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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* NAM KHONG THEN, HUI MIN LER,  
PHILLIP CELAYA, and CHEE HIONG CHEW

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Appeal 2018-006067  
Application 15/278,203  
Technology Center 1700

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Before LINDA M. GAUDETTE, JENNIFER R. GUPTA, and LILAN REN,  
*Administrative Patent Judges.*

REN, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

Appellant<sup>1</sup> requests rehearing of our May 10, 2019 Decision (“Op.”). *See* Request for Rehearing filed July 9, 2019 (“Request”). In the Decision, we affirmed the Examiner’s rejection of claims 1–6 and 8–15 under 35 U.S.C. § 112(a) or 35 U.S.C. § 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement. Op. 3–5. We also reversed the Examiner’s rejection of 1, 2, 5, 8–13, and 15 under 35 U.S.C. § 102(a)(2) as being anticipated by Leung<sup>2</sup> and the Examiner’s rejection of claims 3, 4, 6, and 14 under 35 U.S.C. § 103 as being unpatentable over Leung in further view of Celaya<sup>3</sup>. Op. 5–6.

In a request for rehearing, an appellant is charged with stating the points believed to have been misapprehended or overlooked by the Board. 37 C.F.R. § 41.52. We review the points of the Decision contested by Appellant and determine whether we erred in fact finding or applying the law, and further determine whether any such error changes the outcome of the Decision when viewing all the evidence and arguments anew in light of the preponderance of the evidence standard. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (“[P]atentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument.”).

In this case, Appellant urges that we revisit the written description issue because the claim limitation “passing a current from a lead frame to the singulated lead solely via the one or more tie bars” is sufficiently supported

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<sup>1</sup> Appellant is the Applicant, “Semiconductor Components Industries, LLC,” which, according to the Appeal Brief, is the real party in interest. Appeal Brief of November 28, 2017 (“Br.”), 3.

<sup>2</sup> US 2016/0035651 A1, published Feb. 4, 2016.

<sup>3</sup> US 2010/0187663 A1, published July 29, 2010.

by “FIG. 4 in view of p. 9, lines 1-2” of the Specification. Request 5. We note<sup>4</sup> that these passages of the Specification were not presented in the Appeal Brief or the Reply Brief. *See* Br. 7–10 (arguing that the Examiner erred in finding that the claim fails to comply with the written description requirement based on “Specification at p. 4, 11. 20-25; p. 6, 11. 11-13; p. 7, 11. 14-25; p. 8, 11. 2-7; p. 10, 11. 2-4,” “Specification at p. 6, 11. 14-16, and “Specification at p. 4, 11. 21-25; p. 6, 11. 12-13; p. 7, 11. 16-25; p. 8, 11. 2-7; p. 10, 11. 2-4”); *see also* Reply Br. 1 (arguing the same based on “the instant specification found at p. 4, 11. 20-25; p. 6, 11. 11-13; p. 7, 11. 14-25; p. 8, 11. 2-7; and p. 10, 11. 2-4”).

The term “rehearing” is used in 37 CFR § 1.197(b) for consistency with the appropriate statute (35 U.S.C. § 6(b)). The “rehearing” provided by Rule 197(b) is a reconsideration of the written record as presented on appeal – not new argument or new evidence not previously raised. *See, e.g., In re Alappat*, 33 F.3d 1526, 1532–33 (Fed. Cir. 1994).

In this case, Appellant acknowledges that these passages “were not pointed out specifically in the Appeal Brief or Reply Brief.” Request 6. We disagree with Appellant’s contention that the Board should have scoured the Specification as-filed in the first instance for evidence and disclosure to support Appellant’s arguments.

We remind Appellant that by statute, this Board functions as a board of review, not a *de novo* examination tribunal. 35 U.S.C. § 7(b) (“The

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<sup>4</sup> We further note that, contrary to Appellant’s statement, Specification at page 9 lines 1–2 describes an embodiment of Figure 5 instead of Figure 4. *See* Spec. 8:17–9:3 (describing Figure 5). Appellant does not explain why the texts describing Figure 5 should be relied upon for the embodiment in Figure 4 to show support for this limitation.

[Board] shall . . . review adverse decisions of examiners upon applications for patents . . .”). “Filing a Board appeal does not, unto itself, entitle an appellant to *de novo* review of all aspects of a rejection.” *Ex parte Frye*, Appeal No. 2009-006013, 2010 WL 889747, \*4 (BPAI Feb. 26, 2010). To prevail in an appeal to this Board, Appellant must adequately explain or identify reversible error in the Examiner’s rejection. *See* 37 C.F.R.

§ 41.37(c)(1) (iv) (2012); *see also In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011). In this case, the Examiner provided an analysis for the written description rejection (Final Act. 3; Ans. 7–10 (citing Figures 3 to 4 of the Specification)), and Appellant had ample opportunity in both the Appeal Brief and Reply Brief to identify reversible error in the Examiner’s rejection (Br. 7–10; Reply Br. 1). We carefully considered the record before us and found that no reversible error had been identified. Op. 5. For us to consider Appellant’s new assertion on a Request for Rehearing – that these passages of the Specification that were not previously raised by Appellant should be reevaluated by the Examiner – would be unfair to the Examiner as the Examiner has not had an opportunity to respond to this assertion. We therefore decline to reconsider the rejection.

Appellant also argues that “the Board has construed the claims with inappropriate focus on file history, as it applied to the 35 U.S.C. § 112(a) rejection of the claims, rather than construing the claims in view of the specification as required.” Request 6–7. Appellant did not raise claim construction issues on appeal (*see* Br. 7–11) and we did not construe any claim term in our opinion as it was unnecessary (*see, e.g., Op.*) to resolve the written description issue which is a question of fact. *See PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1307 (Fed. Cir. 2008) (“Compliance

with the written description requirement is a question of fact.”). Instead, we fully and carefully considered Appellant’s arguments and found them unpersuasive and concluded that no reversible error has been identified in the Examiner’s fact findings in support of the written description rejection. Op. 5. Although Appellant faults the Board in failing to construe the claim, Appellant does not propose a construction of any particular claim term, nor does Appellant explain why claim construction is necessary to resolve the factual dispute for the written description rejection. Request 6–7 (arguing only that “the claims should have been construed explicitly in light of the specification in the decision”) (emphasis omitted). We again note that Appellant could have raised – but chose not to raise – these issues in the Appeal Brief. Cloaking a factual issue as one of claim construction – neither of which were previously raised – cannot show that the Board misapprehended or overlooked these issues. 37 C.F.R. § 41.52.

We disagree with Appellant’s assertion that the Board’s affirmance of the written description rejection and reversal of the art-based rejection somehow resulted in “cognitive dissonance.” Br. 7. Contrary to Appellant’s understanding, the written description requirement is separate and independent of the novelty requirement under the statute. In other words, whether the disclosure shows possession to a person of ordinary skill in the art (*Union Oil Co. of California v. Atlantic Richfield Co.*, 208 F.3d 989, 997 (Fed. Cir. 2000)) is a separate inquiry from whether all claim elements are found in one or more prior art references. The statute, 35 U.S.C., requires compliance with not one but all provisions including sections 102, 103, and 112. We further note that contrary to Appellant’s assertion, the record is devoid of evidence showing that the Examiner lacks knowledge as to how to

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proceed. *See* Request 7 (“It would be reasonable to assume that the interests of justice require a resolution of this cognitive dissonance so the Appellant (and the Examiner) are able to clearly understand how to proceed forward with this case.”).

#### CONCLUSION

For the foregoing reasons, we deny Appellant’s Request for Rehearing.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

DENIED