

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 TIM J. CORBETT

Appeal No. 2006-1230
Application No. 10/137,586

ON BRIEF

Before THOMAS, LEVY, and NAPPI, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-20, which are all of the claims pending in this application.

We AFFIRM.

rejection, and to the brief (filed March 18, 2005) and reply brief (filed August 2, 2005) for the appellant's arguments thereagainst.

Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii) (eff. Sept. 13, 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejection advanced by the examiner, and the evidence of anticipation relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we make the determinations which follow. We begin with claim 1.

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). The examiner's position can be

found on pages 4 and 5 of the answer. Appellants' position (brief, page 6) is that with respect to the subject matter depicted in figures 3(a) and 3(b) of Saito, it is not clear from the portion of the disclosure whether or not Saito expressly or inherently describes that the material from which characters 2 and polarity mark 3 are formed is energy-reacted. It is asserted (reply brief, page 2) that prior to the examiner's answer, the examiner relied upon the abstract and drawings of Saito. In the examiner's answer, the examiner relied upon an English language translation of Saito. Appellant argues (id.) that the examiner's reliance in the answer, on an English language translation of Saito and not just the abstract and drawings of Saito, constitutes a new ground of rejection. Appellant adds (reply brief, page 3) that "[i]n any event, it is respectfully submitted that several of the claims that remain pending in the above-referenced application recite subject matter that is not anticipated by the disclosure of Saito." Appellant then proceeds to argue claims 8, 14 and 19, but presents no additional arguments regarding claim 1.

At the outset, we note that in the final rejection, the examiner rejects claims 1-20 as being unpatentable over Saito. The examiner does not state that only the abstract and drawings

are being relied upon. The record indicates that a copy of the translation of the entire document was sent to appellant in the communication dated July 29, 2005. From the mailing date of the translation, it would appear that the translation would have crossed in the mail with the reply brief. To preserve the integrity of the due process to which appellant is entitled, we designate our affirmance, infra, as a New Ground of Rejection in order to allow appellant the opportunity to reopen prosecution, should appellant desire to do so. The following remarks rely on this translation.

Turning to Saito, we find that the semiconductor device is embodied by resin-molding a semiconductor chip (page 2). It is disclosed (page 3) that in the prior art, laser marking caused a channel with a depression shape formed on the resin surface. In the alternate embodiment of figures 3a and 3b, the reference discloses (pages 5 and 6) that the photosensitive resin film 7, which includes a colorable material, is coated on the surface of the molded resin component 1, where a character or mark is exposed and formed in a flat fashion by means of ultraviolet irradiation via a mask.

From this disclosure, we find that the photosensitive resin 7 is coated on the molded resin component 1, and the character or

mark is then formed in a flat fashion by means of ultraviolet irradiation. Because Saito overcomes the problem of laser marking causing a depression in the resin surface, by coating a photosensitive resin film 7 on the molded resin component 1 prior to the ultraviolet irradiation, we find that Saito meets the limitations of claim 1.

We are not persuaded by appellant's assertion (brief, pages 6 and 7) that it cannot be understood whether Saito describes the material from which the characters 2 and polarity mark 3 are formed as being energy-reacted. From the disclosure of Saito that the resin film 7 is photosensitive and that the character or polarity mark is formed by ultraviolet irradiation, we find that the reference is clear that this limitation is met by Saito. From all of the above, the rejection of claim 1 under 35 U.S.C. § 102(b) is affirmed.

We turn next to claim 2. From the disclosure of Saito that the film 7 includes a colorable material, we agree with the examiner (answer, page 6) that Saito discloses the energy-reactive material to include a pigment. Accordingly, the rejection of claim 2 under 35 U.S.C. § 102(b) is affirmed.

We turn next to claim 3. We affirm the rejection of claim 3 because the material of resin film 7 that is masked is unreacted by the ultraviolet irradiation.

We turn next to claim 4. Appellant asserts (brief, page 8) that Saito does not disclose that the color of the reacted material is different from the color of the unreacted material. From the disclosure of Saito (page 6) that the resin film 7 can be colorable material, and the disclosure of figures 1, 3a and 3b of the characters being of different color than the unreacted portions of film 7, we agree with the examiner that Saito meets the limitations of claim 4. The rejection of claim 4 under 35 U.S.C. § 102(b) is affirmed.

We turn next to claim 5. Appellant asserts (brief, pages 8 and 9) that Saito does not teach that the regions of the surface beneath and laterally adjacent the markings are substantially free of decomposition and damage. From the disclosure of Saito of using a mask for the ultraviolet irradiation (page 6) and the disclosure (page 3) that the invention solves the problem of laser marking causing a channel with a depression in the resin surface, we find that Saito meets the language of claim 5. The rejection of claim 5 under 35 U.S.C. § 102(b) is affirmed.

We turn next to claim 6. Appellant asserts (brief, pages 9 and 10) that Saito does not teach that the characters could be bonded or fused to the surface of the molded resin member 1. From our review of Saito, we agree with the examiner for the reasons set forth in the answer (page 8) that the laser or ultraviolet irradiation would fuse the characters to the surface of the molded resin member 1, and that if the characters were not fused to the surface of the molded resin member, they would fall off. Accordingly, the rejection of claim 6 under 35 U.S.C. § 102(b) is affirmed.

We turn next to claim 7. As this claim has not been argued by appellant, it falls with claim 1 from which it depends. The rejection of claim 7 under 35 U.S.C. § 102(b) is affirmed.

We turn next to claim 8. Appellant asserts (brief, page 10) that Saito does not teach that the surface on which the markings are located comprises a surface of a semiconductor die. (See also reply brief, page 3). From our review of Saito, we note that the claim does not recite that the markings are directly located on the surface of the die. As broadly claimed, we agree with the examiner (answer, page 9) that:

Saito teaches an encapsulant resin material 1 covering at least a portion of a semiconductor die, since a semiconductor die is inherently located

within encapsulant resin 1 (see page 2, first paragraph of the translation). Since Saito teaches marking on a surface of a resin 1, and resin 1 is located on a surface of the semiconductor die, then Saito teaches marking on a surface of a semiconductor die, as claimed.

Accordingly, the rejection of claim 8 under 35 U.S.C. § 102(b) is affirmed.

We turn next to independent claim 9. We will sustain the rejection of claim 9 for the reasons set forth by the examiner (answer, pages 4, 5 and 8) and for the reasons set forth, supra, with respect to claim 1. the rejection of claim 9 under 35 U.S.C. § 102(b) is affirmed.

We turn next to claim 10. Appellant asserts (brief, page 12) that Saito does not teach marking on a surface of a die or a surface from which a die is formed. From our review of the record, we agree with the examiner, for the reasons set forth in the answer (page 9) that “[s]ince Saito teaches marking on a surface of a resin 1, and resin 1 is located on a surface of the semiconductor die, then Saito teaches marking on a surface of a semiconductor die, as claimed.” Accordingly, the rejection of claim 10 under 35 U.S.C. § 102(b) is affirmed.

We turn next to claim 11. We affirm the rejection of claim 11 for the same reasons as we affirmed the rejection of claim 2.

We turn next to claim 12. We affirm the rejection of claim 12 for the same reasons as we affirmed the rejection of claim 3.

We turn next to the rejection of claim 13. We affirm the rejection of claim 13 for the same reasons as we affirmed the rejection of claim 4.

We turn next to claim 14. Appellant asserts (brief, page 13) that Saito does not teach that the unreacted energy-reactive material is not bonded or fused to the surface. Appellant adds (reply brief, page 3) that "the disclosure of Saito is limited to a packaged semiconductor device 1 with a resin film 7 including both reacted regions 2, 3 and unreacted regions secured to a surface thereof." From the disclosure (page 6) of Saito we find the resin film 7 is coated on the surface of the molded resin component 1. From the disclosure that the resin is coated on the surface, we find no disclosure that the coated resin that is not energy reacted, is fused or bonded to the surface. Thus, we find that the masked areas are not fused or bonded to the surface since they are not exposed to the laser or ultraviolet irradiation. Accordingly, we find that Saito meets the language of claim 14. The rejection of claim 14 under 35 U.S.C. § 102(b) is affirmed.

We turn next to claim 15. As claim 15 has not been separately argued by appellant, claim 15 falls with claim 9, from which it depends. The rejection of claim 15 under 35 U.S.C. § 102(b) is affirmed.

We turn next to claim 16. We affirm the rejection of claim 16 for the same reasons as we affirmed the rejection of claim 11.

We turn next to claim 17. We affirm the rejection of claim 17 for the same reasons that we affirmed the rejection of claim 12.

We turn next to claim 18. We affirm the rejection of claim 18 for the same reasons as we affirmed the rejection of claim 13.

We turn next to claim 19. We affirm the rejection of claim 19 for the same reasons as we affirmed the rejection of claim 14.

We turn next to claim 20. We affirm the rejection of claim 20 for the same reasons as we affirmed the rejection of claim 5.

SUMMARY

We have affirmed the rejection of claims 1-20 under 35 U.S.C. § 102(b) as being anticipated by Saito for the reasons cogently set forth by the examiner in the answer, as amplified by our comments and findings. However, because we found, supra, that appellant was not sent a copy of the full translation of the

Saito reference until a few days before the reply brief was filed, we designate our affirmance as a New Ground of Rejection under 37 CFR § 41.50(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 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 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. . . .

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-20 under 35 U.S.C. § 102(b) is affirmed. 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; 37 CFR § 41.50(b)

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
STUART S. LEVY)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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