

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 ORLANDO H. AUCIELLO

Appeal No. 2006-1583
Application No. 10/351,826

ON BRIEF

Before THOMAS, HAIRSTON and HOMERE, Administrative Patent Judges.
HOMERE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on Appellant's Request for Rehearing.

REQUEST FOR REHEARING DENIED.

In paper filed June 23, 2006, Appellant requests that we reconsider our decision dated May 31, 2006, wherein we sustained the Examiner's rejection of claim 1 under 35 U.S.C. § 112, 1st paragraph.

We have carefully reviewed our original decision in light of Appellant's request and we find no error in the analysis or logic set forth in our original decision. With full consideration being given to Appellant's remarks¹, we find no basis upon which to grant Appellant's request for rehearing. We, therefore, decline to make any changes to our prior decision with respect to the claim noted above for the reasons that follow.

Appellant argues at page 2 of the Request that the Board failed to consider all the evidence to ensure that under 35 U.S.C. § 112 the specification teaches those skilled in the art how to make and use the full scope of the invention without "undue experimentation". Particularly, at pages 3 and 4 of the Request, Appellant states the following:

It is submitted that the Board has failed to consider the evidence in the record with respect to whether the specification teaches one of ordinary skill in the art how to sputter deposit the material of the invention without "undue experimentation". Dr. Fan's declaration, which is evidence that sputter deposition in this field is usually conducted at room temperature, is uncontradicted by the Examiner and yet the Examiner with the Board's approval has determined by fiat that a person of ordinary skill in the art could not reproduce the sputter deposited film of the invention without undue experimentation. This unsupported conclusion is exactly opposite to the evidence in this record.

Based on the evidence of record, there is no reason to suppose any experimentation is necessary to produce the claimed subject matter since Dr. Fan's declaration establishes the usual practice in the art and Dr. Auciello's declaration, see paragraph 8, states that sputter deposition always produces an amorphous alloy, as claimed. Therefore, the Examiner has not met his initial burden of proof by providing sufficient reasons for doubting the assertion of Dr. Fan. See *In re Wright*, *supra*.

The Board echoed this unsupported opinion of the Examiner in its decision

¹ Request for Rehearing at pages 1-4.

and such an opinion cannot stand in view of the evidence of record."

As indicated in our original opinion, we do not dispute the fact advanced in Dr.

Fan's declaration that sputter deposition is usually conducted at room temperature.

Further, as indicated in our original opinion, we do not dispute the fact advanced in Dr.

Auciello's declaration that when sputter deposition of the material in question, when

performed at room temperature, always results in an amorphous layer. Our original

concern was and still remains whether one of ordinary skill in the art, having read the

specification and having been apprised of the declarations of Dr. Fan and Dr. Auciello,

would have been able to sputter deposit the TiAl alloy to yield an amorphous oxide. We

are still of the view that the ordinarily skilled artisan would have not been able to sputter

deposit the TiAl alloy to yield the amorphous oxide since Appellant's specification

indicates that "it is unclear at the present time whether the oxide alloy is amorphous".

Further, the specification is totally silent on whether the sputter deposition was performed at room temperature. Thus, the ordinarily skilled artisan would have not even sought to achieve such result, as it was not particularly contemplated in Appellant's specification.

CONCLUSION

In view of the foregoing discussion, we grant Appellant's request for rehearing to the extent of reconsidering our decision, but we deny Appellant's request with respect to making any change thereto.

No time period for taking any subsequent action in connection with this appeal

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may be extended under 37 CFR § 1.136(a)(1)(iv).

REQUEST FOR REHEARING DENIED

JAMES D. THOMAS)
Administrative Patent Judge)
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)
) BOARD OF PATENT
KENNETH W. HAIRSTON)
Administrative Patent Judge) APPEALS AND
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