

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 ARVID NEIL ARVIDSON, TERENCE LEE HORSTMAN,
MICHAEL JOHN MOLNAR, CHRIS TIM SCHMIDT,
and ROGER DALE SPENCER, JR.

Appeal 2006-2989
Application 10/298,129
Technology Center 1700

Decided: November 1, 2006

Before KIMLIN, PAK, and WARREN , *Administrative Patent Judges*.
KIMLIN, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

This is an appeal from the final rejection of claims 1-45. Claim 1 is illustrative:

1. A method comprising:
 - a) comminuting polycrystalline silicon rods,

b) sorting the product of step a) using a step deck classifier to obtain a controlled particle size distribution, and

c) removing impurities from the product of step a), step b), or both.

In addition to the admitted prior art found in Appellants' specification, the Examiner relies upon the following references as evidence of obviousness:

Griesshammer	US 4,525,336	Jun. 25, 1985
Dumler	US 5,165,548	Nov. 24, 1992

Journal of Electronics, 44, 46 (1978).

Appellants' claimed invention is directed to a method of removing impurities from comminuted polycrystalline silicon rods which uses a step deck classifier to sort the silicon rods to obtain a controlled particle size distribution. Appellants' Specification, at page 11, states that the polycrystalline silicon rods can be sorted manually or by use of apparatus disclosed in US Patent 5,165,548, or by sorting apparatus disclosed in US Patents 3,905,556, 5,064,076, and 5,791,493 (Spec. 11, last ¶). At page 12, the Specification states "[a]lternatively, the polycrystalline silicon pieces maybe sorted using an apparatus including a step deck classifier" (1st sentence).

The appealed claims stand rejected under 35 U.S.C. § 103(a) as follows:

- (a) claims 1-5 over Griesshammer in view of Dumler,
- (b) claims 6-12 over Griesshammer in view of Dumler,
- (c) claims 13-19, 22 and 23 over Griesshammer in view of Dumler and *Journal of Electronics*,

- (d) claims 20 and 21 over Griesshammer in view of Dumler and *Journal of Electronics*,
- (e) claims 24-31 over Griesshammer in view of Dumler, *Journal of Electronics*, and Yamato, and
- (f) claims 32-45 over Griesshammer in view of Dumler and the admitted prior art found in the specification.

The Examiner's rejection of claims 1-5 over Griesshammer in view of Dumler fails to address one of the limitations of claim 1, namely, sorting the silicon rods using a step deck classifier. The Examiner mistakenly states that "apparatus limitations in process claims are given little or no weight in determining patentability" (Answer 7, 3rd ¶). However, it is fundamental that all limitations of a claim must be given consideration when determining the differences between the claimed invention and the applied prior art. In essence, the Examiner, in determining that the claimed step of using a step deck classifier is entitled to little or no weight, has invoked a type of *per se* rule that has been discredited by our reviewing court. *See In re Brouwer*, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996), and *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995).

In the present case, the Examiner must determine whether the prior art would have provided a suggestion or a motivation to one of ordinary skill in the art to use a step deck classifier in the claimed method of removing impurities from comminuted polycrystalline silicon rods. We note that in the Examiner's rejection of claims 32-45, the Examiner has applied the admitted prior art in the specification for, apparently, the proposition that the claimed step deck classifier was known in the art at the time of filing the present application. To wit, the Examiner states that "the admitted prior art

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in the specification teaches that the claimed methods and apparatus are known to one of ordinary skill in the art as means to use chips of polysilicon” (Answer 6, 1st ¶). Appellants have not made the argument that the claimed classifier is not prior art to the present application and pages 11 and 12 of the Specification referred to above seem to indicate that the claimed classifier is prior art.

Accordingly, this application is remanded to the Examiner for the purpose of allowing the Examiner to complete the examination of the claims on appeal. The Examiner must give full weight and consideration to the claimed step of sorting the comminuted silicon rods using a step deck classifier and must determine the obviousness of doing so in light of the applied prior art and the admitted prior art found in Appellants’ Specification, as well as any other prior art known to the Examiner. The Examiner should also have Appellants state on the record whether the step deck classifier disclosed at page 12 of the specification is prior art to the claimed invention. The Examiner should bear in mind that it appears that the present specification attaches no criticality to using the claimed classifier. Also, the Examiner should apply this analysis to all the claims on appeal which recite the step deck classifier as a limitation. The Examiner’s attention is directed to the Manual of Patent Examining Procedure § 2116.01.

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This remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) (2006) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) (2006) applies if a Supplemental Examiner's Answer is written in response to this remand by the Board.

REMANDED

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