

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WARREN M. FARNWORTH and JOSEPH T. LINDGREN

Appeal No. 2006-2181
Application No. 10/878,586

ON BRIEF

Before KIMLIN, JEFFREY T. SMITH and GAUDETTE, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-20.

Claims 1 and 9 are illustrative:

1. A bond pad array comprising:

a substrate having an array of contact regions, wherein the ratio of a dimension of a contact region to a separation distance between adjacent contact regions is at least 10:1; and

a respective tapered nickel contact formed over each contact region.

9. The bond pad array of claim 1, wherein the ratio of the dimension of the contact region to the separation distance between contact regions is at least 15:1.

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The examiner does not cite prior art in the rejection of the appealed claims.

Appealed claims 1-20 stand rejected under 35 U.S.C. § 112, first paragraph, description requirement.

Appellants do not set forth an argument that is reasonably specific to any particular claim on appeal. Accordingly, all the appealed claims stand or fall together with claims 1 and 9.

We have thoroughly reviewed each of appellants' arguments for patentability. However, we find that the examiner's rejection is well-founded and in accordance with current patent jurisprudence. Accordingly, we will sustain the examiner's rejection for essentially those reasons expressed in the Answer, and we add the following primarily for emphasis.

We agree with the examiner that the claim language "the ratio of a dimension of a contact region to a separation distance between adjacent contact regions is at least 10:1" does not find descriptive support in the original specification, nor does the claim 9 recitation that "the ratio of the dimension of the contact region to the separation distance between contact regions is at least 15:1."

It is by now well settled that the description requirement of 35 U.S.C. § 112, first paragraph, requires that the original

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specification reasonably conveys to one of ordinary skill in the art that the inventor had possession of the claimed subject matter at the time of filing the application. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). In the present case, the examiner properly finds that appellants' original specification utterly fails to convey the concept of a ratio of a dimension of a contact region to a separation distance between adjacent contact regions. To be sure, as emphasized by appellants, the specification provides two examples where such a ratio can be calculated from the dimensions given to be 10:1 and 15:1. However, the fact that a ratio can be gleaned from the disclosure of two numerical values hardly qualifies as a conveyance to one of ordinary skill in the art that the concept of a ratio of a dimension of the contact region to a separation distance between adjacent contact regions was in possession of the present inventors at the time of filing the subject application. Our review of the original specification finds no mention of, or significance attached to, the concept of the recited ratio. Appellants' invention is directed to using a tapered nickel contact formed over each of the contact regions to allow for the regions to be closer together than in the prior art.

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Furthermore, even if it can be argued that the specification examples provide descriptive support for the ratios of 10:1 and 15:1, there is absolutely no descriptive support for the broad claimed ranges of "at least 10:1" and "at least 15:1," which have no upper limit. Although the ratio 15:1 falls within the claimed range of at least 10:1, this one value does not support the much broader range having no upper limit. Appellants cite Ralston Purina Co. v. Far-Mar-Co., Inc., 772 F.2d 1570, 1576, 227 USPQ 177, 180 (Fed. Cir. 1985) for the proposition that "providing examples within the range is sufficient to support claims to the open ended range" (page 4 of Reply Brief, second paragraph). However, Ralston fails to provide precedential support for the proposition advanced by appellants but, rather, is particularly tied to a specific set of facts. As stated in Ralston, "[p]recisely how close the original description must come to comply with the description requirement of 35 U.S.C. § 112 must be determined on a case-by-case basis." Ralston, 772 F.2d at 1575, 227 USPQ at 179. In Ralston the trial court considered evidence regarding the purpose of moisture in the mixture, the physical characteristics of mixtures having different levels of water, the type of test and its degree of accuracy in testing for moisture level, and the approximate

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level of moisture known by those of ordinary skill in the art to be contained in soybean meal. Based on the totality of evidence, the court in Ralston decided certain ranges had descriptive support whereas other ranges did not. Manifestly, the facts of the present record do not correspond to those considered in Ralston.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims 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) (effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

AFFIRMED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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JEFFREY T. SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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LINDA M. GAUDETTE)	
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