

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2006-1133
Application 09/189,098

ON BRIEF¹

Before THOMAS, KRASS, and BLANKENSHIP, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 1 through 20 and 32 through 71, appellant having cancelled claims 21 through 31.

¹ The above-noted panel only recently received this appeal for decision.

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Representative claim 1 is reproduced below:

1. A contact for a semiconductor device, comprising:

an intermediate conductive layer contacting and in electrical communication with a structure located at a lower level than a silicon-containing dielectric layer of the semiconductor device;

an insulator component positioned adjacent said intermediate conductive layer so as to at least thermally insulate said structure; and

an electrically conductive contact layer adjacent said insulator component and in communication with said intermediate conductive layer.

The following references are relied on by the examiner:

Buiguez et al. (Buiguez)	4,770,977	Sept. 13, 1988
Ovshinsky et al. (Ovshinsky)	5,296,716	Mar. 22, 1994
Whitten et al. (Whitten)	5,451,811	Sept. 19, 1995
Brown et al. (Brown)	5,792,594	Aug. 11, 1998

Claims 1 through 20 and 32 through 71 stand rejected under 35 U.S.C. § 103. As evidence of obviousness as to claims 1 through 6, 8 through 10, 32 through 38 and 68 through 70, the examiner relies upon Brown in view of Buiguez, with the addition of Whitten as to claim 11 in a second stated rejection. The examiner rejects claims 7, 12 through 19, 39 through 54, 56

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through 66, 69 and 71 in a third stated rejection as being obvious over Ovshinsky in view of Brown, further in view of Buiguez. To this latter stated rejection, the examiner adds Whitten in a fourth stated rejection as to claims 20, 55 and 67.

Rather than repeat the positions of the appellant and the examiner, reference is made to the brief and reply brief for appellant's positions, and to the answer for the examiner's positions.

OPINION

We reverse because our deliberations have led us to conclude that the examiner has not established a prima facie case of obviousness.

The examiner's statements of the rejections at pages 3 through 7 in the answer appear to be identical to the manner in which the examiner stated the rejections in the final rejection. Among the six independent claims on appeal and the approximately sixty total claims on appeal, the examiner has not established a clear correspondence of all features of all claims on appeal to the prior art relied upon in the rejections of the claims appeal. The statements of the rejections do not treat any dependent claim and there is a speculative if nonexistent treatment of the six independent claims.

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It appears that we are left with the burden of performing this necessary correlation.

Additionally, the examiner has presented only weak reasons of combinability of the applied prior art which appear to be based upon mere conclusory statements. In re Kahn, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), has indicated that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." For example, in the first stated rejection, the examiner merely presents to us a line of reasoning that it would have been obvious to the artisan to have utilized the silicon-containing photosensitive polymers in Buiguez in the device of Brown "because it makes it easy and cost effect[ive] to perform." In the third stated rejection the examiner considers that it would have been obvious to have modified Brown in view of Ovshinsky "to reduce cost promote high throughput and shorten cycle time." These rationales are not explained on the record in such a manner as to convince us that it would have been obvious for the artisan to have performed the claimed modifications or substitutions as urged by the examiner.

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For his part, appellant has presented substantially twenty pages of arguments in the principal brief on appeal challenging the examiner's reasoning of combinability and urging that even if the references were properly combinable for some reason, all the claimed elements recited in the independent claims 1, 12, 32, 39, 45 and 56 are not met by the combination. The answer has only set forth three pages of responsive arguments to those extensive positions set forth by appellant in the brief.

On the basis of the nature and extent of the positions of the examiner and appellant, we must necessarily conclude that the examiner has not established a prima facie case of obviousness of each of the claims on appeal within 35 U.S.C. § 103. We note, however, that from our prospective, the examiner is free to reinstitute better-stated rejections under 35 U.S.C. § 103 based upon the same or additional, different prior art by presenting a detailed correspondence of the claimed features to those which are alleged to be taught in the prior art along with well-explained reasons of combinability within 35 U.S.C. § 103.

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In view of the foregoing, the decision of the examiner
rejecting all claims on appeal under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
ERROL A. KRASS)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
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)	
HOWARD B. BLANKENSHIP)	
Administrative Patent Judge)	

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