

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 CHIN-SHIEN YANG,
CHUAN-HUAI CHEN and CHENG-KUN LIN

Appeal No. 1999-0801
Application 08/552,245

ON BRIEF

Before KIMLIN, PAK and WARREN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellant, in the brief, and based on our review, find that we cannot sustain the rejection of appealed claims 6 and 7, all of the claims in the application, under 35 U.S.C. § 103(a) as being unpatentable over Hanak et al. (Hanak) in view of the admitted prior art in appellants' specification (Figures 1 and 2 as described at pages 1-5) and the rejection of appealed claims 8 through 11¹ under 35 U.S.C. § 103(a) as being unpatentable over (Hanak) in view of the

¹ Claims 6 through 11 are all of the claims remaining in the application See specification, page 12, and the amendments of September 8, 1997 (Paper No. 9).

admitted prior art in appellants' specification, as previously applied, further in view of Maissel et al..² For the reasons pointed out by appellants in the brief, the examiner has failed to make out a *prima facie* case with respect to both grounds of rejection.

It is well settled that "[t]he consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that [the claimed process] should be carried out and would have a reasonable likelihood of success viewed in the light of the prior art. [Citations omitted] Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Thus, a *prima facie* case of obviousness is established by showing that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in the art would have led that person to the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellant's disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (Nies, J., concurring); *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *Dow Chem.*, 837 F.2d at 473, 5 USPQ2d at 1531-32.

In order to consider the examiner's application of the prior art of record to appealed claims 6 and 7, which are representative of the appealed claims and separately argued by appellants (brief, page 3), we must first interpret the same in light of the written description in appellant's specification as it would be interpreted by one of ordinary skill in this art, *see generally, In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), mindful that the terms in the appealed claims must be given their ordinary meaning unless we find that another meaning is intended by appellants. *See, e.g., York Prods., Inc. v. Central Tractor Farm & Family Ctr.*,

² Answer, pages 3-5.

99 F.3d 1568, 1572-73, 40 USPQ2d 1619, 1622 (Fed. Cir. 1996), and cases cited therein (a claim term will be given its ordinary meaning unless appellant discloses a novel use of that term). The plain language of appealed claims 6 and 7 specifies that the “gas baffle . . . comprises a disk having unbroken, upper and lower surfaces.” We find no definition of the term “unbroken” in the written description in appellants’ specification and thus give the term its ordinary dictionary meaning of “**1.** Not broken or tampered with; intact. **2.** Not violated or breached. **3.** Uninterrupted; continuous.” *The American Heritage Dictionary Second College Edition* 1315 (Boston, Houghton Mifflin Company, 1982). Thus, claims 6 and 7 clearly require a gas baffle comprising at least a disk that has intact, continuous surfaces that are not breached or interrupted in any manner.³ We further find that both claims 6 and 7 plainly require “admitting gas” for sputtering “through an inlet centrally located above said gas baffle.”

³ We observe in the written description in appellants’ specification with respect to Figure 3, that “the gas baffle” comprises “plates **31** and **32**,” that “it is seen that the gas baffle . . . [has] no rough protuberances (such as screw heads **21** in [prior art] Fig. 2)” because “plate **32**” is attached to plate **31** “flat-headed screws **33** [are used] in place of the round-headed screws **21**,” wherein “flat-headed screws were counter sunk into the lower surface of **32** so that said surface remained uniformly planar;” and that a screw threaded opening in plate **32** for “threaded rod **39**” permits “pulling lower plate **31** into close contact with upper plate **32**” (page 7). It is apparent from this disclosure that appellants intend to differentiate the gas baffle as shown in Figure 3 from the gas baffle of the acknowledged prior art apparatus shown in Figure 2 (*id.*). However, we readily observe in Figure 3 that the shafts of screws **33** extend through the surface of plate **32**, which is the upper plate of the described baffle, to connect the baffle to shield **2**, and that the upper surface of plate **32** is *not conterminous* with the lower surface of plate **31**, which is the lower plate of the described baffle. Thus, the upper surface of the gas baffle provided by plate **32** is *not* “unbroken,” as we have interpreted this term above, with respect to either the *protuberances* provided by screws **33** or the abrupt edges thereof vis-à-vis plate **33** which will cause *eddies*, that is, interrupted dispersion of the sputtering gas. Whether this disclosure constitutes a written description of an embodiment that falls within the appealed claims as we have interpreted the language “gas baffle . . . comprises a disk having unbroken, upper and lower surfaces,” is a different issue than the interpretation to be made of such language in light of the written description of appellants’ specification as it would be interpreted by one of ordinary skill in this art. In this respect, it is well settled that during prosecution, no limitation included in the specification, by working example or otherwise, will be read into a claim unless the claim provides a basis for such a limitation. *See Zletz, supra; In re Priest*, 582 F.2d 33, 37, 199 USPQ 11, 15 (CCPA 1978), quoting *In re Prater*, 415 F.2d 1393, 1405, 162 USPQ 541, 551 (CCPA 1969) (“We have consistently held that no ‘applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim.’”).

We have carefully considered the disclosure of Hanak as applied by the examiner. It is well settled that a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom, see *In re Fritch*, 972 F.2d 1260, 1264-65, 23 USPQ2d 1780, 1782-83 (Fed. Cir. 1992); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968), presuming skill on the part of this person. *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). We find ourselves in agreement with appellants (brief, pages 4-6) that the construction of Hanak's counter electrode **106** as shown in Hanak Fig. **1**, is not apparent from either the figure or the disclosure of the reference. Indeed, we find it readily apparent from Hanak Fig. 1 that the line in the drawing that the examiner interprets to be a structural "wire supporting the counter electrode" (answer, page 6), is instead conductor **110** which is described in Fig. **1** and disclosed in the reference merely as a common ground for said electrode and metal bottom plate **8** (col. 3, lines 19-22), and no teaching of a support function for said conductor is expressed in or could be inferred from such a written description.⁴ In the absence of evidence or scientific reason advanced in this record with respect to the construction of such a counter electrode, the examiner has not supported the position that "the counter electrode is unbroken" and corresponds to the "gas baffle" specified in the appealed claims as we have interpreted them above (answer, pages 4 and 6-7).

Even assuming that the record establishes that one of ordinary skill in this art would have considered that Hanak's "counter electrode is unbroken," the examiner has not explained why this person would have found in the combination of Hanak and the admitted prior art embodied in specification Figures **1** and **2** any objective teaching, suggestion or motivation to modify the apparatus of Hanak by providing the same with a sputter shield and to centrally locate the inert gas supply inlet above the counter electrode **106** as required by claims 6 and 7. Indeed, bar jar **104** would have been considered by one of ordinary skill in this art to act as a sputter shield and the examiner has not addressed the matter of relocating the inert gas supply inlet. Thus, the fact that the apparatus of Hanak can be modified by adding thereto the shield shown in specification Figures **1** and **2** does not alone provide the basis for combining the applied prior art, see, e.g., *Fritch*, 972 F.2d at 1266, 23 USPQ2d

⁴ Compare the disclosure of the ion gun **206** in Hanak Fig. **2** for which the reference provides little

at 1783, and in any event, without motivation to centrally locate the inert gas inlet, the resulting apparatus would not result in an apparatus that meets the limitations of appellants' claims. *See Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-54, 5 USPQ2d 1434, 1438-41 (Fed. Cir. 1988).

In comparing the apparatus as specified in the appealed claims as we have interpreted them above to the prior art apparatus in specification Figure 2, which we find to be the closest prior art, we observe that the examiner has not advanced a supported position that one of ordinary skill in the art would have modified the surfaces of gas baffle 11 shown therein.⁵

The examiner's decision is reversed.

Reversed

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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CHUNG K. PAK)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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CHARLES F. WARREN)	
Administrative Patent Judge)	

detail (e.g., col. 3, lines 43-47).

⁵ Appellants describe the “novelty of the present invention” with respect to prior art Figure 2 as “being mainly the absence of through hole 9 and protruding screw heads 21” (brief, page 4). While there is a space in gas baffle 11 which is associated with numeral 9 in Figure 2 in this application, there is no discussion thereof in the written description of the specification, and we observe that Figure 2 as it appears in United States Patent 6,030,508 which issued from application 08/552,245, a division of the present application, contains neither a space nor numeral 9.

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