

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SANFORD A. BOLASNA and LAURENCE S. SAMUELSON

Appeal No. 2001-0165
Application 08/893,220

ON BRIEF

Before CALVERT, PATE, and McQUADE, Administrative Patent Judges.

PATE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 35-42. These are the only claims remaining in the application.

The claimed invention is directed to a method of manufacturing a slider in a hard disk drive. The method includes removing a portion of the air bearing surface only at the side edge of the air bearing surface and proximate the magnetic head.

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The claimed subject matter may be further understood by reference to the appealed claims appended to appellants' brief.

The reference of record relied upon by the examiner as evidence of anticipation and obviousness is:

Kawasaki et al. (Kawasaki) 5,513,056 Apr. 30,
1996

REJECTION

Claims 35-41 stand rejected under 35 U.S.C. § 102(e) as anticipated by Kawasaki.

Claim 42 stands rejected under 35 U.S.C. § 103 as unpatentable over Kawasaki in view of appellants' admitted prior art.

The rejections on appeal may be further understood with reference to pages 2 and 3 of the final rejection, paper no. 9.

According to appellants, claims 35-41 stand or fall together, and these claims stand or fall separately from claim 42.

OPINION

We have carefully reviewed the rejections on appeal in light of the arguments of the appellants and the examiner. As a result of this review, we have determined that the applied prior art does not establish the lack of novelty or the obviousness of the claimed subject matter. Therefore, the rejections of all claims on appeal are reversed. Our reasons follow.

The following represents our factual findings with respect to the Kawasaki reference. Kawasaki discloses, in Figure 3, a support structure 1 with a leading edge and trailing edge (both unnumbered). A central air bearing 15 is formed on the support structure with a magnetic head 31 at the rear thereof. A portion of central air bearing 15 has been removed on each side edge at 17 and 18. It is the examiner's finding that Kawasaki anticipates claim 35.

Appellants argue that Kawasaki does not disclose "removing a portion of the air bearing only at a side edge of the air bearing surface and proximate the magnetic head to

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increase the spacing between the disk and the slider" as required in the ultimate clause of the claim. The examiner's responsive argument is that the "only" in this clause is applicable to the "side edge" limitation but not the "proximate" portion of the clause. The appellant has provided an argument on this issue based on the parallel nature of clauses joined by "and" in the English language. This argument is convincing to us, and we are of the view appellants' interpretation is more reasonable. Accordingly, we hold that the claim requires the air bearing surface to be removed only along the side edges and only proximate to the magnetic head.

The examiner further argues that even if the claim is to be interpreted as we have in the previous paragraph, Kawasaki is anticipatory in that all the material removed at 17 and 18 of Kawasaki's air bearing is still proximate the magnetic head as compared to, say, the rails 20 and 25. "Proximate" is a term of degree. When a word of degree is used in a claim we must determine whether the specification provides some standard for measuring that degree. See *Seattle Box Co. v.*

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Indus. Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 573-4 (Fed. Cir. 1984). In this instance, with reference to both appellants' written specification and drawn figures, it is clear that proximate means "next to, adjacent or close to." The entire portions 17 and 18 are not adjacent or next to the magnetic head. Accordingly, Kawasaki does not anticipate appellants' claim 35.

We have also reviewed the rejection of claim 42 on obviousness grounds, but the lack of a reference that discloses or suggests removing a portion of the air bearing as required in claim 35 renders an obviousness rejection unsustainable.

Accordingly, the rejections of all claims on appeal are reversed.

REVERSED

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