

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte TONGBI JIANG and EDWARD A. SCHROCK

Appeal No. 2003-0016
Application No. 09/400,613

ON BRIEF

Before COHEN, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 16 to 18, 20, 21 and 27 to 29. Claims 19, 22 and 23, which are the only other claims pending in this application, have been objected to as depending from a non-allowed claim.

We AFFIRM-IN-PART.

BACKGROUND

The appellants' invention relates particularly to techniques for making electrical contacts for microelectric devices such as integrated circuit devices and contacts utilized with such devices (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Thompson, Sr.	5,740,730	Apr. 21, 1998
Gademann et al. (Gademann)	5,866,951	Feb. 2, 1999

Claims 27 to 29 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims 16, 20 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gademann.

Claims 17 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gademann in view of Thompson.

Claims 27 to 29 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gademann in view of Thompson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 12, mailed May 31, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 11, filed March 13, 2002) and reply brief (Paper No. 13, filed July 9, 2002) for the appellants' arguments thereagainst.

OPINION

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

The indefiniteness rejection

We sustain the rejection of claims 27 to 29 under 35 U.S.C. § 112, second paragraph.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

Claim 27 reads as follows:

A method of forming a deposit in making semiconductor devices comprising the steps of:
forming at least one annular opening in a stencil creating an inner member inward of said opening and an outer member outward of said opening;
and; [sic]
maintaining a physical connection between said inner and outer members.

The examiner's basis for this rejection (answer, pp. 5-6) was that the scope of claims 27 to 29 was unclear. Specifically, the examiner commented that claim 27 appears to be a method of depositing according to the preamble of the claim (i.e., a method of forming a deposit in making semiconductor devices) while the body of the claim is directed only at preparing a stencil (i.e., forming at least one annular opening in a stencil creating an inner member inward of said opening and an outer member outward of said opening; and maintaining a physical connection between said inner and outer members). The examiner then stated that it was unclear if appellants intended to claim a method of depositing or a method of preparing a stencil.

The appellants only argument (brief, p. 9) that the above-noted rejection is in error is that "the stencil of Figure 1 may be utilized to form the annular contacts claimed by Applicants. Therefore, the stencil may be utilized in a method of forming a deposit in making semiconductor devices as recited in Applicant's claims 27-29."

In our view, claim 27 does not comply with the second paragraph of 35 U.S.C. § 112 for the reasons set forth by the examiner. While the stencil made by the forming and maintaining steps of claim 27 may be utilized in a method of forming a deposit in making semiconductor devices, claim 27 does not recite any step of utilizing the formed stencil to form a deposit. Without such a step, it is unclear to us what the metes and bounds of claim 27 is with the degree of precision and particularity that is required. In that regard, it is unclear to us if claim 27 would be met by any stencil (even a stencil not used in forming a deposit in making semiconductor devices) prepared by forming at least one annular opening in a stencil creating an inner member inward of the opening and an outer member outward of the opening and maintaining a physical connection between the inner and outer members. Given this uncertainty, claim 27 is indefinite.

For the reasons set forth above, the decision of the examiner to reject claim 27, and claims 28 and 29 dependent thereon, under 35 U.S.C. § 112, second paragraph, is affirmed.

The obviousness rejections

We will not sustain the rejection of claims 16 to 18, 20, 21 and 27 to 29 under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The appellants argue that the applied prior art does not suggest the claimed subject matter. We agree.

Claims 16 to 18 recite the step of depositing an **annular** member formed of conductive particles in a resinous matrix. Claims 20 and 21 recite the step of forming an upstanding conductive, **annular** member on a first contact surface. Claims 27 to 29 recite the step of forming at least one **annular** opening in a stencil creating an inner member inward of said opening and an outer member outward of said opening.

However, these limitations are not suggested by the applied prior art. In our view, the examiner's position (answer, p. 7) that the above-noted **annular** limitations are met by the plurality of metallic connector spots 13 and electrically conducting adhesive layers 13' which in the examiner's opinion form an **annular** member as shown in Figure 2 of Gademann is clearly in error for the reasons set forth by the appellants in their briefs.

Since the **annular** limitations of the claims under appeal are not taught by Gademann, the examiner's rejections have not set forth evidence that would have made it been obvious at the time the invention was made to a person of ordinary skill in the art to arrive at the claimed subject matter.¹ Accordingly, the decision of the examiner to reject claims 16 to 18, 20, 21 and 27 to 29 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 16 to 18, 20, 21 and 27 to 29 under 35 U.S.C. § 103 is reversed and the decision of the examiner to reject claims 27 to 29 under 35 U.S.C. § 112, second paragraph, is affirmed.

¹ We have reviewed the reference to Thompson but find nothing therein which makes up for the deficiencies of Gademann discussed above.

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

AFFIRMED-IN-PART

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
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