

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LEWIS S. GOLDMANN and CHANDRIKA PRASAD

Appeal No. 2001-1618
Application No. 08/960,565

ON BRIEF

Before HAIRSTON, FLEMING, and GROSS, ***Administrative Patent Judges.***
GROSS, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 22, which are all of the claims pending in this application.

Appellants' invention relates to a spring contact for temporary attachment of a semiconductor wafer to a test and/or burn-in apparatus, where the spring is formed of a shape memory metal. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A spring contact for temporary attachment of a semiconductor wafer to a test and/or burn-in apparatus, said spring fabricated from one of a shape memory metal, said shape

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memory metal plastically deforming under normal test or burn-in contact loading and having a transition temperature at or above the burn-in temperature, or said shape memory metal in combination with another metal.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Brandt et al. (Brandt) 5,488,314 Jan. 30, 1996

Claims 1 through 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Brandt.

Reference is made to the Examiner's Answer (Paper No. 16, mailed October 31, 2000) for the examiner's complete reasoning in support of the rejection, and to appellants' Brief (Paper No. 15, filed August 22, 2000) and Reply Brief (Paper No. 17, filed December 15, 2000) for appellants' arguments thereagainst.

OPINION

We have carefully considered the claims, the applied prior art reference, and the respective positions articulated by appellants and the examiner. As a consequence of our review, we will reverse the obviousness rejection of claims 1 through 22 substantially for the reasons presented by appellants in the Brief and Reply Brief, as further amplified below.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the

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legal conclusion of obviousness. See *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is required to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). Such determinations include the scope and content of the prior art and differences between the prior art and the claims at issue and a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal, Inc. v. Rudkin-Wiley*, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), *cert. denied*, 488 U.S. 825 (1988). "That knowledge can not come from the applicant's invention itself." *Oetiker*, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992). Furthermore, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusionary statements of the examiner. See *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

The examiner in the instant case admits (Answer, page 3) that Brandt does not teach the spring contact being formed from a

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shape memory metal. Nonetheless, the examiner asserts (Answer, page 4) that it would have been obvious to use a shape memory metal because "most of spring contact, probe contact are fabricated from one of a shape memory metal for permitting an increase in the deflections of the probes." The examiner further contends (Answer, page 4) that "it appears that the shape memory metal (4) which is an alloy of Nickel and one of titanium or cobalt having 42 to 48% by weight titanium, balance nickel would have been an obvious modification," that "it would have been well known" to separate spring contacts from each other in an array "by a material selected from the group consisting of invar, silicon or glass ceramic which has coefficient of thermal expansion substantially close to the device under test or burn-in," and that "it would have been obvious that the means to array the spring contacts (4) in a test board is a carrier." The examiner provides no objective evidence to support any of the assertions of obviousness. The examiner merely makes conclusionary statements. In accordance with **Lee**, this is insufficient for a rejection under 35 U.S.C. § 103. Accordingly, we cannot sustain the obviousness rejection of claims 1 through 22 over Brandt.

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CONCLUSION

The decision of the examiner rejecting claims 1 through 22 under 35 U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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