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10/621,862	07/17/2003	Jan Boer	6-2-2-5	1756

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Ryan, Mason & Lewis, LLP
90 Forest Avenue
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EXAMINER

MALEK, LEILA

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Patent Trial and Appeal Board
Informative

Standard Operating Procedure 2

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAN BOER, BAS DRIESEN, RA'ANAN GIL, and
KAI ROLAND KRIEDTE

Appeal 2009-010590
Application 10/621,862
Technology Center 2600

Before ALLEN R. MACDONALD, THOMAS S. HAHN, and
CARL W. WHITEHEAD, JR., *Administrative Patent Judges.*

WHITEHEAD, JR., *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

(1) Appellants and jurisdiction

Jan Boer, Bas Driesen, Ra'anan Gil, and Kai Roland Friedte (Appellants) appeal under 35 U.S.C. § 134 from a final rejection mailed on April 2, 2008. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

(2) Filing date and real party in interest

The application on appeal was filed on July 17, 2003.

The application is assigned of record to Agere Systems Inc. On April 2, 2007, the assignee Agere Systems Inc. completed a merger with LSI Logic Corporation, with the resulting entity being named LSI Corporation. LSI Corporation is the real party in interest.

Appeal Brief, page 1.

(3) Claims and grounds of rejection to be reviewed on appeal

The Examiner entered a Final Office Action (final rejection) which was mailed on April 2, 2008.

Claims 1-38 are pending in the application. Appeal Brief, page 2.

Claims 1, 16, 18, 23, 25, 34, 35, 37, and 38 are independent claims.

Claims 1, 5, 12-14, 16, 17, 25, 28, 33, and 38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sano (European Patent Application Publication Number EP1 367 752 A1, published March 12,

2003) and Tzannes (U.S. Patent Application Publication Number 2004/0047296 A1, published March 11, 2004). Answer, pages 3-9.

Claims 2-4, 6, 26, 27, 29, and 34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sano, Tzannes, and Mobin (U.S. Patent Number 6,522,696 B1, issued February 18, 2003). Answer, pages 9-13.

Claims 7-9, 30, and 31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sano, Tzannes, Mobin, and Balachandran (U.S. Patent No. 6,215,827 B1, issued April 10, 2001). Answer, pages 13-14.

Claims 10 and 32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sano, Tzannes and Mobin, and Li (U.S. Patent Application Publication Number 2003/0157914 A1, published August 21, 2003). Answer, pages 14-15.

Claim 11 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Sano, Tzannes, Mobin, Li, and Balachandran. Answer, pages 15-16.

Claim 15 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Sano, Tzannes, and Balachandran. Answer, pages 16-17.

Claims 18-20, 23, 24, and 37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sano, Tzannes, Mobin, and Balachandran. Answer, pages 17-25.

Claims 21 and 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sano, Tzannes, Mobin, Balachandran, and Li. Answer, pages 25-26.

Claim 36 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Sano, Tzannes, Mobin, Balachandran, and Shurvinton (U.S. Patent Application Publication Number 2005/0130595 A1, published June 16, 2005). Answer, pages 26-27.

Claim 35 was allowed. Answer, pages 27-28.

Appellants filed a Declaration of Prior Invention under 37 C.F.R. §1.131 with exhibits on December 13, 2007 to provide evidence that the actual reduction to practice of the invention in the instant application was at least as early as March 12, 2001. Appeal Brief, page 11. Appellants contend the filing of the Declaration effectively removed Tzannes, having a priority date of March 8, 2002, as 35 U.S.C. § 102(e) prior art. *Id.*

In the Final Rejection, mailed April 2, 2008, the Examiner considered Appellants' Declaration and determined the Declaration to be "ineffective to overcome the references used." Final Rejection, page 2; *see also* Answer, pages 30-33.

Appellants filed an Attorney Affidavit on June 5, 2008 to substantiate Appellants efforts to locate one of the missing inventors required to sign the

Declaration of Prior Invention under 37 C.F.R. §1.131 filed December 13, 2007. Appeal Brief, pages 11-12.

In an Advisory Action mailed June 25, 2008, the Examiner upheld his earlier decision that Appellants' Declaration was "ineffective to overcome the references used." Advisory Action, page 2.

Appellants argue that the Declaration signed by three of the four inventors is sufficient to show actual reduction to practice even without the testimony of the fourth inventor. Appeal Brief, pages 11-13.

Issue

Does the Board have jurisdiction to decide sufficiency of the Declaration of Prior Invention under 37 C.F.R. §1.131?

ANALYSIS

Appellants appealed to the Board because they disagreed with the Examiner's determination that their Declaration of Prior Invention under 37 C.F.R. §1.131 was not sufficient. Appeal Brief 11-13. According to M.P.E.P. §715.08, an Examiner's determination of the sufficiency of Appellants' Declaration in the Final Rejection is under the Examiner's purview.

M.P.E.P. 715.08 is reproduced below:

715.08 Passed Upon by Primary Examiner [R-6]

The question of sufficiency of affidavits or declarations under 37 CFR 1.131 should be reviewed and decided by a primary examiner.

Review of questions of formal sufficiency and propriety are by petition filed under >37 CFR 1.181<. Such petitions are answered by the Technology Center Directors (MPEP § 1002.02(c)).

Review on the merits of a 37 CFR 1.131 affidavit or declaration is by appeal to the Board of Patent Appeals and Interferences.

If Appellants disagreed with or questioned the Examiner's determination of insufficiency with regard to their Declaration, Appellants' recourse was to file a petition under 37 CFR 1.181 to be addressed by the Technology Center Director. *See* M.P.E.P. 715.08. Instead of filing a petition to the Technology Center Director, Appellants sought our review on the sufficiency of the Declaration. Appeal Brief 13. This is a petitionable matter at this stage and we do not have jurisdiction to overrule the Examiner's decision on sufficiency. *See* M.P.E.P. 715.08.

We therefore treat the Examiner's decision on the sufficiency of the declaration as correct in our review on the merits of the various 35 U.S.C. § 103 rejections and reach the same results as the Examiner.

DECISION

The rejections of claims 1-34 and 36-38 under the various 35 U.S.C. § 103 rejections are sustained.

Appeal 2009-010590
Application 10/621,862

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

llw