

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 PANAYOTIS C. ANDRICACOS, W. JEAN HORKANS, KEITH
T. KWIETNIAK, PETER S. LOCKE, and CYPRIAN E. UZOH

Appeal 2006-2410
Application 09/983, 235
Technology Center, 1700

Decided: January 24, 2007

Before PETER F. KRATZ, CATHERINE Q. TIMM, and JEFFREY T.
SMITH, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

A review of the present record before us leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the Examiner, via the Office of the Director of the Technology Center, to consider the following issues and to take action not inconsistent with the views expressed herein.

On December 13, 2004, an Information Disclosure Statement (IDS) was filed in the present application. It is apparent from the record that the Examiner has not yet considered the submitted IDS. The IDS should be considered by the primary Examiner for compliance with 37 C.F.R. §§1.197 and 1.198, the Examiner should take appropriate action therewith. A communication notifying the Applicants of the primary Examiner's decision should be prepared and mailed. It is appropriate that the necessary consideration and processing of the IDS occur prior to a rendering of a decision in this appeal.

The subject matter of appealed claim 19 is directed to a deaerated plating solution comprising copper, an acid wherein the solution comprises a particular level of dissolved oxygen. The Examiner relies upon the combined teachings of the Landau reference with any of the Winters, Stickney, or Tamhaukar references to reject the appealed subject matter. The Examiner has failed to indicate whether the portions of the cited references describe or suggest the removal of oxygen to the extent required by the claims would be reasonably expected by the prior art oxygen removal methods. That is, the Examiner has not indicated, which portions of the references disclose or suggest a plating solution which has an oxygen content less than about 5×10^{-6} moles/liter as required by the claimed invention. We note that the Examiner in the Answer, page 8 line 19, has provided an incomplete statement with respect to the Tamhaukar reference. Consequently, it appears the Examiner has not provided a complete statement regarding the descriptions of the Tamhaukar reference.¹ As such,

¹ The Examiner should affirmatively state, whether the use of gas bubbling through a copper plating solution, such as in the Tamhaukar reference (col. 3), necessarily provides an oxygen level which meets the claim requirement.

the basis of the rejection of the claimed subject matter is unclear on the present record.

The Board of Patent Appeals and Interferences is a board of review and not a vehicle for initial examination. See 35 U.S.C. § 6(b)(2000). The burden is on the Examiner to set forth a prima facie case of obviousness. See *In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996). Findings of fact and conclusions of law must be made in accordance with the Administrative Procedure Act, 5 U.S.C. § 706 (A), (E) (1994). See *Zurko v. Dickinson*, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999). Findings of fact relied upon in making the obviousness rejection must be supported by substantial evidence within the record. See *In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000).

This remand to the examiner pursuant to 37 C.F.R. § 41.50(a)(1) (2004) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

REMANDED

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