

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(2) is not binding precedent of the Board.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 HIROYUKI HARUYAMA

Appeal No. 1998-0446
Application 08/572,195

HEARD: February 24, 2000

Before KRASS, JERRY SMITH and GROSS, Administrative Patent
Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1 and 3-13, which constitute all the claims remaining in the application. An amendment after final rejection was filed on February 11, 1997 and was entered by the examiner.

The disclosed invention pertains to the field of magnetic disk drives. More particularly, the invention relates to the placement of a dust filter in a specific location with respect to the magnetic heads, the arms and the head drive means of the magnetic disk drive.

Representative claim 1 is reproduced as follows:

1. A magnetic disk drive comprising:

a plurality of magnetic disks mounted on a spindle at equally spaced locations on an axis of said spindle and driven to spin by said spindle;

a plurality of magnetic heads each facing a respective magnetic disk for selectively writing or reading data in or out of said magnetic disk, said plurality of magnetic heads each being caused to float a predetermined distance away from said respective magnetic disk by a stream of air generated by relative movement of said magnetic head and said magnetic disk;

a plurality of arms each supporting a respective magnetic head;

a plurality of head drive means including a pivot, each for driving a respective one of said plurality of arms in a rotary motion about said pivot, said plurality of magnetic disks each spinning in a direction such that a stream of air generated at a side adjoining an end of each magnetic head moves from its respective magnetic head, past its respective arm, and toward its respective head drive means, in that order; and

at least one filter disposed proximate to a respective said magnetic disk on a path along which the stream of air flows after being directed by said arms and head drive means past the pivot of said head drive means without being directed around the head drive means.

The examiner relies on the following references:

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Edwards et al. (Edwards)	5,270,887	Dec. 14, 1993 (filed Dec. 04, 1991)
Ebihara et al. (Ebihara) (Japan)	63-157389	June 30, 1988
Yokoyama et al. (Yokoyama) (Japan)	4-285787	Oct. 09, 1992

Claims 1 and 3-13 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Edwards in view of Yokoyama and Ebihara.

Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill

in the art the obviousness of the invention as set forth in claims 1 and 3-13. Accordingly, we reverse.

Appellant has indicated that for purposes of this appeal the claims will all stand or fall together as a single group [brief, page 4]. Consistent with this indication appellant has made no separate arguments with respect to any of the claims on appeal. Accordingly, all the claims before us will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will consider the rejection against independent claim 1 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion

or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden 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 Id.;

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). Only those arguments actually made by appellant have been considered in this decision. Arguments which

appellant could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

With respect to representative, independent claim 1, the examiner cites Edwards as teaching a magnetic disk drive of the type disclosed and claimed except that the air flow in Edwards does not flow as recited in claim 1 and the dust filter in Edwards is not located in the specific location recited in claim 1 [answer, pages 3-4]. The examiner cites Yokoyama and Ebihara as teaching magnetic disk drives in which dust filters are located at different positions from the dust filter of Edwards. The examiner asserts that it would have been obvious to locate Edwards' filter in the manner recited in claim 1 based on the teachings of Yokoyama and Ebihara [id., page 4].

Appellant argues that it would not have been obvious to combine the teachings of the applied references because the air flow path generated in Yokoyama and Ebihara cannot occur in Edwards so there would be no motivation to locate a dust filter in Edwards as suggested by either Yokoyama or Ebihara [brief, pages 4-6]. Appellant also argues that even if it would have been obvious to combine the teachings of Edwards with Yokoyama and Ebihara, there would still be no teaching of placing the filter on a path along which the stream of air flows after being

directed by said arms and head drive means past the pivot of the head drive means as recited in claim 1 [id., pages 6-7]. We agree with the position argued by appellant.

The magnetic disk drives of Edwards, Yokoyama and Ebihara have dust filters located where the air flows inside the respective disk drives. Claim 1 recites a location for the filter which would not be within the air flow of the Edwards disk drive. We agree with appellant that there would be no motivation to modify the location of the filter in Edwards based on Yokoyama or Ebihara because there would be no expectation of collecting any dust in the claimed location. The examiner's position essentially requires that the disk drive of Edwards be redesigned to be something different. Edwards specifically discloses, however, that the "subassemblies of the HDA [head disk assembly] are maintained in a precise relationship in the compact housing by precisely machined mounting positions on base 10" [column 6, lines 57-60]. Thus, Edwards teaches away from moving any of the HDA components with respect to the housing. Any attempt to modify the disk drive of Edwards to incorporate teachings of Yokoyama or Ebihara would have to be based upon an improper attempt to reconstruct appellant's invention in hindsight.

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Since we agree with appellant that there is no motivation to relocate the Edwards filter based on any teaching or suggestion of Yokoyama or Ebihara, we do not sustain the examiner's rejection of

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claims 1 and 3-13 under 35 U.S.C. § 103. Therefore, the decision of the examiner rejecting claims 1 and 3-13 is reversed.

REVERSED

Errol A. Krass)	
Administrative Patent Judge)	
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Jerry Smith)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
Anita Pellman Gross)	
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