

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(2) is not binding precedent of the Board.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. 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 JAMES J. FINLEY

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Appeal No. 95-3463  
Application 08/139,260<sup>1</sup>

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ON BRIEF

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Before HAIRSTON, KRASS, and LEE, Administrative Patent Judges.

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<sup>1</sup>Application for patent filed October 20, 1993. According to applicant, the application is a continuation of Application 07/333,068, filed April 3, 1989; which is a continuation-in-part of Application 07/176,979, filed April 4, 1988, now Patent No. 4,898,789.

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HAIRSTON, Administrative Patent Judge.

REQUEST FOR RECONSIDERATION

Appellant has requested reconsideration of our decision dated November 6, 1997, wherein the decision of the examiner rejecting claims 1 through 7 and 10 through 20 under the grounds of res judicata was reversed, and the decision of the examiner rejecting claims 1 through 7 and 10 through 20 under 35 U.S.C. § 103 was affirmed as to claims 1 through 3, 5 through 7, 11 through 13 and 16 through 18, and was reversed as to claims 4, 10, 14, 15, 19 and 20.

Appellant argues (Request, page 2) that "steps b, f and j of method claim 16 each recite 'sputtering zinc and tin in a reactive atmosphere comprising oxygen to deposit a . . . zinc/tin oxide film on . . .'," and that "[t]he feature of a metal oxide film comprising an oxide reaction product of zinc and tin was found by the Board to be a patentable feature of allowed dependent claims 4 and 14." Appellant acknowledges (Request, page 2) that "the patentable features of steps b, f, and j of method claim 16 were not argued by appellant; however, the Board in making its decision should not overlook

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the obvious patentable features of method claim 16."

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In reversing the obviousness rejection of claims 4 and 14, the Board merely stated (Decision, page 9) that "the examiner has not provided a reason, and we are not aware of one, for replacing the metal oxide used in Woodard with an oxide reaction product of zinc and tin disclosed by Gillery '771." The obviousness rejection of claims 4 and 14 was, therefore, reversed because the examiner failed to satisfy the required duty of establishing a prima facie case of obviousness, and not because claims 4 and 14 were deemed to contain allowable subject matter. Thus, a finding not made in connection with claims argued by appellant will not be made in connection with claims not argued by appellant.

Appellant's request has been granted to the extent that our decision has been reconsidered, but such request is denied with respect to making any modifications to the decision.

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

RECONSIDERATION  
DENIED

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
ERROL A. KRASS	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
	)	
	)	
JAMESON LEE	)	
Administrative Patent Judge	)	

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