

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BABAR A. KHAN, HENRI R. J. R. VAN HELLEPUTTE,
ADRIANUS L. J. BURGMANS, KAREL E. KUIJK, PETRUS F. G.
BONGAERTS, JACOB BRUININK, THOMAS S. BUZAK, KEVIN J. ILCISIN
and PAUL C. MARTIN

Appeal No. 1999-0529
Application 08/588,800

ON BRIEF

Before THOMAS, JERRY SMITH and BLANKENSHIP, Administrative
Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 2-7, 9-13, 24 and 25. Claims 1 and 8 have been canceled. Claims 14-23 stand withdrawn from consideration as being directed to a nonelected

invention.

The disclosed invention pertains to a channel plate for a flat display device comprising elongated channels and electrodes in each of the channels. The invention is particularly directed to the manner in which the channel regions are formed.

Representative claim 24 is reproduced as follows:

24. A channel plate for a flat display device comprising elongated channels and electrode surfaces in each of the channels, said channel plate comprising:

- a) a dielectric substrate having a surface;
- b) a dielectric sheet on the surface of the substrate, the dielectric sheet comprising a plurality of laterally spaced spacer members defined by through-holes in the sheet, the spacer members defining flanking wall portions; and
- c) a thin dielectric sheet-like member on the dielectric sheet;

whereby each of the channels is formed by adjacent flanking wall portions of the spacer members, and the portions of the substrate surface and the thin dielectric sheet extending between the adjacent spacer members.

The examiner relies on the following references:

Martin et al. (Martin)	5,440,201	Aug. 08, 1995
Ilcisin et al. (Ilcisin)	5,528,109	June 18, 1996
		(filed Apr. 19, 1995)

Appeal No. 1999-0529
Application 08/588,800

Claims 24, 25, 2-5, 7, 9 and 13 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Martin. Claims 2-4, 9, 13, 24 and 25 stand rejected under 35 U.S.C.

§ 102(e) as being anticipated by the disclosure of Ilcisin.

Claims 6 and 10-12 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Martin and Ilcisin.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Appeal No. 1999-0529
Application 08/588,800

It is our view, after consideration of the record before us, that the disclosures of Martin and Ilcisin anticipate the invention as set forth in the claims respectively rejected on these references. We are also of the view that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 6 and 10-12. Accordingly, we affirm-in-part.

We consider first the rejections made under 35 U.S.C. § 102. Anticipation under 35 U.S.C. § 102 is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The first anticipation rejection rejects claims 24, 25, 2-5, 7, 9 and 13 based on the disclosure of Martin.

Appeal No. 1999-0529
Application 08/588,800

According to appellants, these claims stand or fall together as a single group [brief, page 7]. We note that claim 7 depends from claim 6 which is not subject to this rejection. Therefore, claim 7 will stand or fall with claim 6 which will be considered below. We will consider independent claim 24 as the representative claim for the other claims of this group.

The examiner indicates how he perceives the invention of claim 24 to be fully met by the disclosure of Martin [answer, pages 3-4]. Appellants argue that elements 120a of Martin are not spacer members in a dielectric sheet defined by through-holes in that dielectric sheet as recited in claim 24. Appellants also argue that elements 110c and 110d are also not spacer members, but are only channel sidewalls formed by bonding long, narrow glass fibers 106 to the surface of the substrate [brief, pages 7-8]. The examiner's response appears to be that members 110c of Martin's Figure 4B are spacer members defined by through holes or elongated channels in the same manner as appellants' spacer members shown in Figure 3 of

Appeal No. 1999-0529
Application 08/588,800

the application [answer, page 6].

We agree with the examiner's finding that Martin anticipates the invention of claim 24. We note that claim 24 is drawn to the structure of a channel plate. Appellants' argument appears to be directed more to the manner in which appellants create spacer members within the dielectric sheet rather than to the claimed resulting structure. As the examiner points out, the dielectric sheet of appellants' disclosed invention is completely missing between the spacer members [note Figure 3]. Thus, the

dielectric sheet of the claimed invention consists of only a series of separated spacer members after the through holes have been formed. There is no "sheet" remaining after the through holes have been formed. We interpret the examiner's position to be that the structure resulting from Martin's added spacer members 110c in Figure 4B is the same as the structure resulting from appellants' dielectric sheet after the through holes have been formed. We agree with the examiner that the structure of claim 24 is the same as

Appeal No. 1999-0529
Application 08/588,800

Martin's structure even though they are made by different techniques. There is no evidence on this record that the structure resulting from spacer members formed by through-holes in a dielectric sheet is any different from the structure resulting from simply placing a plurality of dielectric spacer members on the surface of the substrate. Since claim 24 is directed to a structure rather than to a method of making the structure, we find that the structure of claim 24 is fully met by the disclosure of Martin. Therefore, we sustain the rejection of claims 24, 25, 2-5, 9 and 13 as anticipated by Martin.

The second anticipation rejection rejects claims 24, 25, 2-4, 9 and 13 based on the disclosure of Ilcisin. According to appellants, these claims stand or fall together as a single group [brief, page 7]. Ilcisin is assigned to the same company as Martin, and it appears to show a structure similar to that of Martin. Appellants note the similarity between Martin and Ilcisin and assert lack of anticipation for the same reasons considered above with respect to Martin [brief, page 8]. Since the anticipation issue with respect to Martin was decided adversely to appellants, we also sustain

Appeal No. 1999-0529
Application 08/588,800

the rejection of claims 24, 25, 2-4, 9 and 13 as anticipated by Ilcisin.

We now consider the rejection of claims 6 and 10-12¹ under 35 U.S.C. § 103 based on the teachings of Martin and Ilcisin. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive

at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary

¹ As noted above, claim 7 depends from claim 6 and should have been included with this rejection. As also noted above, claim 7 will stand or fall with claim 6 since it is not separately argued.

Appeal No. 1999-0529
Application 08/588,800

skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this

Appeal No. 1999-0529
Application 08/588,800

decision. Arguments which appellants could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

Claims 6, 11 and 12 recite a spaced crossbar which extends laterally between flanking wall portions. Claim 10 recites specific dimensions of the width, height and pitch of the walls. With respect to claims 6, 11 and 12, the examiner asserts that crossbars would be an obvious design expedient for increasing mechanical strength. With respect to claim 10, the examiner finds that the claimed width, height and pitch of the flanking walls would have resulted from routine experimentation by the artisan [answer, pages 5-6]. With respect to all of these claims, appellants argue that the claimed crossbars and the claimed dimensions are not mere obvious design expedients, and that neither reference teaches the specific details of these claims [brief, pages 9-10]. The examiner simply repeats his position on these questions [answer, page 7].

We find ourselves compelled to agree with appellants on this rejection. The examiner has the responsibility to

Appeal No. 1999-0529
Application 08/588,800

provide us with a factual record which supports his position
on

obviousness. The examiner cannot provide such a record by merely concluding that claim limitations are obvious without evidence on the record which supports that conclusion. In this case, appellants have argued that there is no suggestion of crossbars in either of the applied references and that the applied references would have no need for crossbars because of their different structural properties. The examiner has not rebutted these arguments, but instead, the examiner has simply repeated his bare assertion of obviousness without any factual support. In addition, although the prior art acknowledges that the walls will have dimensions of width, height and pitch which are selectable by the user, there is no teaching in the applied prior art that the three dimensions should have the specific ranges of values recited in the claim or that the ranges should be related in the manner set forth in the claim. We are unpersuaded by this record that the claimed dimensions are the result of routine experimentation as asserted by the

Appeal No. 1999-0529
Application 08/588,800

examiner.

In summary, we find that the examiner has failed to provide a factual record which supports the rejection of the claims under 35 U.S.C. § 103. Therefore, we do not sustain the examiner's rejection of claims 6, 7 and 10-12.

In conclusion, we have sustained the examiner's rejection of the claims under 35 U.S.C. § 102, but we have not sustained the examiner's rejection of the claims under 35 U.S.C. § 103. Therefore, the decision of the examiner rejecting claims 2-7, 9-13, 24 and 25 is affirmed-in-part.

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

AFFIRMED-IN-PART

JAMES D. THOMAS)
Administrative Patent Judge)
)
)
)
JERRY SMITH) BOARD OF PATENT

Appeal No. 1999-0529
Application 08/588,800

Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
HOWARD B. BLANKENSHIP)	
Administrative Patent Judge)	

JS/ki

Appeal No. 1999-0529
Application 08/588,800

Corporate Patent Counsel
US Phillips Corporation
580 White Plains Road
Tarrytown, NY 10591