

The opinion in support of the decision being entered today was written for publication and is binding precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TORU CHONAN

Appeal No. 2001-1827
Application No. 08/696,404

Heard: November 7, 2002

Before HAIRSTON, DIXON, and BLANKENSHIP, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 13-17 and 20, which are all of the claims pending in this application.

We AFFIRM.

Appeal No. 2001-1827
Application No. 08/696,404

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 35, mailed Nov. 21, 2000)¹ for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 34, filed Sep. 8, 2000) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations which follow.

At the outset, we note that appellant has elected to group claims 13-17 as standing or falling together and claim 20 as a separate grouping. (See brief at page 12.) Therefore, we elect claim 13 as the representative claim for the first grouping and claim 20 with the second group, and will address appellant's arguments with respect to claims 13 and 20.

"To reject claims in an application under section 103, an examiner must show an un rebutted *prima facie* case of obviousness. **See In re Deuel**, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995). In the absence of a proper *prima facie* case

¹ We note that all of the copies of the answer in the file were missing page 11 of the 12 page answer. The examiner was contacted and a copy of the missing page was obtained, placed in the file and a copy sent to appellant by facsimile prior to the hearing.

Appeal No. 2001-1827
Application No. 08/696,404

of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. **See In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of prima facie obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.” **In re Rouffet**, 149 F.3d 1350, 1355, 47 USPQ2d 1453 (CAFC 1998). Here, we agree with the examiner’s rejection and find that appellant has not overcome the *prima facie* case of obviousness by showing insufficient evidence by the examiner nor have appellants provided sufficient evidence of secondary indicia of nonobviousness which persuade us of the nonobviousness of the claimed invention.

CLAIM 13

Appellant maintains that claim 13 sets forth “a semiconductor circuit having a reference voltage provided at the gate of the first transistor at or near a voltage potential of a first line voltage . . . to maintain the first transistor in a ‘just on’ state.” (See brief at page 13.) Appellant argues that the use of the FET in a just on state creates a current source-drain path connecting the bonding pad to the second line voltage while avoiding subjecting the transistor to operating in a saturation state. This use of a reference voltage generator for that purpose in a function generating circuit has been unknown and reduces the current flow without effect by environmental fluctuations. (See brief at page 13.) We do not find that appellant’s argument is commensurate with the scope of

independent claim 13 since we do not find express support maintaining the transistor in a “just on” state or minimizing the current flow. Therefore, this argument is not persuasive. Appellant argues that the amount of current of the invention is minimized relative to amount of current used in the operation of the admitted prior art. (See brief at page 14.) Again, we do not find clear support in the language of independent claim 13 to support this argument.

Appellant argues that Eaton’s Figure 3 circuit provides a voltage limited to slightly more than one threshold voltage below V_{cc} of Eaton to provide a stable voltage source for use within an IC. Appellant argues that just because Eaton discloses a reference voltage generating circuit does not establish that Eaton suggests maintaining a gate voltage “just on” or “just off” to control saturation issues in gate switching. (See brief at page 14.) Again, we do not find appellant’s argument commensurate with the language of independent claim 13. Therefore, this argument is not persuasive.

Appellant argues that there is no motivation or suggestion in the AAPA and Eaton to provide the claimed invention. (See brief at page 15.) We disagree with appellant. The examiner has provided a line of reasoning for the combination at page 6 of the answer. Appellant argues that Eaton does not disclose “a reference voltage provided at the gate of a first transistor at or near a voltage potential of a first line voltage . . . to maintain the first transistor in a ‘just on’ state”. (Brief at page 15.) As discussed above, we do not find appellant’s argument commensurate in scope with the

express language of independent claim 13. Therefore, this argument is not persuasive. The examiner relies upon the teachings of Eaton at column 1, lines 6-12, which teaches that the reference generator is independent of fluctuations in operating voltage and other parameters. We agree with the examiner that having a reference voltage source independent of fluctuations would have been desirable motivation for combining the teachings of Eaton with the admitted prior art which uses both a reference voltage at ground (element 3 in Figure 1) and a voltage V_{DD} (element 2 in Figure 2). Appellant argues that one seeking to reduce current consumption would not combine the teachings since Eaton and the AAPA have distinct unrelated functions. (See brief at page 15.) We disagree with appellant's conclusion. Appellant has not shown any error in the motivation set forth by the examiner. Appellant argues that the examiner has not established why it would have been obvious to one of ordinary skill in the art to select and combine the teachings of the AAPA and Eaton. (See brief at pages 17-18.) We disagree with appellant. We find that the examiner has provided a line of reasoning for selecting and combining the teachings which appellant has not persuasively rebutted or shown error therein. Appellant argues that the examiner has relied upon impermissible hindsight to reject claims 13-17 and 20. We disagree with appellant.

Appellant argues that the combination of teachings of the AAPA and Eaton does not teach the "just on" and "just off" to control saturation along with seeking to reduce the current consumption. (See brief at page 19.) As discussed above, we do not find

Appeal No. 2001-1827
Application No. 08/696,404

appellant's arguments commensurate in scope with the express language of independent claim 13. Therefore, these arguments are not persuasive, and we will sustain the rejection of independent claim 13 and its dependent claims 14-17 which have been grouped therewith by appellant. Also, since appellant has not provided separate arguments for the patentability of dependent claim 20, beyond merely paraphrasing the language of the claim at page 14 of the brief, we will similarly group claim 20 as falling with independent claim 13.

CONCLUSION

To summarize, the decision of the examiner to reject claims 13-17 and 20 under 35 U.S.C. § 103 is affirmed.

Appeal No. 2001-1827
Application No. 08/696,404

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

AFFIRMED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JOSEPH L. DIXON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
HOWARD B. BLANKENSHIP)	
Administrative Patent Judge)	

JD/RWK

Appeal No. 2001-1827
Application No. 08/696,404

SCULLY SCOTT MURPHY & PRESSER, PC
400 GARDEN CITY PLAZA
GARDEN CITY, NY 11530