

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOSHIHIRO HANAMURA

Appeal No. 95-1202
Application No. 08/106,144¹

HEARD: October 13, 1998

Before DOWNEY, KIMLIN, and JOHN D. SMITH, Administrative Patent Judges.

JOHN D. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal pursuant 35 U.S.C. § 134 from the final rejection of claims 1-6.

Claim 1 is representative and is reproduced below:

¹ Application for patent filed August 13, 1998. According to appellant, the application is a continuation of Application 08/106,144, filed November 30, 1992; now abandoned.

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1. A composite electric circuit part comprising:

an insulating substrate;

first and second terminal electrodes formed so as to be externally engageable at a first edge end portion of the insulating substrate;

a third terminal electrode formed so as to be externally engageable at a second edge end portion of the insulating substrate;

a first passive element formed on the insulating substrate, two respective terminals thereof being connected directly to the first and second terminal electrodes; and

a second passive element formed on the insulating substrate, two respective terminals thereof being connected directly to the second and third terminal electrodes;

wherein the first, second and third terminal electrodes and the first and second passive elements are formed on one surface of the insulating substrate.

The sole reference of record relied upon by the examiner is:

Towers, "Hybrid Microcircuits," Pentech Press, 1979, pp.8-11, 76-79.

The appealed claims stand rejected under 35 U.S.C. § 102(b) as anticipated by Towers.

We reverse.

As set forth by the court in *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983),

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cert denied, 465 U.S. 1026 (1984), for a proper anticipation rejection under 35 U.S.C. § 102(b) it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it." The review of any prior art rejection, whether for anticipation or obviousness, however requires first that the claims have been correctly construed to define the scope and meaning of the relevant limitation. *Gechter v. Davidson*, 116 F.3d 1454, 1457, 43 USPQ2nd 1030, 1032 (Fed. Cir. 1997). In proceedings before the Patent and Trademark Office, claims are to be given their broadest *reasonable* interpretation consistent with the specification, and claim language should be read in light of the specification as it would be construed by one of ordinary skill in the art. *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

In setting forth his anticipation rejection herein, the examiner has construed the claim language

first and second terminal electrodes formed so as to be externally engageable at a first end edge portion of the insulating substrate
and

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a third terminal electrode formed so as to
be externally engageable at a second end
edge portion of the insulating substrate

as "reading on" any prior art composite electric circuit, such as shown by Towers' Figure. 1.6, where a cross-sectional view representative of the circuit shows terminal electrodes "in the vicinity" of an "edge portion" defined by the plane forming the top of an insulating substrate and the plane of the page.

Suffice it to say, the examiner's interpretation of the relevant claim language regarding the end edge portion is unreasonable. This is evident from a cursory review of appellant's Figures 1 and 2 which show a plan view and a cross sectional view of appellant's electrical device respectively and appellant's specification which states that a "first electrode 12 and a second electrode 13 are provided at the left end portion (In Fig. 1) of a surface of an insulating substrate," and a "third electrode 14 is provided at the right end portion of the same surface." See the specification at page 5, lines 4 through 9.

As appellant correctly points out, a cross-sectional view of a prior art device, by definition, cannot show any edge of

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the substrate extending in the direction through which the cross-section is being taken. As a factual matter, we agree with appellant that Figure 1.6 of Towers does not show any electrode formed so as to be externally engagable at an end edge portion of an insulating substrate. Thus, we necessarily agree with appellant that Towers does not describe an insulating substrate with first, second, and third electrodes at end edge portions separately connected to a capacitor and resistor (i.e, first and second passive elements) in the manner required by appealed claim 1.

We also agree with appellant that the examiner unreasonably construed the claim language "second passive element" as "reading on" a structure which comprises two separate resistive films connected by some sort of an electrode structure. We find nothing in appellant's specification justifying such a broad definition of a "passive element."

The examiner's reliance on the Figure 6.5(a) embodiment by of Towers does not remedy the stated anticipation rejection. While the examiner argues that the need to build electrodes at an "end edge portion of an insulating substrate"

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is clearly taught by Figure 6.5(a) of Towers, the examiner has failed to adequately explain how this prior art embodiment describes first, second and third electrodes at end edge portions separately connected to first and second passive elements in the manner required by the appealed claims.

The examiner's rejection of the appealed claims, therefore, is reversed.

REVERSED

MARY F. DOWNEY)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
EDWARD C. KIMLIN)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JOHN D. SMITH)	
Administrative Patent Judge)	

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APJ John Smith

APJ kimlin

APJ Downey

DECISION: REVERSE
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s): _____

Prepared: August 12, 1999

Draft Final

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OB/HD GAU

PALM / ACTS2 / BOOK
DISK (FOIA) / REPORT