

***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(2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* WILLIAM K. DENNIS

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Appeal No. 96-2068  
Application 08/157,580<sup>1</sup>

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ON BRIEF

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Before CAROFF, WARREN and OWENS, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

*Decision on Appeal and Opinion*

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 13 and 19 through 26.<sup>2</sup>

We have carefully considered the record before us, and based thereon, find that we cannot sustain the ground of rejection of claims 13 and 19 through 26 under 35 U.S.C. § 103 over Moyle in

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<sup>1</sup> Application for patent filed November 24, 1993.

<sup>2</sup> Amendment of June 23, 1994.

view of Hirata et al., in further view of Palmer,<sup>3</sup> advanced by the examiner on appeal.<sup>4</sup> It is well settled that the examiner may satisfy his burden of establishing a *prima facie* case of obviousness under § 103 by showing some objective teachings or suggestions in the prior art taken as a whole or that knowledge generally available to one of ordinary skill in the art would have led that person to combine the relevant teachings of the applied prior art in the proposed manner to arrive at the claimed invention, including each and every limitation of the claims, without recourse to the teachings in appellant's disclosure. *See generally In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (Nies, J., concurring); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988). The examiner has failed to carry his burden.

As pointed out by appellant in his brief and again in his reply brief, the examiner has not advanced on this record any evidence or scientific reasoning establishing that the claimed method of manufacturing a light transparent window in a package for an integrated circuit having elements erasable by light comprising at least the steps specified in the appealed claims was within the ordinary skill in this art at the time the claimed invention was made. We find that even if the combined teachings of Moyle, Hirata et al. and Palmer would have reasonably suggested to one of ordinary skill in this art to modify either the package and the manufacturing thereof disclosed by Moyle (e.g., Moyle Fig. 4E), or the prior art package and manufacturing thereof described by this reference (col. 3, line 64, to col. 4, line 11, and Moyle Fig. 3), by the teachings of Hirata et al. and Palmer to accommodate an EPROM, the resulting package would have a transparent plate on top of transparent material as taught by Hirata et al. (col. 4, and Fig. 4, numerals **31** and **32**) and manufactured by the process of that reference or the process of Palmer. With respect to the methods of manufacture taught by the applied references, we agree with appellant that Palmer does not support the examiner's allegation that the specific process steps of the appealed claims constitute a "conventional technique" known in the art as these steps are

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<sup>3</sup> The references relied on by the examiner are listed at page 2 of the answer.

<sup>4</sup> As appellant points out in the reply brief, claim 13 was separately rejected over Moyle in view of Hirata et al., while claims 19 through 26 were rejected over Moyle in view of Hirata et al., in further view of Palmer, in the final rejection of September 26, 1994 (Paper No. 6).

not found in that reference or, indeed, in either of the other references. Thus, it is inescapable that the combined references applied by the examiner taken as a whole would not have resulted in the claimed method. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-54, 5 USPQ2d 1434, 1438-41 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988). Accordingly, it is manifest that the only direction to appellant's claimed invention as a whole on the record before us is supplied by appellant's own specification. *Fine, supra*; *Dow Chem., supra*.

The examiner's decision is reversed.

*Reversed*

MARC L. CAROFF	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
CHARLES F. WARREN	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
TERRY J. OWENS	)	
Administrative Patent Judge	)	

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