

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2006-2461
Application No. 09/991,020

ON BRIEF

Before KRASS, JERRY SMITH, and BLANKENSHIP Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-24, which constitute all the claims pending in this application.

The disclosed invention pertains to an electronic test program for testing a device. Specifically, the test program allows the user to select a set of specifications that define a particular test. The selected set of specifications is

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs¹ and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the disclosure of Akasheh fully meets the invention as set forth in claims 1-19 and 21-24. We further conclude that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claim 20. Accordingly, we affirm.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing

¹ An appeal brief was initially filed on Apr. 25, 2005. In response to a Notice of Non-Compliant Appeal Brief, appellant filed a corrected appeal brief on Jul. 15, 2005. An examiner's answer was then filed on Sept. 29, 2005, and a reply brief was filed on Dec. 1, 2005. The Board, however, returned the case to the examiner on Apr. 11, 2006 for consideration of an Information Disclosure Statement and revision of the answer to correct certain formalities. In response, the examiner submitted a revised examiner's answer on Apr. 19, 2006. Appellant then filed a supplemental reply brief on Jun. 13, 2006. Throughout this opinion, we refer to (1) the corrected appeal brief filed Jul. 15, 2005 (hereafter "brief"), (2) the revised examiner's answer filed Apr. 19, 2006 (hereafter "answer"), and (3) the supplemental reply brief filed Jun. 13, 2006 (hereafter "reply brief").

the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the briefs have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

The examiner has indicated how the claimed invention is deemed to be fully met by the disclosure of Akasheh [answer, pages 3-10]. Regarding independent claims 1, 8, and 21, appellant argues that Akasheh does not disclose receiving a selected one of a plurality of previously created alternative specifications for assessing a datapoint generated by a test, wherein each of the plurality of alternative specifications is a different specification for assessing the datapoint as claimed [brief, page 7; reply brief, page 2]. Specifically, appellant argues that Akasheh does not indicate alternative specifications, but rather indicates only one associated specification for each of multiple parameters [brief, page 8; reply brief, page 3]. In this regard, appellant notes that the user employs the tolerance manager to set the tolerance condition for a given parameter of interest, and then applies that condition to the test to be conducted [answer, pages 7 and 8; reply brief, pages 2 and 3].

The examiner responds that multiple previously created alternative specifications are provided when the user sets the voltage parameter in

Akashch's Instrument Interface Module (IIM) setup window in Fig. 3c [answer, page 12]. The examiner further contends, among other things, that the voltage value that the user sets constitutes a selected one of a plurality of created alternative specifications as claimed [id.].

Appellant responds that the term "specification" as used in the present application means "the acceptable limits or tolerance against which the result of a measurement is to be judged" [reply brief, page 4]. With this construction, appellant argues that Akashch does not disclose a specification of limits of acceptability of a measurement result. Rather, Akashch discloses that the script transmitted to the instrument contains the voltage to which the instrument output is to be set [reply brief, page 5].

We will sustain the examiner's anticipation rejection of independent claims 1, 8, 16, and 21. Although we find the examiner's reliance on the IIM setup window in Fig. 3c problematic essentially for the reasons noted by appellant, we nevertheless conclude that Akashch fully meets all claimed limitations.

Akashch discloses a computer based test operating system that tests a unit under test (UUT) 114 with a number of different test instruments 112. An advantage of Akashch's system is that it obviates the need to rewrite the test program each time a test instrument is replaced. To this end, IIM acts as a layer between the test program and instruments by translating inputs to the instruments from the language used by the test program into a language or script understandable by the new instrument [Akashch, col. 2, lines 22-40].

The system further comprises tolerance manager 107 that defines tolerance data and checks the measurement with the predefined tolerance data [Akasheh, col. 3, lines 39-41]. Specifically, the tolerance manager allows the user to select tolerance criteria to be used to test UUTs with various instruments [Akasheh, col. 7, lines 18-21].

The setup mode of the tolerance manager includes a set tolerance window 800 that enables the user to specify the desired tolerance parameters [Akasheh, Fig. 8; col. 13, lines 52-57]. As shown in Fig. 8, the user can enter a desired nominal value (e.g., "3.00") for a given parameter (e.g., volts). Significantly, the user can also select a desired operator (" $<$ ", " $<=$ ", " $>$ ", " $>=$ ", " $==$ ", or " $|=$ ") from a menu of operators that specifies the type of comparison between the returned reading and the nominal value [Akasheh, col. 13, lines 58-67; Fig. 8]. For example, the checkmark adjacent the " $<$ " (less than) symbol indicates that the user selected that option for the comparison [see Akasheh, col. 13, lines 65-67; Fig. 8].

We find this user-selectable operator in the tolerance manager fully meets the limitation calling for "a selected one of a plurality of previously created alternative specifications for assessing a datapoint generated by a test" as claimed. That is, each respective operator (" $<$ ", " $<=$ ", " $>$ ", " $>=$ ", " $==$ ", or " $|=$ ") dictates the type of comparison that constitutes a "previously created alternative specification." The user selects one such "specification" to specify the type of comparison -- and ultimately the pass or fail criteria -- for a particular test. Even

with the same nominal value, selecting a different operator (e.g., selecting “>” instead of “<”) could drastically change the assessment of the acquired data generated by the test. Moreover, our interpretation fully comports with appellant’s definition of “specification”: the respective operators dictate “the acceptable limits or tolerance against which the result of a measurement is to be judged.”²

Because Akasheh discloses all claimed limitations of independent claims 1, 8, 16, and 21, the examiner’s anticipation rejection of those claims is therefore sustained.

Akasheh anticipates the dependent claims as well. Regarding claims 2, 3, 9, 10, 15, and 22, selecting and activating the menu of operators from the tolerance manager screen in Fig. 8 of Akasheh fully meets receiving a request for a display of the plurality of available specifications wherein the request comprises the selection of an option of a displayed menu as claimed. Regarding claims 4, 5, 11, 12, and 17-19, the menu of operators corresponds to the plurality of specifications displayed on a menu as discussed previously. Claims 7, 14, and 24 are also fully met by Akasheh since the instructions for determining the plurality of specifications available (i.e., the available operators in the tolerance manager in Fig. 8) comprises instructions for directing the processing unit to determine the test applied to the device since each operator ultimately represents a different test. Even with user intervention, the processing unit will

² See reply brief, page 4.

ultimately determine the test once the user selects the desired operator.

Therefore, because Akasheh discloses all claimed limitations of dependent claims 2, 3, 9, 10, 12, 15, and 22, the examiner's anticipation rejection of those claims is likewise sustained.

Regarding claims 6, 13, and 23, the examiner indicates that Akasheh discloses a process or instructions invoked by the test procedure editor (TPE) that direct the processing unit to determine the UUT being tested [answer, pages 6 and 15]. The examiner notes that if multiple UUTs exist, the user is instructed to select a UUT. However, if there is only one UUT, it is automatically selected [answer, pages 6 and 16]. Appellant responds that Akasheh refers to a user making a selection – not directing a processing unit to determine the device being tested.

We will sustain the examiner's rejection of claims 6, 13, and 23. The scope and breadth of the claim language fully reads on Akasheh's automatic selection of the UUT when only one UUT is defined [see Akasheh, col. 16, lines 38-40]. Although the user is prompted to select a UUT from multiple UUTs, the system's automatic selection of a single UUT nonetheless constitutes instructions for directing the processing unit to determine the device being tested (i.e., the single device) as claimed.

Moreover, even the act of prompting the user to select a UUT reasonably constitutes instructions for directing the processing unit to determine the device being tested. Even with user intervention, the processing unit will ultimately

determine the device being tested (i.e., the user-selected device). Because Akasheh discloses all claimed limitations, the examiner's anticipation rejection of claims 6, 13, and 23 is therefore sustained.

We next consider the rejection of claim 20 under 35 U.S.C. § 103(a) as being unpatentable over Akasheh in view of appellant's admitted prior art. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 277 F.3d at 1343, 61 USPQ2d at 1433-34. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's

conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000). See also In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden 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 Id.; 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 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's rejection essentially finds that Akasheh discloses all of the claimed subject matter except for an environmental test [answer, page 11]. The examiner then refers to appellant's own specification that admits that such

environmental tests that expose devices under test to various temperature, pressure, and humidity conditions are known in the art [id.]. The examiner then concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to include an environmental test to determine whether the device met or exceeded certain environmental tolerances in addition to operational tolerances [id.].

We will sustain the examiner's rejection of claim 20. We find that (1) the examiner has established at least a prima facie case of obviousness, and (2) appellant has not persuasively rebutted the examiner's prima facie case. In this regard, appellant merely notes that the addition of the admitted prior art fails to cure the deficiencies of Akasheh in connection with independent claim 16 [brief, page 16; reply brief, page 15]. Appellant adds that the alleged admitted prior art fails to disclose or imply an environmental test [id.]. But such a mere conclusory statement without supporting analysis or evidence hardly rebuts the examiner's prima facie case – a position that we find reasonable. The rejection of claim 20 is therefore sustained.

In summary, we have sustained the examiner's rejection with respect to all claims on appeal. Therefore, the decision of the examiner rejecting claims 1-24 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

ERROL A. KRASS)	
Administrative Patent Judge)	
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JERRY SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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