

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHING-YUH TSAY and HUGH P. MC ADAMS

Appeal No. 1997-0258
Application No. 08/251,052¹

HEARD: November 2, 1999

Before HAIRSTON, RUGGIERO, and HECKER, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-12. Amendments after final rejection filed August 7, 1995, March 29, 1996, and July 12, 1996 were entered by the Examiner. As a result of these amendments, claims 5 and 11 have been canceled and the rejection of claim 6 has been

¹ Application for patent filed May 31, 1994.

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withdrawn by the Examiner. Accordingly, claims 1-4, 7-10, and 12 are before us on appeal.

The claimed invention relates to a power-up detection circuit with a reset feature which resets the detection circuitry after an initial power-up detection signal is produced. More particularly, Appellants indicate at pages 8 and 9 of the specification that this reset circuitry establishes a DC current path to ground to conduct DC current to reset the power-up circuitry to produce a subsequent power-up detection signal.

Claim 1 is illustrative of the invention and reads as follows:

1. A device to produce a first power-up detection signal comprising:

a reference generator circuit for producing a reference voltage;

detection circuit coupled to said reference generator circuit to detect said reference voltage as power is being applied to said device;

power-up circuitry coupled to said detection circuitry to produce said first power-up detection signal based on said reference voltage;

reset circuitry coupled to said power-up circuitry to reset said power-up circuitry by establishing a DC current path from said power-up circuitry to ground to conduct DC

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We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, the arguments in support of the rejections and the evidence of anticipation and obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' 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 Answers.

It is our view, after consideration of the record before us, that claim 12 particularly points out the invention in a manner which complies with 35 U.S.C. § 112, second paragraph. We are also of the view that the disclosure of Hsieh does not fully meet the invention as recited in claims 1 and 7. In addition, it is our conclusion that the 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 set forth in claims 2-4 and 8-10. Accordingly, we reverse.

We consider first the rejection of claim 12 as being indefinite under the second paragraph of 35 U.S.C. § 112.

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The general rule is that a claim must set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure as it would be by the artisan. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed in light of the specification. Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

We note that, although the Examiner indicated on page 2 of the Supplemental Examiner's Answer dated July 25, 1996 that the 35 U.S.C. § 112., second paragraph, rejection of claim 12 was being maintained, the Examiner also indicated that the amendment after final rejection filed along with Appellants' Supplemental Reply Brief on July 12, 1996 was to be entered. This amendment amended the language of claim 12 to be identical with the language of claim 6, the second paragraph of 35 U.S.C. § 112 rejection of which had been previously withdrawn by the Examiner. Notwithstanding the apparent contradiction in the Examiner's treatment of claims 6 and 12

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with regard to the issue of indefiniteness, our independent review of the language of claim 12 reveals no ambiguity or lack of clarity in the claim recitations. It is our view that the skilled artisan, having considered the specification in its entirety, would have no difficulty ascertaining the scope of the invention recited in dependent claim 12. Therefore, the rejection of claim 12 under the second paragraph of 35 U.S.C. § 112 is not sustained.

We now consider the rejection of claims 1 and 7 under 35 U.S.C. § 102(b) as being anticipated by Hsieh.³ Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Assoc, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ

³ The 35 U.S.C. § 102(b) rejection of claims 1 and 7 was set forth as a new ground of rejection in the Examiner's Answer.

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303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to independent claims 1 and 7, the Examiner attempts to read the various limitations on the Hsieh reference (Answer, pages 5-7). Appellants' arguments in response (Reply Brief, page 2) center on the alleged deficiency of Hsieh in disclosing the claimed establishment by the reset circuitry of a DC current path to ground after a first power up detection signal and only after a reference voltage has terminated to enable production of a second power-up detection signal, a feature which appears in all of the independent claims on appeal.

After careful review of the Hsieh reference in light of the arguments of record, we are in agreement with Appellants' stated position in the Briefs. The Examiner, apparently recognizing the lack of any explicit description of a DC current path to ground in the reset circuitry of Hsieh, nonetheless offers the conclusion that, by necessity, Hsieh's AND gate 83 must have pull-down circuitry to pull output node 4E' low by a current path to ground. No support on the record, however, has been presented by the Examiner for this

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conclusion. We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference, common knowledge or capable of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a prima facie case. In re Knapp-Monarch Co., 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); In re Cofer, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966). Further, even assuming arguendo that a DC current path to ground was shown to exist in Hsieh, the Examiner has not shown how such current path would be established according to the conditions set forth in the claims. For the above reasons, we do not sustain the 35 U.S.C. § 102(b) rejection of claims 1 and 7.

We next turn to a consideration of claims 2-4 and 8-10 which the Examiner rejected under 35 U.S.C. § 103. Independent claims 4 and 10 in this group are similar to claims 1 and 7 discussed above but include a further limitation requiring a transistor in the reset circuitry to conduct DC current. Dependent claims 2 (on which claim 3 is dependent) and 8 (on which claim 9 is dependent) also contain this limitation. The Examiner, as the basis for the 35 U.S.C.

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§ 103 rejection, proposes to modify Hsieh by asserting the obviousness to the skilled artisan of providing a transistor in the reset circuitry to conduct DC current. In the Examiner's view, the skilled artisan would have found it obvious to utilize CMOS circuitry in the AND gate of Hsieh since the remainder of Hsieh's circuitry is CMOS. The Examiner concludes (Answer, page 7), therefore, that since AND gates comprising CMOS circuitry which include transistors to conduct DC current are well known, the resulting circuitry would meet the claim limitations.

As with the Examiner's earlier findings regarding the establishment of current path to ground, we find such assertions to be totally lacking of any support on the record. Further, regardless of the merits of the Examiner's position as to the inclusion of transistor circuitry in Hsieh's AND gate 83, we note that each of the independent claims 4 and 10 requires an establishment of a DC current path to ground by the reset circuitry. Our earlier discussion with regard to independent claims 1 and 7 found Hsieh to be lacking in any teaching or suggestion of this feature. Accordingly, we do

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not sustain the Examiner's obviousness rejection of claims 2-4 and 8-10.

Finally, we note that the Examiner's final rejection included claims 1 and 7 in the group of claims rejected under 35 U.S.C. § 103. While the Examiner, in the summary statement on page 2 of the Supplemental Examiner's Answer dated July 25, 1996, did not include claims 1 and 7 in the group of claims rejected under 35 U.S.C. § 103, the obviousness rejection of these claims has not been expressly withdrawn. To the extent that the Examiner maintains the 35 U.S.C. § 103 rejection of claims 1 and 7, this rejection is not sustained. For all of the reasons discussed previously, there is no teaching of the establishment of a DC current path to ground in the reset circuitry of Hsieh as claimed, nor any convincing reasoning supplied by the Examiner as to why it would be obvious to do so. In conclusion, we have not

sustained any of the Examiner's rejections of the claims on appeal. Therefore, the Examiner's decision rejecting claims 1-4, 7-10, and 12 is reversed.

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REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
STUART N. HECKER)	
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APJ HAIRSTON

APJ HECKER

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

Prepared: April 20, 2001

Draft Final

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OB/HD GAU

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