and 7-10 are hereby rejected under 35 U.S.C. § 102 as anticipated by Romankiw. With n = 1, these claims cover a one-layer bifilar winding such as disclosed by Romankiw in Figure 1B.

CONCLUSION

The examiner's rejections of Claims 1-10 are not sustained. A new ground of rejection is entered against Claims 1, 3-5, and 7-10.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so

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rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED - 37 CFR § 1.196(B)

JAMES D. THOMAS)	
Administrative Patent Judge)	
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MICHAEL R. FLEMING)	BOARD OF PATENT
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