

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PATRICK J. RYAN,
MICHAEL R. CONBOY
and STEPHEN P. HOVESTOL

Appeal No. 2003-0931
Application 09/383,508

ON BRIEF

Before MCQUADE, NASE, and BAHR, Administrative Patent Judges.

Per curiam.

DECISION ON APPEAL

Patrick J. Ryan et al. appeal from the final rejection (Paper No. 16) of claims 1 through 4, 6 through 12 and 19, all of the claims pending in the application.

THE INVENTION

The invention relates to "a semiconductor fabrication facility employing one or more reticle sorters" (specification, page 1).¹ Representative claims 1, 10 and 19 read as follows:

¹ A reticle is a mask having clear and opaque features corresponding to a pattern to be created in a photolithography process (see page 1 in the specification).

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1. A reticle sorter coupled between a reticle storing system and one or more photolithography exposure tools, comprising:
one or more bays adapted for holding a cassette having slots for reticles;
a sorting system adapted for retrieving the reticles from and inserting the reticles into the slots in order to sort the reticles within the cassette; and
an inspection system, coupled between the one or more bays and an input port of the reticle sorter, for inspecting a characteristic of each reticle.

10. The reticle sorter of claim 1, wherein the sorting system includes two or more docking locations.

19. A reticle sorter coupled between a reticle storing system and one or more photolithography exposure tools, comprising:
one or more bays adapted for holding a plurality of cassettes having slots for reticles; and
a sorting arrangement adapted for retrieving the reticles from and inserting the reticles into the slots so as to sort the reticles between cassettes.

THE REJECTION

Claims 1 through 4, 6 through 12 and 19 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellants regard as the invention.

Attention is directed to the appellants' brief (Paper No. 20) and to the examiner's final rejection and answer (Paper Nos.

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16 and 21) for the respective positions of the appellants and examiner regarding the merits of this rejection.²

DISCUSSION

The explanation of the rejection in the final rejection and answer indicates that the examiner considers the scope of claims 1 through 4, 6 through 12 and 19 to be unclear due to the recitations of the "bays" in independent claims 1 and 19 and the "docking locations" in dependent claim 10.³ According to the examiner, these recitations are indefinite when considered in conjunction with the underlying specification.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In determining whether this standard is met, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but

² In the final rejection, claims 1 through 4, 6 through 12 and 19 also stood rejected under 35 U.S.C. § 112, first paragraph. Upon reconsideration, the examiner has withdrawn this rejection (see page 2 in the answer).

³ Further mentions of the "bays" and "docking locations" appear in dependent claims 9 and 12 and dependent claim 11, respectively.

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always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id. When considered in light of the prior art and the application disclosure, claims otherwise indefinite may be found reasonably definite, and claims definite on their face may be found indefinite. In re Kroekel, 504 F.2d 1143, 1146, 183 USPQ 610, 612 (CCPA 1974).

In the present case, the summary of the invention on pages 2 and 3 in the appellants' specification mirrors the language employed in claims 1 and 19 by stating that the reticle sorter includes one or more "bays" each capable of holding a cassette having slots for reticles. In contrast, the detailed description of Figures 1, 2, 3A and 3B on pages 3 through 6 in the specification (1) refers to "bays" only with respect to Figure 1 which depicts a sorter-less prior art fabrication plant 100 including fabrication areas or "bays" 110 having tools for processing semiconductor wafers, and (2) portrays the reticle sorters 230 and 300 shown in Figures 2, 3A and 3B as having "docking locations" 310 (but no "bays") for holding cassettes, a "docking location" 350 for holding reticles, and an arm 330 (not a sorting system including two or more docking locations as

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recited in claim 10) for retrieving reticles from and inserting them into cassette slots. Finally, the detailed description of Figure 4 on pages 7 and 8 in the specification delineates a process flow for a sorter having both a cassette "docking location" and something called a "docking bay."

Notwithstanding the appellants' position to the contrary, the foregoing inconsistencies in the underlying specification involving the use of the terms "bays," "docking locations," "docking location" and "docking bay" justify the examiner's determination that the above noted recitations in claims 1, 10 and 19 relating to the bays and docking locations, read as they are required to be in light of the specification, render the scope of the appealed claims unclear.

We shall therefore sustain the standing 35 U.S.C. § 112, second paragraph, rejection of claims 1 through 4, 6 through 12 and 19.

Since the change of the word "bays" in claims 1 and 19 to either "docking locations" or "locations" in all occurrences of "bays" would overcome the rejection of claims 1 and 19 under 35 U.S.C. § 112, second paragraph, we exercise our authority under 37 CFR § 1.196(c) and give the appellants the right to amend claims 1 and 19 by amending all occurrences of the word

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"bays" to either "docking locations" or "locations." In addition, we further exercise our authority under 37 CFR § 1.196(c) by giving the appellants the right to amend claims 9 and 12 by amending the word "bays" to either "docking locations" or "locations." If the appellants choose to amend claims 1, 9, 12 and 19 pursuant to our recommendation, we note that claims 10 and 11 would remain rejected under 35 U.S.C. § 112, second paragraph, for the reasons set forth above with respect to claim 10.

SUMMARY

The decision of the examiner to reject claims 1 through 4, 6 through 12 and 19 is affirmed. In addition, this decision contains a recommendation under 37 CFR § 1.196(c) giving the appellants the right to amend claims 1, 9, 12 and 19 by amending all occurrences of the word "bays" to either "docking locations" or "locations."

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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; 37 CFR § 1.196(c)

JEFFREY V. NASE)	
Administrative Patent Judge)	BOARD OF PATENT
)	
)	APPEALS AND
)	
)	INTERFERENCES
JENNIFER D. BAHR)	
Administrative Patent Judge)	

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MCQUADE, Administrative Patent Judge, dissenting-in-part.

The majority's affirmance of the examiner's rejection is well founded for the reasons expressed above. The accompanying recommendations under 37 CFR § 1.196(c), on the other hand, are unwarranted and ill advised.

In the final rejection (Paper No. 16), the examiner invited the appellants to revise the claims (and implicitly the specification) to overcome the now affirmed 35 U.S.C. § 112, second paragraph, rejection. The appellants chose not to do so, and instead filed a response (Paper No. 17) insisting that the claims were definite as is because "it would be plainly apparent to the skilled artisan that the specification uses the terms 'bay' and the phrase 'docking location' interchangeably [sic] and synonymously" (page 2). In their brief (Paper No. 20), the appellants again urged that the claims were definite, but this time argued that "bays" were examples of "docking locations" (see page 2), that "the assertedly confusing limitations define different claim limitations, rather than the same feature" (page 5), and, in the same vein, that "the limitations are directed to two different features" (page 5). These inconsistencies in the appellants' arguments mirror the inconsistencies in the

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specification and claims which led to the examiner's rejection and the majority's affirmance thereof.

As the appellants chose to take this case to appeal without attempting to overcome the rejection by amendment, it is not clear why, now that the examiner's position has been validated on appeal, they are being afforded the right conveyed by the majority's action under 37 CFR § 1.196(c) to amend the claims 1, 9, 12 and 19 by changing "bays" to either --docking locations-- or --locations--. Furthermore, the above noted inconsistencies in what has been variously disclosed, claimed and argued by the appellants, considered with the fact that the appellants had previously amended claim 1 to change "locations" to "bays" (see Paper No. 7), cast substantial doubt on the majority's implicit determination, which is binding on the examiner, that claims 1 through 4, 6 through 9, 12 and 19 as so amended would particularly point out and distinctly claim the subject matter the appellants regard as their invention. This issue would be far better settled through continued prosecution before the

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examiner rather than by the preemptive action taken by the
majority.

JOHN P. MCQUADE) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
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