

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte HONG-SUNG SONG
and
SUNG-WOONG MOON

Appeal No. 2005-0918
Application No. 09/785,423

ON BRIEF

Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 17, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a tape carrier package (TCP) film used for fabricating a liquid crystal display. More particularly, the appellants' invention relates to a TCP film having an enhanced mounting efficiency (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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|-----------|-----------|---------------|
| Honda | 4,702,370 | Oct. 27, 1987 |
| Hashimoto | 6,297,964 | Oct. 2, 2001 |

Claims 1 to 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Honda in view of Hashimoto. The basis for the rejection as set forth on pages 3-4 of the examiner's answer (mailed August 19, 2004) is as follows:

Honda '370 discloses a tape carrier package film (synthetic resin carrier tape 30') for electronic components, comprising: a tape carrier package part having a mounting portion for a driving integrated circuit, wherein the tape carrier part is defined by depressions (recess 34'), a peripheral part having a plurality of sprocket holes (36'); and a plurality of punching holes (34b') formed by cutting a pad of the tape carrier package part and a part of the peripheral pad which will inherently reduce connection between the tape carrier package part and the peripheral part and is formed along a border of the tape carrier package part and the peripheral part. See Figure 4 embodiment. Honda '370 is silent about

whether the tape carrier package is a package film.^[1] Hashimoto '964 is cited merely as an example that it is old and conventional to make tape carrier packages from package film. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the tape carrier package of Honda '370 from package film as taught by Hashimoto '964, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

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The punching holes (34b') of Honda '370 will inherently reduce connection between the tape carrier package pad and the peripheral part and will inherently assist in separation of the tape carrier package pad from the peripheral part.

The appellants' arguments against this rejection are set forth in the brief (filed July 29, 2004) and reply brief (filed October 18, 2004). The examiner's response to those arguments are set forth in the answer.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the

¹The examiner appears to have made contradictory findings. First, the examiner found that Honda "discloses a tape carrier package film." Thereafter, the examiner found that Honda "is silent about whether the tape carrier package is a package film."

examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 17 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Claims 1 and 5, the independent claims on appeal, read as follows:

1. A tape carrier package film for a liquid crystal display, comprising:
 - a tape carrier package part having a mounting portion for a driving integrated circuit, wherein the tape carrier package part is defined by depressions;
 - a peripheral part for securing the tape carrier package part, said peripheral part having a plurality of sprocket holes; and
 - a plurality of punching holes formed by cutting a part of the tape carrier package part and a part of the peripheral part for reducing a connection between the tape carrier package part and the peripheral part.

5. A tape carrier package film, comprising:
 - a peripheral part having sprocket holes; and

a tape carrier package part on the package film defined by depressions, said tape carrier package part having a mounting portion for receiving an integrated circuit;

wherein a plurality of punching holes are formed along a border of the tape carrier package part and the peripheral part, the punching holes assisting separation of the tape carrier package part from the peripheral part.

In our view, the combination of Honda and Hashimoto as set forth in the rejection under appeal does not arrive at the subject matter of either claim 1 or claim 5 for the reasons set forth by the appellants in the brief and reply brief. In particular, the following limitations are not taught or suggested by the applied prior art: (1) a plurality of punching holes formed by cutting a part of the tape carrier package part and a part of the peripheral part for reducing a connection between the tape carrier package part and the peripheral part as recited in claim 1; and (2) a plurality of punching holes are formed along a border of the tape carrier package part and the peripheral part, the punching holes assisting separation of the tape carrier package part from the peripheral part as recited in claim 5. Honda's recesses 34' are formed by embossing film or sheet material.² As such, the lead storing parts 34b' of the recesses 34' are not punching

²Each recess 34' comprises a main body storing part 34a responding to the shape or size of the main body 20a' of the electronic component 20', and two lead storing parts 34b' for storing the two leads 20b' of the electronic component 20'.

holes formed by cutting.³ Likewise, the lead storing parts 34b' of the recesses 34' do not assist separation of a tape carrier package part from a peripheral part.

For the reasons set forth above, the decision of the examiner to reject claims 1 and 5, and claims 2 to 4 and 6 to 17 dependent thereon, under 35 U.S.C. § 103 is reversed.

³In our view, the term "cutting" as used in claim 1 to describe how the punching holes are formed is a structural limitation entitled to patentable weight since cutting imparts distinctive structural characteristics to the final product than does embossing.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 17 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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