



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/606,998	12/01/2006	Li Tang	10-3870-00	8218
105639	7590	01/22/2013	EXAMINER	
Tabarrok & Zahrt (SFAGATE-10/11)			HARRIS, GARY D	
60 South Market Street			ART UNIT	
Suite 1250			PAPER NUMBER	
San Jose, CA 95113			1727	
			NOTIFICATION DATE	
			DELIVERY MODE	
			01/22/2013	
			ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docteting@tzpatents.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LI TANG, WEILU XU, YOUFENG ZHENG, SHANGHSIEN
ROU, CONNIE CHUNLING LIU, JIANHUA XUE, and LI-LIEN LEE

Appeal 2011-000294
Application 11/606,998
Technology Center 1700

Before RICHARD E. SCHAFER, PETER F. KRATZ, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-10, and 21-30, which are the only claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

Representative claim 1 reads as follows¹:

1. A perpendicular magnetic recording medium, comprising:
 - (a) a non-magnetic substrate having a surface; and
 - (b) a plurality of overlying thin film layers forming a layer stack on said substrate surface, said layer stack including a magnetically hard perpendicular magnetic recording layer structure and an underlying soft magnetic underlayer (SUL),wherein said perpendicular magnetic recording medium has only one SUL, and said SUL has a thickness up to about 100 Å.

The Examiner maintains, and Appellants appeal, the following rejections:

Claims 1-10 and 21-30 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement.

Claims 1-10 and 21-30 under 35 U.S.C. § 103(a) as being unpatentable over the combined prior art of Li² and Bertero³.

OPINION

The § 112 Rejection

For an applicant to comply with the 35 U.S.C. § 112, first paragraph, written description requirement, the applicant's Specification must "convey with reasonable clarity to those skilled in the art that, as of the filing date

¹ Independent claims 21 and 26 are to a similar corresponding perpendicular magnetic recording medium. Claims 1, 21 and 26 have not been separately treated by the Examiner; the same rationale has been applied to these claims (*see generally* Ans.).

² US 7,201,977 B2 patented April 10, 2007.

³ US 6,893,748 B2 patented May 17, 2005.

sought, he or she was in possession of the invention.”” *Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.*, 541 F.3d 1115, 1122 (Fed. Cir. 2008) (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991)).

After review of the respective positions provided by Appellants and the Examiner, we find that a preponderance of the evidence supports Appellants’ position that the original disclosure provides support for the term “only one” soft magnetic underlayer as recited in each independent claim (Br. 5, 6; Spec. Fig. 2, paras. [0037], [0038]). As Appellants explain, the Specification, including Fig. 2, describes and illustrates to one of ordinary skill an embodiment wherein only one soft magnetic layer 4’ is present (*id.*).

Accordingly, we reverse the Examiner’s § 112 rejection on appeal.

The § 103 Rejection

The Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) *quoted with approval in KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

It is elementary that to support an obviousness rejection, all of the claim limitations must be taught or suggested by the prior art applied. *See In re Royka*, 490 F.2d 981, 984-85 (CCPA 1974).

The fact finder must be aware “of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. at 421(citing *Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966) (warning against a “temptation to read into the prior art the teachings of the invention in issue”)).

After review of the respective positions provided by Appellants and the Examiner, we agree with Appellants that the Examiner has not met the burden in this case for substantially the reasons set forth by Appellants in their Brief. Specifically, we agree with Appellants that the Examiner fails to articulate any persuasive reason why an artisan would seek to modify Li based on Bertero so as to result in the recited soft magnetic underlayer (SUL) thickness of up to 100 Å. (*see, e.g.*, Br. 6-8). Significantly, the single SUL in Li has a minimum thickness of 100nm (1000 Å), ten times more than the recited maximum limit, and the SUL layers of Bertoro similarly have a combined thickness over 10 times the recited maximum thickness limit, which teaches away from the claimed range. *See In re Sebek*, 465 F. 2d 904, 907 (CCPA 1972) (obviousness rejection based on optimization reversed where claimed values were outside the prior art range and the prior art optimum resided within the range).

For the foregoing reasons, and those presented by Appellants in the Brief, the Examiner has not satisfied the initial burden of presenting a prima facie case of obviousness, and we conclude that the Examiner’s rejection is improperly based upon improper hindsight reasoning. *KSR*, 550 U.S. at 421.

For these reasons and those set out in the Brief, we reverse the Examiner’s § 103 rejection on appeal.

Appeal 2011-000294
Application 11/606,998

CONCLUSION

In summary, the rejections before us on appeal are reversed.

REVERSED

tc