

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER M. BAUMGART, WING P. LEUNG,
HUNG V. NGUYEN, THAO A. NGUYEN, and
ANDREW C. TAM

Appeal No. 1998-2496
Application No. 08/714,831

ON BRIEF

Before KRASS, LALL, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 15-43, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a textured data storage disk having a brittle nonmetallic substrate. An understanding of the invention can be derived from a reading of exemplary claim 15, which is reproduced below.

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15. A magnetic recording disk having an outer surface with a nominal surface plane for storing magnetically-readable data, said disk comprising:

a layer of glass substrate material having a substantially planar substrate surface;
and

a magnetizable film layer deposited over said glass substrate surface having a substantially uniform thickness and substantially planar surface which has a disk recording region and a disk contact start and stop (CSS) region for landing and take-off of a magnetic head;

said substrate surface having a substrate CSS region below the disk CSS region;

said substrate CSS region having a plurality of regularly-spaced-apart elevations, each said elevation having a diametral dimension D_d in the interval from 1 to 100 micrometers and rising to a maximum height $h_d < 100$ nanometer above said substrate surface; and

each elevation being a smoothly shaped dome and free of surface cracks and material ejection.

No prior art references of record are relied upon by the examiner in rejecting the appealed claims.

Claims 15-43 stand rejected under 35 U.S.C. § 112, first paragraph as being based upon a specification which fails to adequately teach how to make an/or use the invention, i.e. failing to provide an enabling disclosure. Claims 35-37, 39, 40 and 42 stand rejected under 35 U.S.C. § 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which appellants regards as the invention.

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Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 34, mailed March 9, 1998) which incorporates the rejections made in the final rejection for the examiner's reasoning in support of the rejections, and to the appellants' brief (Paper No. 33, filed December 30, 1997) and reply brief (Paper No. 35, filed April 7, 1998) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Appellants argue that the examiner has not set forth a *prima facie* case with respect to both rejections under 35 U.S.C. § 112. (See brief at page 9.) Appellants argue that the PTO is "required to assume that the specification complies with the enablement provision of Section 112 unless it has 'acceptable evidence or reasoning' to suggest otherwise." (See brief at page 9, citing **Gould v. Quigg**, 822 F.2d 1074, 3 USPQ2d 1302 (Fed. Cir. 1987).)¹ We agree with appellants that the PTO bears the initial burden of supplying acceptable evidence or reasoning as to why the specification is

¹We note that appellants do not provide a pinpoint cite to support this proposition, and we have been unable to locate the specific quotation.

deemed as non-enabling. We further agree with appellants that the examiner has not met this initial burden of setting forth evidence or a line of reasoning why the invention, as claimed, is not enabling. The examiner maintains that the specification “gives no effective guidance on the critical ranges for effectiveness for the various features such as, D_s , D_d , and h_d . Certainly there are values for these that will not produce an effective, workable CSS device.” (See final rejection at page 2.) But the examiner provides no rationale as to why one skilled in the art would require more than that provided in the specification concerning the process of making the disks. The mere fact that the range is large and the examiner believes that at the periphery of the range the device may not be workable or effective, in our view, is not a measure of enablement. The examiner maintains that “[t]he extreme overall ranges stated for the various features are such that undue and extensive testing would be required to produce a workable system.” (See answer at page 4). We disagree with the examiner. First, we find that the example set forth in the specification provides an adequate starting point for the skilled artisan to begin any testing. The knowledge and skill of the artisan would have been such that the analysis of the desired resulting characteristics of the disk would have directed the artisan as to the appropriate modifications to be made in its manufacture. Second, we find that the examiner's rejection is directed more toward the breadth of the claims rather than to enablement. If the examiner believes that the lower range of the values is such as “reading on a ‘flat’ disk”

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(see answer at page 4), then this position is best addressed with a prior art rejection rather than by questioning enablement. Therefore, we cannot sustain the rejection of claim 15-43 under 35 U.S.C. § 112, first paragraph for lack of enablement.

With respect to the rejection of claims 35-37, 39, 40 and 42 under 35 U.S.C. § 112, first and second paragraphs for lack of enablement or in the alternative, for failing to particularly point out and distinctly claim the subject matter appellants regard as their invention because appellants have not specified the location of the bumps on the disk, again, the examiner does not provide evidence or a convincing line of reasoning for the rejections. While the specification discloses the bumps generally at the location of the CSS, the specification does not limit the bumps to this location. In our view, skilled artisans would have realized that for a readable medium, the bumps would be detrimental to the operation of the disk and reader if they were in the storage area. Again, this is a question of the breadth of the claims which is best addressed with a prior art rejection rather than questioning the sufficiency of the disclosure or the particularity of the claim language. In our view, the invention, as claimed, is supported by an enabling disclosure and the claims clearly set forth the invention. Therefore, we cannot sustain the rejection of claim 35-37, 39, 40 and 42 under a lack of enablement or in the alternative, as lacking particularity.

CONCLUSION

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To summarize, the decision of the examiner to reject claims 15-43 under 35 U.S.C. § 112, first paragraph is reversed and the decision of the examiner to reject claims 35-37, 39, 40 and 42 under 35 U.S.C. § 112, first and second paragraphs is reversed .

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
PARSHOTAM S. LALL)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
JOSEPH L. DIXON)	
Administrative Patent Judge)	

jld/vsh

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