

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID L. FELDMAN

Appeal No. 2001-2687
Application No. 09/524,858

ON BRIEF

Before JERRY SMITH, BLANKENSHIP, and SAADAT, Administrative Patent Judges.
BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 36-42, which are all the claims remaining in the application.

We reverse.

BACKGROUND

The disclosed invention relates to a multi-chip module. Representative claim 40 is reproduced below.

40. A computer module comprising a central processing unit, a serial port, a parallel port, a drive controller, a keyboard interface, a DRAM interface and flash memory mounted in a relatively flat rectangular housing which is adapted to be mounted on a circuit board in a flat position, and a plurality of connector pins extending from the housing and arranged in a single row along three adjacent peripheral edges of the housing for connection to electrical conductors on the circuit board.

The examiner relies on the following references:

Zamborelli et al. (Zamborelli)	5,646,542	Jul. 8, 1997
Cunningham et al. (Cunningham)	5,659,680	Aug. 19, 1997

Claims 36-39 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cunningham and Zamborelli.

Claims 40-42 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cunningham.

We refer to the Final Rejection (Paper No. 4) and the Examiner's Answer (Paper No. 8) for a statement of the examiner's position and to the Brief (Paper No. 6) and the Reply Brief (Paper No. 9) for appellant's position with respect to the claims which stand rejected.

OPINION

We will reverse the rejections of the claims under 35 U.S.C. § 103 for the reasons summarized by appellant at page 2 of the Reply Brief. The system components in Cunningham are “mounted on a motherboard or card which is connected to a back plane by edge connectors, and contrary to the Examiner’s contention, the components which make up the computer system in Cunningham et al. are not mounted in a relatively flat housing which is adapted to be mounted on a circuit board.”

The rejections contend that Cunningham teaches the claimed computer elements “mounted in a relatively flat housing which is adapted to be mounted on a circuit board in a flat position” (Claim 36), and “mounted in a relatively flat rectangular housing which is adapted to be mounted on a circuit board in a flat position” (Claim 40). (Answer at 4-6.) The Answer does not specifically point out where the relevant “housing” may be found, nor what the “module” may be, but refers to Figures 2b and 3 of Cunningham.

Figure 1 of Cunningham illustrates a diagnostic test system 100. The rear face of the system contains standard PC compatible ports. Cunningham col. 4, ll. 24-54. The internal layout of the system (Fig. 2A) includes four primary circuit boards: a motherboard 300, a keypad adapter 301, a backplane 311, and a PCMCIA adapter board 323 (FIG. 3) coupled to the PCMCIA board connector 321 of the backplane 311.

Col. 4, l. 65 - col. 5, l. 3. Figure 3 of Cunningham illustrates the numerous chips and other components making up the boards. Col. 5, l. 4 et seq.

The physical relationship between the various boards and I/O module slots are shown in Figures 2b, 2c, and 2d. Col. 11, ll. 24-26. The motherboard 300 contains the bulk of the circuitry of the test system 100. As illustrated in Fig. 3, the motherboard 300 includes standard PC motherboard components, integral VGA LCD/CRT display controller 302, integral board mounted hard disk support 306, Flash BIOS 308A, 308B, a system memory 310, serial (312, 314) and parallel (316) ports, an optional floppy controller 318, and a power supply 320. Col. 12, ll. 4-10. The motherboard is made up of a four layer construction, with the majority of the components being surface mounted, such that all components can be mounted on one side of the board. Id. at ll. 30-41.

Figure 2b of Cunningham depicts motherboard 300 as being substantially rectangular. However, we agree with appellant that the above-quoted language of instant claims 36 and 40 distinguishes over the circuit boards and components disclosed by Cunningham. We disagree with the examiner's apparent claim interpretation, as suggested at page 19 of the Answer. If the functions of the claimed components were to be found in a single integrated circuit package, in our view the device would not meet the claim requirement that the components be "mounted" in a relatively flat housing.

We note that the relevant claim requirements are consistent with the structure of a multi-chip module, as disclosed by appellant. The examiner refers to several

Appeal No. 2001-2687
Application No. 09/524,858

references in the Answer that are not applied in the instant rejections. Cf. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970) (“Where a reference is relied on to support a rejection, whether or not in a ‘minor capacity,’ there would appear to be no excuse for not positively including the reference in the statement of rejection.”). Of those references, it appears that only one (U.S. Patent 4,763,188; Johnson) describes structure consistent with a multi-chip module, a fact which may further indicate that the rejections are based on an erroneous interpretation of the instant claims.¹

The examiner has not shown that Cunningham or Zamborelli, or any combination thereof, discloses or suggests all the requirements of independent claims 36 and 40. See In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (in a determination of unpatentability “the Board must point to some concrete evidence in the record in support of...[the]...findings”). We thus do not sustain the Section 103 rejections of the claims.

¹ We acknowledge that it may be proper to produce new evidence (e.g., a reference) in support of a fact officially noticed, when the asserted fact has been traversed by an applicant. In that case, absent entering new grounds of rejection, the reference could only be used for the limited purpose of showing the fact alleged, rather than for any additional teachings it might provide. In any event, the critical feature that the rejections allege to be taught by Cunningham was not contained in any of the instances of “Official Notice” in the rejections.

Appeal No. 2001-2687
Application No. 09/524,858

CONCLUSION

The rejections of claims 36-42 under 35 U.S.C. § 103 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
HOWARD B. BLANKENSHIP)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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MAHSHID D. SAADAT)	
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Appeal No. 2001-2687
Application No. 09/524,858

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