

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SRINIVASAN SRIDHARAN
and MICHAEL MOROZ

Appeal 2007-1388
Application 10/431,346
Technology Center 1700

Decided: July 27, 2007

Before BRADLEY R.GARRIS, CHARLES F. WARREN, and PETER F. KRATZ, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

We remand the application to the jurisdiction of the Examiner pursuant to 37 C.F.R. § 41.35(b) and 37 C.F.R. § 41.50(a)(1) for action in accordance with our comments below.

Appellants' claimed invention is directed to a method of forming a protective overglaze on an electronic device surface. The method includes steps of applying a lead-free and cadmium-free glass composition to the surface of the electronic device and firing the glass composition to form the protective overglaze.

On April 07, 2006, the Appellants submitted a Brief. In the Brief, the Appellants present arguments against the Examiner's two stated rejections, noting that the Examiner's anticipation rejection of claims 1, 2, 7-12 and 16 over Hormadaly (U.S. Pat. No. 6,171,987) in combination with Tunker (U.S. Pat. 5,827,789), Nigrin (U.S. Pat No. 4,285,731), or Clifford (U.S. Pat No. 5,244,848) should have been expressed as an obviousness rejection because three separate secondary references were combined with the primary reference. *See Brief 5, footnote 1 and Final Office Action 2-3.*

In an apparent uncompromising manner despite Appellants' notification of this anomaly in footnote 1 of the Brief, the Answer dated June 22, 2006 maintains the anticipation rejection of claims 1-11 and 29-37 over the above-noted references while employing an obviousness analysis. This continued inconsistency goes unabated notwithstanding that the Examiner's Answer bears the initials or signatures of two Appeal Conferees in addition to the Examiner's signature. In addition, the Examiner acknowledges that Hormadaly does not teach titanium dioxide as being present in the applied glass composition in an amount that corresponds to the claimed amount for that glass constituent (Answer 3). However, the Examiner does not explain how close the claimed titanium dioxide is to the disclosed amount for that constituent disclosed or suggested by Hormadaly.

The latter point is significant in that the Examiner does not present a conversion of the mole percent ranges for the glass constituents disclosed by Hormadaly into a weight percent range for a proper comparison with the claimed amount of titanium dioxide in the Answer. While we recognize that conversions into weight percent ranges of the glass constituents for a few of the Examples of Hormadaly are presented in Table 3 of Appellants' Specification, the Examiner does not rely on this Specification Table in the Final Office Action or the Answer. Consequently, Appellants do not specifically address this Table in the Brief in responding to the Examiner's rejections of their claims.

This is important because the Examiner has not favored the appeal record with an analysis of the Table 3 data from Appellants' Specification and whether that Table reflects the closest Examples and disclosure of Hormadaly relative to the glass compositions being used in the claimed method. In this regard, the modified Example JH9A of Specification Table 3 may suggest that at least a 3.26 weight percent amount of titanium dioxide would have been within the grasp of an ordinarily skilled artisan from the teachings of Hormadaly alone. Nor has the Examiner specifically addressed the somewhat differing limitations of Appellants' independent claim 7 in the rejection. A portion of the Examiner's rejoinder (Answer 6) appears to be directed to appealed claim 7 but does not make up for the lack of treatment of this claim in the rejection itself. In this regard, the Examiner does not address or make any use of Specification Table 4 wherein B2T3 or orthorhombic bismuth titanate (a non-silicate crystal) is shown as apparently being formed when using a glass composition corresponding to the disclosure of Hormadaly.

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As another matter, Appellants and the Examiner brief us on different evidentiary records as being relied upon in the rejections. The Examiner attempts to introduce U.S. Pat. No. 4,446,241 as part of the applied prior art evidence being relied upon in the rejection of claims 1, 2, 7-12, and 16 (Answer 5). However, the Brief is directed to arguing a rejection based on the evidence actually referred to by the Examiner in the statement of the rejection. *See In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). In addition, the Examiner has not fairly addressed all of Appellants' considerable arguments against the Examiner's rejections as presented in the Brief.

As a final point, the record reflects that an Information Disclosure Statement was filed on April 10, 2007, which requires the Examiner's consideration.

In light of the above-noted matters, this remand to the Examiner requires the Examiner to take more corrective action than could reasonably be expected to be handled via a Supplemental Examiner's Answer. Accordingly, this Remand pursuant to 37 C.F.R. § 41.50 (a)(1) is not solely for further consideration of a rejection already made.

REMANDED

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