

The opinion in support of the decision being entered today is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte CETIN NMI KAYA

---

Appeal No. 2006-1532  
Application No. 09/620,649

---

ON BRIEF

---

Before OWENS, DELMENDO, and FRANKLIN, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

**DECISION ON APPEAL UNDER**  
**35 U.S.C. § 134**

1           This is a decision on an appeal under 35 U.S.C. § 134  
2 (2006) from the examiner's rejection of claims 12 through 19  
3 (Office action mailed June 15, 2004).<sup>1,2</sup>

4           Because the examiner has made out a prima facie case of

---

<sup>1</sup> This application was the subject of a prior appeal in which we affirmed the examiner's decision to reject the same claims now on appeal. Ex parte Kaya, No. 2003-1564 (B.P.A.I. October 23, 2003), reh'g denied (December 31, 2003).

<sup>2</sup> Claim 20, the only other pending claim, stands allowed and is therefore not involved in this appeal.

1 unpatentability with respect to the appealed claims and since  
2 the appellant has failed to direct us to any persuasive argument  
3 or evidence in rebuttal, we affirm.

4

5

**The Appealed Subject Matter**

6 The subject matter on appeal relates to an integrated  
7 circuit having independently formed array and peripheral  
8 isolation dielectrics. (Specification at 1, lines 2-5.)

9 Claims 12, 14, and 18, which are illustrative of the  
10 appealed subject matter, read as follows:

11 12. An integrated circuit, comprising:  
12 a first dielectric layer disposed outwardly from  
13 a substrate;  
14 a plurality of gate stacks, each gate stack  
15 comprising:  
16 a floating gate body disposed outwardly from  
17 the first dielectric layer;  
18 a second dielectric region disposed  
19 outwardly from the floating gate body; and  
20 a first polysilicon layer disposed outwardly  
21 from the second dielectric region; and  
22 a plurality of dielectric isolation regions  
23 disposed between the gate stacks, the dielectric  
24 isolation regions formed after the formation of the  
25 gate stacks.

26

27 14. The integrated circuit of Claim 12, wherein  
28 each dielectric isolation region comprises:  
29 an isolation oxide layer; and  
30 an isolation dielectric layer;  
31 the dielectric isolation region formed by:  
32 growing approximately 200Å of oxide outwardly  
33 from the gate stacks;





Appeal No. 2006-1532  
Application No. 09/620,649

1 selected claims. 37 CFR § 1.192(c)(7)(2004)(effective Apr. 21,  
2 1995).<sup>3</sup>

3 The relevant facts of this case are not in dispute.

4 The subject application was filed on July 20, 2000,  
5 claiming divisional application status under 35 U.S.C. §§ 120  
6 and 121 (2001) based on prior non-provisional application  
7 09/168,047, which was filed on October 7, 1998 and issued to the  
8 appellant as United States patent 6,194,267 on February 27,  
9 2001. (Transmittal letter filed on July 20, 2000; preliminary  
10 amendment filed on July 21, 2000.)

11 On May 16, 2001, the appellant further amended the  
12 application in an attempt to claim benefit of priority under 35  
13 U.S.C. § 119(e)(1) based on provisional application 60/060,561  
14 filed on September 30, 1997.<sup>4</sup> (Amendment filed on May 16, 2001.)  
15 This priority claim, however, was inappropriate because parent  
16 non-provisional application 09/168,047 was not filed within  
17 twelve months of the filing date of provisional application  
18 60/060,561 as required under 35 U.S.C. § 119(e)(1). That is,

---

<sup>3</sup> We apply the regulation in effect at the time the appeal brief was filed.

<sup>4</sup> The appellant asserts, and the examiner does not challenge, that the specification in the provisional application

Appeal No. 2006-1532  
Application No. 09/620,649

1 parent application 09/168,047 was filed on October 7, 1998,  
2 which is seven days after the expiration of provisional  
3 application 60/060,561. Accordingly, the earliest possible  
4 effective filing date for the appealed claims is the filing date  
5 of the parent application, which is October 7, 1998.

6 Van Buskirk, the principal prior art reference, issued on  
7 December 14, 1999 based on an application filed on January 16,  
8 1998. Because Van Buskirk issued from an application filed  
9 before the earliest effective filing date that may be accorded  
10 to the appealed claims, it is facially prior art under 35 U.S.C.  
11 § 102(e).

12 The following timeline summarizes the events in question:

13	Provisional	Van Buskirk	Expiration	Parent	Subject
14	appln.	effective date	of Provisional	appln.	appln.
15	9/30/1997	1/16/1998	9/30/1998	10/7/1998	7/20/2000
16	^	^	^	^	^
17	-----				

18 The appellant does not dispute the examiner's determination  
19 that Van Buskirk describes every limitation recited in appealed  
20 claims 12, 13, 15, and 16. Nor does the appellant contest the  
21 examiner's determination that one of ordinary skill in the art  
22 would have found the subject matter of appealed claims 14, 17,

---

is substantially identical to the specification in the subject application. (Appeal brief at 5.)

1 18, and 19 obvious over the combined teachings of: (i) Van  
2 Buskirk; and (ii) Chan or Woo.

3         Rather, the appellant relies on Pfaff v. Wells Electronics,  
4 Inc., 525 U.S. 55, 60 (1998), to argue that the term "invention"  
5 as used in 35 U.S.C. § 102(e) does not include any "reduction to  
6 practice" requirement. (Appeal brief at 3.) According to the  
7 appellant, "35 U.S.C. nowhere defines 'invention' by  
8 determination solely of the questions of reduction to practice  
9 or conception with diligence up to a reduction to practice  
10 (actual or constructive)." (Appeal brief at 3-4.) The  
11 appellant contends that the abandoned or lapsed provisional  
12 application, which was filed before the effective date of the  
13 Van Buskirk reference, contains an enabling description of the  
14 claimed invention (i.e., "ready for patenting" as explained in  
15 Pfaff) on which the appellant may rely to antedate Van Buskirk.  
16 (Appeal brief at 5.) Specifically, the appellant contends that  
17 patent counsel's declaration filed on July 23, 2001 "could and  
18 should be considered as though it is a declaration under 37  
19 C.F.R. 1.131" and that Van Buskirk is not §102(e) prior art  
20 because the "declaration, considered in conjunction with the  
21 Pfaff decision, provides specific reference to the provisional  
22 application which was a demonstration of the claimed invention

1 herein as being ready for patenting prior to the effective date  
2 of the Van Buskirk et al. reference." (Appeal brief at 6.)

3 We do not subscribe to the appellant's misapplication of  
4 legal precedent and circular logic. Pfaff never holds that the  
5 term "invention" means conception, as the appellant seems to  
6 believe (reply brief filed May 4, 2005). When read in proper  
7 context, it is clear that Pfaff defines "invention" in the  
8 context of whether an actual reduction to practice is necessary  
9 to trigger the on-sale bar of 35 U.S.C. § 102(b). Pfaff, 525  
10 U.S. at 57 n.2. The Supreme Court held that it was not.  
11 Indeed, as support for the proposition that "invention" does not  
12 require actual reduction to practice, Pfaff identifies an  
13 instance where the filing of an application (i.e., constructive  
14 reduction to practice) was held to be sufficient. Pfaff, 525  
15 U.S. at 62, n.10 (citing Alexander Millburn Co. v. Davis-  
16 Bournonville Vo., 270 U.S. 390, 401-402 (1926)).<sup>5</sup>

17 Pfaff held:

18 [T]he invention must be ready for patenting.  
19 That condition may be satisfied in at least two ways:  
20 by proof of reduction to practice before the critical  
21 date; or by proof that prior to the critical date the

---

<sup>5</sup> 35 U.S.C. § 102(e), the statute upon which the examiner relies to reject the appealed claims, is said to be a codification of Millburn. Chisum on Patents § 3.07 at 3-204 (2002).

1 inventor had prepared drawings or other descriptions  
2 of the invention that were sufficiently specific to  
3 enable a person skilled in the art to practice the  
4 invention.

5  
6 Pfaff, 525 U.S. 67-68. The appellant's overreaching statement  
7 that "[t]he Pfaff decision overrides the C.F.R. [i.e., 37 CFR  
8 § 1.131]" (reply brief at 3) lacks merit.

9 In our view, 37 CFR § 1.131 is entirely consistent with  
10 Pfaff. 37 CFR § 1.131 reads as follows:

11 (a) When any claim of an application or a  
12 patent under reexamination is rejected, the inventor  
13 of the subject matter of the rejected claim, the owner  
14 of the patent under reexamination, or the party  
15 qualified under §§ 1.42, 1.43, or 1.47, may submit an  
16 appropriate oath or declaration to establish invention  
17 of the subject matter of the rejected claim prior to  
18 the effective date of the reference or activity on  
19 which the rejection is based. The effective date of a  
20 U.S. patent, U.S. patent application publication, or  
21 international application publication under PCT  
22 Article 21(2) is the earlier of its publication date  
23 or date that it is effective as a reference under 35  
24 U.S.C. 102(e). Prior invention may not be established  
25 under this section in any country other than the  
26 United States, a NAFTA country, or a WTO member  
27 country. Prior invention may not be established under  
28 this section before December 8, 1993, in a NAFTA  
29 country other than the United States, or before  
30 January 1, 1996, in a WTO member country other than a  
31 NAFTA country. Prior invention may not be established  
32 under this section if either:

33 (1) The rejection is based upon a U.S. patent  
34 or U.S. patent application publication of a pending or  
35 patented application to another or others which claims  
36 the same patentable invention as defined in  
37 § 1.601(n); or  
38

1 (2) The rejection is based upon a statutory  
2 bar.

3 (b) The showing of facts shall be such, in  
4 character and weight, as to establish reduction to  
5 practice prior to the effective date of the reference,  
6 or conception of the invention prior to the effective  
7 date of the reference coupled with due diligence from  
8 prior to said date to a subsequent reduction to  
9 practice or to the filing of the application.

10 Original exhibits of drawings or records, or  
11 photocopies thereof, must accompany and form part of  
12 the affidavit or declaration or their absence  
13 satisfactorily explained. [Underscoring added.]  
14

15 Thus, consistent with Pfaff's definition of "invention," an  
16 applicant may establish a date of invention prior to the  
17 effective date of the reference by a showing of prior conception  
18 coupled with due diligence from prior to the effective date of  
19 the reference to the filing of an application (i.e., a  
20 description sufficiently specific to enable a person having  
21 ordinary skill in the art). Consistent with the holding in  
22 Pfaff, 37 CFR § 1.131 does not require actual reduction to  
23 practice, although evidence of actual reduction to practice may  
24 be used to antedate a reference.

25 A declaration may be filed to antedate a 35 U.S.C. § 102(e)  
26 reference. When filed, however, the declaration must comply  
27 with 37 CFR § 1.131. It must be submitted by the inventor of  
28 the subject matter of the rejected claim, the owner of the  
29 patent under reexamination, or the party qualified under 37 CFR

1 §§ 1.42, 1.43, or 1.47. In this case, the appellant does not  
2 rely on a declaration executed by the inventor or a party  
3 qualified under 37 CFR §§ 1.42, 1.43, or 1.47 as required under  
4 this rule. Instead, the appellant relies on a declaration,  
5 which was executed by patent counsel, alleging what are believed  
6 to be the facts of the case. (Patent counsel's declaration,  
7 captioned "AMENDMENT UNDER 37 C.F.R. 1.116 AND DECLARATION,"  
8 filed July 23, 2001.) For this reason alone, the appellant has  
9 not effectively antedated any of the applied prior art  
10 references.

11 Even if we assume that patent counsel's declaration  
12 satisfies the rule, which it does not, the appellant has not  
13 established "reduction to practice prior to the effective date  
14 of the reference, or conception of the invention prior to the  
15 effective date of the reference coupled with due diligence from  
16 prior to said date to a subsequent reduction to practice or to  
17 the filing of the application." Here, the appellant has shown  
18 conception of the invention prior to the effective date of the  
19 reference (January 16, 1998), as evidenced by the filing of the  
20 provisional application on September 30, 1997. Nevertheless,  
21 proof of this conception must be coupled with proof of due  
22 diligence from prior to January 16, 1998 to the filing of the

Appeal No. 2006-1532  
Application No. 09/620,649

1 parent application (October 7, 1998). Again, however, the  
2 appellant does not direct us any evidence establishing due  
3 diligence during the relevant time period, which is from just  
4 prior to January 16, 1998 to October 7, 1998. That the  
5 appellant missed the statutory deadline for claiming benefit of  
6 an earlier filing date under 35 U.S.C. § 119(e)(1) based on the  
7 provisional application strongly suggests that due diligence was  
8 lacking during at least part of the time period from just prior  
9 to the effective date of reference to the filing of the parent  
10 application. The appellant has not identified persuasive  
11 evidence establishing diligence for the seven days from the  
12 expiration of the lapsed provisional application to the filing  
13 of the parent application. In re Mulder, 716 F.2d 1542, 1545,  
14 219 USPQ 189, 193 (Fed. Cir. 1983) ("A liberal construction of  
15 the rule, which is clearly intended to benefit applicants, will  
16 permit applicants to show diligence from just prior to the date  
17 of the reference to their convention filing date, rather than  
18 all the way from their proven conception date, but liberality  
19 cannot be extended to the point of eliminating all proof of  
20 diligence, no matter how short [two days] the period to be  
21 covered." ).

1           The description in the provisional application could have  
2 been properly used as part of the evidence needed to establish  
3 that the invention was "ready for patenting" (i.e., as a  
4 constructive reduction to practice in the context of 37 CFR  
5 § 1.131) before the effective date of Van Buskirk. Here,  
6 however, the appellant permitted the provisional application to  
7 lapse. The appellant's arguments that equate "ready for  
8 patenting" with the mere existence of an enabling description of  
9 the invention in an abandoned or lapsed provisional application  
10 amount to an attempt to circumvent the statutory scheme of 35  
11 U.S.C. §§ 111(b), 119, 120, and 121, thus rendering many of the  
12 provisions including non-revivable abandonment of a provisional  
13 application or the copendency and timeliness requirements a  
14 nullity.<sup>6</sup> Cf. In re Costello, 717 F.2d 1346, 1350, 219 USPQ 389,  
15 391 (Fed. Cir. 1983)("It has long been settled, and we continue  
16 to approve the rule, that an abandoned application, with which  
17 no subsequent application was copending, cannot be considered a  
18 constructive reduction to practice...It is inoperative for any  
19 purpose, save as evidence of conception.").

---

<sup>6</sup> In this regard, we point out that a provisional application is not submitted for examination. 35 U.S.C. § 111(b)(8). Thus, it does not necessarily constitute evidence

1           The appellant urges that a prior art reference may be  
2 antedated by ways other than that set forth in 37 CFR § 1.131.  
3 (Appeal brief at 6.) The appellant, however, does not cite any  
4 persuasive legal authority for this proposition. Moreover, a  
5 fundamental rule underlying a 35 U.S.C. § 102(e) rejection is  
6 that the applicant whose claims are rejected would not be the  
7 "first inventor" in the face of the reference United States  
8 patent. Millburn, 270 U.S. at 402. Accordingly, it is  
9 reasonable to require that the showing of facts necessary to  
10 antedate a 35 U.S.C. § 102(e) reference be similar to those  
11 required to show priority of invention under 35 U.S.C. § 102(g).

12           For these reasons, we uphold the examiner's rejections.

13

14

**Summary of Decision**

15

In sum, we AFFIRM the examiner's rejections of:

16

1. claims 12, 13, 15, and 16 under 35 U.S.C. § 102(e) as  
anticipated by Van Buskirk;

17

18

2. claims 14 and 17 under 35 U.S.C. § 103(a) as

19

unpatentable over the combined teachings of Van

20

Buskirk and Chan; and

---

that the invention described therein was "ready for patenting"  
or was constructively reduced to practice at the time of filing.



Appeal No. 2006-1532  
Application No. 09/620,649

1 RHD/yrt  
2  
3  
4  
5  
6 W. JAMES BRADY, III, ESQ.  
7 TEXAS INSTRUMENTS INC  
8 7839 CHURCHILL WAY, M/S 3999  
9 DALLAS TX 75265