UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOACHIM GERHARD CLABES, MICHAEL STEPHEN FLOYD,
PAUL DAVID MUENCH, and LAWRENCE JOSEPH POWELL

Appeal 2007-4340
Application 10/366,437
Technology Center 2100

Decided: June 30, 2008

Before JOSEPH L. DIXON, JAY P. LUCAS, and STEPHEN C. SIU, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-5, 9-13, and 16-18. We have jurisdiction under 35 U.S.C. § 6(b).

BACKGROUND

Appellants' invention relates to a thermally aware integrated circuit. (Spec. 1). An understanding of the invention can be derived from a reading of exemplary claims 13 and 17, which are reproduced below.

> 13. An integrated circuit, comprising:
>
> a temperature sensing circuit configured to generate a signal indicative of a substrate temperature in proximity to the sensing circuit;
>
> means for determining a temperature associated with the sensing circuit signal; and
>
> comparison means to compare the determined temperature to a threshold temperature and to assert a signal based on the comparison;
>
> wherein the temperature sensing circuit [(TSC)] produces a signal having a temperature dependent frequency and wherein the temperature determining means is configured to compare the TSC signal frequency to a signal having a temperature invariant frequency
>
> wherein the temperature determining means includes means for counting the number TSC signal cycles that occur during a specified number of cycles of the temperature invariant signal.

> 17. An integrated circuit, comprising:
>
> a temperature sensing circuit configured to generate a signal indicative of the integrated circuit's temperature in proximity to the sensing circuit; and
>
> comparison circuitry configured to assert a corrective action signal responsive to the sensed integrated circuit temperature exceeding a specified threshold;

wherein the temperature sensing circuit comprises an oscillating circuit producing a signal having a temperature dependent frequency;

wherein the comparison circuitry includes means for comparing the frequency of the sensing circuit signal to a signal having a temperature stable frequency by counting the number of sensing circuit signal cycles that occur during a specified number of cycles of the temperature stable signal.

PRIOR ART APPLIED

Kikinis	US 5,502,838	Mar. 26, 1996
Rusu	US 2004/0037346 A1	Feb. 26, 2004

REJECTIONS

Claims 1, 3, and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kikinis.

Claims 2, 4-5, 13, and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis and further in view of Rusu.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and Appellants regarding the above-noted rejection, we make reference to the Examiner's Answer (mailed Nov. 14, 2006) for the reasoning in support of the rejections, and to Appellants' Brief (filed May 30, 2006) for the 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 that follow.

With respect to Appellants' Brief, we note that Appellants' Brief merely provides a Summary of the Claimed Invention with respect to independent claims 1 and 17. Appellants do not provide a summary of independent claim 13 as required by 37 C.F.R. § 41.37(c)(1)(v) which requires a concise explanation of the subject matter defined in each of the independent claims involved in the appeal. Furthermore, Appellants have not identified the corresponding structure, acts, or materials as described in the Specification corresponding to each of the claimed functions in independent claim 13.

While it may not appear at first to be significant, Appellants have elected to group independent claim 13 with independent claim 17 as addressed in the Brief at pages 5 and 6-7. Therefore, the Board may select independent claim 13 as the representative claim in this grouping. This selection may obviate Appellants' distinction between the two different embodiments as discussed at page 2 of the Brief.

Additionally, Appellants have not clearly identified the corresponding structure, acts, or materials for the "means for comparing the frequency" as recited in independent claim 17.

LEGAL PRINCIPLES

When the Appellants filed the Brief on Appeal, such a brief was required to include "[a] concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by

reference characters." 37 C.F.R. § 41.37(c)(1)(v)(2005). "[R]eference to page and line number of the specification . . . is [always] considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application." M.P.E.P. § 1206 (8th ed., 3d, rev., Aug. 2005).

ANALYSIS

Here, independent claim 13 recites in pertinent part various means plus function limitations and independent claim 17 recites a "means for comparing." Because the Appellant's *Summary of the Claimed Subject Matter* fails to mention all the means, it fails to explain the subject matter defined in the independent claim. Although the *Summary* cites to a few reference characters, moreover, it does not refer to the Appellants' Specification by page and line number for each of the recited elements in each independent claim and identify the correspondence for the functional limitations under 35 U.S.C. § 112, sixth paragraph.

We decline to substitute our speculation for the greater certainty that should come from the Appellants summarizing claim 13. Because Appellants include the patentability of claim 13 in the grouping with independent claim 17, a specific summary thereof is especially important. Additionally, Appellants should identify if any subject matter has been expressly excluded in the interpretation of the functional language. We likewise decline to substitute our speculation for the greater certainty that should come from the Appellants referring to pages and line numbers of the Specification that describe the subject matter of claims 13 and 17.

Any additional Brief submitted by the Appellants should be self-contained with respect to all arguments. No prior Brief should be referenced

or incorporated therein. Furthermore, any Answer submitted by the Examiner should be self-contained with respect to all rejections and arguments; no prior Answer or Office action should be referenced or incorporated therein. If the Examiner deems it appropriate to modify the rejection in light of the properly construed claim limitations, a supplemental Examiner's Answer would be required.

CONCLUSION

Under 37 C.F.R. § 41.50(d), we give the Appellants a non-extendable time period of thirty days within which to respond to this order. Failure to comply with the order within that time may result in the *sua sponte* dismissal of his appeal. 37 C.F.R. § 41.50(d). No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

ORDERED; 37 C.F.R. § 41.50(d)

tdl/ce

IBM AUSTIN (ANTHONY ENGLAND)
C/O LAW OFFICE OF ANTHONY ENGLAND
PO BOX 5307
AUSTIN, TX 78763-5307