

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ASHISH PANDYA
and
ROGER F. SINTA

Appeal No. 2003-1911
Application 09/228,694

ON BRIEF

Before GARRIS, KRATZ, and MOORE, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-34 which are all of the claims in the application.

The subject matter on appeal relates to the photoresist composition comprising a polymer resin that comprises an acid-labile group, a meta-hydroxyphenyl group, and a para-phenoxyphenyl group, wherein the meta-phenoxyphenyl group has a

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single meta-hydroxy moiety and is unsubstituted at other available ring positions. This appealed subject matter is adequately illustrated by independent claim 1 which reads as follows:

1. A photoresist composition comprising a photoactive component and a resin that comprises a polymer that comprises 1) an acid labile group; 2) a meta-hydroxyphenyl group; and 3) a para-hydroxyphenyl group, wherein the meta-hydroxyphenyl group has a single meta-hydroxy moiety and is unsubstituted at other available ring positions.

The references set forth below are relied upon by the examiner in the Section 102 and Section 103 rejections before us:

Watanabe et al. (Watanabe)	5,844,057	Dec. 1, 1998
Watanabe et al. (Japanese '137) (Japanese Patent)	6-49137	Feb. 22, 1994
Urano et al. (Urano) (European Patent Application)	0 780 732 A2	June 25, 1997

Claims 23, 27 and 29 stand rejected under the second paragraph of 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which the appellants regard as their invention.

Claims 1-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over either Watanabe or Urano.

Claims 17 and 18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese '137.

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Finally, claims 1, 3, 5 and 13-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese '137 in view of Watanabe.

On page 9 of the Brief, the appellants state that "[t]he rejected claims do **not** stand or fall together since each claim is considered separately patentable in its own right". In light of this statement, we will separately consider each claim to the extent that it has been separately argued. See 37 CFR § 1.192(c)(7) and (8) (2002). Also see Ex parte Schier, 21 USPQ2d 1016, 1018 (Bd. Pat. App. & Int. 1991).

Rather than reiterate the reiterate the respective positions advocated by the appellants and by the examiner, concerning the above-noted rejections, we refer to the Brief (i.e., the Brief filed December 17, 2002 as Paper No. 20) and to the Answer for a complete exposition thereof.

OPINION

The examiner has favored us with an Answer which presents thoroughly developed findings of fact, conclusions of law and rebuttals to argument vis-à-vis the issues before us on this appeal. There is no need to burden the record with our own exposition of these issues in light of the exemplary presentation thereof in the Answer. We shall adopt as our own, therefore, the

findings, conclusions and rebuttals presented by the examiner in the Answer. We add the following brief comments for emphasis.

The examiner's Section 112, second paragraph, rejection of claims 23, 27 and 29 is hereby sustained summarily since this rejection has not been contested by the appellants on the record of this appeal (see page 13 of the Brief).

We also hereby sustain the examiner's Section 102 rejection of claims 17 and 18. As completely explained in the Answer, the appellants' argument that Japanese '137 "does not teach . . . polymers having meta-hydroxyphenyl groups as Appellant[s] claims [sic, claim]" (Brief, page 11) is factually incorrect, and the argument that Japanese '137 "does not teach . . . polymers that contain an acrylate acid labile group as recited in Appellant's [sic, Appellants'] independent claim 24" (Brief, page 12) is irrelevant to the rejection under consideration of claims 17 and 18.

As for the Section 103 rejections, notwithstanding a full consideration of the appellants' arguments¹ thereagainst, the

¹It is appropriate to here observe that pages 14-20 of the Brief contain comments regarding claims 1-23 and 25-34 which the appellants seem to regard as arguments relating to the separate patentability of these claims. However, these comments generally constitute little more than a reiteration of the subject matter

(continued...)

applied references establish a prima facie case of obviousness for the reasons well detailed in the Answer. On pages 13-14 of the Brief, the appellants contend that the Pandya declaration of record rebuts any prima facie case under Section 103 which may exist and that the examiner has inappropriately disregarded this declaration. In fact, the examiner has not disregarded this declaration but instead has determined that it is inadequate to establish non-obviousness. In particular, it is the examiner's determination that the comparative showing set forth in the declaration fails to establish non-obviousness because it does not compare the here-claimed subject matter with the closest prior art and because it is not commensurate in scope with the claimed subject matter to which it pertains.

¹(...continued)

defined by the claim in question without specifically identifying the examiner's error in determining that the claim subject matter is unpatentable. Indeed, as noted on pages 25-26 of the Answer, the appellants comments regarding claim 17 are not even accurate with respect to the subject matter defined thereby. Under these circumstances, it is not immediately apparent that such comments qualify as arguments pursuant to 37 CFR § 1.192(c)(7) and (8). Nevertheless, with commendable professionalism and industry, the examiner has responded to each and every one of these comments by explaining the basis, including the identification of specific prior art disclosure, for his own patentability determination with respect to each of the claims in question.

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These ultimate determinations by the examiner are well taken. For example, see In re Merchant, 575 F.2d 865, 868-69, 197 USPQ 785, 787-88 (CCPA 1978) and In re Dill, 604 F.2d 1356, 1361, 202 USPQ 805, 808 (CCPA 1979). The examiner's fundamental position on this matter is reinforced by the fact that neither the Brief nor the declaration contains any explanation at all as to why the comparative polymer tested in the declaration showing is thought to be as close or closer than the prior art polymers specifically disclosed in the applied references. Likewise, neither the Brief nor the declaration contains any explanation at all as to why the three polymers tested in the declaration are thought to be commensurate in scope with the appellants' claimed subject matter. In addition to the foregoing, it is important to stress that the declaration contains no discussion at all of the test results or even an unembellished characterization of these results as being unexpected.

For the reasons set forth above and in the Answer, we determine that the evidence in the appeal record before us, on balance, clearly weighs most heavily in favor of an obviousness conclusion. Therefore, we also sustain each of the examiner's Section 103 rejections advanced on this appeal.

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CONCLUSION

The decision of the examiner 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

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
)	
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)	BOARD OF PATENT
PETER F. KRATZ)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
JAMES T. MOORE)	
Administrative Patent Judge)	

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