

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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN D. WILSON
and BRUCE D. EMO

Appeal No. 96-1856
Application 08/193,324¹

ON BRIEF

Before THOMAS, HAIRSTON and MARTIN, Administrative Patent
Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's
final rejection of claims 1-3 and 11-15.

¹ Application for patent filed February 8, 1994.

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Representative claim 11 is reproduced below:

11. A method of conditioning a magnetic read/write head adapted for use with a storage medium, said method comprising the steps of:

causing said head to perform an operation on a first sector of a track on a storage medium;

determining whether said first operation resulted in an error; and

if said error occurred, moving said head to a remote position relative to said storage medium and

again causing said head to perform said operation on said track of said storage medium.

The following references are relied on by the examiner:

Obrea	4,837,702	June 6,
1989		
Supino, Jr. et al. (Supino)	5,053,892	Oct. 1,
1991		

Claims 11-15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Supino. This reference, in combination with Obrea, is utilized within 35 U.S.C. § 103 to reject claims 1-3.

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Rather than repeat the arguments of the appellants and the examiner, reference is made to the brief, the final rejection and the answer for the respective details thereof.

OPINION

We reverse each rejection essentially for the reasons set forth by the appellants in the brief on appeal.

Turning first to the rejection of independent claim 11, the pertinent language of claim 11 that is in dispute is "moving said head to a remote position relative to said storage medium." As to this rejection, we find ourselves in essential agreement with appellants' position set forth at pages 5 and 6 of the brief on appeal. Therefore, we do not agree with the examiner's view that Supino's diagnostic inner tracks 48 may be said to comprise a remote position relative to said storage medium. Appellants' position as argued is consistent with the disclosed invention, including the more specific recitation of the remote position in claim 11 as defined in claim 12 as the remote rest position, which is position 50 in Figure 1 of the disclosed invention.

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Interpreting the language of claim 11 alone, the claim does not recite that the movement of the head occurs to a remote position relative to the previously recited first sector of a track on a storage medium. Such language would have given the examiner reason to interpret the overall claim in a manner consistent as argued in the rejection. Therefore, appellants correctly state at the top of page 6 of the brief on appeal that a diagnostic track in the region 48 of Supino's Figure 1 cannot be said to be "a remote position relative to a storage medium" as recited in claim 11 because "the spare sector is necessarily located on the storage medium." Since diagnostic tracks 48 are on the magnetic disc 40 of Figure 2 of Supino, they cannot be said to be remote relative to the entire magnetic disc 40 itself.

Because we do not affirm the rejection of independent claim 11, we must therefore also reverse the rejection of its dependent claims 12-15.

Finally, we turn to the rejection of claims 1-3 under 35 U.S.C. § 103. The pertinent portion of claim 1 on appeal

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is "the number of said subsequent recovery operations being determined by a specific amount of time." It is clear from the application as filed and its discussion of Supino as well as Supino itself and the examiner's position with respect to it, that the disclosure of this reference is limited to a fixed number of retry operations as best depicted in Figure 3. Note the fifth attempt decision block and essentially most of the discussion at column 3 of this reference. There is no teaching or suggestion in this reference alone which would have lead the artisan to take a time-based approach of the type set forth in claim 1 on appeal.

On the other hand, we agree with appellants' view that Obrea is nonanalogous art as expressed at pages 6 and 7 of the brief on appeal. Since the examiner's position at pages 4 and 5 of the answer impliedly agree with appellants' view that Obrea is not in appellants' field of invention, in accordance with the noted precedent by both the examiner and appellants, we must then look to arts which are "reasonably pertinent" to the particular problem with which the inventor was involved. As even the title of Obrea reveals, not only is Obrea

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nonanalogous from the point of view that it is directed to postage meter operations, it is also nonanalogous from the point of view that his solutions are concerned with infinite loop lockout situations. This is most simply expressed in Obrea in the summary of the invention at column 2 as well as the last two paragraphs at column 4 of his patent. Since Supino operates in Figure 3 in accordance with a fixed number of loop attempts, that is, the number 5, the operation of Supino's head recovery operational system would not ordinarily be faced with the situation of having to contend with infinite loop lockout situations.

Similarly, even if we were to agree with the examiner's view that Obrea would have been analogous art to be available for combination with Supino within 35 U.S.C. § 103, we find that the artisan would not have done so for the same last stated reason. Even considering the teachings of Obrea from an analogous art perspective, we find that the artisan perhaps would have found some pertinence of the teachings of this reference to the problems encountered by the inventor but that these teachings

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in Obrea would not have been "reasonably" pertinent to the artisan and the inventor facing the problems as the inventor had in this application. Therefore, there appears to be some merit to appellants' view that the examiner has exercised impermissible hindsight in applying Obrea.

Since we do not sustain the rejection of claim 1, we must reverse the rejection of its dependent claims 2 and 3.

In view of the foregoing, we have reversed the rejection of claims 11-15 under 35 U.S.C. § 102(b), as well as the rejection of claims 1-3 under 35 U.S.C. § 103. Accordingly, the decision of the examiner is reversed.

REVERSED

	James D. Thomas)	
	Administrative Patent Judge)	
)	
	Kenneth W. Hairston)	BOARD OF
PATENT)	
	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
	John C. Martin)	
	Administrative Patent Judge)	

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