

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN T. HARSHFIELD

Appeal No. 1998-1659
Application No. 08/486,635

ON BRIEF

Before THOMAS, KRASS, and GROSS, Administrative Patent Judges.
GROSS, Administrative Patent Judge.

REQUEST FOR REHEARING

In a decision dated March 13, 2001, the decision of the examiner rejecting claims 1 through 8, 17, and 18 under 35 U.S.C. § 103 was affirmed.

Appellant argues (Request, pages 1-2) that the Board failed to separately address claim 8, though appellant stated in the grouping of the claims that claim 8 was to fall independently from the other claims. However, claim 8 was not argued separately from the other claims as required by 37 CFR

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§ 1.192(c)(7). Appellant merely restated the claim limitation of claim 8, which is insufficient as an argument for separate patentability. As stated in 37 CFR § 1.192(c)(7),

For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable. (Underlining added for emphasis.)

Appellant (Request, pages 2-4) now argues the examiner's treatment of claim 8 in the Answer, though appellant filed a Reply Brief and made no mention of claim 8 therein. Normally we would not consider appellant's attempt to belatedly present new arguments directed to the examiner's rejection of a claim, since a new argument advanced in a request for rehearing, but not advanced in appellant's briefs, is not properly before the Board. See *Ex parte Hindersinn*, 177 USPQ 78, 80 (Bd. App. 1971) wherein the Board held that an argument advanced in the petition as to disclosure relied upon by the examiner and not advanced in the brief or the reply brief constituted a new

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argument to which the examiner had no chance to respond and, therefore, was not properly before the Board. Note also *In re Kroekel*, 803 F.2d 705, 708-09, 231 USPQ 640, 642-43 (Fed. Cir. 1986) and *Cooper v. Goldfarb*, 154 F.3d 1321, 1331, 47 USPQ2d 1896, 1904 (Fed. Cir. 1998) wherein the Court noted that a party cannot wait until after the Board has rendered an adverse decision and then present new arguments in a request for reconsideration. Nonetheless, we will consider appellant's new arguments as to claim 8 as follows.

Appellant contends (Request, page 3) that based on the disclosure at column 3, lines 19-22, Lee teaches that the aperture formed between the spacers would be at least 60 percent of the size of the aperture formed in the dielectric material. However, appellant discusses relative aperture diameters, whereas the claim calls for a relationship between the lateral cross-sectional areas of the apertures. Further, we fail to understand how appellant arrives at 60 percent. On the other hand, we find that Lee suggests the claimed relationship between the lateral cross-sectional areas.

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Specifically, Lee teaches (column 3, lines 1-6) that d , the minimum lithographic dimension, equals 2 microns.

Further, when Lee adds a smoothing layer to reduce the size of the diameter to below d , the slope of the smoothing layer forms an angle θ greater than 20° from the vertical to the substrate (see column 3, lines 7-57, and column 4, lines 21-26). Figure 5 and the adjacent figure illustrate the result.

Here, $d = 2\mu\text{m}$,

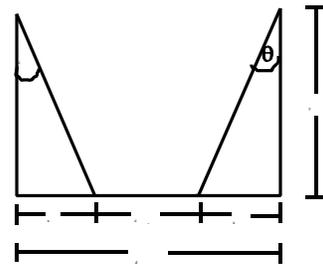
$\theta > 20^\circ$, and $y =$ the thickness of the material, which equals $7000D$ or $0.7\mu\text{m}$

when $d = 2\mu\text{m}$. Thus, $\tan \theta = x/y = [(d-d')/2]/y = [(2-d')/2]/0.7 = (2-d')/1.4$. Since, $\tan 20^\circ = 0.36397$, and tangent increases as the angle increases between 0° and 90° , $(2-d')/1.4 \geq 0.36397$, or $d' \leq 1.49044$. The ratio of the

lateral cross-sectional area for the second aperture (with diameter d') to

that of the first aperture (with diameter d) equals $\frac{B(d'/2)^2}{B(d/2)^2}$, which reduces to $(d')^2/d^2$, which is less than or equal to $(1.49044)^2/2^2$, or

0.5554. In other words, Lee teaches



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that the lateral cross-sectional area for the second aperture should be less than or equal to about 55 percent of the lateral cross-sectional area of the first aperture. Since a range of less than or equal to about 55 percent overlaps the claimed range of less than 50 percent, the teachings of Lee render the claimed range obvious. See *In re Malagari*, 499 F.2d 1297, 1302, 182 USPQ 549, 553 (CCPA 1974). Therefore, our affirmation of the rejection of claim 8 over Buckley in view of Lee and Ovshinsky is proper.

Accordingly, 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.

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

REHEARING
DENIED

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Administrative Patent Judge)	
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)	BOARD OF PATENT
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