

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte UWE SEIDEL AND RAINER BRAUN

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Appeal No. 1999-0763  
Application No. 08/529,322

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ON BRIEF

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Before CAROFF, OWENS, and PAWLIKOWSKI, Administrative Patent Judges.

CAROFF, Administrative Patent Judge.

DECISION ON APPEAL

This decision on appeal relates to the examiner's final rejection of all of appellants' pending claims. Subsequent to the final rejection, appellants chose to cancel claim 5, and the examiner withdrew all rejections based upon 35 U.S.C. § 112. Accordingly, the sole issue before us relates to the examiner's rejection of claims 1-4 and 6-8 under 35 U.S.C. §

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103 for obviousness in view of either admissions of prior art in appellant's specification (pages 1-4) or Heller et al. (5,292,558), taken in combination with Cheng et al. (5,215,619) and Turner et al. (5,281,320).

The appealed claims relate to a method for back-etching of tungsten-coated substrate surfaces by pressing the substrate against a cooled specimen holder during back-etching with a retaining ring having prong-shaped extensions.

Based upon the record before us, we agree with appellants that the examiner has failed to establish a prima facie case of obviousness. Accordingly, we shall reverse the rejection at issue for the following reasons.

It is not enough that the prior art may suggest that fingers or prongs are the functional equivalent of a retaining ring which extends around the entire periphery of a substrate. For instance, see Cheng et al. (column 13, lines 22-26). This does not end the inquiry since appellants' claims further require that the prong-shaped extensions must be "back-up free relative to etching products liberated in the back-etching, causing the etching products to flow past the prong-shaped

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extensions and be purposefully deposited outside the substrate surface."

Appellants' specification (page 9, lines 11-14; page 10, lines 6-22; page 11, lines 3-14) describes a number of specific factors, e.g. the shape and dimensions of the prongs, which are determinative in obtaining this desired effect as claimed. The examiner offers no convincing reason, nor are we aware of any, why the prongs or fingers described and depicted in the cited references would necessarily produce the outcome required by the instant claims even if used in the particular context of back-etching tungsten-coated substrate surfaces. To wit, Cheng et al. is silent with regard to the dimensions of radial fingers 78 F. Thus, it would be sheer speculation to postulate that the fingers depicted in Cheng et al. would necessarily function as claimed. Similarly, it would be sheer speculation to postulate that the fingers depicted in Turner et al. would necessarily function as claimed since Turner et al., like Cheng et al., fail to recognize or disclose any critical interrelationship between the shape and dimensions of the fingers which would necessarily result in their being

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"back-up free" within the context of the method defined by the instant claims.

For the foregoing reasons, the decision of the examiner is reversed.

REVERSED

MARC L. CAROFF	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
TERRY J. OWENS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
BEVERLY A. PAWLIKOWSKI	)	
Administrative Patent Judge	)	

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APJ CAROFF

APJ OWENS

APJ PAWLIKOWSKI

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

Prepared: May 20, 2002

Draft                  Final

3 MEM. CONF.    Y                  N

OB/HD                  GAU

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