

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD D. MANN

Appeal No. 96-3978
Application No. 08/092,628¹

ON BRIEF

Before THOMAS, RUGGIERO, and FRAHM, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 21-26, all of the claims pending in the present

¹ Application for patent filed July 15, 1993. According to appellant this application is a continuation of 07/786,327, filed October 31, 1991, now U.S. Patent No. 5,261,073, issued November 9, 1993, which is a division of Application No. 07/348,318, filed May 5, 1989, now U.S. Patent No. 5,307,469, issued April 26, 1994.

Appeal No. 96-3978
Application No. 08/092,628

application. Claims 1-20 have been canceled. An amendment after final rejection which proposed changes to the specification was filed June 5, 1995 and was indicated as being entered on the filing of appeal by the Examiner in the advisory action dated June 28, 1995.

The disclosed invention relates to a computer memory system having a memory control unit which is coupled to a system bus for receiving memory addresses and which is further coupled to a plurality of memory units over a memory bus. An access speed or timing characteristic of a selected memory unit is communicated over the memory bus to the memory control unit in response to a transmitted memory address.

Claim 21 is illustrative of the invention and reads as follows:

21. A memory control unit coupled during use to a system bus for receiving memory addresses therefrom, said memory control unit further being coupled during use to one or more memory units by a second bus, the second bus including a plurality of signal lines for transmitting, during a memory access cycle, a memory address to the one or more memory units, each of said one or more memory units being comprised of a plurality of semiconductor memory devices having a plurality of addressable memory storage locations, said memory control unit further including means, coupled to and responsive to a signal asserted on the second bus by one of the memory units selected by the transmitted memory address, the asserted signal indicating an access speed of the selected memory unit, for

Appeal No. 96-3978
Application No. 08/092,628

specifying a duration of the memory access on an access-by-access basis so as to make a duration of the memory access cycle compatible with the access speed of at least the semiconductor memory devices of the selected memory unit.

The Examiner relies on the following references:

Morgan	4,980,850	Dec. 25, 1990
		(Filed May 14, 1987)
Bowater et al. (Bowater)	5,301,278	Apr. 05, 1994
		(Effectively filed Apr. 29, 1988)

Claims 21-26 stand finally rejected under 35 U.S.C. § 103 as being unpatentable over Bowater in view of Morgan. Rather than reiterate the Arguments of Appellant and the Examiner, reference is made to the Briefs² and Answer for the respective details.

OPINION

We have carefully considered the subject matter on

² The Appeal Brief was filed September 14, 1995. In response to the Examiner's Answer dated June 7, 1996, a Reply Brief was filed June 27, 1996 which was acknowledged and entered by the Examiner without further comment on April 1, 1997.

Appeal No. 96-3978
Application No. 08/092,628

appeal, the rejections advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Briefs along with the Examiner's rationale in support of the rejections 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 obviousness of the invention as set forth in claims 21-26. 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

Appeal No. 96-3978
Application No. 08/092,628

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, 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

Appeal No. 96-3978
Application No. 08/092,628

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).

With respect to independent claims 21 and 23, the Examiner seeks to modify the memory system of Bowater by relying on Morgan to supply the missing teaching of providing configuration information from a memory in response to a query by a memory controller.

In response, Appellant (Brief, page 13) asserts a lack of suggestion or motivation in the references for combining or modifying teachings to establish a prima facie case of obviousness. After careful review of the Bowater and Morgan references, we are in agreement with Appellant's stated position in the Briefs. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make 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). The Examiner's statement of the grounds of rejection at pages 4 and

Appeal No. 96-3978
Application No. 08/092,628

5 of the Answer, is lacking in any rationale as to why the skilled artisan would modify Bowater in such a manner.

We are further in agreement with Appellant's assertion on pages 9 and 10 of the Brief that even assuming, arguendo, that Bowater and Morgan could be combined as suggested by the Examiner, the resulting combination would not suggest to one of ordinary skill the invention set forth in independent claims 21 and 23. In Appellant's view (Brief, page 8), all of the memory parameters output from the memory boards in Morgan are static configuration parameters which are not related to the access speed or timing characteristic of a memory device. From this observation, Appellant concludes that Morgan adds nothing to the teachings of Bowater that would suggest to the skilled artisan the varying of the speed of memory accesses with control signals from the memory devices. We agree.

We note that in the responsive arguments portion at page 6 of the Answer, the Examiner has responded to Appellant's arguments with regard to the speed related characteristics of the memory output parameters of Morgan by suggesting that Morgan's parameters (error correction, size and number of banks) are "analogous" to access speed. However, on careful

Appeal No. 96-3978
Application No. 08/092,628

review of Morgan we agree with Appellant (Reply Brief, page 2) that whether or not these parameters are "physical" characteristics of a memory, as asserted by the Examiner, they are static parameters which give no indication of access speed.

Since, for all of the reasons discussed above, we are of the view that the prior art applied by the Examiner does not support the rejection, we do not sustain the rejection of independent claims 21 and 23. Therefore, we also do not sustain the rejection of dependent claims 22 and 24-26.

In conclusion , we have not sustained the Examiner's rejection of any of the claims under 35 U.S.C. § 103. Accordingly, the decision of the Examiner rejecting claims 21-26 is reversed.

REVERSED

JAMES D. THOMAS)
Administrative Patent Judge)
)
)
)

Appeal No. 96-3978
Application No. 08/092,628

)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
ERIC S. FRAHM)	
Administrative Patent Judge)	

lp

Appeal No. 96-3978
Application No. 08/092,628

RONALD J. PAGLIERANI, ESQ.
WANG LABORATORIES, INC.
600 TECHNOLOGY PARK DRIVE
M/S 01N-440
BILLERICA MA 01821

Leticia

Appeal No. 96-3978
Application No. 08/092,628

APJ RUGGIERO

APJ THOMAS

APJ FRAHM

DECISION: REVERSED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s): _____

Prepared: March 21, 2000

Draft Final

3 MEM. CONF. Y N

OB/HD GAU

PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT