

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**

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

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**Ex parte** Wolfgang Feiler

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Appeal No. 2006-0547  
Application No. 10/276,568

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ON BRIEF

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Before JERRY SMITH, BARRETT, and DIXON, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 12-22, which are all of the claims pending in this application.

We AFFIRM.

## BACKGROUND

Appellant's invention relates to a semiconductor power component with meandering polysilicon resistor. A copy of the representative claim under appeal is set forth below.

12. A semiconductor power component, comprising a reduced surface field region located between a high-pressure side and a low-pressure side; at least one polysilicon resistor located between said high pressure side and said low pressure side, said polysilicon resistor being disposed above said reduced surface field region being electrically insulated from said reduced surface field region, said polysilicon resistor being formed so that it is operative for signal transmission between said high-pressure side and said low-pressure side and being laid in a meandering pattern from said high pressure side to said low pressure side, said polysilicon resistor having a linear voltage drop along its length and being formed so as to provide signal transmission between said high-pressure side and said low-pressure side.

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

Endo	5,315,139	May 24, 1994
Robb et al.	5,714,396	Feb. 3, 1998
Christiansen	6,054,891	Apr. 25, 2000

Claims 12, 13, 15, and 19-22 stand rejected under 35 U.S.C. § 102 as being anticipated by Robb. Claim 14 stands rejected under 35 U.S.C. § 103 as being unpatentable over Robb in view of Endo. Claims 16-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Robb in view of Christiansen.

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Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's answer (mailed Jun. 24, 2005) for the examiner's reasoning in support of the rejections, and to the applicant's brief (filed Apr. 22, 2005) for appellant's arguments thereagainst.

### **OPINION**

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Only those arguments actually made by appellant have been considered in this decision. Arguments that appellant could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by appellant [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)]. Appellant has elected to group all of the dependent claims as standing or falling with independent claim 12. Therefore, we will evaluate appellant's arguments with respect to independent claim 12.

### **35 U.S.C. § 102**

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

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**Verdegaal Bros., Inc. v. Union Oil Co.**, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), **cert. denied**, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in **Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), **cert. denied**, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it." While all elements of the claimed invention must appear in a single reference, additional references may be used to interpret the anticipating reference and to shed light on its meaning, particularly to those skilled in the art at the relevant time. **See Studiengesellschaft Kohle v. Dart Indus., Inc.**, 726 F.2d 724, 726-727, 220 USPQ 841, 842-843 (Fed. Cir. 1984).

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. **See Kalman v. Kimberly-Clark Corp.**, 713 F.2d at 772, 218 USPQ at 789.

Initially we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. **See Verdegaal Bros., Inc. v. Union Oil Co.**, 814 F.2d at 633, 2 USPQ2d at 1054. A prior art reference

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anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (**see Hazani v. Int'l Trade Comm'n**, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and **RCA Corp. v. Applied Digital Data Systems, Inc.**, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference (**see Kalman v. Kimberly-Clark Corp.**, 713 F.2d at 772, 218 USPQ at 789).

We must point out, however, that anticipation under 35 U.S.C. § 102 is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. **See RCA Corp. v. Applied Digital Data Systems, Inc.**, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); **cert. dismissed**, 468 U.S. 1228 (1984).

Appellant argues that in accordance with the invention, the polysilicon resistor has a linear voltage drop along its length and is formed so as to provide signal transmission between the high pressure side and the low pressure side. (Brief at page 5.) Appellant argues that the reference belongs to the same art and teaches some features which are similar to the features of the present invention, but that Robb does not disclose a power component in which, through a polysilicon resistor, a signal is transmitted from the high pressure side to the low pressure side. (Brief at page 6.)

Appellant argues that since Robb does not disclose the signal transmission, the rejection is not tenable. (Brief at page 6.)

The examiner has addressed this argument at paragraph (3) on page 6 of the answer. Here, the examiner has found that appellant has not defined the terms high pressure side and low pressure side except with respect to the meandering pattern of the polysilicon resistor in Figures 1 to 3. The examiner maintains that Robb contains a high pressure side and low pressure side with respect to the higher or lower potential contacts 33 and 29. The examiner maintains that the polysilicon resistor could transmit a signal. The examiner maintains that intended use and other functional language must result in a structural difference between the claimed invention and the prior art.

(Answer at pages 6-7.) We agree with the examiner that the claim language must establish some structural difference between the semiconductor power component and the prior art. We find that the examiner's position is that the polysilicon resistor of Robb is a polysilicon resistor "being formed so that it is operative for signal transmission" and "being formed so as to provide signal transmission." We agree with the examiner and find that there is no structural difference between independent claim 12 and Robb. We find that the polysilicon resistor of Robb is capable of providing signal transmission. If appellant desires to claim a new use of an old device that the new use must be claimed as a process or needs to recite structural differences between the claimed invention and the prior art device. Therefore, we find that the examiner has established a

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**prima facie** case of anticipation and appellant has not shown error therein. Therefore, we will sustain the rejection of independent claim 12 and its dependent claims 13, 15, and 19-22.

### **35 U.S.C. § 103**

Additionally, appellant has elected to group all dependent claims as standing or falling with claim 12 and not present separate argument to the rejection under 35 U.S.C. § 103. Therefore, we sustain dependent claims 14 and 16-18 also.

### **CONCLUSION**

To summarize, the decision of the examiner to reject claims 12, 13, 15, and 19-22 under 35 U.S.C. § 102 is AFFIRMED, and the decision of the examiner to reject claims 14 and 16-18 under 35 U.S.C. § 103 is AFFIRMED.

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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)(1)(iv).

**AFFIRMED**

JERRY SMITH	)	
Administrative Patent Judge	)	
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	)	
LEE E. BARRETT	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS
	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JOSEPH L. DIXON	)	
Administrative Patent Judge	)	

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