

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(2) is not binding precedent of the Board.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. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RANDALL D. HAMPSHIRE

Appeal No. 1998-0821
Application 08/175,319

ON BRIEF

Before HAIRSTON, KRASS and FLEMING, **Administrative Patent Judges.**

FLEMING, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 20 and 21, all of the claims pending in the present application. Claims 1 through 19 have been canceled.

The invention relates to data storage systems employing rotating media, and more particularly to operating systems for controlling plural operations of disc drive systems.

Independent claim 20 is reproduced as follows:

20. A method for carrying out servo operations in a disc drive for controlling the movement and position of a servo head in relation to servo tracks on a servo surface of a rotating disc of the disc drive, wherein the disc drive includes a servo circuit connected to the servo head for generating servo information representative of the location of the servo head with respect to the servo surface, actuator means for repositioning the servo head in response to a correction signal received by the actuator means, a servo microcomputer programmed to periodically input servo information from the servo circuit and output a correction signal to the actuator means in relation to the servo information, a system microcomputer programmed to provide servo commands for selected servo operations to the servo microcomputer, the method comprising:

storing a plurality of servo routines, corresponding to the servo commands, in the servo microcomputer for generating the correction signal from the servo information utilizing preselected servo parameters comprising at least one of system configuration data and timing data;

storing the servo parameters in the system microcomputer, the system microcomputer being separate from the servo microcomputer; and

transferring the servo parameters from the system microcomputer to the servo microcomputer when a servo command is issued to the servo microcomputer.

The Examiner relies on the following references:

Malka et al. (Malka) 4,879,642 Nov. 07, 1989

Franklin et al. "*Digital Control of Dynamic Systems*", 2nd edition, published by Addison-Wesley Publishing Company (MA) (1990), pp. 652, 703-709 and 779-783. (Franklin).

Claims 20 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable

over Franklin in view of Malka.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the briefs and answer for the respective details thereof.

OPINION

We will not sustain the rejections of claims 20 and 21 under 35 U.S.C. § 103.

The Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d 989, 995, 217, USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." *Para-Ordnance Mfg. v. SGS Importer Int'l, Inc.*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), *cert. denied*, 519 U.S. 822 (1996), citing *W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

On page 5 of the brief, Appellant argues that Appellant's claim 20 requires

storing the servo parameters (comprising at least one of system

configuration or timing data) in the system microcomputer . . . and transferring the servo parameters . . . to the servo microcomputer when a system command is issued

Appellant argue that the claim requires that the system configuration data and timing data are stored in the system computer and are transferred to the servo microcomputer at the same time as the servo command is issued. Appellant argues on pages 5 and 6 that Malka fails to teach system configuration data or timing data as set forth in Appellant's claim 20. Appellant has provided a declaration executed by the inventor Randall D. Hampshire, wherein Mr. Hampshire states that system configuration data are understood in the disc drive art to be the data that defines the hardware and software of the data processing system effecting operation of the disc drive in question. Paragraph 2 of the declaration also sets forth several examples of system configuration data. Mr. Hampshire further declares in paragraph 11 that the Malka reference fails to teach or suggest system configuration that defines hardware and software of a disc system.

We agree with the Appellant that neither Malka or Franklin teaches or suggest

a method for carrying out servo operations in a disc drive for controlling the movement and position of a servo head in relation to servo tracks comprising storing a plurality of servo routines, corresponding to servo commands, in the servo microcomputer for generating the correction signal from the servo information utilizing preselected servo parameters comprising at least one of system configuration data and timing data;

storing the servo parameters in the system microcomputer, the system microcomputer being separate from the servo computer; and transferring the

Appeal No. 1998-0821
Application 08/175,319

servo parameters from the system computer to the servo microcom-puter
when a servo command is issued to the servo microcomputer

as recited in Appellant's claim 20.

We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a *prima facie* case. *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984); *In re Knapp-Monarch Co.*, 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); *In re Cofer*, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966). Furthermore, our reviewing court states in *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785, 788 (Fed. Cir. 1984) the following:

The Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), focused on the procedural and evidentiary processes in reaching a conclusion under Section 103. As adapted to ex parte procedure, Graham is interpreted as continuing to place the "burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under section 102 and 103". *Citing In re Warner*, 379 F.2d 1011, 1020, 154 USPQ 173, 177 (CCPA 1967).

In view of the foregoing, we have not sustained the rejection of claims 20 and 21

Appeal No. 1998-0821
Application 08/175,319

under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ERROL A. KRASS)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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)	
MICHAEL R. FLEMING)	
Administrative Patent Judge)	

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Appeal No. 1998-0821
Application 08/175,319

Shawn B. Dempster
SEAGATE TECHNOLOGY, LLC
Intellectual Property Dept. - SHK2LG
1280 Disc Drive
Shakopee, MN 55379-1863