

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** MATTHEW D. BATES,  
NICHOLAS D. BUTLER,  
MALCOLM D. BUTTIMER,  
ADRIAN C. GAY,  
and JONG-HAN KIM

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Appeal No. 95-2219  
Application 08/041,922<sup>1</sup>

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ON BRIEF

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Before JERRY SMITH, BARRETT and FLEMING, **Administrative Patent Judges**.

FLEMING, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of claims 1 through 20, all of the claims pending in the present application.

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<sup>1</sup> Application for patent filed April 2, 1993. According to applicants, this application is a continuation of Application 07/484,717, filed February 23, 1990, now abandoned.

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The invention relates to processing of iterative tasks in data processors.

The independent claims 1 and 15 are reproduced as follows:

1. A processor comprising:

means for storing a plurality of values at addressable storage locations;

means for storing a processor condition code; and

logic for decoding instructions from a sequence of stored instructions, said instructions including a specific instruction defining an operation between a first value at a first address specified by said instruction, and a second value at a second addressable storage location, the second addressable location determined from a second address specified in said instruction and the state of said processor condition code.

15. Processing apparatus comprising:

means for fetching instructions from storage for decoding and execution, said instructions including a specific instruction defining an operation between a first operand comprising a first addressable value and a second operand comprising either a second addressable value or a third addressable value depending on a processor condition code; and

means for decoding the instructions fetched from storage by said fetching means, said decoding means decoding said specific instruction by selecting an address of one of said second and third addressable values as said second operand based on said condition code.

The Examiner relies on the following reference:

Brown et al. (Brown)                      4,677,573                      June 30, 1987

Claims 1 through 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Brown.

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Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the briefs<sup>2</sup> and answer for the respective details thereof.

**OPINION**

We will not sustain the rejection of claims 1 through 20 under 35 U.S.C. § 103.

The Examiner has failed to set forth a *prima facie* case of obviousness. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." *Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), *citing W. L. Gore & Assocs., Inc. v.*

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<sup>2</sup> Appellants filed an appeal brief on August 19, 1994. We will refer to this appeal brief as simply the brief. Appellants filed a reply appeal brief on January 3, 1995. We will refer to this reply appeal brief as the reply brief. The Examiner stated in the Examiner's letter dated January 30, 1995 that the reply brief has been entered and considered but no further response by the Examiner is deemed necessary.

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*Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), **cert. denied**, 469 U.S. 851 (1984).

The Examiner argues on pages 3 and 4 of the answer that Brown teaches "the invention substantially as claimed." The Examiner refers to Appellants' claim 1 and states the following:

Brown et al. did not specifically detail a second value at a second addressable storage location determined from a second address specified by said instruction and the state of said processor condition code, exactly as claimed. However, it would have been obvious to one of ordinary skill in the art, at the time the claimed invention was made, that any value stored in any storage location has to be specified by an address in order to retrieve the value from a processor (i.e., AU) to operate on the value. As to the second value to be determined by, including the processor's condition code it would have been obvious to one of ordinary skill in the art that to differentiate the first value from the second value for representing pixels or points, one of the values has to be different and could be specified by condition code and addresses.

We note that the Examiner has not provided any further evidence to support his case.

Appellants argue on page 3 of the reply brief that the Examiner has admitted that Brown does not teach logic for decoding instructions as recited in Appellants' claims. Appellants argue that the Examiner provides no teaching or support whatsoever in support of his assertion that it would have been obvious to provide such logic, but instead the Examiner only

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provides a broad unsupported general conclusion of obviousness. Appellants further argue that the Examiner has failed to provide any teaching whatsoever, other than Appellants' specification, that would motivate one of ordinary skill in the art to modify Brown to provide Appellant's claimed processor.

We agree. We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference, common knowledge or capable of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a *prima facie* case. ***In re Knapp-Monarch Co.***, 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961). ***In re Cofer***, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." ***In re Fritch***, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), ***citing In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." ***Para-Ordnance Mfg. v. SGS Importers Int'l***, 73 F.3d at

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1087, 37 USPQ2d at 1239, *citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13.

Upon reviewing Brown, we fail to find any suggested desirability of modifying Brown to obtain a logic for decoding instructions as recited in Appellants' claims 1 through 14 or a means for decoding the instructions as recited in Appellants' claims 15 through 20.

We have not sustained the rejection of claims 1 through 20 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

**REVERSED**

JERRY SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
LEE E. BARRETT	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS
	)	AND
	)	INTERFERENCES
	)	
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