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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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

**MAILED**

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

**JAN 23 1996**

Ex parte SATOSHI MATSUI

PAT.&T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Appeal No. 95-2462  
Application 07/671,318<sup>1</sup>

ON BRIEF

Before THOMAS, KRASS and JERRY SMITH, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 4. Claim 5 was cancelled.

The invention is directed to a data length deciding circuit for an information processing apparatus.

Independent claim 1 is reproduced as follows:

1. An information processing apparatus for processing information utilizing a plurality of instructions having different data lengths by use of microprograms [sic] after judging first data length information related to each for the instruc-

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

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tions according to either a method of indirectly specifying the first data length information or a method of directly specifying the first data length information in the microprogram, comprising:

a data length specifying means for specifying one of either the directly specified data length information or indirectly specified data length information;

a storing means for storing second data length information dedicated to an interrupt process;

a controlling means for controlling the storing means; and a selecting means for selecting the output of either the data length specifying means or the storing means.

The examiner relies on the following reference:

MacGregor et al. (MacGregor)            4,649,477            Mar. 10, 1987

Claims 1 through 4 stand rejected under 35 U.S.C. 102(b) as anticipated by MacGregor. Claims 2-4 stand further, alternatively, rejected under 35 U.S.C. 103 as unpatentable over MacGregor.

Reference is made to the brief and answer for the respective details of the positions of appellant and the examiner.

#### OPINION

After due consideration of the evidence before us, we will not sustain either the rejection of claims 1 through 4 under 35 U.S.C. 102(b) or the rejection of claims 2 through 4 under 35 U.S.C. 103.

The initial burden for establishing anticipation or obviousness of claimed subject matter rests with the examiner. With regard to anticipation, it is required that each element of the claim in issue be found, either expressly described or under

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principles of inherency, in a single prior art reference. Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983). For a finding of obviousness under 35 U.S.C. 103, it is incumbent upon the examiner to provide a reason why one having ordinary skill in the 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 inference 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, 5 USPQ2d 1434 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984); In re Sernaker, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983). It is imperative for the decision maker to place himself back in time to when the invention was unknown, i.e., without the appellants' disclosure at his side, and determine, in light of all the objective evidence bearing on the issue of obviousness, whether one having ordinary skill in the art would have found the claimed invention as a whole obvious under 35 U.S.C. 103. Panduit Corp. v. Dennison Mfg. Co., 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985), vacated, 475 U.S. 809, 229 USPQ 478 (1986), aff'd. on remand, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987). It should be recognized that the fact that the prior

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art could be modified so as to result in the combination defined by the claims at bar would not have made the modification obvious unless the prior art suggests the desirability of the modification. In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986).

Independent claim 1 is a "picture claim" for what is shown in Figure 2 of the instant application wherein the conventional data length specifying means is shown as element 4, the "storing means" is shown as element 5, the "controlling means" is element 6 and the "selecting means" is element 7.

While the examiner contends that MacGregor discloses each and every one of the claimed elements, identifying, in MacGregor's Figures 1 and 2, element 12 as the data length specifying means, element 32 as the storing means, elements 34 and 38 as the controlling means and element 14 as the selecting means, these elements of MacGregor do not have the same structural interdependence as the claimed subject matter. According to the examiner's analysis of MacGregor via-á-vis the claimed elements, the storing means and the controlling means are part of the data length specifying means. Thus, looking at MacGregor's Figure 2 in view of the examiner's analysis, the output of

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"storing means" 32, i.e., 16, is also an output of the "data length specifying means." Accordingly, it would be nonsensical to speak of a selecting means for selecting the output of either the data length specifying means or the storing means since, in the examiner's analysis of MacGregor, these outputs are one and the same.

Moreover, independent claim 1 specifically calls for the storing means to be "dedicated to an interrupt process." Nowhere in MacGregor is an interrupt process even mentioned or suggested. The examiner recognizes this and contends that MacGregor "inherently contains interrupt support" [page 2 of the answer]. Further, the examiner contends, from the bottom of page 3 to the top of page 4 of the answer, that the reason MacGregor does not mention how to select data length during an interrupt operation is that the selection process "must be no different from selecting data length during normal instruction execution."

While interrupt processes are commonplace in data processing and information processing systems, we find no basis for the examiner's assertion that such an interrupt is somehow "inherent" in MacGregor and we decline to join in the examiner's speculation that since MacGregor does not mention any interrupts, it must be

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because selection of data during an interrupt process is no different than selecting data during normal instruction execution. The examiner has the initial duty of supplying the factual basis for a rejection and the examiner may not, because he/she may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in his/her factual basis. In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967).

Even if we were to assume, arguendo, that an interrupt process is somehow suggested by MacGregor and that the "storage means," 32, of MacGregor stores information relative to such an interrupt operation, there is no indication, whatsoever, in MacGregor that such a "storage means" for storing second data length information is "dedicated" to an interrupt process, as claimed. In fact, if it were so "dedicated," MacGregor surely would have said something about the purpose of size selector 32 relative to storing information "dedicated to an interrupt process."

Since we find the subject matter of instant independent claim 1 neither anticipated nor made obvious by MacGregor, we



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