

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PEI C. CHEN,
GRACE L. GORMAN,
CHERNGYE HWANG,
VEDANTHAM RAMAN,
and
RANDALL G. SIMMONS

Appeal No. 1999-2280
Application No. 08/686,567

ON BRIEF

Before HAIRSTON, BARRETT, and FLEMING, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 31.

The disclosed invention relates to the use of a silicon coating on an air-bearing surface of a slider.

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Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A slider for supporting a magnetic head comprising:
a slider body having a leading end, a trailing end, and an air bearing surface; and
a silicon coating on the air bearing surface.

The references relied on by the examiner are:

Kubo et al. (Kubo) 5,198,934 Mar. 30, 1993

Petersen, "Thin Film Magnetic Heads," 21 IBM Technical Disclosure Bulletin, No. 12, p. 5002 (May 1979).

Claims 1, 2, 4, 6 through 14, 16, 18 through 24, 26 and 28 through 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kubo.

Claims 3, 15, 25 and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubo.

Claims 5, 17 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubo in view of Petersen.

Reference is made to the briefs (paper nos. 14 and 17) and the answer (paper no. 15) for the respective positions of the appellants and the examiner.

OPINION

We have carefully considered the entire record before us, and we will reverse the 35 U.S.C. § 102(b) rejection of claims 1,

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2, 4, 6 through 14, 16, 18 through 24, 26 and 28 through 30, and the 35 U.S.C. § 103(a) rejection of claims 3, 5, 15, 17, 25, 27 and 31.

The examiner makes the point (answer, page 8) that:

Clearly and without question, Kubo et al (US 5,198,934) discloses a planarized silicon coating ((39); see COL. 5, line 4) is provided on at least a portion of the air bearing surface. More specifically, Kubo et al (US 5,198,934) discloses the coating as silicon dioxide. Silicon dioxide, contains silicon. Moreover, the claims are open ended, containing the word "comprising." Thus other coatings and/or compounds of silicon are not in any way excluded from the **claimed invention**.

Appellants argue (brief, page 6) that:

Claims 1, 11 and 20 each include the feature of a slider having an air bearing surface coated with a silicon coating for protecting the air bearing surface. None of the prior art references of record in the present case, either alone or in reasonable combination, teach or suggest an apparatus as defined by claims 1, 11 and 20. For example, at col. 5, line 4, the *Kubo et al.* reference discloses using a coating material such as silicon dioxide, as opposed to the elemental silicon.

If Kubo had a "silicon" coating on an air-bearing surface of a slider, then the open-ended nature of appellants' claims would not preclude other coatings (e.g., silicon dioxide) on the air-bearing surface. Since Kubo discloses the use of a silicon dioxide coating on an air-bearing surface of a slider, and not a silicon coating, the examiner's open-ended claim statement is

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inapposite reasoning in any justification for the anticipation rejection. Thus, the 35 U.S.C. § 102(b) rejection of claims 1, 2, 4, 6 through 14, 16, 18 through 24, 26 and 28 through 30 is reversed because we agree with appellants' argument that silicon dioxide is not silicon.

Based upon the same reasoning, the 35 U.S.C. § 103(a) rejection of claims 3, 15, 25 and 31 is reversed. The 35 U.S.C. § 103(a) rejection of claims 5, 17 and 27 is reversed because the teachings of Petersen do not cure the noted shortcoming in the teachings of Kubo.

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DECISION

The decision of the examiner rejecting claims 1, 2, 4, 6 through 14, 16, 18 through 24, 26 and 28 through 30 under 35 U.S.C. § 102(b) is reversed, and the decision of the examiner rejecting claims 3, 5, 15, 17, 25, 27 and 31 under 35 U.S.C. § 103(a) is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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MICHAEL R. FLEMING)	
Administrative Patent Judge)	

KWH:hh

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