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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* NING SHI, XIAO WU, and HONG ZHANG

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Appeal 2010-005361  
Application 10/857,586  
Technology Center 2600

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Before ALLEN R. MacDONALD, MICHAEL J. STRAUSS, and  
JOHN G. NEW, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF CASE

### *Introduction*

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1-7, 9-15, and 22. We have jurisdiction under 35 U.S.C. § 6(b).

### *Exemplary Claims*

Exemplary claims 1, 9, and 22 under appeal read as follows:

1. A magnetic recording head comprising:

a first surface comprising a first material;

a second material disposed on and in contact with said first material; and

wherein said second material comprises a coefficient of thermal expansion less than that of said first material, and wherein said first material acts to reduce propagation of surface defects of said second material.

9. A magnetic recording head comprising:

a first head overcoat layer;

a thermal expansion constraining layer disposed on and in contact with said first head overcoat layer; and

a sealant layer disposed on and in contact with said thermal expansion constraining layer, wherein said sealant layer comprises greater shock resistance than said thermal expansion constraining layer.

22. A magnetic recording head comprising:

coil means for generating a magnetic field for recording data on a magnetic media;

alternating layer means coupled to said coil means, said alternating layer means comprising:

a plurality of coating means for constraining thermal expansion of an underlying layer; and

a plurality of sealant means for protecting said coating means from shock and moisture.

*Rejections*

1. The Examiner rejected claims 1-5 under 35 U.S.C. § 102(e) as being anticipated by Pust (US 6,842,308 B1).<sup>1</sup>
2. The Examiner rejected dependent claims 6 and 7 as being unpatentable under 35 U.S.C. § 103(a) over Pust.<sup>2</sup>
3. The Examiner rejected claims 9-15 and 22 as being unpatentable under 35 U.S.C. § 103(a) over Pust and Appellants' Admitted Prior Art (AAPA).<sup>3</sup>
4. The Examiner rejected claims 1-5 and 9-13 under 35 U.S.C. § 102(b) as being anticipated by Hamaguchi (US 6,122,148).
5. The Examiner rejected dependent claims 6, 7, and 14 as being unpatentable under 35 U.S.C. § 103(a) over Hamaguchi.

*Appellants' Contentions*

1. At pages 15-16 of the Appeal Brief, Appellants contend that Pust does not support anticipation of claim 1 because:

There is no evidence to support that "a layer of Al<sub>2</sub>O<sub>3</sub> would" necessarily "prevent damage or defects due to cracking, moisture, oxidation, shock, etc." Forces created during use of the magnetic head slider (e.g., shock and vibrational forces) can be applied to the second material 640 via the Al<sub>2</sub>O<sub>3</sub> layer and the Al<sub>2</sub>O<sub>3</sub> layer may in fact inherently increase the propagation of damage or defects to the second material 640. Therefore,

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<sup>1</sup> Separate patentability is not argued for claims 2-5. Except for our ultimate decision, these claims are not discussed further herein.

<sup>2</sup> The patentability of dependent claims 6 and 7 under 103(a) is not separately argued from that of the independent claims rejected under 102(a). Except for our ultimate decision, these claims are not discussed further herein.

<sup>3</sup> Separate patentability is not argued for claims 10-15 and 22. Except for our ultimate decision, these claims are not discussed further herein.

Appellants respectfully submit that Pust does not anticipate "said first material acts to reduce propagation of surface defects of said second material," as claimed.

Appellants respectfully submit that Pust does not satisfy a *prima facie* case of anticipation under 35 U.S.C. §102(b).

2. At page 19 of the Appeal Brief, Appellants contend that Pust and AAPA do not support the obviousness of claim 9 because:

Appellants respectfully submit that Examiner did not produce a *prima facie* case of obviousness and the Appellants are under no obligation to submit evidence of nonobviousness. Pust and the Convention Art do not teach or suggest "said sealant layer comprises greater shock resistance than said thermal expansion constraining layer," as claimed.

#### *Issue on Appeal*

Whether the Examiner has erred in rejecting claim 1 as being anticipated?

Whether the Examiner has erred in rejecting claim 9 as being unpatentable?

#### ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants' contentions (App. Br. and Reply Br.) that the Examiner has erred.

We disagree with Appellants' conclusions. We adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in the Examiner's Answer in response to Appellants' Appeal Brief. We concur with the conclusion reached by the Examiner.

Contrary to Appellants' arguments, the Examiner has presented a prima facie case for both anticipation and obviousness. Also, contrary to Appellants' arguments, it is well established that the burden of going forward has shifted to Appellants. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977). "[W]hen the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d at 1255. *See also Titanium Metals Corp.of America v. Banner*, 778 F.2d 775 (Fed. Cir. 1985). Appellants have presented no evidence that the Pust's structure, which is identical to the claimed structure, fails to possess the claimed properties.

### CONCLUSIONS

- (1) The Examiner has not erred in rejecting claims 1-5 as being anticipated under 35 U.S.C. § 102(e).
- (2) The Examiner has not erred in rejecting claims 6, 7, 9-15, and 22 as being unpatentable under 35 U.S.C. § 103(a).
- (3) Claims 1-7, 9-15, and 22 are not patentable.

DECISION

The Examiner's rejections of claims 1-7, 9-15, and 22 based on Pust are affirmed.<sup>4</sup>

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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<sup>4</sup> Having affirmed the rejections based on Pust, we do not reach the rejections based on Hamaguchi.