

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** STEVEN R. ROBINSON and WILLIAM A. CHREN

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Appeal No. 2004-1402  
Application No. 09/383,478

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ON BRIEF

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Before DIXON, GROSS, and NAPPI, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1-9 and 28-39, which are all of the claims pending in this application.

We REVERSE.



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answer (Paper No. 14, mailed Nov. 24, 2003) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 13, filed Oct. 27, 2003) and reply brief (Paper No. 15, filed Feb. 2, 2004) for appellants' arguments thereagainst.

### OPINION

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

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the

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claimed subject matter is ***prima facie*** obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in

the prior art or that knowledge generally available to one of ordinary skill in art would lead that individual to combine the relevant teachings of the references." **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) .

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations set forth in independent claim 1. The examiner acknowledges that the AAPA lacks "a dynamic storage unit coupled to the barrel shifter, the dynamic storage unit storing the output of the barrel shifter," but the examiner maintains that the teaching of the basic structure of a dynamic storage unit as taught by Ishibashi alone would have suggested the use of dynamic latches/storage to one skilled in the art, having the

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knowledge that dynamic latches are “smaller, faster and more energy efficient than a static latch.” (See answer at page 3-4.) We disagree with the examiner’s conclusion and find that the examiner’s conclusion is not well based in the teachings of the applied prior art and not supported by evidence in the record.

Appellants argue throughout both the brief and reply brief that the combination of the two references would not have suggested an RNS adder having “a dynamic storage unit coupled to the barrel shifter, the dynamic storage unit storing the output of the [modulo  $m_i$ ] barrel shifter.” We agree with appellants that the teachings of Ishibashi with respect to the basic structure of a dynamic latch would not have suggested the substitution of a dynamic latch for any static latch as taught in the adder in the AAPA. (See also reply brief at page 5 for disadvantages of dynamic storage units.) Appellants argue that the examiner’s rejection is also based upon hindsight reconstruction of the claimed invention. (See reply brief at page 4.) We agree with appellants since we find no evidence in the record to suggest the examiner’s combination of references. Therefore, we cannot sustain the examiner’s rejection of independent claims 1 and 31 and their dependent claims.

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**CONCLUSION**

To summarize, the decision of the examiner to reject claims 1-9 and 28-39 under 35 U.S.C. § 103 is reversed.

**REVERSED**

JOSEPH L. DIXON	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
ANITA PELLMAN GROSS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
ROBERT E. NAPPI	)	
Administrative Patent Judge	)	

JLD:clm

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