

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

\_\_\_\_\_  
Ex parte DARRELL G. HILL

\_\_\_\_\_  
Appeal No. 97-1542  
Application No. 08/159,648<sup>1</sup>

\_\_\_\_\_  
ON BRIEF

\_\_\_\_\_  
Before HAIRSTON, FLEMING, and GROSS, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 12 and 18 through 21.

The disclosed invention relates to an integrated circuit.

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<sup>1</sup> Application for patent filed November 30, 1993.

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Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. An integrated circuit, comprising:

(a) at least one transistor formed at a frontside surface of a substrate;

(b) a first ground plane covering portions of said frontside surface, wherein portions of said transistor remain uncovered by said first ground plane;

(c) an insulating layer over said uncovered portions of said transistor;

(d) a bond pad at a backside surface of said substrate, said backside surface opposite said frontside surface; and

(e) a conducting via through said substrate coupling said at least one transistor to said bond pad.

No references were relied on by the examiner.

Claims 1 through 12 and 16 through 21 stand rejected under the first paragraph of 35 U.S.C. § 112 for "containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention" (Answer, page 3). According to the examiner (Answer, page 4), "[t]he newly added claim limitation, 'a first ground plane covering portions of said frontside surface,' in claim[s] 1 and 9 pertaining to partial

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coverage of the first ground plane is not supported by the specification," and "the coverage of the insulative layer over the uncovered portions is not supported by the specification."

Appellant argues (Brief, page 4) that "every element of the disputed portions of the claims are [sic] supported in the drawings," and "[t]he portions of the specification supporting Figures 6a and 6b also supports [sic] the claimed invention."

Reference is made to the brief and the answer for further detailed positions of the appellant and the examiner.

#### OPINION

The lack of written description rejection<sup>2</sup> of claims 1 through 12 and 18 through 21 is reversed.

We agree with the appellant that the referenced portion of the specification (page 11, last paragraph), and the drawing provide adequate written description for the questioned claim limitations. The drawing (Figures 6a and 6b) shows "a first ground plane [620] covering portions of said

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<sup>2</sup> The first paragraph of 35 U.S.C. § 112 includes three distinct sections (i.e., enablement, written description, and best mode). The rationale for rejecting the claims on appeal is the lack of written description (Answer, page 4), and not the lack of enablement (Answer, page 3).

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frontside surface" of substrate 600, "an insulating layer [622] over . . . uncovered portions of . . . transistor" 602 or 612, and "an insulating layer [622] over a base contact [606] and an emitter contact [608] of . . . transistor" 602.

DECISION

The decision of the examiner rejecting claims 1 through 12 and 18 through 21 under the first paragraph of 35 U.S.C. § 112 is reversed.

REVERSED

KENNETH W. HAIRSTON )  
Administrative Patent Judge )  
)  
)  
)

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	)	BOARD OF PATENT
MICHAEL R. FLEMING	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
ANITA PELLMAN GROSS	)	
Administrative Patent Judge	)	

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APJ HAIRSTON

APJ GROSS

APJ FLEMING

DECISION: REVERSED  
Send Reference(s): Yes No  
or Translation (s)  
Panel Change: Yes No  
Index Sheet-2901 Rejection(s): \_\_\_\_\_

Prepared: March 23, 2000

Draft    Final

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PALM / ACTS 2 / BOOK  
DISK (FOIA) / REPORT