

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(2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KLAUS J. GETZLAFF,  
JOHANN HAJDU,  
BRIGITTE ROETHE, and  
UDO WILLE

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Appeal No. 96-0635  
Application 08/132,410<sup>1</sup>

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ON BRIEF

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

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134  
from the examiner's rejection of claims 9-18, which constitute

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<sup>1</sup> Application for patent filed October 6, 1993.

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all the claims remaining in the application. An amendment after final rejection was filed on March 20, 1995 and was entered by the examiner.

The disclosed invention pertains to a computer system for executing microinstructions. More particularly, first and second buffers are provided for storing transient and relatively permanent microinstructions respectively. The invention is related to the manner in which erroneous instructions in the buffers are detected and the manner in which erroneous instructions are replaced.

Representative claim 9 is reproduced as follows:

9. A computer system for executing microinstructions, said system comprising:

a processor;

a first buffer for storing a plurality of blocks of transient microinstructions;

a second buffer for storing a plurality of blocks of microinstructions which are loaded at power up and remain loaded except if erroneously loaded;

means for directing said processor to execute microinstructions in order and determining when a next microinstruction to be executed is not stored in said first or second buffers;

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means, coupled to the determining means, for loading another block containing said next microinstruction into said first buffer; and

means for detecting when a microinstruction to be executed from either said first or second buffers is erroneous, avoiding execution of said erroneous microinstruction, activating the loading means to reload a block containing a valid version of said erroneous microinstruction into said first or second buffer, respectively, and causing the directing means to direct said processor to execute said valid version microinstruction.

The examiner cites the following references in the answer:

Johnson et al. (Johnson)	4,422,144	Dec. 20, 1983
Day et al. (Day)	4,538,265	Aug. 27, 1985

Claims 9-18 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Day. Johnson is not listed in the statement of the rejection in either the final rejection or the answer. Johnson is referred to in the response to arguments section of the answer wherein Johnson is said to suggest a particular feature of the claimed invention.

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

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection 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 as set forth in claims 9-18. Accordingly, we reverse.

We consider first the rejection of independent claim 9 as unpatentable over the teachings of Day. In the rejection, the examiner basically asserts that Day performs the error recovery routine as in the claimed invention except that Day does not teach organizing the local data into transient and permanent areas. The examiner states that configuring a

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memory in such a manner was well-known in the art, and the examiner concludes that it would have been obvious to the artisan to reconfigure the Day memory in the manner recited in claim 9 [final rejection, pages 3-4].

Appellants respond in the brief that the first and second buffers as recited in claim 9 are not taught or suggested by the system of Day as admitted by the examiner [brief, pages 3-4]. The examiner responds to appellants' argument by asserting that appellants have ignored the level of skill in the art. The examiner also reiterated his position that a bifurcated control store would have been obvious to the artisan at the time the invention was made. The examiner makes reference to Johnson here as evidence that a bifurcated control store was known in the art [answer, pages 4-5]. Appellants note that Johnson was not applied in the final rejection, and even if Johnson's teachings were considered, Johnson does not suggest reloading instructions into the permanent part of the control store [reply brief].

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The examiner responds that Johnson would have suggested the modification of Day to arrive at the subject matter of claim 9 [supplemental answer].

At the outset we note that Johnson is not listed in the statement of the rejection but is merely cited in the arguments section of the examiner's answer. We have reminded examiners

many times that a reference not positively included in a statement of rejection is not considered as applied prior art. Note In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). Thus, if the examiner is relying on Johnson to establish the state of the art and/or the level of skill in the art, then the examiner should have listed Johnson in the statement of the rejection.

Although Johnson has not been properly cited as prior art in this rejection, we note that it was cited to support the examiner's previous contention that bifurcated buffers were well-known in this art. We also observe that appellants have responded to the rejection as if Johnson had been

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properly applied [reply brief]. In the interest of administrative efficiency, we shall comment on the merits of this rejection.

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, 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,

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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).

The examiner has focused his attention on the function performed by the claimed invention rather than on the specific recitations of claim 9. Day simply confirms that the concept of replacing erroneous microinstructions with correct instructions was practiced in this art. Claim 9, however, requires more than this. As the examiner has admitted, Day does not teach first and second buffers as claimed. The mere addition to Day, however, of a bifurcated control store as taught by Johnson does not teach the invention recited in claim 9. Claim 9 recites that the transient instructions from the first buffer and the "permanent" instructions of the second buffer are reloaded into the same respective buffer

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when they are determined to be erroneous. Since one of the buffers in Johnson is a read-only store, there is no provision in Johnson for reloading the instructions designated as permanent when an instruction is determined to be erroneous. There is no suggestion from the collective teachings of Day and Johnson that the instruction loading should be accomplished in the manner recited in independent claim 9, and the examiner has not provided a reasonable rationale to suggest the obviousness of the invention of claim 9. Therefore, we do not sustain the rejection of claim 9 whether based on Day alone or on the combination of Day and Johnson.

Since claims 10-18 all depend from claim 9, we also do not sustain the rejection of any of these claims. The decision of the examiner rejecting claims 9-18 is reversed.

REVERSED

JAMES D. THOMAS )  
Administrative Patent Judge )  
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) BOARD OF PATENT

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JERRY SMITH	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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