

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* CAO JIANJUN, KYLE SPRING and DEVANA COHEN

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Appeal 2008-2827  
Application 10/427,469  
Technology Center 2800

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Decided: September 11, 2008

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Before EDWARD C. KIMLIN, TERRY J. OWENS, and  
CATHERINE Q. TIMM, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

Appellants state that “[c]laims 23-30 are pending and on appeal herein” (pg. 1 of principal Brief). Claims 23 and 25-30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hshieh. Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hshieh in view of

Ferla. However, under the heading “GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL”, Appellants state “[w]hether claim 23 is anticipated by Hshieh, U.S. 6,172,398 under 35 U.S.C. §102(b)” (page 5 of principal Br.). Appellants do not state that the Examiner’s § 103 rejection of claim 24 is to be reviewed on appeal, nor do Appellants state that the § 102 rejection of claims 25-30 is to be reviewed on appeal. Accordingly, this application is remanded to the Examiner to provide Appellants the opportunity to clarify on the record which rejections are being appealed. In particular, Appellants should clarify whether the § 102 rejection of claims 25-30, as well as the § 102 rejection of claim 23, is being appealed, and whether the Examiner’s § 103 rejection of claim 24 is under appeal.

Also, Appellants state that “[t]he argument starting on page 7, line 13, and ending on page 8, line 8 of the Answer is not fully understood”, and Appellants request clarification of the argument (Rep. Br. 2, third para.). Since we agree with Appellants that the cited section of the Answer is not a model of clarity, the Examiner should honor Appellants’ request. In particular, the Examiner should clarify the statements that “[t]he peak actually starts from the beginning of the channel region where the redistribution-compensation is small, line A-A” and “[a]s can be seen in figure 3B, the peak begins at the beginning of the line B-B” (Ans. 7, last para.). In addition, the Examiner makes a statement that does not appear to support a rejection under § 102 which requires identity between the claimed subject matter and the reference disclosure. Specifically, the Examiner

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states “[i]n this case, supposed [sic] Hshieh does not describe the concentration profile, which is created by the lines A and B as mentioned above, the structure, figure 3A, would resemble a similar profile” (Ans. 8, first para.). Manifestly, the reference disclosure of a similar concentration profile is not a description of the claimed concentration profile within the meaning of § 102. Likewise, the Examiner’s reference to Hshieh manufacturing a **similar** power MOS calls into question whether Hshieh describes the same, not similar, semiconductor device claimed by Appellants. (*see* Ans. 6, last para.).

This remand to the Examiner pursuant 37 C.F.R. § 41.50(a)(1) 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.

REMAND

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