

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL KIMELMAN and IAN FIELD

Appeal 2008-1661
Application 10/417,335
Technology Center 2100

Decided: May 29, 2008

Before JAMES D. THOMAS, ALLEN R. MACDONALD
and ST. JOHN COURTENAY III, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1 through 4, 6 through 17, and 19 through 26, the Examiner having objected to claims 5 and 18. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing was conducted on this appeal on May 22, 2008.

As best representative of the disclosed and claimed invention, independent claim 1 is reproduced below:

1. An integrated circuit comprising:

a plurality of functional circuits for performing data processing operations;

at least one functional bus for providing communication between said plurality of functional circuits during non-diagnostic functional operation of said integrated circuit; and

a diagnostic bus-master circuit for performing a diagnostic operation upon at least one of said plurality of functional circuits by issuing a bus transaction request via said at least one functional bus to one or more of said plurality of functional circuits during real time operation of said plurality of functional circuits.

The following references are relied on by the Examiner:

Katz	US 5,664,124	Sep. 2, 1997
Bauer	US 6,208,924 B1	Mar. 27, 2001
Edwards	US 6,779,145 B1	Aug. 17, 2004 (Filed Oct. 1, 1999)
Moyer	US 2003/0172214 A1	Sep. 11, 2003 (Filed Mar. 8, 2002)
Mahowald	US 2004/0139247 A1	Jul. 15, 2004 (Filed Jan. 15, 2003)

SPI glossary definition of Flash Memory
AMBA Specification (Rev. 2.0) (1999) p. 1-12
Computer Hope.com glossary article “Bus”
Siliconfareast.com article “System on a Chip”
WaterWheel.com article “Motherboard External Bus”

In a first stated rejection, the Examiner relies upon Bauer to reject claims 1, 2, 9, 12, 14, 15, and 22 under 35 U.S.C. § 102(b) as being

anticipated by Bauer. This rejection includes independent claims 1 and 14 on appeal. All other claims on appeal not listed within this first stated rejection stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner relies upon Bauer in view of Katz as to claims 6 and 19. In a third stated rejection, the Examiner relies upon Bauer alone to reject claims 10, 11, and 23 through 25. Next, the Examiner relies upon Bauer in view of Moyer as to claims 3, 4, 16, and 17 in a fourth stated rejection. The Examiner relies upon Bauer in view of Mahowald as to claims 7 and 20 in a fifth stated rejection. In a sixth stated rejection, the Examiner relies on Bauer in view of Mahowald, further in view of Edwards as to claims 8 and 21. Lastly, in a seventh stated rejection, the Examiner relies upon Bauer in view of AMBA to reject claims 13 and 26.

Rather than repeat the positions of the Appellants and the Examiner, reference is made to the Brief and Reply Brief for Appellants' positions, and to the Answer for the Examiner's positions.

OPINION

Generally, for the reasons set forth by Appellants in the Brief and Reply Brief, we reverse the rejection of independent claims 1 and 14 under 35 U.S.C. § 102 and, therefore, the respective rejections of all their dependent claims.

More particularly, we agree with Appellants initial view in the Brief and Reply Brief that Bauer does not disclose an integrated circuit per se. There appears, as argued, to be no identified structural element in Bauer that is disclosed to be fabricated in the form of an integrated circuit. There is no disclosure in Bauer that the control device 1 of figure 1 is fabricated as a

complete integrated circuit even though we may agree with the Examiner's view that the microcomputer 5 within this control device 1 in figure 1 may ordinarily be regarded as constructed by integrated circuit fabrication techniques. Nevertheless, we would be speculating to agree with the Examiner that the entire control device 1 conventionally would be manufactured utilizing an integrated circuit technology. In this light, the Examiner's view at the bottom of page 13 of the Answer that the elements of control device 1 "can be constructed as integrated circuits" essentially begs the question.

It is also noteworthy that the elements within Bauer that the Examiner attempts to correspond to the claimed functional circuits, the functional bus and the diagnostic bus-master circuit of independent claim 1 on appeal are not stated to be manufactured by an integrated circuit structural approach. These elements are not stated in Bauer to be within the microcomputer 5 even if we assume that this element is an integrated circuit.

This discussion is significant because we agree with Appellants' view at page 4 of the Reply Brief that the Examiner misstates the conventional meaning of the word "comprising." The named elements of the functional circuits, the at least one functional bus and the diagnostic bus-master circuit of claim 1 on appeal are necessarily named elements that must be within the integrated circuit of claim 1 on appeal. As stated earlier, no teaching exists for fabricating any element per se in Bauer in this manner. In like manner, method independent claim 14, in its long preamble, must have an integrated circuit having a plurality of functional circuits and at least one functional bus

operable with them to meet the structural requirements of this claim. Again, Bauer can not meet these requirements of independent claim 14 on appeal.

In view of the foregoing, since Bauer can not meet the claimed integrated circuit requirements of independent claims 1 and 14 on appeal, we must also reverse the respective rejections of all their dependent claims.

The decision of the Examiner is reversed.

REVERSED

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