

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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER A. FRANKLIN, ARTHUR G. MERRYMAN,
RAJESH S. PATEL and THOMAS A. WASICK

Appeal No. 2000-1664
Application No. 09/114,790

ON BRIEF

Before NASE, CRAWFORD, and BAHR, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 6 through 15, which are all of the claims pending in this application.

The appellants' invention relates to a method of forming a multilayer thin film structure ("MLTF"). An understanding of the invention can be derived from a reading of exemplary claim 6, which appears in the appendix to the appellants' brief.

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The prior art

The prior art reference of record relied upon by the examiner and rejecting the appealed claims is:

McAllister et al. (McAllister)	5,757,079	May 26,
		1998

The rejection

Claims 6-15 stand rejected under 35 U.S.C. § 103 as being unpatentable over McAllister.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above noted rejection, we make reference to the final rejection (Paper No. 7) and the answer (Paper No. 12) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 11) and reply brief (Paper No. 15) for the appellants' arguments thereagainst.

Opinion

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, and to the

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respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

McAllister discloses a method of forming a multilayer thin film structure which comprises a series of layers. The layers include a dielectric layer which has metal thereon and a top surface layer which has vias, chip connection pads, and via-pad connection steps thereon. McAllister does not disclose that the surface layer includes a plurality of orthogonal X conductor lines and Y conductor lines.

Appellants argue that McAllister is silent with regard to the need for a plurality of orthogonal X conductor lines and Y conductor lines on the top surface of the MLTF.

The examiner concludes that although McAllister does not expressly disclose the formation of orthogonal X and Y conductor lines, it is within the ordinary skill of the person of ordinary skill in the art given the teaching of McAllister that X and Y conductor lines could be formed (final rejection at page 3). The examiner also states, in the answer at page 3, that it is

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inconceivable that one of ordinary skill in the art given the teachings of McAllister would not be able to practice appellants' claimed invention.

The test for obviousness is not whether one of ordinary skill in the art could or would be able to practice the claimed invention given the teachings of the prior art. The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness under 35 U.S.C. § 103, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference. To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellants disclosure. See e.g., Uniroyal, Inc. v. Rudkin-Wiley Corp. 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

It is our conclusion that the Examiner has failed to establish a prima facie case of obviousness in regard to claims

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6 through 15 because the examiner has not addressed the motivation of one skilled in the art to modify the McAllister reference so as to include X and Y conductor lines.

It appears to us that the examiner relied on hindsight in reaching his obviousness determination. However, our reviewing court has said, "to imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It is essential that "the decision maker forget what he or she has taught at trial about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." Id. Since the step of building the top surface layer so as to include X and Y conductor lines is not taught or suggested by McAllister, we

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will not sustain the rejection of claim 6 and claims 7 through
15 dependent thereon.

The decision of the examiner is reversed.

REVERSED

JEFFREY V. NASE)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MURRIEL E. CRAWFORD)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

MEC/jrg

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