

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUO MATSUZAKI

Appeal No. 96-2576
Application 08/148,271¹

ON BRIEF

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

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed November 8, 1993.

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This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-9, which constitute all the claims in the application.

The disclosed invention pertains to a battery mounted integrated circuit device. Specifically, the invention relates to a thin film laminated battery mounted on a semiconductor chip. Power receiving circuits within the semiconductor chip receive battery power through switches located within the semiconductor chip.

Representative claims 1 and 4 are reproduced as follows:

1. A battery mounted integrated circuit device, comprising:

a semiconductor chip in which an integrated circuit including a plurality of power receiving circuits with different operating voltages is formed;

a thin film laminated battery, made of a solid electrolytic film mounted on said semiconductor chip, for producing a plurality of voltages; and

a power source switch incorporated in said integrated circuit for connecting said battery to said power receiving circuits to supply said plurality of voltages from said battery to said power receiving circuits on demand.

4. A battery mounted integrated circuit device, comprising:

a semiconductor chip in which an integrated circuit including at least one power receiving circuit is formed;

a normal power source for supplying power to said integrated circuit;

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a thin film laminated battery made of a solid electrolytic film mounted on said semiconductor chip; and

a power source switch incorporated in said integrated circuit for connecting said battery to said at least one power receiving circuit;

wherein said battery is previously charged by said normal power source while said integrated circuit is being operated by said normal power source, and during power failure, said power source switch is automatically operated so that power is supplied from said battery to said at least one power receiving circuit.

The examiner relies on the following references:

Shimohigashi	4,672,586	June 09, 1987
McCain	5,153,710	Oct. 06, 1992

Claims 1-9 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers McCain in view of Shimohigashi.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer 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 appellant's arguments set forth in the briefs along with the examiner's

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rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the collective 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 1-9. 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, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.,

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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).

As indicated by the cases just cited, the examiner has at least two responsibilities in setting forth a rejection under 35 U.S.C. § 103. First, the examiner must identify all the differences between the claimed invention and the teachings of the prior art. Second, the examiner must explain why the identified differences would have been the result of an obvious modification of the prior art. Since the differences between the claimed invention and the applied prior art in this case appear to have been properly identified and argued by the examiner and appellant, the question for disposition is whether the examiner's conclusion of obviousness is supported by the evidence of record in this case and the analysis provided by the examiner.

With respect to independent claim 1, appellant argues that the following recitations of the claim are not suggested by the applied prior art: (1) the semiconductor chip has a plurality

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of power receiving circuits with different operating voltages; (2) the battery is mounted on the semiconductor chip; and (3) a power source switch is incorporated within the integrated circuit. Appellant also argues that there is no motivation for duplicating the single integrated circuit of McCain and then using the different voltage sources as taught by Shimohigashi. In other words appellant questions whether there is any suggestion to modify the teachings of McCain with the teachings of Shimohigashi in the manner proposed by the examiner.

We will not concern ourselves with the propriety of each of the three distinctions raised by appellant because we agree with appellant that there is no suggestion to duplicate McCain's integrated circuit and to add plural operating voltages as suggested by the examiner. The invention of claim 1 would require a modification of McCain and a combination with Shimohigashi which could come only from a hindsight reconstruction of the invention. Although the examiner asserts that it is obvious to duplicate components and provide plural voltages, we agree with appellant that the modification proposed by the examiner would not result in the invention of claim 1 [reply brief, page 5]. The mere fact that the prior art may be modified in the manner suggested by the examiner does not make

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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); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). We find no such suggestion here.

With respect to independent claim 4, appellant argues that the following recitations of the claim are not suggested by the applied prior art: (1) the battery is previously charged by the normal power source; (2) the battery is mounted on the semiconductor chip; and (3) a power source switch is incorporated within the integrated circuit. We will base this decision primarily on this latter point raised by appellant. With respect to this point, the examiner asserts that the McCain power switch is located within the integrated circuit because McCain seeks to minimize the need for additional external pins [answer, page 3]. Alternatively, the examiner simply concludes that it would have been obvious to broadly integrate the claimed power source switch within the integrated circuit [answer, pages 3 and 4-5].

The examiner and appellant disagree on where the power switch in McCain is located. We find the examiner's understanding of McCain and her reasoning to be speculative at best. We are not inclined to support a rejection based upon a

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completely speculative interpretation of a reference. The examiner's burden to present a prima facie case of obviousness is not satisfied by such speculation. Additionally, the examiner's rationale that it would have been obvious to locate the power source switch within the integrated circuit simply because integration is desirable fails to address the obviousness of applying that principle to the particular invention set forth in the claims before us.

In summary, we cannot sustain the examiner's rejection on obviousness because the evidence of record in this case does not provide the factual support necessary to support the examiner's position. Therefore, the decision of the examiner rejecting claims 1-9 is reversed.

REVERSED

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