

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASANORI IWABUCHI

Appeal No. 1996-4190
Application 08/311,710

HEARD: FEBRUARY 10, 2000

Before KRASS, LALL and GROSS, Administrative Patent Judges.

LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection¹ of claims 8 to 15. Claims 1 to 7 are canceled.

¹ An amendment after the final rejection was filed as paper no. 18 and was entered in the record for the purposes of this appeal.

The invention relates to a magnetic disk drive which records and reproduces data onto/from a magnetic medium by moving a magnetic head mounted on an actuator arm over the medium. More particularly, the invention is directed to a mechanism for fixing the head in place when the disk drive is not operated. A magnetic body is located on the end of the actuating arm away from the head. As the arm moves, when operating, the magnetic body defines a planar locus of points. A magnet is located on a base and is spaced apart from the magnetic body in a direction perpendicular to said planar locus of points. The magnetic body, and hence the arm carrying the head, is held in a fixed place by the magnetic field of the magnet, without a physical contact between the body and the magnet. The invention is further illustrated by the following claim. Representative claim 8 is reproduced as follows:

8. A structure for fixing a magnetic head which records or reproduces data in or out of a medium having a recording area and a parking area, said structure comprising:

- a base on which the medium is mounted;
- an arm holding the magnetic head over the medium;
- movable means for moving said arm;

Appeal No. 1996-4190
Application 08/311,710

a member mounted on said arm;

a magnetic body mounted on said member and movable through a planar locus of points as said arm moves;

a magnet fixed to said base for attracting said magnetic body and spaced apart from said magnetic body in a direction perpendicular to a plane containing said planar locus of points, said magnetic body standing closest to said magnet when the magnetic head is positioned over the parking area of the medium, said magnet being magnetized perpendicularly to said plane containing said planar locus of points; and

a yoke mounted on said magnet for absorbing magnetic lines of force issuing from said magnet.

The Examiner relies on the following reference:

| | | |
|------------------|-----------|--|
| Sun et al. (Sun) | 5,003,422 | Mar. 26, 1991 |
| Stefansky | 5,170,300 | Dec. 8, 1992 (filed: Jan. 22, 1991) |

Claims 8 to 9 stand rejected under 35 U.S.C. § 102 over Sun or Stefansky. Claims 10 to 15 stand rejected under 35 U.S.C. § 103 over Sun or Stefansky.

Rather than repeat the positions and the arguments of Appellant or the Examiner, we make reference to the briefs² and the answer for their respective positions.

² A reply brief was filed as paper no. 29 and was entered in the record without any further response by the Examiner [paper no. 31].

Appeal No. 1996-4190
Application 08/311,710

OPINION

We have considered the rejections advanced by the Examiner. We have, likewise, reviewed Appellant's arguments against the rejections as set forth in the briefs.

It is our view, after consideration of the record before us,

that the rejections under 35 U.S.C. § 102 and under 35 U.S.C. § 103 are not proper. Accordingly, we reverse.

Now we analyze the various rejections.

Rejections under 35 U.S.C. § 102

The Examiner has rejected claims 8 and 9 as being anticipated by Sun or Stefansky.

We note that a prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)).

We first take the independent claim 8. The critical issue

Appeal No. 1996-4190
Application 08/311,710

in determining the propriety of the rejection is the interpretation given by the Examiner to the phrase "a magnet fixed to said base for attracting said magnetic body and spaced apart from said magnetic body in a direction perpendicular to a plane containing said planar locus of points ..." (Claim 8). The Examiner contends [answer, pages 10 and 11]:

In marked up figure 4 of Sun et al. [copy attached to the brief], the plane is shown as a horizontal line. Following the direction perpendicular to that line ... reveals the space defined by the two vertical lines and the magnetic body and the magnet are spaced apart in this direction In other words, the magnet and the magnetic body are not contacting each other in this direction. There is space between them in this direction.

Appellant argues [brief, page 6]:

[T]he magnet is fixed to a base and spaced apart from the magnetic body in a direction perpendicular to a plane containing the locus of points through which a [sic, the] magnetic body moves. This results in the magnetic body being able to move over the magnet.

We agree with the interpretation given by Appellant for two reasons. First, the interpretation by the Examiner is not logical because the term "direction" defines a line, and not a plane as the Examiner interprets it. Therefore, the phrase

Appeal No. 1996-4190
Application 08/311,710

"in a direction perpendicular to a plane" means it is along a line which is perpendicular to the plane of locus of the movement of the magnetic body, i.e., along a vertical line. Thus, if the locus plane is horizontal, the claim calls for the magnet and the magnetic body to be located in two different horizontal planes which are spaced apart in the vertical direction. Secondly, the disclosure [figures 2A, 2B and 5 through 9] clearly shows that the magnet and the magnetic body are located in two separate horizontal planes, vertically spaced apart, such that the magnetic body does not physically come in contact with the magnet as it moves in its horizontal plane. Looking at the applied prior art, neither Sun nor Stefansky meets this "spaced apart..." limitation of claim 8. Therefore, we do not sustain the anticipation rejection of claim 8, and its dependent claim 9, over Sun or Stefansky.

Rejections under 35 U.S.C. § 103

Claims 10 to 15 are rejected as being obvious over Sun or Stefansky.

As a general proposition in an appeal involving a rejection under 35 U.S.C. § 103, an Examiner is under a burden

Appeal No. 1996-4190
Application 08/311,710

to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The Examiner has offered [answer, pages 4 to 9] a detailed explanation of the obviousness rejection over Sun or Stefansky. However, we find a fatal flaw in the approach taken by the Examiner. Each of these claims contains a limitation corresponding to the limitation we have discussed above, i.e., "a magnet fixed to said base for attracting said magnetic body and spaced apart from said magnetic body in a direction perpendicular to a plane containing said planar locus of points ..." We note that our finding above in regard to claim

Appeal No. 1996-4190
Application 08/311,710

8 equally applies here. Consequently, the obviousness rejection of claims 10 to 15 over Sun or Stefansky also falls for the same reasons. In conclusion, we reverse the Examiner's final rejection of claims 8 to 9 under 35 U.S.C. § 102 over Sun or Stefansky. Further, we reverse the obviousness rejection under 35 U.S.C. § 103 of claims 10 to 15 over Sun or Stefansky.

REVERSED

| | | |
|-----------------------------|---|-----------------|
| ERROL A. KRASS |) | |
| Administrative Patent Judge |) | |
| |) | |
| |) | |
| |) | |
| PARSHOTAM S. LALL |) | BOARD OF PATENT |
| Administrative Patent Judge |) | APPEALS AND |
| |) | INTERFERENCES |
| |) | |
| |) | |
| ANITA PELLMAN GROSS |) | |
| Administrative Patent Judge |) | |

Sughrue, Mion, Zinn, MacPeak & Seas
2100 Pennsylvania Avenue, NW
Washington, DC 20037-3202

Appeal No. 1996-4190
Application 08/311,710

psl/ki