

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YASUYUKI NOZUYAMA

Appeal No. 1997-0342
Application 08/229,135

HEARD: April 20, 2000

Before BARRETT, RUGGIERO and LALL, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 10 through 16. Claims 1 through 9 were canceled earlier in the prosecution. An amendment after final

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rejection filed October 18, 1995 which canceled claims 11 and 12 was entered by the Examiner. A further amendment after final rejection filed

February 20, 1996 along with the Appeal brief which canceled claim 13 was also entered by the Examiner. Accordingly, claims 10 and 14 through 16 remain before us on appeal.

The claimed invention relates to a test facilitating circuit in which tests are carried out in either a self-test mode or a fault diagnosis/failure analysis mode. In the self test mode, a test data generating circuit outputs test data onto an internal bus while during the fault diagnosis/failure analysis mode, data is transferred onto the internal bus through a register from external input terminals. A selector is utilized to select the test data from either the internal bus or the external input terminals for the respective test modes.

Claim 14 is illustrative of the invention and reads as follows:

14. A test facilitating circuit comprising:

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a test data generating circuit to output test data, in a first test mode, onto a bus to which a logic circuit under test is connected to receive input data;

a selector having two inputs connected respectively to an external terminal and the bus, for outputting data from said external terminal in a second test mode and data on the bus in said first test mode;

a register for transferring test data from the selector onto the bus in the second test mode; and

a built-in self-test circuit for carrying out a test with test data on the bus in the first test mode and in the second test mode.

The Examiner relies on the following prior art:

Kahn et al. (Kahn)	5,167,020	Nov. 24, 1992
		(Filed May 25, 1989)
Nozuyama	5,398,250	Mar. 14, 1995
		(Effectively filed Jun. 22, 1989)

Claim 14 stands finally rejected under 35 U.S.C. § 103 as being unpatentable over Kahn. In a new ground of rejection in the Answer, the Examiner rejected claims 10, 15 and 16 under 35 U.S.C. § 103 as being unpatentable over Kahn in view of Nozuyama.

Rather than reiterate the arguments of Appellant and the

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Examiner, reference is made to the Briefs¹ and Answers for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, the arguments in support of the rejections and the evidence of obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, 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 Answers.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention set forth in

¹The Appeal Brief was filed February 20, 1996. In response to the Examiner's Answer dated March 21, 1996, Appellant filed a Reply Brief on May 21, 1996 to which the Examiner responded with a Supplemental Examiner's Answer dated July 29, 1996.

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claims 10 and 14 through 16. Accordingly, we reverse.

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), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044,

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1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S.
825

(1988); Ashland Oil, Inc. v. Delta Resins & Refractories,
Inc.,

776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert.

denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v.

Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933

(Fed.

Cir. 1984). These showings by the Examiner are an essential
part

of complying with the burden of presenting a prima facie case
of

obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24

USPQ2d

1443, 1444 (Fed. Cir. 1992).

With respect to independent claim 14, the Examiner
contends that Kahn discloses all of the claim limitations with
the exception that there is no explicit teaching of providing

a two input selector for selecting which data to output onto an internal bus. To address this deficiency, the Examiner argues (Answer, page 3) the obviousness to the skilled artisan of performing the selection operation with a two input selector by asserting the commonly known and typical usage of such a selector device. In a similar assertion, at page 2 of the Supplemental Answer, the Examiner includes the claimed transfer register in the category of well known basic components to which the skilled artisan would have found obvious to utilize.

In response, the primary thrust of Appellant's arguments centers on the alleged deficiency of Kahn in disclosing the claimed selector and register with the specific interconnections and functions as recited in claim 14. After careful review of the Kahn reference in light of the arguments of record, we are in agreement with Appellant's stated position in the Briefs. While we do not dispute the Examiner's contention that selector devices are commonly used to pick among various inputs and registers are often used to transfer data onto a bus, such contention does not address the

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issue of obviousness with respect to the specific limitations of the claim. The selector and register elements in Appellant's claim 14 are recited as having a specific interrelationship with the system bus including specific functions which are performed in conjunction with such interrelationship. As the Examiner has stated in the Answer, no such registers or selectors are explicitly seen to exist in Kahn. Further, the Examiner has provided no indication as to how and where the skilled artisan might have found it obvious to modify the Kahn teachings to arrive at the particular selector and register arrangement of the claimed invention. The 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, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). Since, in our view, the Examiner's line of reasoning does not establish a prima facie case of motivation, the Examiner's 35 U.S.C. § 103 rejection of claim 14 is not sustained.

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As a new ground of rejection in the Answer, the Examiner has asserted the obviousness of claims 10, 15 and 16 based on the combination of Kahn and Nozuyama. From the Examiner's statement of the grounds of rejection at page 4 of the Answer, it is apparent that Nozuyama was applied solely to address the micro-ROM limitations of these claims. We note, however, that each of the independent claims 10 and 16 contain limitations similar to that of claim 14 relating to the interrelationship of a selector and a register with the system bus. As discussed supra, we do not find the Examiner's line of reasoning with respect to the obviousness to the skilled artisan of incorporating selector and register elements in Kahn in the specific manner claimed to be well founded. Further, our review of Nozuyama reveals nothing that would overcome the innate deficiencies of Kahn and, accordingly, we do not sustain the Examiner's 35 U.S.C. § 103 rejection of claims 10, 15 and 16.

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In summary, we have not sustained either of the Examiner's 35 U.S.C. § 103 rejections of the claims on appeal. Accordingly, the decision of the Examiner to reject claims 10 and 14 through 16 is reversed.

REVERSED

LEE E. BARRETT)
Administrative Patent Judge)
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) BOARD OF PATENT
JOSEPH F. RUGGIERO)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
PARSHOTAM S. LALL)
Administrative Patent Judge)

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