

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KRISHNA G. SACHDEV, UMAR M. AHMAD,  
FAREED Y. AUDI, DANIEL G. BERGER,  
JOHN U. KNICKERBOCKER and CHON C. LEI,

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Appeal No. 2003-0955  
Application 09/406,645

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ON BRIEF

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Before KIMLIN, PAWLIKOWSKI, and MOORE, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 3, 5 through 7, and 22 through 24. Claims 4 and 8 through 21 have been canceled.

Claims 1 and 22 are representative of the subject matter on appeal and are set forth below:

1. A method for removing cured resin deposits from ceramic and metal surfaces of electronic modules comprising the steps of:

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supplying a ceramic or metal electronic module having a cured resin residue deposit on the module surface;

contacting the module with a stripping composition consisting essentially of a tetraalkyl ammonium hydroxide base where the alkyl groups are C1 to C4, a surfactant and a di- or tri-propylene glycol alkyl ether wherein the alkyl group is a  $\text{GH}_2,111$  wherein n is an integer of 1-4, the contacting being performed for an effective time to strip and degrade the cured resin residue deposit on the substrate surface; and

rinsing the contacted module to remove the residual degraded contacted resin and stripping composition.

22. A method for removing cured resin deposits from ceramic and metal surfaces of electronic modules comprising the steps of:

supplying a ceramic or metal electronic module having a cured resin residue deposit on the module surface;

contacting the module with a stripping composition consisting essentially of a tetraalkyl ammonium hydroxide base where the alkyl groups are C1 to C4, a surfactant and a di- or tripropylene glycol alkyl ether wherein the alkyl group is a  $\text{C}_n\text{H}_{2n,1}$  wherein n is an integer of 1-4, with the proviso that the composition does not contain N-methyl-2-pyrrolidone, the contacting being performed for an effective time to strip and degrade the cured resin residue deposit on the substrate surface; and

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rinsing the contacted module to remove the residual degraded contacted resin and stripping composition.

Claims 22 through 24 stand rejected under 35 U.S.C. § 112, first paragraph (description).

Claims 1 through 3 and 5 through 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Corby in view of Sato and further in view of Cala.

Claim 22 stands rejected under 35 U.S.C. § 103 as being unpatentable over Sato in view of Roscoe.

The examiner relies on the following references as evidence of unpatentability:

Corby et al. (Corby)	3,673,099	Jun. 27, 1972
Roscoe	3,839,234	Oct. 01, 1974
Cala et al. (Cala)	5,814,588	Sep. 29, 1988
Sato et al. (Sato)	5,185,235	Feb. 09, 1993

On page 5 of the brief, appellants group claims 1 through 3 and 5 through 7 together and group claims 22 through 24 together.

We therefore consider claims 1 and 22 in this appeal. 37 CFR § 1.192 (c) (7) (2000).

#### OPINION

##### I. The 35 U.S.C. § 112, first paragraph rejection

On page 3 of the answer, the examiner rejects claims 22 through 24 because claim 22 recites "with the proviso that the composition does not contain N-methyl-2-pyrrolidone." The examiner states that this phrase is not supported by the originally filed specification. Appellants respond to the examiner's position on pages 7 through 12 of the brief.

We note that an ipsis verbis disclosure is not necessary to satisfy the written description requirement of § 112. The disclosure need only reasonably convey to one of ordinary skill in the art that the inventors had possession of the subject matter in question. See In re Edwards, 568 F.2d 1349, 1351-52, 192 USPQ 465, 467 (CCPA 1978). Upon our review of the specification, we find that several embodiments are disclosed. For example, on page 10, beginning at line 12, a first embodiment is disclosed which does not include an N-methylpyrrolidone (NMP) as a component. On page 10, beginning at line 20, a second embodiment is disclosed wherein NMP is specifically disclosed as a component of the stripping composition. At page 11 of the specification, beginning at line 12, various solvents are disclosed and beginning at line 22, in the second embodiment, an NMP is specifically disclosed as a solvent. Also, as stated by appellants in their brief, specific examples are set forth that do not include NMP as a component. See for example, page 13, beginning at line 22 of the specification. Therefore, we find that the disclosure provides a supporting description of a stripping composition that does not contain NMP. We therefore reverse the 35 U.S.C. § 112, first paragraph rejection of claims 22 through 24.

II. The 35 U.S.C. § 103 rejection of claims 1 through 3 and 5 through 7.

The examiner's position regarding this rejection is set forth on pages 4 through 6 of the answer. Beginning on page 12 of the brief, appellants argue that their claimed stripping composition is a composition consisting essentially of a

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tetraalkyl ammonium hydroxide base, a surfactant and a di- or tri-propylene glycol alkyl ether. Appellants argue that the term "consisting essentially of" excludes NMP. (Brief, page 13). Appellants therefore argue that Corby, where an NMP is present in an amount of least 25%, is not an appropriate reference because a person with skill in the art would have to remove the major component of Corby which is NMP. (Brief, pages 13 through 14). In response, beginning on page 7 of the answer, the examiner states that appellants arguments are unpersuasive because appellants have not submitted factual evidence showing that NMP materially affects the basic and novel characteristics of the instant invention, especially when appellants' own specification sets forth embodiments that utilize NMP. We agree. We note that in the case of a product claim, the phrase "consisting essentially of" excludes ingredients which would affect the basic and novel characteristics of the product defined in the claims. In re Garnero, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1869). Here, appellants have not shown that NMP would affect the basic and novel characteristics of the product defined in the claims and therefore, we agree with the examiner's position in this regard. We also agree with the examiner's position and application of Sato and Cala and refer to pages 4 through 6 in the answer and also page 8 in the answer in support thereof. We are mindful of appellants' argument that Sato includes an organic solvent B. (Brief, page 13). Appellants argue that organic solvent B of Sato is a known hazardous solvent and that therefore, claim 1 excludes such component. We disagree with appellants' interpretation of Sato in this regard. In column 3 of Sato, other classes of solvents are disclosed other than hazardous solvents. Therefore, appellants' argument is unconvincing.

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In view of the above, we affirm the rejection.

III. The 35 U.S.C. § 103 rejection of claim 22.

Claim 22 as discussed above, recites the phrase "with the proviso that the composition does not contain N-methyl-2-pyrrolidone." The examiner's rejection involves Sato in view of Roscoe. Sato sets forth a composition comprising tetramethyl ammonium hydroxide (TMAH), dipropylene glycol monomethyl ether but no surfactant. (Answer, page 6). The examiner relies on Roscoe for utilizing surface active agents to enhance the cleaning properties of the composition that includes glycol ether. (Answer, page 6). The examiner concludes that it would have been obvious to include the surfactant of Roscoe in Sato to enhance the cleaning properties of the composition.

As mentioned above, appellants argued that their composition does not contain an organic solvent B which, according to Sato, can be a hazardous solvent which the claim would exclude. We refer to our comments made above in regards to this rejection and remain unconvinced by appellants' arguments in this regard. At the top of page 15, appellants' state that Roscoe does not cure the deficiencies of Sato.

In view of the above, we therefore affirm the rejection.

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IV. Conclusion

The rejection of claims 22 through 24 under 35 U.S.C. § 112, first paragraph (description) is reversed.

The rejection of claims 1 through 3 and 5 through 7 under 35 U.S.C. § 103 as being un patentable over Corby in view of Sato and further in view of Cala is affirmed.

The rejection of claim 22 under 35 U.S.C. § 103 as being unpatentable over Sato in view of Roscoe is affirmed.

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

AFFIRMED

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
BEVERLY A. PAWLIKOWSKI	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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JAMES T. MOORE	)	
Administrative Patent Judge	)	

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