

File

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

APR 12 1996

PAT & TM OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte WILLIAM R. KRENİK,  
LOUIS J. IZZI and  
CHENWEI J. YIN

Appeal No. 94-3062  
Application 07/734,344<sup>1</sup>

ON BRIEF

Before THOMAS, CARDILLO and BARRETT, Administrative Patent Judges.

CARDILLO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal taken under 35 U.S.C. § 134 from the examiner's rejection of claims 1-18, 28 and 29. Claims 19-27, the only other claims remaining in this application, stand withdrawn from consideration. The amendment

<sup>1</sup> Application for patent filed July 19, 1991.

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pursuant to 37 CFR § 1.193(b) which was filed with the reply brief has been entered.

The invention is directed to a test circuit, the nature of which is apparent from a reading of illustrative claim 1, which we reproduce as follows:

1. Test circuitry comprising:

a multiplexer for selectively receiving multiple bit control words defining test functions to be executed by said test circuitry and for outputting data from said test circuitry;

a plurality of digital data inputs for receiving multiple bit words of digital data;

a register coupled to said multiplexer for storing a one of said multiple bit control words received by said multiplexer;

control circuitry coupled to said register for controlling execution of said test function defined by said one of said control words being held in said register;

first test circuitry coupled to said digital data inputs, said multiplexer and said control circuitry for passing said digital data words received at said digital data inputs to said multiplexer for output in response to a first control word of said control words being stored in said register.

The reference of record relied upon by the examiner is:

Whetsel, Jr. (Whetsel)                      5,084,874                      January 28, 1992  
(effectively filed September 7, 1988)

Claims 1-18, 28 and 29 stand rejected under 35 U.S.C.

§ 103. As evidence of obviousness, the examiner offers Whetsel.

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Rather than repeat the arguments of the appellants or the examiner, we make reference to the briefs and the answer for the details thereof.

OPINION

After a careful review of the record before us, we find that the evidence of § 103 obviousness proffered by the examiner is insufficient to carry the examiner's burden of establishing a prima facie case. Consequently, we reverse.

Before we explain why we find Whetsel to be lacking any fair teachings as to several key limitations of the claimed subject matter before us, we first must make it clear that we have no supervisory authority over the examiner. Accordingly, appellants' complaints as to the examination process related to the prosecution of this application appearing in the briefs are misdirected. If appellants are dissatisfied with the manner that the examination of this application has been conducted and/or how the guidelines of the Manual Of Patent Examining Procedure have been followed, these matters should have been resolved, either informally or formally (by petition, note 37 CFR § 1.181), as they arose with appropriate officials charged with such supervisory functions.

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Turning to the merits of the rejection which is within our jurisdiction, we note that the examiner has, at page 5 of the answer, responded to one of appellants' contentions as follows:

The appellant [sic, appellants] contends [sic, contend] that the claimed limitation of selectively receiving multiple bit control words defining test functions to be executed could not be found in Whetsel. The examiner asserts that this limitation is taught in Whetsel-Figure 2, Control Bus. The control signals in Figure 2 along with the multiplexers 22 and 28 operate to define the test functions that will be executed by the test cell (Whetsel - column 4, lines 12-37). The appellant [sic] further states [sic] that this recitation, which was previously provided, is inadequate. The examiner asserts that the control bus in Figure 2 uses "control words" of "HOLD" and "DMX" as well as control signals "A" and "B" and that these words/signals are equivalent to the applicant's [sic, applicants'] claimed limitation of "control words."

The examiner goes on at page 6 of the answer to assert that:

As stated in the previous office action, paper number 6, the latches 24 and 26 are analogous to a register and that the control words/signals of "A", "B" and "HOLD" are stored in these registers.

However, these assertions by the examiner, as well as the further assertions of pages 6-8 of the answer, appear to us to be based upon a misunderstanding of what Whetsel reasonably teaches. In this regard, we agree with appellants observations of the paragraph bridging pages 4 and 5 of the reply brief that:

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[I]t is clear from Whetsel Figure 2 and the description thereof that signals A, B and HOLD are not stored in latches 24 and 26.

In fact, we find that control signals "A" and "B" merely serve to control which of the 4 inputs to multiplexer 22, none of which are "A" or "B," will become the single output from 22. See col. 4, lines 25-28. Clearly, there can be no storage of signals "A" and "B" by either 24 or 26 under these circumstances. Moreover, it is not clear to us how flip-flop 24 is being interpreted by the examiner as equivalent to a storage register or how the "HOLD" signal applied to a latch (26) can be interpreted to be itself a "control word" or part of a "control word" which has been received by a multiplexer. In addition, while latch 26 can be controlled (by the "HOLD" signal) to either propagate the output of flip-flop 24 or to hold its present state (see col. 4 lines 28-31), we can find nothing in any of this suggesting that any of the control signals "A," "B," "DMX" and "HOLD" should be stored anywhere, much less by a register coupled to a multiplexer as claimed. Consequently, we find it is clear that appellants are correct in noting (at the top of page 5 of the rely brief) that the "HOLD" signal is applied to the latch 26 directly and not to any multiplexer as the claims require. We note that we view "DMX" as being a similar enabling signal and not something in the nature of a "control word" or a part of such

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a "word" that is suggested as an input to a multiplexer connected to a register for eventual storage in the register.

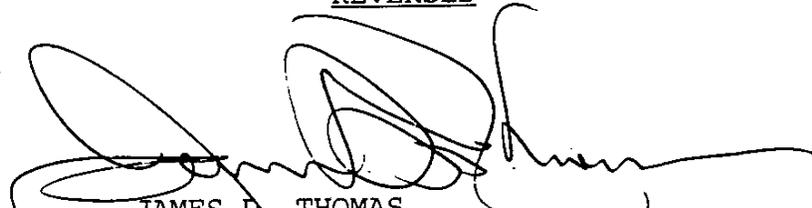
We note that we can also find no merit in the examiner's suggestion of page 3 of the answer that there is some reason apparent from a consideration of the clear separate and distinct input selecting functions performed by multiplexers 22 (4 to 1) and 28 (2 to 1) and the disclosed cooperation of 22 with elements 24 and 26 that would even remotely hint that these multiplexers could be combined while maintaining the disclosed overall circuit function and at least an identifiable storage function. Said differently, we do not see how the separate functions of the two different multiplexers would or could be performed by a single multiplexer connected to a storage register, as the examiner apparently envisions it.

Since the examiner's rejection does not address all of the argued limitations of the claims before us and adequately explain why the artisan with Whetsel before him would have found the subject matter claimed to have been obvious, we find there to be no prima facie case of § 103 obviousness. Moreover, because our independent review of Whetsel does not fill in any of the gaps we have noted as existing in the examiner's rationale as to the § 103 obviousness of the subject matter of appellants claims

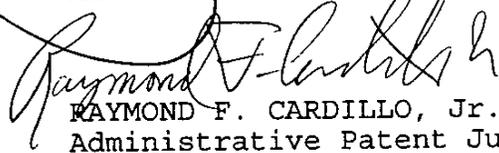
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at bar, we must reverse the rejection of these claims.  
Accordingly, the decision of the examiner is reversed.

REVERSED

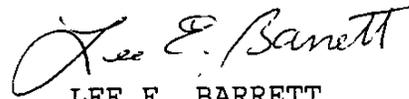


JAMES D. THOMAS )  
Administrative Patent Judge )



RAYMOND F. CARDILLO, Jr. )  
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