

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HOMER B. KLONIS, ROBERT G. MCKENNA,
and RONALD A. JASCOTT

Appeal No. 2001-1889
Application No. 09/222,453

ON BRIEF

Before RUGGIERO, DIXON, and BLANKENSHIP, Administrative Patent Judges.
BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-18, which are all the claims in the application.

We reverse.

BACKGROUND

The invention is directed to a spatial light modulator package, whereby a window is glued to a window frame to avoid distortion of the glass that may occur, according to appellants, with the prior art method of heat bonding. Claim 10 is reproduced below.

10. A micromechanical package lid comprising:
a glass window; and
a metal window frame glued to said glass window.

The examiner relies on the following references:

Poradish et al. (Poradish)	5,293,511	Mar. 8, 1994
Yamada et al. (Yamada)	5,508,834	Apr. 16, 1996

Claims 1-17 stand rejected under 35 U.S.C. § 102 as being anticipated by Poradish.

Claim 18 stands rejected under 35 U.S.C. § 103 as being unpatentable over Poradish and Yamada.

We refer to the Final Rejection (Paper No. 6) and the Examiner's Answer¹ (Paper No. 14) for a statement of the examiner's position and to the Brief (Paper No. 10) and the Reply Brief (Paper No. 12) for appellants' position with respect to the claims which stand rejected.

¹ The paper is styled "Supplemental Examiner's Answer," but is a substitute for an earlier paper (Paper No. 11).

OPINION

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

The examiner sets forth findings (Answer at 5-6) with respect to how Poradish is deemed to meet the limitations of the claims before us. Appellants complain (e.g., Brief at 3) that the rejection, even though set forth under section 102 for anticipation, seems to pick and choose elements or steps from among the five separate methods described by Poradish.

We agree with appellants that combining different embodiments found in a reference does not normally support a finding of anticipation. Whether there is suggestion to combine elements or steps of different embodiments is an inquiry under obviousness, rather than anticipation. "Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

Perhaps more important, however, we find that the examiner relies on certain elements or steps in the reference that cannot be considered to meet the terms of the instant claims.

Instant claim 10 appears to be drafted in extremely broad terms. However, the claim does require “a glass window” and “a metal window frame glued to said glass window.” The claim thus requires (1) a glass window, (2) a metal window frame, and (inherently) (3) an adhesive attaching the metal window frame and the glass window.

The rejection asserts (Answer at 5 and 10) that the “window frame” reads on element 146, as shown in Figure 9, and is attached to substrate 46 (Fig. 6). According to the reference, base 46 is made of a molded ceramic material. Poradish at col. 6, ll. 5-6. However, element 146 (Fig. 9) is not any form of “metal window,” but is an alternative base which lacks the cavity 48 (Figs. 1 and 5-7) in which chip 12 resides in first base 46. Alternative base 146 may be paired with a different cover 142 (Fig. 8). Col. 6, ll. 14-30.

Of the five techniques that the reference describes for affixing a cover to a base (cols. 8 and 9), the second (col. 8, l. 66 - col. 9, l. 16) uses a soft metal for affixing a cover to seal ring 70 on base 46 (Fig. 1). The fifth (col. 9, ll. 40-56) uses a solder preform 100 (Fig. 6) that is melted, in combination with solder-wettable metallic coating 102 and 104. However, none of the techniques describe providing a “metal window frame” or a “window frame.” A “frame” in the instant context denotes a separate supportive structure, rather than a substance that functions as an adhesive. See Webster’s Ninth New Collegiate Dictionary at 489 (1990), noun def’n 3a (“an open case or structure made for admitting, enclosing, or supporting something <a window ~>”).

Instant claim 1 requires the step of “gluing a window to a window frame,” which has not been shown in the reference. The claim also requires “attaching a metal sealing ring to said ceramic package substrate.” The rejection (Answer at 5) points to column 9, lines 40-56 (the fifth technique), which might be fairly considered “attaching a metal sealing ring.” However, the rejection also refers (Answer at 10) to “metal” [element 72] “sealing ring” [element 70]. Reference numeral 72 (Fig. 6) merely denotes the upper surface of seal ring 70. Col. 8, ll. 3-11; col. 9, ll. 40-42. Moreover, seal ring 70 is not metallic. Seal ring 70 is formed of an electrically insulative material (col. 2, ll. 48-51; col. 11, ll. 21-22) such as glass (col. 6, ll. 52-60).

Instant claim 15 requires a window frame attached to a sealing ring, and a window glued to the window frame. Since not all elements of independent claim 1, 10, and 15, respectively, have been shown in the reference, we do not sustain the rejection of claims 1-17 under 35 U.S.C. § 102 as being anticipated by Poradish.

We also do not sustain the rejection of claim 18 under 35 U.S.C. § 103 as being unpatentable over Poradish and Yamada. The claim requires a window frame attached to a sealing ring, and a glass window glued to the window frame. The teachings of Yamada fail to remedy the basic deficiencies of the Poradish reference.

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CONCLUSION

The rejection of claims 1-17 under 35 U.S.C. § 102 is reversed. The rejection of claim 18 under 35 U.S.C. § 103 is reversed.

REVERSED

JOSEPH F. RUGGIERO
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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