

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 CHARLES M. WATKINS

Appeal No. 1998-2260
Application No. 08/535,685

ON BRIEF

Before KRASS, BARRETT and LALL, Administrative Patent Judges.

LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the final rejection of claims 1 to 5 and 14 to 28. Claims 6 to 13 have been canceled.

The invention relates to a method of aligning substrates in a flat panel display. The display is a field emission display (FED) that has a faceplate anode and a cathode with a large number of electron emitting microtips. The invention uses a light beam to align openings in the substrates, rather

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than using alignment marks. The invention is further
illustrated by
claim 1 below.

1. A process for aligning a plurality of substrates in a
flat panel display, the process comprising:

providing an optical path through each substrate of the
flat panel display, wherein alignment of the optical paths
corresponds to a desired alignment of the substrates;

detecting the light exiting the optical path of a second
substrate; and

positioning the substrates of the flat panel display
relative to each other such that the amount of detected light
is optimized.

The Examiner relies on the following reference:

Harvey et al. (Harvey) 4,904,087¹ Feb. 27, 1990

Claims 1 to 5 and 14 to 28 stand rejected under 35

U.S.C.

§ 103 over Harvey.

¹ In the brief and the answer, the patent number was
mistakenly listed as 5,337,151. However, from the context of
the discussions of the text of the patent in the briefs and
the answer, and in the letter acknowledging the reply brief
(paper no. 16), it is clear that Harvey patent was the basis
of the final rejection and the Appellant's arguments. We so
consider it here.

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Rather than repeat the positions and the arguments of Appellant or the Examiner, we make reference to the briefs² and the answer for their respective positions.

² A reply brief was filed as paper no. 15 which was allowed entry by paper no. 16, without any response on merits from the Examiner.

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OPINION

We have considered the rejections advanced by the Examiner. We have, likewise, reviewed Appellant's arguments against the rejection as set forth in the briefs.

It is our view, after consideration of the record before us, that the rejection under 35 U.S.C. § 103 is sustained with respect to claims 1 to 5 and 14 to 17, but not with respect to claims 18 to 28. Accordingly, we affirm-in-part.

Rejection under 35 U.S.C. § 103

In our analysis, we are guided by the general proposition that in an appeal involving a rejection under 35 U.S.C. § 103, an examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788

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(Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). We are further guided by the precedent of our reviewing court that the limitations from the disclosure are not to be imported into the claims. In re Lundberg, 244 F.2d 543, 113 USPQ 530 (CCPA 1957); In re Queener, 796 F.2d 461, 230 USPQ 438 (Fed. Cir. 1986). We also note that the arguments not made separately for any individual claim or claims are considered waived. See 37 CFR § 1.192 (a) and (c). In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) ("It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art."); In re Wiechert, 370 F.2d 927, 936, 152 USPQ 247, 254 (CCPA 1967) ("This court has uniformly followed the sound rule that an issue raised below which is not argued in this court, even if it has been properly brought here by reason of appeal, is regarded as abandoned and will not be considered. It is our function as a court to decide disputed issues, not to create them.").

Analysis

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At the outset, we note the grouping at page 2 of the brief as follows: group one as made of claims 1 to 3, 17 to 19, and 26 to 28 and, group two of claims 4 to 5, 14 to 16, and 20 to 25. However, wherever applicable in our analysis, the merits of the claims will override this grouping. We start in the order of the above grouping.

Claims 1 to 3, 17 to 19, and 26 to 28

Even though Appellant treats these claims as one group and does not argue them individually except for claim 18 which is briefly discussed separately in the brief at page 3, and further in the reply brief at page 2, we discuss the two independent claims of this group, 1 and 18, separately because they contain different limitations. We take claim 1 first. We agree with the Examiner's position [answer, pages 3 to 5] that Harvey shows an apparatus and method of aligning two flat substrates 11 and 12 using an optical beam, and that it would have been obvious at the time of invention for an artisan to adopt this technique to the aligning of the flat panels of a display. Appellant argues that the claimed invention is an application of the technique to a different physical

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application, but we find no criticality in transferring the use of the alignment technique of Harvey to a flat panel display, and Appellant has not shown any such criticality or unobviousness. Therefore, we sustain the obviousness rejection of claim 1 and its dependent grouped claims 2, 3 and 17.

With respect to claim 18, we agree with Appellant [reply brief, page 2] that Harvey does not show or suggest the method of forming a flat display panel which comprises the steps of "forming an optical path through a first substrate . . . , the first substrate being part of one of an anode and a cathode of the display," "forming . . . a second substrate . . . , the second substrate being part of the other of the anode and the cathode of the display," and "sealing together the first and second substrates" The Examiner has not provided any evidence to support obviousness of these steps, and we find none. Therefore, we do not sustain the obviousness rejection of claim 18 and its dependent and grouped claims 19 and 26 to 28.

Claims 4 to 5, 14 to 16, and 20 to 25

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we take claim 4 as the representative of this group. Appellant argues [brief, page 3] that "there is no teaching of forming a metallic film over substrates . . . and then etching back an opening for alignment purposes. Harvey only shows the use of transparent slits and zone plates on the surfaces." However, we find that Harvey teaches that "[t]he transparent slits (openings) . . . can conveniently be made by photolithographic masking and etching simultaneously . . . on photomasks . . ." (col. 3, lines 60 to 64.) Therefore, we sustain the obviousness rejection of claim 4 and its grouped claims 5, and 14 to 16. As for claims 20 to 25 of this group, even though they are grouped with claim 4 and are not argued separately, they depend on independent claim 18, which we have found above to be unobvious. For that reason, we do not sustain the obviousness rejection of claims 20 to 25.

In summary, we have affirmed the Examiner's decision rejecting claims 1 to 5 and 14 to 17 and reversed the decision rejecting claims 18 to 28.

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

AFFIRMED-IN-PART

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS
Administrative Patent Judge)	AND
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PARSHOTAM S. LALL)	
Administrative Patent Judge)	

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WAYNE M. KENNARD
HALE AND DORR
60 STATE STREET
BOSTON, MA 02109