

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD SHENG-TONG SHYR, ENRICO F. NAPOLETANO
and MARIE GUILLOT

Appeal No. 1996-3194
Application 08/218,802

ON BRIEF

Before KRASS, JERRY SMITH and BLANKENSHIP, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-9 and 21-24. Claims 10-20 stand withdrawn from consideration as being directed to a nonelected invention. Claims 25-28 were

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indicated in the final rejection to contain allowable subject matter. In response to the filing of the appeal brief, the examiner has indicated that claims 21-24 now contain allowable subject matter [answer, page 2]. Therefore, this appeal now involves only the rejection of claims 1-9.

The disclosed invention pertains to a case or module for enclosing a semiconductor circuit, such as a surge protector.

Representative claim 1 is reproduced as follows:

1. A module comprising:

a semiconductor subassembly including a plurality of semiconductor components;

a hollow case including first and second case parts, wherein the first and second case parts encapsulate the semiconductor subassembly; and,

force applying means for applying force on the semiconductor assembly to retain the semiconductor components thereof together, wherein the force applying means and at least one of the first and second case parts are of unitary construction.

The examiner relies on the following reference:

DeBalko et al. (DeBalko) 5,175,662 Dec. 29, 1992

Claims 1-9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of DeBalko.

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Rather than repeat the arguments of appellants or the examiner, we make reference to the main brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of anticipation relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the disclosure of DeBalko does fully meet the invention as set forth in claims 1, 6, 8 and 9. We reach the opposite conclusion with respect to claims 2-5 and 7. Accordingly, we affirm-in-part.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of

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inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984); cert. dismissed, 468 U.S. 1228 (1984); W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner indicates how he reads the claims on the disclosure of DeBalko [answer, pages 4-5]. Of particular note is that the examiner reads the force applying means of claim 1 on any of contacts 42-44, contacts 21-27 or contacts 63 and 64 of DeBalko [id., page 4]. With respect to clamp contact 44, appellants argue that neither clamp 44 and cover part 54 nor clamp 44 and base part 20 are of unitary construction as recited in claim 1 [brief, page 6]. With respect to contacts 21-25, appellants make the same argument just discussed as well as arguing that these contacts do not provide a force on the semiconductor assembly to retain the semiconductor components together as recited in claim 1 [id.].

With respect to the latter argument, we agree with

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appellants. Although contacts 21-27 of DeBalko may apply a force to the housing 31, these contacts would not apply a force to retain the semiconductor components together as recited in claim 1. The only contacts of DeBalko which can be considered to apply a force as recited in claim 1 are the contacts 42-44. As noted above, however, appellants argue that these contacts and one of the case parts 20 and 54 are not of unitary construction as claimed.

The examiner has interpreted the phrase "wherein the force applying means and at least one of the first and second case parts are of unitary construction" to be met by a disclosure of the force applying means being of unitary construction and either of the case parts separately being of unitary construction. We agree with the examiner that this interpretation is reasonable even though it is not what appellants intended the phrase to mean. During prosecution, claims are given their broadest reasonable interpretation because an applicant has an opportunity to amend the claims to properly cover only what was intended. In our view, claim 1 could have been easily amended to limit the scope of the claim to what was intended. For example, the phrase quoted above

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could be changed to "wherein the force applying means is of unitary construction with at least one of the first and second parts." We would interpret this phrase as requiring the unitary construction argued by appellants.

We also note at this time that we do not agree with the examiner's position that any assembly of components becomes a unitary construction after assembly. The phrase "unitary construction" means that all parts making up the assembly were constructed at the same time from the same materials. Two separately manufactured components which are affixed to each other do not result in a unitary construction within the usual meaning of that phrase.

In summary, we agree only with the examiner's position that the wherein clause of claim 1 is technically met by the clamp 44 and either case part 20 or 54 of DeBalko. Since the examiner's claim interpretation is reasonable, and since the claim could be easily amended to limit its scope to what appellants intended, we sustain the rejection of claim 1 as fully met by the disclosure of DeBalko.

With respect to dependent claims 2 and 3, the examiner reads the claimed spring tab on any of the contact parts used

in the rejection of claim 1 [answer, page 4]. As we noted above, the only force applying means of DeBalko which retain the semiconductor components together are the contacts 42-44. None of these contacts can be considered to be a spring tab as recited in claims 2 and 3. Additionally, the claimed phrase "wherein the first [second] spring tab and the first [second] case part are of unitary construction" appears to require a singular unitary construction as argued by appellants. Although this view might seem inconsistent with our consideration of the similar phrase of claim 1, it is precisely because of our interpretation of claim 1 that we reach this result for claims 2 and 3. The wherein phrases of claims 2 and 3 would be superfluous and unnecessary if they were interpreted to mean that each spring tab and each case part were separately of unitary construction. Claim 1 already accounts for that limitation. Therefore, we construe the wherein clause of claims 1 and 2 as requiring a single unitary construction of the spring tab and the case part. For these reasons, we are of the view that DeBalko does not anticipate the invention of claims 2 and 3. Therefore, we do not sustain the rejection of claims 2 and 3 or of claims 4 and 5 which

respectively depend from claims 3 and 2.

With respect to dependent claim 6, appellants argue that semiconductor components 34 and 37 of DeBalko are not between plates 42 and 43 as would be required by the claim [brief, page 9]. This argument is not persuasive. The plurality of semiconductor components of claim 1 can be read on only components 32, 33, 35, 36 and 38 of DeBalko. Since these semiconductor components are situated between plates 42 and 43 of DeBalko, claim 6 can be read on the disclosure of DeBalko. Therefore, we sustain the rejection of claim 6. It should be noted that the claimed plates cannot be read on conductors 21-27

as proposed by the examiner because these conductors do not form part of the semiconductor assembly within housing 31.

With respect to dependent claim 7, appellants argue that only one component (surge protector 38) is between the force means 44 and the plates 42 and 43 of DeBalko and not a plurality of components as claimed [brief, page 9]. We agree. As we noted above, only clamp 44 of DeBalko satisfies the force applying means of independent claim 1. That being the case, we agree with appellants that the clamp 44 of

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DeBalko is not aligned with the semiconductor components used in our interpretation of claim 6 (components 32, 33, 35, 36 and 38). Therefore, we do not sustain the rejection of claim 7.

With respect to dependent claims 8 and 9, we agree with the conclusion reached by the examiner. Claim 8 modifies claim 1 by reciting that the force applying means is deformable. The force applying means of DeBalko (clamp 44) appears to be deformable. Claim 9 modifies claim 1 by reciting that the first and second case parts snap together in a friction fit. Appellants argue that the assembly in DeBalko is an interference arrangement rather than a friction fit [brief, page 10]. We fail to see how the phrase "friction fit" distinguishes over the fit in DeBalko. We are of the view that the snap arrangement of DeBalko represents a friction fit.

In conclusion, the examiner's anticipation rejection of claims 1-9 is sustained with respect to claims 1, 6, 8 and 9, but is not sustained with respect to claims 2-5 and 7. Therefore, the decision of the examiner rejecting claims 1-9 is affirmed-in-part.

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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

ERROL A. KRASS)	
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)	
JERRY SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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JS/ki

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