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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/259,295	10/26/2005	Kanguo Cheng	ROC920050218US1	4189
7590	02/15/2013		EXAMINER	
James R. Nock IBM Corporation Intellectual Property Law Dept. 917 3605 Hwy. 52 North Rochester, MN 55901			KIM, SUN M	
			ART UNIT	PAPER NUMBER
			2813	
			MAIL DATE	DELIVERY MODE
			02/15/2013	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KANGGUO CHENG, HERBERT L. HO
and JACK A. MANDELMAN

Appeal 2010-008741
Application 11/259,295
Technology Center 2800

Before ALLEN R. MacDONALD, HUNG H. BUI and
LYNNE E. PETTIGREW, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Introduction

Appellants appeal under 35 U.S.C. § 134(a) from a rejection of claims 15-20. We have jurisdiction under 35 U.S.C. § 6(b).

Exemplary Claims

Exemplary claim 15 under appeal reads as follows (emphasis added):

15. A method, comprising;

(a) providing a substrate including a microelectronic device;

and

(b) forming a void in the substrate around a portion of the microelectronic device ***so that the void reduces a parasitic leakage between the microelectronic device and the bulk substrate.***

Rejections

1. The Examiner rejected claims 15-17, 19, and 20 under 35 U.S.C. § 102(b) as being anticipated by Mandelman (US 6,437,401 B1).¹

2. The Examiner rejected dependent claim 18 as being unpatentable under 35 U.S.C. § 103(a) over Mandelman.²

3. The Examiner rejected dependent claims 15-17, 19, and 20 as being unpatentable under 35 U.S.C. § 103(a) over Schindler (US 7,033,926).³

¹ Separate patentability is not argued for claims 16, 17, 19, and 20. Except for our ultimate decision, these claims are not discussed further herein.

² The patentability of dependent claim 18 under 103(a) is not separately argued from that of the independent claims rejected under 102(b). Except for our ultimate decision, this claim is not discussed further herein.

³ Appellants' Appeal Brief is silent as to this rejection and does not request its review as required by 37 C.F.R. § 41.37(c)(1)(vi). Therefore appeal of this rejection was waived and we affirm this rejection as a matter of form.

4. The Examiner rejected dependent claim 18 as being unpatentable under 35 U.S.C. § 103(a) over the combination of Schindler and Lur (US 2004/0097013 A1).⁴

Appellants' Contentions

1. Appellants contend that the Examiner erred in finding that Mandelman anticipates claim 15 because “the Examiner’s burden of establishing that conductive material 19 is a microelectronic device has not been met.” (App. Br. 5).

2. At pages 3-5 of the Appeal Brief, Appellants also contend that Mandelman does not support anticipation of claim 15 because:

Mandelman fails to disclose, for example, forming a void in a substrate around a portion of a microelectronic device ***so that the void reduces a parasitic leakage between the microelectronic device and the bulk substrate.***

(App. Br. 3) (emphasis added).

Issues on Appeal

1. Whether the Examiner has erred in rejecting claim 15 as being anticipated because Mandelman’s item 19 is not a microelectronic device?

2. Whether the Examiner has erred in rejecting claim 15 as being anticipated because the Examiner is required ***to prove*** that Mandelman possesses the claimed functional limitation (“reduces parasitic leakage”) asserted by Appellants to be critical for establishing novelty in the claimed subject matter, (i.e., because the Examiner does not possess the authority to

⁴ Appellants’ Appeal Brief is silent as to this rejection and does not request its review as required by 37 C.F.R. § 41.37(c)(1)(vi). Therefore appeal of this rejection was waived, and we affirm this rejection as a matter of form.

require Appellants to prove that the prior art product does not possess the characteristics relied on)?

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants' contentions (App. Br. and Reply Br.) that the Examiner has erred in rejecting the claims based on Mandelman.

We disagree with Appellants' conclusions. We adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in the Examiner's Answer in response to Appellants' Appeal Brief. We concur with the conclusion reached by the Examiner.

As to Appellants' above contention 1, we disagree for the reasons set forth by the Examiner in the discussion of the storage capacitor node 19. (See particularly Ans. 6-7).

As to Appellants' above contention 2, we disagree. We conclude that the Examiner has set forth a reasonable basis to believe that Mandelman's structure possesses the claimed functional limitation ("reduces parasitic leakage"). (See particularly Ans. 7-8). Contrary to Appellants' arguments, the Examiner has presented a *prima facie* case for both anticipation and obviousness. Also contrary to Appellants' arguments, it is well established that the burden of going forward has shifted to Appellants. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977).

“When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.” *In re Spada*, 911 F.2d 705, 709 (Fed. Cir. 1990). However, the *prima facie* case can be rebutted by evidence showing that the prior art product does not necessarily possess the characteristics of the claimed product. *Best*, 562 F.2d at 1255; *see also Titanium Metals Corp. v. Banner*, 778 F.2d 775 (Fed. Cir. 1985). Appellants have presented no evidence that Mandelman’s structure, which is identical to the claimed structure, fails to possess the claimed properties.

CONCLUSIONS

(1) The Examiner has not erred in rejecting claims 15-17, 19, and 20 as being anticipated under 35 U.S.C. § 102(b) over Mandelman.

(2) The Examiner has not erred in rejecting claim 18 as being unpatentable under 35 U.S.C. § 103(a) over Mandelman.

(3) The Examiner has not erred in rejecting claims 15-17, 19, and 20 as being unpatentable under 35 U.S.C. § 103(a) over Schindler.

(4) The Examiner has not erred in rejecting claim 18 as being unpatentable under 35 U.S.C. § 103(a) over the combination of Schindler and Lur.

(5) Claims 15-20 are not patentable.

DECISION

The Examiner’s rejections of claims 15-20 are affirmed.

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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).

AFFIRMED

ELD