

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: September 16, 2008

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

DIXON, *Administrative Patent Judge.*

REMAND TO THE EXAMINER

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 1 and 17, which are reproduced below.

1. An integrated circuit, comprising:

a temperature sensing circuit (TSC) for producing a signal having a temperature varying characteristic wherein the characteristic is indicative of the temperature of a substrate in which the sensing circuit is located;

a temperature cell to receive the TSC signal, measure the temperature varying characteristic of the TSC signal, and produce an output signal indicative thereof; and

a control circuit configured to receive the temperature cell output signal and to control a corrective action signal based on a comparison between a temperature corresponding to the temperature cell output signal and a predetermined temperature threshold

further comprising multiple TSCs connected to a temperature cell wherein each TSC provides a corresponding TSC output signal to the temperature cell;

wherein each TSC output signal is indicative of the temperature associated with the corresponding TSC;

wherein temperature cell is configured to generate a temperature cell output signal, wherein the temperature cell output signal is a serial signal wherein each of the TSC output signals comprises a respective time slice of the serial 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' Substitute Brief (filed Jul. 29, 2008) for the arguments thereagainst.

OPINION

As a consequence of our review, we determine that the case must be remanded to the Examiner for the following reasons.

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. We note that various citations in the originally filed Brief, and the Substitute Brief including the Claims Appendix, and the Request for Action at page 11 of the Substitute Appeal Brief still mention independent claim 13 which Appellants have clearly identified as not being appealed. Appellants clarify in the Substitute Appeal Brief, filed July 29, 2008, at page 1 that independent claim 13 is not being appealed. To obviate any further confusion, we remand the case to the Examiner to cancel non-appealed independent claim 13 pursuant to 37 C.F.R. 41.33(b)(1) (2007), MPEP 1215.03 (8th ed. Rev. 6, Sept. 2007), and *Ex parte Ghuman*, <http://www.uspto.gov/web/offices/dcom/bpai/prec/rm081175.pdf>

Additionally, we note again that Appellants' Substitute Appeal Brief does not clearly identify the corresponding structure, acts, or materials for the "means for comparing the frequency" as recited in independent claim 17. The Summary of the Claimed Invention at page 6 of the Substitute Brief identifies the two signals circuits which produce the signals to be compared, but the Brief does not identify the structure, acts, or materials that perform the "comparing" function. Specifically, lines 20-22 of page 5 of the Specification recites that "[t]hermal control unit **120**, as described in greater detail below, likely includes circuitry that enables the unit to compare

temperature information to predetermined and typically programmable temperature thresholds.” [Emphasis added.] While the cited portions of the Specification say that a comparison is performed, we find Appellants’ relied upon text to not show any corresponding structure on the “integrated circuit” to carryout the recited function.

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).

MPEP 1215.03 Partial Withdrawal [R-3]

A withdrawal of the appeal as to some of the claims on appeal operates as an authorization to cancel those claims from the application or reexamination proceeding and the appeal continues as to the remaining claims. The withdrawn claims will be canceled from an application by direction of the examiner at the time of the withdrawal of the appeal as to those claims. Examiner may use the following form paragraph to cancel the claims that are withdrawn from appeal at the time of the withdrawal:

ANALYSIS

Here, independent claim 17 recites a “means for comparing.” Although the *Summary* cites to a few reference characters and pages and line

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numbers, it does not specifically identify the correspondence for the functional limitation under 35 U.S.C. § 112, sixth paragraph.

We 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 independent claim 17.

CONCLUSION

Under 37 C.F.R. § 41.50(a), we remand this application to the Examiner to cancel independent claim 13 pursuant to 37 C.F.R. § 41.33(b)(1) (2007), MPEP § 1215.03 (8th ed. Rev. 6, Sept. 2007), and *Ex parte Ghuman*,

<http://www.uspto.gov/web/offices/dcom/bpai/prec/rm081175.pdf>
and to take any other action deemed necessary.

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

REMANDED; 37 C.F.R. § 41.50(a)

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