

The opinion in support of the decision being entered today was not written and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD C. BLISH, II
and JOHN JAMES SLEVIN

Appeal No. 2006-0754
Application 10/212,950¹

ON BRIEF

Before KIMLIN, PAK, and KRATZ, Administrative Patent Judges.
PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1 through 10 which are all the claims pending in the above-identified application. We have jurisdiction pursuant to 35 U.S.C. § 134.

APPEALED SUBJECT MATTER

Claims 1 and 6 are representative of the subject matter on appeal and read as follows:

1. A marking structure for a body comprising:
a first layer on the body, the first layer being
of a material which is observable and apparent in

¹ Application for patent filed August 6, 2002.

visible light and which fluoresces upon application thereto of non-visible electromagnetic waves; and a second layer on the first layer, the second layer having an opening which extends therethrough to expose a portion of the first layer.

6. A method of marking a body comprising:
providing a first layer on the body, the first layer being of a material which is observable and apparent in visible light and which fluoresces upon application thereto of non-visible electromagnetic waves;
providing a second layer on the first layer; and
providing an opening in the second layer and extending therethrough to expose a portion of the first layer.

PRIOR ART

The prior art references relied upon by the examiner are:

Liang et al. (Liang)	5,418,855	May 23, 1995
Hatchard et al. (Hatchard)	6,181,017 B1	Jan. 30, 2001
Kuczynski et al. (Kuczynski)	6,280,797 B1	Aug. 28, 2001
Bolken et al. (Bolken)	6,576,496 B1	Jun. 10, 2003 (Filed Aug. 21, 2000)

REJECTION

Claims 1 through 10 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Hatchard, Bolken, Liang and Kuczynski.

OPINION

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by the examiner and the appellants in support of their respective positions. This review has led us to conclude the examiner's § 103 rejection is not well founded. Accordingly, we reverse the examiner's § 103 rejection for essentially the reasons set forth in the Brief. We add the following for emphasis and completeness.

As correctly found by the examiner (the Answer, page 4):

Hatchard et al. teaches the marking of a semiconductor device with an insulation coating and first and second marking coatings with a marking cut by laser so that it penetrates the second layer and into the first layer (abstract, Figure 7, col. 3, lines 20-30). The outer coating may be a different color than the inner coating so that when the outer coating is cut through to expose the inner layer, **a color that is distinguished from the color of the outer layer is seen** (col. 5, lines 1-20). Emphasis added.

Hatchard goes onto teach that "[b]ecause the second coating 160 and the third coating 162 have different color, the markings composed of the grooves 164, 166, and 168 is relatively easy to see." See column 5, lines 35-37. Thus, forming markings in Hatchard's article using materials that are invisible to the naked eye, as suggested by the examiner, would be counter to

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the purpose delineated in Hatchard. To do as suggested by the examiner is to destroy the invention on which Hatchard is based. Ex parte Hartman, 186 USPQ 366, 367 (Bd. App. 1974). As correctly pointed out by the appellants (the Brief, pages 4-8), the teachings of Bolken, Liang and Kuczynski relied upon by the examiner would not have suggested modifying the hidden second coating layer (layer 160) of Hatchard in the manner proposed by the examiner.

Thus, having considered the totality of record, including due consideration of all of the arguments proffered by both the examiner and the appellants, we determine that the examiner has not established a prima facie case of obviousness within the meaning of § 103(a). Accordingly, we reverse the examiner's decision rejecting all of the claims on appeal under § 103(a).

NEW GROUND OF REJECTION

Pursuant to 37 CFR § 41.50(b)(2004), we enter a new ground of rejection against claims 1, 4 and 6.

Claims 1, 4 and 6 are rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim subject matter which the applicants regard as their invention. As explained in Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1377, 55 USPQ2d 1279, 1282 (Fed. Cir. 2000),

for a claim to comply with § 112, paragraph 2, it must satisfy two requirements: first, it must set forth what "the applicant regards as his invention," and second, it must do so with sufficient particularity and distinctness, i.e., the claim must be sufficiently "definite." See also 35 U.S.C. § 112.

Here, the appellants fail to satisfy the first requirement of Solomon. In the Background Art section of the specification, the appellants state (page 1, lines 14-19) that:

Figure 1 illustrates a typically marked semiconductor device 20. As shown therein, the semiconductor device 20 includes a die 22 having a lid or transfer molding compound such as epoxy 24 thereon. A white layer 26, for example, a layer with white paint, is provided on the lid 24, and the black layer 28, for example black paint, is provided on the layer 26. **A laser cutting step is undertaken to provide openings (one shown at 30) in the layer black 28 to the full depth thereof down to the white layer 26, to expose portions of the white layer 26.** Emphasis added.

The appellants state that "[w]ith this structure, it is readily possible for a counterfeiter to provide counterfeit markings as illustrated in Figure[s] 2-4." See the specification, page 1, lines 24-25. To avoid this problem, the appellants extend an opening provided in the black layer further into the white layer to a substantial depth of the white layer as illustrated in Figures 5 through 12. See the specification, page 2, lines 3-30. The appellants define this feature as the appellants' improvement over the Background art discussed at page 1 of the specification.

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Id. Yet, claims 1, 4 and 6 recite the Background art feature, rather than what the appellants regard as their invention. Compare claims 1, 4 and 6 with the Background Art section of the specification. As stated in Allen Eng'g Corp. v. Bartell Indus., Inc., 299 F.3d 1336, 1348, 63 USPQ2d 1769, 1776 (Fed. Cir. 2002):

Where it would be apparent to one of skill in the art, based on the specification, that the invention set forth in a claim is not what the patentee regarded as his invention, we must hold that claim invalid under § 112, paragraph 2.

Thus, we determine that claims 1, 4 and 6 do not meet the requirements of the second paragraph of 35 U.S.C. § 112.

CONCLUSION

In view of the foregoing, we reverse the examiner's decision rejecting the claims on appeal and enter a new ground of rejection against claims 1, 4 and 6.

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN

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TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

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

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
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CHUNG K. PAK)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
PETER F. KRATZ)	
Administrative Patent Judge)	

CKP:sld

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