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MAR 24 1995

PATENT OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MIKIHIRO KIMURA

Appeal No. 93-4324
Application 07/336,622¹

RECONSIDERATION

Before JERRY SMITH, HARKCOM, and FLEMING, Administrative Patent Judges.

FLEMING, Administrative Patent Judge.

DECISION ON REQUEST FOR RECONSIDERATION

Appellant requests that we reconsider our decision dated January 4, 1995, with respect to 1) the decision raises a new ground for rejection and should be remanded to the Examiner, 2) the decision fails to consider differences between the invention and the applied art and 3) the decision should not have viewed the dependent claims to stand or fall together with the independent claims.

¹ Application for patent filed April 10, 1989. According to applicant, the application is a continuation of Application 07/157,498, filed February 17, 1988, now abandoned.

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As to the first point, the Appellant argues that the decision established a new rationale as a basis for affirming the Examiner's rejection. In particular, it is the Appellant's position that the Examiner refused to give any significance to the recited "contact region" contending that the limitations are non-limitations and the decision which finds that Baglee meets this limitation is a new ground of rejection.

However, it is not the position of the Examiner to ignore the limitation of the "contact region" as alleged by the Appellant. The Examiner instead is arguing the language "contact region" is broad language and as broad language Baglee meets this limitation. In fact, the Examiner states in the answer on page 5 that "there are no 'contacts' recited on the "contact regions". The Examiner further states on pages 5 and 6 that the contact regions "are merely arbitrarily designated places" on the superlattice. The Examiner further states on the same page that "[a]ny superlattice over a grooved surface has such regions which may, if one wishes, be called 'contact regions'. Finally, the Examiner concludes with the following statement:

The entire argument in the Brief is based not on any alleged difference in the structure here v.s. the identical structure in the prior art, but solely on the assertion that appellant uses different nomenclature to define exactly the same structure.

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Clearly, the Examiner is not ignoring the limitation as argued by the Appellant, but instead, the Examiner is arguing that Baglee meets Appellant's claimed limitation, "contact region" because the limitation is a broad limitation.

We did not reverse the Examiner's rejection for failure to give patentable weight to the limitation. We agreed with the Examiner that the limitation is broad and is indeed met by Baglee. We did not provide a new ground of rejection. Appellant points to our statement on page 6 of the decision as evidence of a new ground. However, we are simply agreeing with the Examiner's position that a "contact region" is broad and then we are showing how exactly the regions on the Baglee superlattice meet this limitation as argued by the Examiner. Our reviewing court recognizes that although "using different language in its decision", a board decision which fully shows why the appealed claims define nothing inventive over the prior art relying on the reference cited by the Examiner is not a new ground of rejection. *In re Cowles*, 156 F.2d 551, 555, 70 USPQ 419, 422 (CCPA 1946). We further note that the court ruled "that such differing forms of expression did not constitute different grounds of rejection and were of little consequence". *In re Bush*, 296 F.2d 491, 131 USPQ 263 (CCPA 1961) citing *In re Cowles*, 156 F.2d 551, 70 USPQ 419 (CCPA 1946).

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As to the second point, we fail to find that the claimed limitation, "device", set forth the further limitation of "an active tunneling device on a superlattice structure with remote contacts" as argued on pages 7 through 9. We fail to find that the specification defines the term "device" as being only an active device and not a passive device. Clearly, the term device includes both passive and active devices. Thus, Appellant's claimed limitation, device, is met by Baglee. Appellant further states on page 9 that "as is clear from Figs. 2 and 7-9, there is no 'contact' region as that term is understood in the art, and as illustrated in applicant's Fig. 10B for example, where an electrode contacts the contact region of the superlattice layer." However, we remain unpersuaded because we have previously pointed out that Appellant's claim language is not limited to an electrode contact or to even an area on the superlattice that is able to connect to a remote electrode contact.

Finally, as to the third point, the Appellant argues that dependent claims 19, 21 and 24 do not stand or fall together with the independent claims because of the brief statements on page 8. However, in reviewing these statements, Appellant did not argue that these claim limitations are different than the prior art with reasons supporting the position, but instead, Appellant simply restates the claim limitations. These statements alone do

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