

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TORSTEN SCHERF,
LOTHAR VOGT and UDO KLAAS

Appeal No. 2006-0007
Application No. 09/601,715

ON BRIEF

Before THOMAS, OWENS, and LEVY, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from a rejection of claims 12-21, which are all of the pending claims.

THE INVENTION

The appellants claim methods for activating at least one function of an electrical device based on control commands predefined in a test routine. Claims 15 and 18 are illustrative:

15. A method for activating at least one function of an electrical device, comprising the steps of:

causing a control unit of the electrical device to execute a test routine stored in a storage area allocated to the electrical device;

causing the control unit to activate the at least one function on the basis of control commands predefined in the test routine; and

reproducing information about an operation of the activated at least one function on a reproducing device of the electrical device;

wherein a sequence of the test routine executed by the control unit varies as a function of a manipulation of at least one operating control element of an operator unit of the electrical device.

18. A method for activating at least one function of an electrical device, comprising the steps of:

causing a control unit of the electrical device to execute a test routine stored in a storage area allocated to the electrical device;

causing the control unit to activate the at least one function on the basis of control commands predefined in the test routine;

reproducing information about an operation of the activated at least one function on a reproducing device of the electrical device; and

causing the control unit to invoke test signals for functional settings of the electrical device stored in the storage area as a function of the test routine.

THE REFERENCES

Mitchell et al. (Mitchell)	5,365,438	Nov. 15, 1994
Klappert et al. (Klappert)	5,602,815	Feb. 11, 1997
Symanow et al. (Symanow)	5,999,104	Dec. 7, 1999 (filed Dec. 3, 1997)
Obradovich et al. (Obradovich)	6,009,355	Dec. 28, 1999 (filed Jan. 28, 1997)
Medd et al. (Medd)	6,029,262	Feb. 22, 2000 (filed Nov. 25, 1997)

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 12, 14-17, 19 and 20 over Obradovich in view of Mitchell and Medd; claim 13 over Obradovich in view

of Mitchell, Medd and Symanow; claim 18 over Obradovich in view of Mitchell; and
claim 21 over Obradovich in view of Mitchell, Medd and Klappert.

OPINION

The rejections are affirmed as to claim 18 and reversed as to claims 12-17 and
19-21.

Claim 18

Obradovich discloses an information and control system (100) which provides a user with automobile operation instructions, maintenance procedures, safety measures and general information, and permits the user to program or adjust different vehicle parts and accessories (col. 4, line 61 - col. 5, line 48). The system performs a self test on power up or at the user's request wherein each interface in the system is polled, performs an active self test, and reports the test results to an interface (114) where the results are gathered and caused to be displayed on an interface (102a) (col. 10, lines 35-42).

The appellants argue that the applied prior art does not disclose causing a control unit to invoke, as a function of a test routine, test signals for functional settings of an electrical device stored in a storage area allocated to the electrical device (brief, pages 16-17).

The appellants' storage device can be inside or outside the electrical device (specification, page 4, line 21 - page 5, line 1). Obradovich's input/output control logic

for performing the self test (col. 10, lines 35-37) necessarily must be stored in such a storage device.

The appellants argue that the only reasonable way to interpret claim 18 consistent with the specification is that the claim requires that the test routine is an internal test operation performed by the electrical device (reply brief, pages 3 and 6).

During patent prosecution, claims are to be given their broadest reasonable interpretation consistent with the specification, as the claim language would have been read by one of ordinary skill in the art in view of the specification. See *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); *In re Herz*, 537 F.2d 549, 551, 190 USPQ 461, 463 (CCPA 1976); *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976). Limitations, however, are not to be read from the specification into the claims. See *In re Prater*, 415 F.2d 1393, 1405, 162 USPQ 541, 551 (CCPA 1969).

Claim 18 does not require that the test is an internal test operation by the electrical device but, rather, requires that a control unit of the electrical device is caused to execute a test routine and to invoke test signals for functional settings of the electrical device. Furthermore, the appellants' specification

does not limit the test to such an internal test. Hence, the appellants are improperly reading the internal test limitation into the claim. Because Obradovich's self test is a test of each interface of the electrical device performed through the electrical unit's self-test interface (114), it necessarily is performed by a control unit of the electrical device which invokes test signals for functional settings of the electrical device.

For the above reasons we are not convinced of reversible error in the examiner's rejection of claim 18.

Claims 12-17 and 19-21

Claim 15, which is the only independent claim among claims 12-17 and 19-21, requires that a sequence of a test routine executed by a control unit of an electrical device varies as a function of a manipulation of at least one operating control element of an operator unit of the electrical device. For a suggestion of this limitation the examiner relies upon Medd's abstract and column 2, line 32 to column 3, line 26 (answer, pages 4 and 9).

The relevant portion of the relied-upon portion of Medd is included in the following disclosure:

[T]he present invention is a technique for automatically preparing a test program such as for a memory integrated circuit (IC) in which graphic indications of the logic states for a set of test signals over a series of cycles are combined with graphic indications of test cycle repetition parameters. After the graphic indication of the test signal states and repetition parameters are prepared, detailed instructions for IC test equipment are then automatically generated by a compiler program that interprets a data structure representing the graphic indications of the test cycle repetition parameters to produce tester microcode and other test parameters. As a result, a test engineer need not create a computer program in order to prepare a test specification for a device such as a memory IC which includes cycle repetitions. [col. 2, lines 32-45]

* * *

The user of the system may change the parameters of the test sequence by using a graphic input device such as a mouse to change the length and position of the arrow on the graphic display. [col. 2, lines 51-55]

* * *

A default specification may be provided in which test signals such as address signals are automatically cycled through all possible states during iteration of the specified test cycles so that all storage locations in the memory device are tested. Alternatively the user may specify a number of iterations to be performed and/or patterns of addresses and/or data signals to be applied to the device for each iteration. [col. 2, lines 58-65]

The examiner argues that "[a]lthough the test unit taught by Medd is external, the test unit is used to modify testing of an electrical device and is therefore an operating control element

of the operator unit of the electrical device because it controls testing of the device" (answer, page 9). The examiner has not established that Medd's external test program, even if it controls testing of an electrical device, reasonably can be considered to be an element of an operator unit of the electrical device.

We therefore conclude that the examiner has not carried the burden of establishing a *prima facie* case of obviousness of the invention claimed in the appellants' claims 12-17 and 19-21.¹

DECISION

The rejection under 35 U.S.C. § 103 of claim 18 over Obradovich in view of Mitchell is affirmed. The rejections under 35 U.S.C. § 103 of claims 12, 14-17, 19 and 20 over Obradovich in view of Mitchell and Medd, claim 13 over Obradovich in view of Mitchell, Medd and Symanow, and claim 21 over Obradovich in view of Mitchell, Medd and Klappert, are reversed.

¹ The examiner does not rely upon Symanow or Klappert for any disclosure that remedies the above-discussed deficiency in Obradovich.

Appeal No. 2006-0007
Application No. 09/601,715

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

AFFIRMED-IN-PART

JAMES D. THOMAS)
Administrative Patent Judge)
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TERRY J. OWENS) BOARD OF PATENT
Administrative Patent Judge) APPEALS
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