

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 50

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MOTOJI EGAWA,
KAZUTOSHI TAKAYANAGI,
AKIO TAKAYAMA,
TETSUJI FUJITA,
and
AKINOBU SANO

Appeal No. 1998-3356
Application No. 08/391,472

HEARD: FEBRUARY 22, 2001

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

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 22 and 23. In an Amendment After Final (paper number 40), claim 22 was amended.

The disclosed invention relates to a floating magnetic

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head in which round-chamfered edges completely surround slider
rails

except in an area adjacent a track portion of a magnetic head core bonded to a side surface of one of the slider rails.

Claim 22 is the only independent claim on appeal, and it reads as follows:

22. A floating magnetic head comprising:

a substantially rectangular slider having a top surface and a bottom surface, the slider made of a non-magnetic substance, and having a first end defining a leading end and a second end defining a trailing end, the slider being provided with a groove on an outside surface of the slider, wherein the groove extends from a side surface toward the second end such that the groove gradually increases in depth from the side surface towards the second end and forms an opening at the second end, the side surface located between the first end and the second end and between the top surface and the bottom surface;

rails provided on an air-bearing side of the slider that faces a recording medium to produce a floating force;

a magnetic head core bonded to the side surface of the slider external to the rails by a glass bonding layer between them, the magnetic head core having an inclined face on a side opposite to the bonding side, the magnetic head core having a track portion and a read/write gap and having first and second legs, the second leg being located at the second end of the slider without protruding from the second end such that the first leg is located between the second leg and the first end of the slider, the track portion of the magnetic head core being attached externally outside of the rails by bonding; and

a coil wound around the second leg, the coil being at least partially in the groove, wherein the edges

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completely surrounding the rails on the slider are round-
chamfered except adjacent the track portion.

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The references¹ relied on by the examiner are:

Takahashi et al. (Takahashi) 1992 (published Japanese Kokai Patent Application)	04-3308	Jan. 8,
Kyocera ² 1992 (published Japanese Kokai Patent Application)	04-028010	Jan. 30,

Claims 22 and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kyocera in view of Takahashi.

Reference is made to the final rejection (paper number 39), the briefs (paper numbers 42 and 45) and the answer (paper number 44) for the respective positions of the appellants and the examiner.

OPINION

The obviousness rejection of claims 22 and 23 is reversed.

The examiner acknowledges (answer, pages 4 through 6) that the applied references do not teach that "the edges

¹Copies of the translations of these references are attached.

²The inventor of this reference is listed in the translation as Kazuyoshi Sakasegawa. In order to avoid confusion in our decision, we will use the name Kyocera that was used by both appellants and the examiner.

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completely surrounding the rails on the slider are round-chamfered except adjacent the track portion." According to the examiner (answer, page 6):

This so-called *critical* feature is only shown in FIG. 16 of the present invention and described on page 17, lines 13-16 (of the sub-specification), as merely improving the resistance to the CSS operation which "enhancing the reliability and can accommodate high-density recording." The Examiner maintains that appellant has [sic, appellants have] not sufficiently set forth on record how this round-chamfering provides unobvious or unexpected results, e.g., through detailed comparative testing, showing these unobvious or unexpected results. It is maintained that such round-chamfering, although conceivably improving the CSS operation of the magnetic head, would have been provided for by a skilled artisan.

Appellants argue (reply brief, pages 4 and 5) that:

[A]ppellants are under no obligation to show unobvious or unexpected results when the Patent Office fails to provide a prima facie case of obviousness. The Patent Office has the burden of showing the obviousness of the claimed features The Examiner's Answer admits there is support for the claimed feature, but then asserts that the Patent Office does not consider this to be a patentable distinction merely because it is only shown in Figure 16 and described on page 17, lines 13-16. This clearly does not support a prima facie case of obviousness as the Patent Office has never shown the claimed feature in the prior art. The number of times a feature is mentioned in a specification or drawings does not determine its patentability

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We agree with appellants' argument. In the absence of a prima facie showing of unpatentability by the examiner, the burden of proof never shifted to appellants to prove the nonobviousness of the claimed invention. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). For this reason, the obviousness rejection of claims 22 and 23 is reversed.

DECISION

The decision of the examiner rejecting claims 22 and 23 under 35 U.S.C. § 103 is reversed.

REVERSED

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KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
LEE E. BARRETT))
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	

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KWH:hh

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