

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(2) is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHER J. FORD and ARTHUR J. WAGER

Appeal No. 95-2576
Application 07/962,952¹

HEARD: Feb. 03, 1998

Before BARRETT, FLEMING and JERRY SMITH, **Administrative Patent Judges**.

FLEMING, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of
claims 1 through 12, all of the claims present in the
application.

¹Application for patent filed October 16, 1992.

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The invention relates to a method for testing an integrated circuit device to determine if latent defects exist within the device. Appellants disclose on page 3 of the specification that the method includes applying a voltage to the integrated circuit and controlling the voltage being applied to the integrated circuit device as a function of the channel lengths.

The independent claim 1 is reproduced as follows:

1. A method for testing an integrated circuit device, said integrated circuit device having a plurality of electronic devices, each of said plurality of electronic devices having a channel of a predetermined length, said testing method comprising the steps of:

applying a voltage to said integrated circuit device;
and

controlling said voltage being applied to said integrated circuit device as a function of channel lengths.

The Examiner relies on the following references:

Groves et al.	4,588,945	May 13, 1986
Schinabeck	4,637,020	Jan. 13, 1987

Claims 3, 6, 8, 9 and 12 stand rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention. Claims 1 through 4, 6, 8, 10 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Groves. Claims 5, 7, 9 and 11 stand rejected under 35 U.S.C. § 103 as

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being unpatentable over Groves and Schinabeck.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the briefs² and answer for the respective details thereof.

OPINION

We will not sustain the rejection of claims 3, 6, 8, 9 and 12 under 35 U.S.C. § 112, second paragraph, as well as the rejection of claims 1 through 12 under 35 U.S.C. § 103.

Analysis of 35 U.S.C. § 112, second paragraph, should begin with the determination of whether claims set out and circumscribe the particular area with a reasonable degree of precision and particularity; it is here where definiteness of the language must be analyzed, not in a vacuum, but always in light of teachings of the disclosure as it would be interpreted by one possessing ordinary skill in the art. *In re Johnson*, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977), citing *In re Moore*, 439 F. 2d 1232, 1235, 169 USPQ 236, 238 (1971). Furthermore, our

²Appellants filed an appeal brief on October 20, 1994. We will refer to this appeal brief as simply the brief. Appellants filed a reply appeal brief on March 9, 1995. We will refer to this reply appeal brief as the reply brief. The Examiner responded to the reply brief with a letter, mailed April 20, 1995, stating that the reply brief has been entered and considered but no further response by the Examiner is deemed necessary.

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reviewing court points out that a claim which is of such breadth that it reads on subject matter disclosed in the prior art is rejected under 35 U.S.C. § 102 rather than under 35 U.S.C. § 112, second paragraph. See *In re Hyatt*, 708 F.2d 712, 715, 218 USPQ 195, 197 (Fed. Cir. 1983) and *In re Borkowski*, 422 F.2d 904, 909, 164 USPQ 642, 645-46 (CCPA 1970).

On pages 4 and 5 of the answer, the Examiner argues that the term "capable" in Appellants' claims 3, 6 and 12 should be avoided because it is not clear whether or not anything happens. We note that claims 3, 6 and 12 recite "predetermining from known electronic device characteristics a shortest channel length capable of receiving said maximum voltage." On pages 8 and 9 of the specification, Appellants disclose the selection step which determines the maximum voltage to be applied to a device under test. Appellants disclose that the voltage is determined based upon the maximum voltage that the shortest channel length is capable of receiving without damage to the device. In light of the teachings of the disclosure as it would be interpreted by one possessing ordinary skill in the art, we find that the language "predetermining from known electronic device characteristics a

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shortest channel length capable of receiving said maximum voltage" is definite. Therefore, we find that the above quoted Appellants' claim language sets out and circumscribes the particular area with a reasonable degree of precision. In view of the foregoing, we will not sustain the Examiner's decision that Appellants' claims 3, 6, 8, 9 and 12 are properly rejected under 35 U.S.C. § 112, second paragraph.

Turning to the Examiner's rejection of Appellants' claims under 35 U.S.C. § 103, the Examiner has failed to set forth a **prima facie** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. **In re Sernaker**, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." **Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.**, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), **cert. denied**, 117 S.Ct. 80 (1996) **citing W. L. Gore & Assocs., Inc. v.**

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Garlock, Inc., 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), **cert. denied**, 469 U.S. 851 (1984).

The Examiner states on page 6 of the answer that "Groves does not explicitly show the step of controlling the applied voltage as a function of said channel lengths." The Examiner states on the same page that Grove shows the device under test is connected to the test apparatus via various wires. The Examiner further states that the "feature of controlling the applied voltage as a function of the wire lengths is inherent in the operation of the Grove's test apparatus in order for Grove's wire to usually stay in the safe region." On page 12 of the answer, the Examiner argues that Appellants' claimed term "channel" does not exclude the inclusion of the Grove's wire lengths.

Appellants argue on pages 2 through 4 of the reply brief that the Examiner has improperly interpreted "channel length" as recited in Appellants' claims as including a wire length. Appellants argue that the definition of "channel lengths" cannot include wire lengths. Appellants argue that the Appellants' specification, at page 6, defines a channel as "... an end-to-end electrical path through a semiconductor body, for example, a

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field-effect transistor." We note that Appellant's specification at page 6, lines 18-21, recites:

As used herein, channel refers to the end-to-end electrical path through a semiconductor body, for example, a field-effect transistor.

Appellants conclude that since Appellants' specification clearly defines the term "channel" as the end-to-end electrical path through a semiconductor body thereby excluding a metal wire, the invention is not rendered obvious by the wire lengths taught in Groves.

When interpreting a claim, words of the claim are generally given their ordinary and accustomed meaning, unless it appears from the specification or the file history that they were used differently by the inventor. ***Carroll Touch, inc. v. Electro Mechanical Sys., Inc.*** 15 F.3d 1573, 1577, 27 USPQ2d 1836, 1840 (Fed. Cir. 1993). We find that Appellants' specification as well as the file history show that Appellants used the term "channel" to mean the end-to-end electrical path through a semiconductor body. Thus, Appellants' claims distinguish the Grove's wire lengths and the Examiner erred interpreting the Appellants' claims as reading on the Grove's wire lengths. Furthermore, we fail to find that Schinabeck overcomes this deficiency.

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We have not sustained the rejection of claims 3, 6, 8, 9 and 12 under 35 U.S.C. § 112, second paragraph, or the rejection of claims 1 through 12 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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MICHAEL R. FLEMING)	
Administrative Patent Judge)	

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