

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARY L. SWOBODA,
HENRY R. HOAR and JOSEPH A. COOMES

Appeal No. 1999-2344
Application 08/720,586

ON BRIEF

Before THOMAS, KRASS and FLEMING, Administrative Patent Judges.
THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the board from the examiner's final rejection of claims 1-12.

Representative claim 1 is reproduced below:

1. An electronic system comprising:

electronic circuitry to be tested, said electronic circuitry including serial scan shift register latches; and

a serial scan generator embedded in the electronic system upon manufacture and connected to said serial scan shift register latches of said electronic circuitry thereby facilitating testing of said electronic circuitry.

The following references are relied on by the examiner:

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|------------------------|-----------|--------------------------------------------------------|
| Powell et al. (Powell) | 4,710,933 | Dec. 1, 1987 |
| Whetsel, Jr. (Whetsel) | 4,872,169 | Oct. 3, 1989 (filing date Dec. 8, 1988) |
| Hwang et al. (Hwang) | 5,032,783 | Jul. 16, 1991 (effective filing date Oct. 23, 1985) |

Claims 1-12 stand rejected under 35 U.S.C. § 102(b) or § 102(e) as being clearly anticipated by either Hwang or Whetsel or Powell.

Rather than repeat the positions of the appellants and the examiner, reference is made to the brief and reply brief for the appellants' positions, and to the final rejection for the statement of the rejection and the answer for the examiner's responsive arguments to the brief.

OPINION

We reverse all rejections of claims 1-12 under 35 U.S.C. § 102.

At the outset, we summarily reverse the rejection relying upon Whetsel because the examiner has failed to established a prima facie case of anticipation. Neither page 3 of the final rejection where the examiner sets forth and relies upon the statement of the rejection as to this reference, nor the answer itself discuss in any detail what figures, columns or portions of Whetsel the examiner relies upon as a basis for the rejection of all claims on appeal. Furthermore, the examiner has failed to address any arguments in

the brief and reply brief as to this reference in his responsive arguments portion of the answer. Therefore, we reverse all rejections under 35 U.S.C. § 102 based upon Whetsel.

We also reverse the rejections under 35 U.S.C. § 102 based upon Powell and Hwang. We agree with appellants' observation at page 3 of the principal brief on appeal that Hwang and Powell disclose essentially the same features with an essentially common disclosure. The disputed language in representative claim 1 on appeal between the examiner and appellants is the feature of claim 1 "a serial scan generator embedded in the electronic system upon manufacture." Essentially the same features are recited in independent method claim 10 on appeal.

To simplify our consideration of the issues, we refer to the following statements made by the appellants at the top of page 2 of the reply brief:

The Applicants have never argued that the references did not teach a serial test scan generator. The Applicants urge that the cited references fail to show that the serial test scan generator is "embedded in the electronic system upon manufacture" as recited in claim 1. Thus the Applicants do not dispute that Hwang et al and Powell et al inherently disclose the serial test scan generator. However, the Applicants submit that this teaching of Hwang et al and Powell et al fails to anticipate the recitation in claim 1 that the "serial scan generator embedded in the electronic system upon manufacture."

We have not been provided any evidence by the examiner in Powell or Hwang that a serial scan generator is "embedded" in an electronic system upon manufacture as required by both independent claims 1 and 10 on appeal. The examiner's assertion at page 4 of the answer that such a generator is incorporated internally of the VLSI circuit 10 in Figure 1 of Powell and Hwang is misplaced. The mere mention of a patent to Komonytsky, U.S. Patent 4,519,078, at columns 1 and 2 of Powell and Hwang provides to us no evidence to substantiate the examiner's assertion that such a generator is "embedded" in the electronic system of these references. Moreover, the scan data in and scan data out signals 28 and 30 in Figure 1 of these references indicates that they come from an external source to VLSI circuit 10 itself. Additionally, since the rejections are set forth under 35 U.S.C. § 102, to the extent Komonytesk may be relied upon by the examiner on the merits for its teachings in conjunction with Powell or Hwang, no rejection has been made before us under 35 U.S.C. § 103.

Beyond all this, we agree with appellants' assertions in the principal brief and reply brief that Powell and Hwang do not individually provide any disclosure within themselves of a serial scan generator embedded in an electronic system upon manufacture as recited in both independent claims 1 and 10 on appeal. Even though

the term "embedded" is broadly defined in the specification as filed in the last paragraph at the bottom of page 22, the rejections under 35 U.S.C. § 102 of claims 1-12 as being anticipated by Hwang or Powell must be reversed.

In view of the foregoing, the decision of the examiner rejecting claims 1-12 under 35 U.S.C. § 102 is reversed.

REVERSED

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| James D. Thomas |) | |
| Administrative Patent Judge |) | |
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| Errol A. Krass |) | BOARD OF PATENT |
| Administrative Patent Judge |) | APPEALS AND |
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| Michael R. Fleming |) | |
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