

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

Paper No. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YU-EN PERCY CHANG
YURI IGOR MARKEVITCH and SCOTT THOMAS

Appeal No. 2002-0471
Application 09/277,862

ON BRIEF

Before WARREN, JEFFREY T. SMITH and MOORE, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellants, in the brief, and based on our review, find that we cannot sustain the rejections of appealed claims 1, 3 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Deshpande et al. (Deshpande) in view of Toyoda et. al. (Toyoda); of appealed claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Deshpande in view of Toyoda further in view of Strom; and of appealed claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Deshpande in view of Toyoda further in view of Suenaga et al.^{1, 2}

¹ Appealed claims 1 through 5 are all of the claims in the application.

² Answer, pages 3-5.

In order to establish a *prima facie* case of obviousness, the examiner must show that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in this art would have led that person to the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellants' disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988). The requirement for objective factual underpinnings for a rejection under § 103(a) extends to the determination of whether the references can be combined. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002), and cases cited therein.

As an initial matter, we find that, when considered in light of the written description in the specification as interpreted by one of ordinary skill in this art, *see, e.g., In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), the plain language of appealed claim 1 encompasses a method for producing positive camber on the air bearing surface (ABS) of a slider comprising at least the specified three steps, the first of which is "scribing lines on the air bearing surface side of a slider row between individual sliders in the slider row." The dispute in this appeal centers on whether one of ordinary skill in this art would have found in the combined teachings of Deshpande and Toyoda the reasonable suggestion to modify the process of Deshpande by inserting the step of scribing lines of the ABS side of a slider row in the manner taught by Toyoda in the reasonable expectation of producing positive camber on the ABS of an individual a slider.

The examiner takes the position that because Toyoda teaches scribing lines on the ABS side of a slider row as well as on the reverse or back side thereof in the language "[s]cribe lines may be formed in only one surface in place of forming them in both the [ABS] and [back side] surfaces" and "[f]or example, scribe lines 4 are formed in only the" back side (col. 4, lines 17-60), this disclosure would have reasonably suggested to one of ordinary skill in this art to form scribe lines solely on the ABS side of the slider row (answer, page 3). Based on this

disclosure, the examiner concludes that one of ordinary skill in this art would have modified the method of Deshpande by scribing lines on the ABS side of the slider row with the expectation of reducing “surface stress along the scribe lines in order to reduce deformation along the length of the slider row . . . because both references teach similar processes and end-products” (*id.*, pages 3-4).

Appellants submit that the method of Deshpande includes a step for producing stress on the back side of the slider row but not on the ABS side thereof and does not teach the manner in which the slider row is separated or diced into individual sliders, and that “Toyota specifically teaches that to achieve positive camber on a slider, the back side of the slider should be scribed” (brief, pages 4-5). Thus, appellants argue that “[t]he combined teachings of Deshpande and Toyota would teach one skilled in the art to scribe lines on the back side of the slider to achieve positive camber,” and therefore the claimed method including the step of scribing the ABS side is not rendered obvious by the combination of references (*id.*, page 5).

The examiner responds that Toyota teaches “producing a stress pattern on the ABS side of the slider by forming scribed lines (col. 4, lines 20-42)” (answer, page 6), and because this reference teaches forming scribe lines on both the ABS side and the back side, and, “[f]or example,” on only the back side, the reference as a whole would have suggested forming scribe lines on the ABS surface as well (*id.*, pages 6-7). We note here that in the passage cited by the examiner, Toyota discusses a method wherein both the ABS side and the back side of the slider row are scribed.

It is well settled that a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom, *see In re Fritch*, 972 F.2d 1260, 1264-65, 23 USPQ2d 1780, 1782-83 (Fed. Cir. 1992); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968), presuming skill on the part of this person. *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). The difficulty that we have with the examiner’s position is that while one of ordinary skill in this art would have reasonably inferred from the cited passage in Toyota that scribe lines can be formed only on the ABS side of the slider row, *see generally, In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976) (“The fact that neither of the references expressly discloses

asymmetrical dialkyl moieties is not controlling; the question under 35 USC 103 is not merely what the references expressly teach, but what they would have suggested to one of ordinary skill in the art at the time the claimed invention was made.”), the examiner has not set forth on this record a scientific explanation of the result on the slider row and subsequently on each individual slider diced therefrom, that one of ordinary skill in this art would have reasonably expected from scribing only the ABS side of the slider row with respect to producing positive camber on the ABS of a slider. Indeed, the bare allegation of similarity in processes and products does not establish the steps that one of ordinary skill in the art would have performed on a slider row scribed only on the ABS side following the teachings of Toyoda or how such steps according to Toyoda would have suggested the modification of the steps of the method of Deshpande necessary to incorporate the step of scribing of the ABS side of the slider row. As appellants point out, Toyoda only discloses that scribing the back side of the slider row will result in positive camber.

Accordingly, on this record, we agree with appellants that the result of combining the teachings of Deshpande and Toyoda is a step of scribing the back side of a slider row, which, of course, does not result in method that meets the limitations of appellants’ claims. *See Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-54, 5 USPQ2d 1434, 1438-41 (Fed. Cir. 1988). Thus, we reverse the grounds of rejection advanced on appeal, all of which are based on the combined teachings of Deshpande and Toyoda.

The examiner’s decision is reversed.

Other Issues

We suggest that any further prosecution of the appealed claims before the examiner further include consideration of the transitional term “comprising,” *see generally, In re Baxter*, 656 F.2d 679, 686-87, 210 USPQ 795, 802-03 (CCPA 1981) (“As long as one of the monomers in the reaction is propylene, any other monomer may be present, because the term ‘comprises’ permits the *inclusion* of other steps, elements, or materials.”), with respect to whether the same would open the appealed claims to encompass methods which include the additional step of scribing the back side of the slider row and, if so, whether the combined the teachings of Deshpande and Toyoda (col. 4, lines 20-42) apply to such claimed embodiments.

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