

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 KUMAR NAGARAJAN and ZAFER KUTLU

Appeal No. 2006-2051
Application No. 10/396,955

ON BRIEF

Before RUGGIERO, SAADAT and HOMERE, **Administrative Patent Judges.**

HOMERE, **Administrative Patent Judge.**

REMAND TO EXAMINER

This is a remand of the appeal under 35 U.S.C. § 134 from the final rejection of claims 1 through 7 and 17 through 21, in accordance with 37 CFR § 41.50(a)(1). After considering the record before us, we are convinced that the instant appeal is not ready for a meaningful review. Accordingly, we hereby remand the application to the Examiner to consider the following issues, and to take appropriate action.

BACKGROUND

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. An underfill for an integrated circuit package comprising:

a base material; and

a filler material constitutes a selected percentage by weight of the underfill to provide an optimum balance between interfacial die stress of a low-k dielectric layer of an integrated circuit die and solder bump strain for reliability of the integrated circuit package.

REJECTIONS AT ISSUE

A. Claims 1 through 7 and 17 through 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Admitted Prior Art (APA), Chan (US Patent Application No. 2004/0086719) and Jayaraman (US Patent No. 6,724,091). We refer herein to the Examiner's Answer (mailed on March 8, 2006).

REASONS FOR REMAND

The Examiner's statement of the rejection of claims 1 through 7 and 17 through 21, at page 4 of the Examiner's Answer, alleges that the claims are unpatentable over the combination of

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APA, Chan and Jayaraman. Particularly, the Examiner relies upon APA (drawing figures 1 and 2, specification page 5, line 27 through page 6, line 8 of Appellants' written description) as a primary reference to establish a *prima facie* case of obviousness against the cited claims.

Under current patent law, a statement by an applicant during prosecution identifying the work of another as "prior art" is an admission that that work is available as prior art against the claims, regardless of whether the admitted prior art would otherwise qualify as prior art under the statutory categories of 35 U.S.C. 102. **Riverwood Int'l Corp. v. R.A. Jones & Co.**, 324 F.3d 1346, 1354, 66 USPQ2d 1331, 1337 (Fed Cir. 2003). However, even if labeled as "prior art," the work of the same inventive entity may not be considered prior art against the claims unless it falls under one of the statutory categories. **Id.**; see also **Reading & Bates Construction Co. v. Baker Energy Resources Corp.**, 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984) ("[W]here the inventor continues to improve upon his own work product, his foundational work product should not, without a statutory basis, be treated as prior art solely because he admits knowledge of his own work. It is common sense that an inventor, regardless of an admission, has knowledge of his own

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work.") Consequently, the examiner must determine whether the subject matter identified as

"prior art" is applicant's own work, or the work of another. In the absence of another credible explanation, examiners should treat such subject matter as the work of another. Where the specification identifies work done by another as "prior art," the subject matter so identified is treated as admitted prior art. **In re Nomiya**, 509 F.2d 566, 571, 184 USPQ 607, 611 (CCPA 1975) (holding applicant's labeling of two figures in the application drawings as "prior art" to be an admission that what was pictured was prior art relative to applicant's improvement).

We note in the present case that the Examiner's statement of the rejection incorrectly sets out APA as a base reference for the rejection. Particularly, figure 1 and page 5, line 27 through page 6, line 8 do not qualify as admitted prior art. Figure 1 and cited portion of the Appellants' specification are directed to the estimated interfacial die stress at the interface between the underfill and a low-k silicon dielectric and the solder bump strain for four underfill material in a 45 mm ball grid array package. There is no indication in Appellants' specification that such teachings are directed to the previous work of another or otherwise drawn from the prior art.

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They thus pertain to Appellants' own disclosure of their invention.

If the Examiner wishes to maintain the instant rejection, the Examiner must accordingly provide a supplemental Examiner's Answer in which the Examiner correctly applies the proper requirements, as prescribed under current patent law.

CONCLUSION

This remand to the Examiner pursuant to 37 CFR § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental Examiner's Answer is written in response to this remand by the Board.

This application, by virtue of its "special" status, requires an immediate action. See MPEP § 708.01 (8th ed., Rev. 3, August 2005). It is important that the Board be informed promptly of any action affecting the appeal in this case.

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REMANDED

JOSEPH F. RUGGIERO)
Administrative Patent Judge)
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) BOARD OF PATENT
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