

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 56

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PRAVEEN CHAUDHARI,
RICHARD J. GAMBINO, ETI GANIN, ROGER H. KOCH,
LIA KRUSIN-ELBAUM, ROBERT B. LAIBOWITZ,
GEORGE A. SAI-HALASZ, YUAN-CHEN SUN,
and MATTHEW R. WORDEMAN

Appeal No. 2001-0546
Application 07/842,722¹

ON BRIEF

Before HAIRSTON, KRASS, and BARRETT, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON REQUEST FOR REHEARING

Appellant filed a request for "REHEARING PURSUANT TO 1/23/03 DECISION" (Paper No. 55) (pages referred to as "RR__") on

¹ Application for patent filed February 24, 1992, entitled "Superconductor Gate Semiconductor Channel Field Effect Transistor," which is a continuation of Application 07/733,361, filed July 19, 1991, now abandoned, which is a continuation of Application 07/473,292, filed February 1, 1990, now abandoned.

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March 24, 2003, and docketed at the Board on June 9, 2003, requesting rehearing of our decision (Paper No. 54) (pages referred to as "D__") entered January 23, 2003. In that decision, we: (1) sustained the rejection of claims 18, 26-28, 31, and 32 under 35 U.S.C. § 112, first paragraph, lack of written description; (2) reversed the rejection of claims 1, 13, and 29 under § 103(a) over Kugimiya and Lee; (3) reversed the rejection of claim 30 under § 103(a) over Kugimiya, Lee, and Yamada; (4) sustained the rejection of claims 26-28, 31, and 32 under § 103(a) over Nishino and Lee; (5) sustained the rejection of claim 18 under § 103(a) over Nishino, Lee, and Eda; and (6) entered a new ground of rejection as to claims 1, 13, and 29 under § 103(a) over Nishino, pursuant to 37 CFR § 1.196(b),

The request for rehearing is DENIED.

OPINION

"The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which rehearing is sought." 37 CFR § 1.197(b) (2002). It is not clear from the request for rehearing what points appellants think were misapprehended or overlooked in our decision. Since the request for rehearing is short, we address each paragraph.

The first three paragraphs seem to be just introductory or background statements that require no response.

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Appellants state (RR1-2): "The prosecution progress up through this, 1/23/03 affirm in part, reverse in part and new ground of rejection decision that is to be reviewed, may be considered to be, that all rejections on art are of the 35USC103 [sic] type, that no art has appeared that would indicate that the concept is not patentable and that there are still concerns with enablement with respect to some claims."

This appears to be a mere statement by appellants rather than an argument about something overlooked or misapprehended in our decision. However, the statement "that no art has appeared that would indicate that the concept is not patentable" (RR2) ignores the fact that numerous claims stand rejected over prior art and that it is the claimed subject matter, not whatever appellants consider to be the "concept," that must be shown to be patentable. Further, the statement "that there are still concerns with enablement with respect to some claims" (RR2) is erroneous because the § 112, first paragraph, rejection is based on lack of written description, not lack of enablement.

Appellants state that "[t]here are some concerns" (RR2) and (RR2): "It is a first concern that in the record assembled through the long pendency including five examiners and two continuations, there is marginal, if any, record of continuity and recognition of the previous examiner's work in the support being relied on for the rejection."

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This "concern" does not point to anything overlooked or misapprehended in our decision. Nor is it apparent what action appellants would have us take to modify our decision.

Appellants state (RR2): "It is a second concern that in the 35USC103 [sic] rejections, the record is not exactly clear what is relied on as the suggestion or motivator for the combination."

This argument just vaguely raises the question of motivation without pointing to any particular statement of motivation as error and without pointing to any place where the decision fails to state a motivation. The decision speaks for itself, including the motivation for the obviousness rejections.

Appellants state (RR2):

It is a third concern that the amendment; concerning the limitation "said gate insulator and said gate member producing a work function in the mid range of said substrate energy band gap range" which merely means that up to the three elements of the structure, the substrate, the oxide and the superconductor gate in each others presence will result in a desired work function; is being viewed too narrowly in the new ground of rejection. The variation in ingredients, of any or all of the superconductor gate member, of the Ruthenium oxide example oxide member, and of the substrate member, can affect the entire gate and produce the desired work function.

The limitation "said gate insulator and said gate member producing a work function in the mid range of said substrate energy band gap range" appears in claim 27. Claim 27 and its dependent claims were rejected under 35 U.S.C. § 112, first paragraph, for lack of written description of this limitation

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(D7-10). Appellants state that the limitation "is being viewed too narrowly in the new ground of rejection (RR2); however, appellants fail to point out where the limitation is described in the specification, whether it is viewed narrowly or broadly. Appellants have not particularly said what the error is in our decision so that we may address the perceived problem.

We have reconsidered our decision in light of appellants' arguments. We are not persuaded of any errors in our opinion, nor have appellants really pointed to any. Accordingly, the request for rehearing is DENIED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ERROL A. KRASS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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LEE E. BARRETT)	
Administrative Patent Judge)	

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