

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HIROO INABA, SHINJI SAITO,  
and HIROSHI OGAWA

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Appeal No. 96-2941  
Application 07/903,353<sup>1</sup>

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HEARD: August 6, 1996

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Before KIMLIN, JOHN D. SMITH<sup>2</sup> and WARREN, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-12, 14, 17-23, 25, 32, 41-43, 45, 46, 48, 49 and 51-59. Claims 70, 71, 73, 75, 77, 79 and 80 have been allowed by the examiner. Claims 31, 35 and 40, the other claims remaining in the present

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<sup>1</sup> Application filed June 24, 1992, for Reissue of U.S. Patent No. 5,051,320, issued September 24, 1991, based on Application 07/309,580, filed February 9, 1989.

<sup>2</sup> Administrative Patent Judge (APJ) McFarlane participated in the hearing of the appeal but resigned before this decision. APJ John D. Smith has been substituted on this merits panel.

Appeal No. 96-2941  
Application 07/903,353

application, have been objected to by the examiner. Claim 1 is illustrat

1. A magnetic recording medium comprising a non-magnetic support having provided thereon a lower magnetic layer [having a thickness of 2.5  $\mu\text{m}$  or higher] and an upper magnetic layer having a thickness of 2  $\mu\text{m}$  or lower [in this order], wherein both the upper and lower magnetic layers contain [ferromagnetic] magnetic particles and a binder, and the lower magnetic layer contains carbon black having an average primary particle diameter of less than 20  $\mu\text{m}$  in an amount of from 1.0 to 20 parts by weight per 100 parts by weight of the [ferromagnetic] magnetic particles present in the lower magnetic layer, and the upper magnetic layer contains carbon black having an average primary particle diameter of at least 40  $\mu\text{m}$  but less than 80  $\mu\text{m}$  in an amount of from 0.1 to 10.0 parts by weight per 100 parts by weight of the [ferromagnetic] magnetic particles present in the upper magnetic layer[, but less than the amount of carbon black used in the lower magnetic layer].

The examiner does not rely upon prior art in the rejection of the appealed claims.

Appellants' claimed invention in this Reissue application is directed to a magnetic recording medium which finds utility as a video tape. The claimed magnetic recording medium comprises a non-magnetic support, a lower magnetic layer and an upper magnetic layer having a thickness of 2  $\mu\text{m}$  or lower. Both the lower and upper magnetic layer contain carbon black, but the carbon black in the lower layer has an average primary particle diameter less than the average primary particle diameter of the carbon black in the upper layer.

Appeal No. 96-2941  
Application 07/903,353

Appealed claims 1-12, 14, 17-23, 25, 32, 41-43, 45, 46, 48, 49 and 51-55 stand rejected under 35 U.S.C. § 112, first paragraph.<sup>3</sup>

Upon careful consideration of the opposing arguments presented on appeal, we will not sustain the examiner's rejection.

The examiner states at page 3 of the Answer that the appealed claims stand rejected under 35 U.S.C. § 112, first paragraph, "as the disclosure is enabling only for claims limited to one in which the upper magnetic layer is 2.0 micro or lower and the content of carbon black in the upper layer is 0.1-10 parts and the content of carbon black in the lower layer is 1.0-20 parts." As pointed out by appellants, the features of the invention referred to by the examiner are, in fact, recited in the appealed claims. Acknowledging this, the examiner states at page 4 of the Answer that "[a]ppellants amended to put back the limitation for the upper magnetic layer but not for the lower magnetic layer." Thus, it is the examiner's position that the present specification does not enable recording mediums within

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<sup>3</sup> Although the examiner's statement of the rejection at page 3 of the Answer includes claims 35 and 40, the examiner acknowledges in the paragraph bridging pages 3 and 4 of the Answer that the inclusion of claims 35 and 40 in the statement of the rejection is "an inadvertent oversight." Claims 35 and 40 are objected to by the examiner.

Appeal No. 96-2941  
Application 07/903,353

the scope of the appealed claims which do not limit the lower magnetic layer to those having a thickness of 2.5  $\mu\text{m}$  or higher.

It is well settled that the examiner has the initial burden of establishing lack of enablement by compelling reasoning or objective evidence. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982); In re Armbruster, 512 F.2d 676, 677, 185 USPQ 152, 153 (CCPA 1975); In re Marzocchi, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971). In the present case, as urged by appellants, the patented specification expressly discloses that when the lower magnetic layer is thinner than 2.5  $\mu\text{m}$ , the lower layer contributes less to the improvement of electroconductivity and, therefore, the thickness of the lower magnetic layer is preferably 2.5  $\mu\text{m}$  or higher (column 4, lines 53-56). On the other hand, the examiner has merely pointed out other portions of the specification which indicate that a thickness of 2.5  $\mu\text{m}$  or higher for the lower magnetic layer is part of the present invention, which, of course, is true. However, when such portions relied upon by the examiner are read in context with the disclosure at column 4, lines 53-56, the inescapable conclusion, absent compelling reasoning or objective evidence to the contrary, is that, prima facie, the present specification enables recording mediums wherein the lower magnetic layer is less than 2.5  $\mu\text{m}$ .

Appeal No. 96-2941  
Application 07/903,353

Since the examiner has not established a prima facie case of non-enablement, we find no need to evaluate appellants' declaration evidence of enablement.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
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	)	
	)	
JOHN D. SMITH	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
CHARLES F. WARREN	)	
Administrative Patent Judge	)	

Appeal No. 96-2941  
Application 07/903,353

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