

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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ELLIS T. CHA

Appeal No. 2002-2300
Application No. 09/186,212

ON BRIEF

Before COHEN, ABRAMS, and McQUADE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 7, 8, 13 and 14.¹

We AFFIRM.

¹Appeal was taken from the final rejection of claims 1-18. However, in the Answer the examiner indicated that claims 3-6, 9-12 and 15-18 now are objected to as being dependent upon a rejected claim, but would be allowable if rewritten in independent form. This leaves claims 1, 2, 7, 8, 13 and 14 before us on appeal.

BACKGROUND

The appellant's invention relates to a subambient air bearing slider for use in disk drives. An understanding of the invention can be derived from a reading of exemplary claim 1, which has been reproduced below.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Strom <u>et al.</u> (Strom)	5.062,017	Oct. 29, 1991
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Claims 1, 2, 7, 8, 13 and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Strom.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the Answer (Paper No. 13) for the examiner's complete reasoning in support of the rejections, and to the Supplemental Brief (Paper No. 12)² for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

²The original Appeal Brief (Paper No. 10) was considered by the examiner to be defective (Paper No. 11), which resulted in the filing of the Supplemental Brief.

The guidance provided by our reviewing court with regard to the matter of anticipation is as follows: Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See, for example, In re Paulsen, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). Anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference. See Verdegaaal Brothers Inc. v. Union Oil Co. of California, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987). Nor does it require that the reference teach what the applicant is claiming, but only that the claim on appeal "read on" something disclosed in the reference, *i.e.*, all limitations of the claim are found in the reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984).

There is no dispute that Strom is directed to a subambient pressure air slider. Using the language of claim 1 as a guide, the Strom slider illustrated in Figure 11 comprises a slider body (110) defined by a leading edge (121) and two side edges extending longitudinally along the slider body having an air bearing surface including a lead portion (120) and first and second rails (116 and 118) coupled together via the lead portion. Each of the first and second rails include a neck portion (132 and 138;

defined by parallel edges at 126 and 128) and a rear portion (134 and 140), with the rear portion having a width greater than the neck portion. The lead portion and the first and second rails form a subambient pressure region (122; column 8, lines 4 and 5) in between the first and second rails when the slider body flies above a moving recording medium. Each rear portion “includes” an inside rail edge facing the subambient pressure area (the widening inside edges that originate at the rear terminuses of the parallel edges which define the neck portions and terminate at the parallel edges which define the rearmost section of the rear portion), such that each of the inside rail edges forms an angle greater than 0° with a longitudinal axis of the slider. There also is a first secondary structure (125) that has a height less than the height of the first and second rails and is disposed adjacent to one of the inside rail edges.

All of the language recited in claim 1 therefore “reads on” structure in Strom, and thus the reference anticipates the claim.

The appellant’s arguments presented on pages 3 and 4 of the Supplemental Brief do not persuade us that by the analysis set forth above is defective for, as we stated above, the rear portion of each of the rails appears clearly to have a width greater than the neck portion, and secondary structure meeting the terms of the claim is present. The argument that the appellant’s bearing slider is “stiffer” than that of Strom appears to be predicated upon limitations that are not present in claim 1, and thus fails at the outset. See In re Self, 671 F.2d 1344, 213 USPQ 1 (CCPA 1982).

We therefore will sustain the examiner's rejection of claim 1, as well as the like rejection of claims 2, 7, 8, 13 and 14, which the appellant has chosen to group with claim 1 (Supplemental Brief, page 3).

CONCLUSION

The rejection of claims 1, 2, 7, 8, 13 and 14 as being anticipated by Strom is sustained.

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 CFR § 1.136(a).

AFFIRMED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
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