

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOHN G. MCBRIDE

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Appeal No. 2004-0040  
Application No. 09/273,820

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ON BRIEF

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Before THOMAS, BARRY, and SAADAT, Administrative Patent Judges.  
THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 1 through 3, 7, 9, 10 and 15 through 18. The examiner has indicated the allowability of claims 11 through 14 and has objected to claims 4 through 6, 8 and 19 through 22.



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To properly construe the subject matter of the testing performed in the body of representative claim 1, as well as its corresponding independent system claim 15, the design tests of the preamble are properly referred to by the testing functions in the body of the claim as well as the context of the overall claim being performing design tests in a circuit design environment, a feature also present in the preamble. In contrast to the first and second files requiring only "at least one" test, the exclusion function at the end of claim 1 on appeal appears to indicate that plural tests are found within each of these first and second files.

In affirming the rejection set forth by the examiner, we do not agree with appellant's basic assertion repeated in the brief and reply brief that Van Huben fails to disclose at least two separate files, each of which stores a list of plural tests to be excluded. This appears to be the principal argument of appellant in the brief and reply brief. The examiner's initial reliance upon the library process including physical design checks on a circuit design, such as the discussion at column 104 in Van Huben, is consistent with the showing in figure 9 of various test vectors existing within the environment of Van Huben's overall design control system. It is clear initially from the abstract

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that various databases, files and relational objects of data in some fashion are encompassed within the teachings of the bulk of this reference. Thus, it is clear to us and the artisan that Van Huben encompasses plural physical design checks and/or test vectors that are selectively chosen to be performed on circuits as set forth at lines 1 through 3 of column 104.

Significant teachings of column 110 beginning at line 31 had been outlined by the examiner in the answer. The teachings there make clear that the Process/Data Manager has the capability of selectively exempting from processing a file or group of files and that selected files are individually marked or markable by the file exception utility by the user in accordance with the showing in figure 84. The examiner correctly relies upon the following teaching at the bottom of column 110 at lines 58 through 63:

The user selects the processes that are to be exempt for the selected files. The Control Repository process tables are updated to list the excepted files. Each time the Process Manager invokes a process it compares the exception list to the files being processed. If there's a match, the file is excluded from the processing list.

Taken together with the teachings of column 104 relied upon by the examiner, as essentially argued by the examiner in the answer, the terms files or group of files are properly

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interpreted by the artisan as including plural design checks or plural design/test vectors as we outlined earlier. Thus, the capability is fairly taught when the teachings of columns 110 and 104 are construed together that plural checks per file are capable of being selectively chosen by the user, even to the point of selecting plural such files as well. These include the first and second files of independent claims 1 and 15 on appeal as well as the third listed file in dependent claim 7. Each is permissibly excluded at the option of the user. In our view, the artisan is fairly taught that each of the respective files may comprise one or more tests at least to the extent claimed in independent claims 1 and 15 on appeal. We are therefore unpersuaded by appellant's arguments in the brief and reply brief as to these claims.

With respect to dependent claim 2 argued at page 14 of the principal Brief on appeal, we are not persuaded that the reference does not fairly teach the artisan within 35 U.S.C. § 102 that exclusion of all tests are identified in the first or second files. Column 110, lines 58 and 59 clearly indicate that the "user selects the processes that are to be exempt for the

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selected files." The user is clearly given the option to selectively choose the files and the contents within the files to be deleted to include all of the individual test vectors or processes or physical design checks that may be encompassed within a given file.

As to dependent claim 3, the examiner's reliance upon the portion of column 110 that we quoted earlier clearly indicates that the Process/Data Manager keeps track of the files that are being processed or executed, at least to the extent recited in claim 3 on appeal. The substance of the features of claim 7 have already been addressed in our earlier discussion. Thus, we are not persuaded by appellant's arguments at pages 17 and 18 of the brief as to this claim.

As to dependent 10, we are persuaded by the examiner's rationale initially expressed at page 4 of the answer, which is expanded upon slightly at pages 7 and 8 of the answer. As compared to non argued claim 9, claim 10 requires that directory locations of the respective first and second files be located at different directory locations. As well argued by the examiner in the noted portions in the examiner's answer, the artisan would

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not expect any given "directory location" comprise both first and second files. Even if the claimed files are located within the same directory, they would not be located in the same directory location. Clearly, the teaching value of Van Huben and what the artisan knows as normal in operating systems generally, even separate directories would encompass the ability to store first and second files in separate locations. Appellant's arguments do not dispute the examiner's reliance on the Microsoft Computer Dictionary, third edition, at page 148, which is clearly a standard reference work; the examiner is free to rely upon this dictionary to expand upon the teachings of files and terms already resident within Van Huben itself. We are therefore not persuaded by appellant's arguments at pages 18 through 20 of the brief as to claim 10 on appeal.

Turning lastly to the subject matter of independent claim 15, in addition to our previous remarks with respect to our consideration of the features of independent claims 1 and 15 on appeal together, we note appellant's argument that claim 15 recites a "means for executing" feature therefore invoking the sixth paragraph of 35 U.S.C. § 112. The argument at page 21 of the brief urging that this feature be narrowly construed is

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noted. However, the persuasiveness of the position is severely weakened because appellant has not set forth any corresponding structure in the specification as filed from which corresponding structure may be ascertained by us and the examiner that would not be in the reference. It appears that appellant's claimed means for executing is encompassed within the broadly defined computer program labeled Electrical Rule Checker 100 in the various figures, which is clearly comparable to the broadly defined design control system and the Data/Processor Manager as argued by the examiner in the answer within Van Huben. The first and second storage locations of claim 15 have been addressed in our most recent discussion of dependent claim 10. Since appellant's grouping of claim 15 within group VI includes arguments presented only as to claim 15 and not directed to claims 16, 17 and 18, we sustain the rejection of these dependent claims as well.

In briefly considering the responses and the arguments in the reply brief, appellant's positions here are substantially, briefly repetitive to those we have already considered with respect to the features argued in general positions in the principal brief on appeal. We do not regard the examiner's

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interpretations of Van Huben as being misplaced, and the examiner is free to utilize multiple or the same systems teachings in a reference for more than one claimed feature. Essentially, we agree with the examiner's reliance upon the teachings identified in the answer, which we have embellished upon slightly by our own consideration of the teachings of the reference, to place the artisan within possession of the subject matter of the claims rejected within 35 U.S.C. § 102. The examiner is free to be persistent in reliance upon any given portion or portions of a reference notwithstanding appellant's arguments to the contrary.

In view of the foregoing, the decision of the examiner rejecting all claims on appeal 35 U.S.C. § 102 is affirmed.

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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).

AFFIRMED

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
LANCE LEONARD BARRY	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
	)	
	)	
MAHSHID D. SAADAT	)	
Administrative Patent Judge	)	

JDT/vsh

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