

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte LOREN A. HALUSKA

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Appeal No. 1996-3816  
Application No. 08/293,331<sup>1</sup>

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ON BRIEF

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Before JOHN D. SMITH, PAK, and KRATZ, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 54 through 56. Claims 57-60, which are

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<sup>1</sup> Application for patent filed August 22, 1994. According to appellant, this application is a division of Application No. 08/077,469, filed June 15, 1993; which is a continuation of Application No. 07/683,908, filed April 11, 1991, now abandoned; which is a continuation of Application No. 07/423,317, filed October 18, 1989, now abandoned.

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all of the remaining claims pending in this application, have  
been indicated as allowable by the examiner.



OPINION

Having carefully considered each of appellant's arguments, we are not persuaded of reversible error on the part of the examiner. Accordingly, we will sustain this rejection. We add the following comments for emphasis.

We initially note that appellant states at page 2 of the brief that the claims stand or fall together. Accordingly, we shall focus our consideration of the issues raised in this appeal primarily as they relate to representative claim 54.

In obviousness-type double patenting rejections, any analysis employed parallels the guidelines for analysis of a § 103 obviousness determination. See *In re Longi*, 759 F.2d 887, 892-93, 225 USPQ 645, 648 (Fed. Cir. 1985). Accordingly, the question this appeal presents requires us to decide whether the claims on appeal herein encompass a product which would not have been patentably distinct from the product necessarily produced by

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the process of claims 1-5, 12, and 13 of Mine<sup>2</sup>. We answer this question in the affirmative.

Although Mine does not claim the product of the process of claims 1-5, 12, and 13, the resulting product of Mine's process would be indistinguishable from the here claimed product since the process steps are essentially the same as in appealed claims 54-56. In this regard, we note that the appealed claims describe the coated electronic device product in terms of the method of making the device.

Appealed claim 54 calls for an electronic device to be coated with a solution of solvent and hydrogen silsesquioxane resin with the solvent being evaporated to deposit a preceramic coating, which coating is heated to a temperature of between about 500 up to about 800°C in an inert atmosphere

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<sup>2</sup>According to the assignment records of the Patent and Trademark Office, an assignment of the Mine patent to Dow Corning Corporation was recorded on July 25, 1997. The real party in interest (assignee) of the present application identified by appellant at page 1 of the brief is Dow Corning Corporation. Accordingly, consideration of an obviousness-type double patenting rejection is appropriate by virtue of the common assignee notwithstanding the different inventive entities between the Mine patent and the present application.

to thereby obtain the coated product which is the subject of the appealed

claims. According to appellant's specification, the silica coating does not have essentially any Si-H bonds (appellant's specification, Example 1).

Mine claims a method of forming a film (coating) by providing a film of a hydrogen silsesquioxane resin on a substrate using a solvent solution, removing the solvent, and heating the resin film in an inert atmosphere to a temperature of between 250 up to, but not including, 500°C to reduce hydrogen in the film to less than 80% of that in the resin used (Mine, claims 1 and 2). An electrical device such as a semiconductor may be used as the substrate to be coated in the claimed process of Mine (claim 4).

In view of the above, and a comparison of the claims of Mine and the appealed claims, we agree with the examiner that the product of the appealed claims encompasses and would have been *prima facie* obvious from the product produced by carrying out the claimed process of Mine. *Compare In re Best*, 562 F.2d

1252, 1255, 195 USPQ 430, 433-434 (CCPA 1977). In this regard, we also determine that the term "about" utilized by appellant in his claims to describe the temperature range to which the coating is heated permits some tolerance and would have encompassed temperatures within Mine's claimed temperature range. See *In re Woodruff*, 919 F.2d 1575, 1577-1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990) and *In re Ayers*, 154 F.2d 182, 185, 69 USPQ 109, 112 (CCPA 1946).

Appellant's challenge the examiner's rejection on the rationale that the claims can't be in conflict in that the claims of the application and patent are directed to separate categories of invention (brief, page 4). We do not find this line of reasoning persuasive.

As we indicated above, the test for obviousness-type double patenting is analogous to a § 103 obviousness determination and requires us to determine whether the claims are patentably distinct which we have done and answered in the negative, not whether they involve the same or separate categories of invention as argued. The fact that the claims of the application are drawn to a product whereas the claims of the patent are drawn to a process does not automatically

dispose of the patentability issue in appellant's favor as argued. See *In re Lonardo* 119 F.3d 960, 968, 43 USPQ2d 1262, 1268 (Fed. Cir. 1997), *cert. denied* 118 S.Ct 1164 (1998).

Appellant further asserts that the obviousness-type double patenting rejection is not justified since the examiner asserted that the product could be made by another method in a restriction requirement between product and method claims in parent application No. 07/423,317 (brief, page 5). At the outset, we note that the provisions of the third sentence of 35 U.S.C. § 121 do not prohibit the use of the Mine patent in the obviousness-type double patenting rejection at issue herein since the application upon which the Mine patent issued was voluntarily filed and was not the subject of a restriction requirement. Moreover, we do not find the examiner's statements in making the restriction requirement in the parent application No. 07/423,317 particularly relevant to the present inquiry for reasons set forth by the examiner at pages 5 and 6 of the answer.

We do not agree with the view expressed in the dissenting opinion regarding the appropriateness of assigning an estoppel effect to the examiner's prior restriction requirement in

light of appellant having allegedly detrimentally relied thereon. In this regard, we consider the plain language of the third sentence of 35 U.S.C. § 121 to be dispositive of this issue in that the use of Mine as a reference herein is clearly not precluded thereby. Nor do we find that equity would favor the appellant in the present situation in that appellant voluntarily filed and was in control of the prosecution of this application as well as the flow (or lack thereof) of information regarding the existence of these separately filed applications to the respective examiners. Also, the present record does not support an inference of appellant having detrimentally relied on the prior restriction requirement.

Accordingly, we sustain the examiner's rejection since the resulting product of Mine's claimed process would be patentably indistinguishable from the here claimed product since the process steps are essentially the same as discussed above.

#### **OTHER ISSUES**

In the event of any further prosecution of this

application, the examiner should investigate and determine whether or not the Mine patent is available as prior art with respect to this application under 35 U.S.C. § 102(f) or (g). In this regard, it is noted that 35 U.S.C. § 103(c) only excludes § 102(f) or (g)

subject matter as prior art if the subject matter (e.g., Mine patent) and the application were owned by the same person or subject to common assignment **at the time the invention was made**. See Chart II-B on page 800-14 of the Manual of Patent Examining Procedure (MPEP) (7th ed., 1998).

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 54-56 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over

claims 1-5, 12, and 13 of Mine (U.S. Patent No. 5,370,904) is affirmed.

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

AFFIRMED

JOHN D. SMITH	)	
Administrative Patent Judge	)	BOARD OF PATENT
	)	APPEALS
	)	AND
PETER F. KRATZ	)	INTERFERENCES
Administrative Patent Judge	)	

PAK, *Administrative Patent Judge*, Dissenting

I respectfully dissent from the majority's opinion. The present application, which includes the appealed product-by-process claims, is a division of an application containing process claims, which matured into U.S. Patent 5,380,567. Claim 1 of U.S. Patent 5,380,567, which was the subject of the restriction requirement by the same examiner in the present application, is reproduced below.

1. A method of forming a coating on an electronic device consisting essentially of:

(A) coating the electronic device with a solution consisting essentially of a solvent and hydrogen silsesquioxane resin;

(B) evaporating the solvent to deposit a preceramic coating on the electronic device; and

(C) heating the preceramic coating to a temperature of between about 500E up to about 800EC. under an inert gas atmosphere.

This claim recites process limitations which are closer to the process limitations of the product-by-process claims in question than the claims of U.S. Patent 5,370,904 issued to Mine et al. For convenience, claim 1 of U.S. Patent 5,370,904 (Mine et al.) is reproduced below.

1. A method for the formation of a silicon oxide film comprising:

forming a hydrogen silsesquioxane resin film on the surface of a substrate and

converting the hydrogen silsesquioxane resin into silicon oxide ceramic by heating the resin film-bearing substrate in an inert gas atmosphere at 250EC. up to, but not including, 500EC. until the content of silicon-bonded hydrogen in the silicon oxide product has reached # 80% of the content of silicon-bonded hydrogen in the hydrogen silsesquioxane resin.

During prosecution of the parent application of the present divisional application, the examiner determined that the process claims of U.S. Patent 5,380,567 and the product-by-process claims in question are patentably distinct from one another for the restriction purposes. The examiner now takes the position that the process claims of U.S. Patent 5,370,904 (Mine et al.), which are less close to the product-by-process claims in the present application than the process claims of U.S. Patent 5,380,567, are not patentably distinct from the product-by-process claims. Under this circumstance, it is my opinion that the examiner is estopped from taking a position different from a previous one which resulted in filing of the present divisional application. When applicant relies on the examiner's restriction requirement to his detriment, the examiner should be precluded from taking a position contrary to his initial position. This intent, in my view, is

manifested in 35 U.S.C. § 121. Indeed, the Court in *In re Taylor*, 360 F.2d 232, 236, 149 USPQ 615, 619 (CCPA 1966) held that no obviousness-type double patenting exists under similar circumstances. Specifically, the Court in *Taylor*, 360 F.2d at 236, 149 USPQ at 619 states that:

Were the process claims of the patent identical with the process step recited in the appealed claim, a closer question might have been presented. We note, however, in this respect that in this art it appears to have been a past practice of the Patent Office to require restriction under Rule 142 between claims defining collagen films and claims defining a process for centrifugally casting a film.

The appealed claim defines a product wherein oriented collagen fibers having a preferred tensile strength are produced in a collagen film of uniform thickness. The patented claims define a process in which the collagen film of uniform thickness. The patented claims define a process in which the collagen solution is subjected to spin casting on a precast wax base and helical cutting the film to produce a collagen film of uniform cross-section. While the patented process may produce a product which falls within the claim to a product as defined in the appealed claim, this does not require the conclusion that double patenting exists.

Accordingly, the decision of the examiner regarding the obviousness-type double patent rejection should be reversed.

CHUNG K. PAK ) BOARD OF PATENT  
Administrative Patent Judge ) APPEALS AND  
) INTERFERENCES

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KRATZ

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APJ KRATZ

APJ JOHN D. SMITH

APJ PAK

DECISION: **AFFIRMED**

Prepared By: TINA

**DRAFT TYPED:** 30 Jan 01

**FINAL TYPED:**