

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY P. ERHARDT, KASHMIR S. SAHOTA, and EMMANUIL LINGUNIS

Appeal No. 2005-2173
Application No. 10/2005/151,595
Technology Center 2800

ON BRIEF

Before KRASS, GROSS, and SAADAT, *Administrative Patent Judges*.
GROSS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

In a decision dated March 17, 2006, the decision of the examiner rejecting claims 1 through 16 under the written description portion of 35 U.S.C. § 112, first paragraph, claims 4 through 7 and 12 through 15 under 35 U.S.C. § 112, second paragraph, claims 1, 3, 9, and 11 under 35 U.S.C. § 102(b) over Lee, and claims 4 through 6 and 12 through 14 under 35 U.S.C. § 103 over Lee was reversed. The decision of the examiner rejecting claims 1, 3, 4, 8, 9, 11, 12, and 16 under 35 U.S.C. § 102(e) or alternatively under 35 U.S.C. § 103 over Chen was reversed as to claims 4 and 12, but affirmed as to claims 1, 3, 8, 9, 11, and 16. Also, the decision of the examiner rejecting claims 1 through 3, 7, 9 through 11, and 15 under 35 U.S.C. § 102(e) or alternatively under 35 U.S.C. § 103 over Park was affirmed.

In the Request for Rehearing filed April 4, 2006, appellants ask us to reconsider three issues. First, appellants argue (Request for Rehearing, page 2) that adding

“entirely” before the word “filling” in the specification is not new matter. Therefore, appellants ask us to make a decision that no new matter has been introduced. However, as pointed out in the decision at page 3, whether an amendment to the specification was properly objected to under 35 U.S.C. § 132 as introducing new matter is petitionable, not appealable. This issue is not within our jurisdiction to decide.

Next, appellants argue (Request for Rehearing, pages 3-4) that the antecedent basis for the “opening” recited in claims 1, 3, 9, and 11 can only be “in the ‘forming an opening in a semiconductor substrate.’ Thus, the boundaries of the opening are limited to that of the substrate because the only interpretation of the claim element is ‘entirely filling the opening [formed in the semiconductor substrate] with a doped material.’” Appellants assert (Request for Rehearing, page 3) that “the examiner’s interpretation of the oxide-lined trench as the opening is unreasonable since filling ‘the’ opening in the oxide-lined trench would require a second opening, which does not appear in the claim and for which there is no antecedent basis.” Therefore, appellants conclude that the oxide-lined trench in Chen cannot be an opening as required by the claims.

We disagree with appellants. Appellants are interpreting Chen’s trench as the claimed opening. However, in Chen, the dielectric lined trench is an opening in the substrate. The step of “forming an opening in a semiconductor substrate” in claim 1 or “forming shallow trenches in the silicon substrate” in claim 9 is satisfied by Chen’s two steps of forming the trench and laying the dielectric layer. Put another way, the opening in the substrate is formed when the dielectric layer is formed. Then, the dielectric lined trench, “the opening” or “the shallow trench,” is entirely filled with a doped material. Appellants’ claims do not preclude an intervening layer of a dielectric material, as the opening or shallow trench can be defined as Chen’s trench after the dielectric layer is formed. Thus, we find appellants’ arguments unpersuasive.

Appellants (Request for Rehearing, page 4) contend that the rejection of claims over Park is incorrect for the same reasons set forth against the rejection over Chen. However, as explained *supra*, we find no error in our interpretation of the claims and the application of Chen thereagainst. Accordingly, we also find no error in the rejection of the claims over Park.

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CONCLUSION

Appellant's request for rehearing has been granted to the extent that our decision has been reconsidered, but such request is denied with respect to making any modifications to the decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

REHEARING DENIED

ERROL A. KRASS Administrative Patent Judge))))))	BOARD OF PATENT APPEALS AND INTERFERENCES
ANITA PELLMAN GROSS Administrative Patent Judge)))	
MAHSHID D. SAADAT Administrative Patent Judge))	

APG/vsh

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