

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 40

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte PATRIZIA MILAZZO, GREGORIO BONTEMPO and ANGELO ALZATI

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Appeal No. 1998-0824  
Application No. 08/621,767

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ON BRIEF

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Before FLEMING, GROSS, and LEVY, *Administrative Patent Judges*.

FLEMING, *Administrative Patent Judge*.

**DECISION ON APPEAL**

This is a decision on appeal under 37 U.S.C. § 134 from the final rejection of claims 1 through 37, all the claims pending in the present application.

The present invention relates to output power stages employing a power switch for connecting to a ground node a load and wherein static power consumption within the driving circuit is substantially eliminated.



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submitted by the Appellants in view of the teachings of Takahashi.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the brief<sup>1</sup> and answer<sup>2</sup> for the respective details thereof.

**OPINION**

We will not sustain the rejection of claims 1 through 37 under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally

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<sup>1</sup> Appellants filed an Appeal Brief on June 18, 1997. Appellants filed a Reply Brief on October 31, 1997. The Examiner mailed an Office Communication on January 16, 1998, stating that the Reply Brief had been entered and considered but no further response by the Examiner is deemed necessary.

<sup>2</sup> The Examiner mailed an Examiner's Answer on September 2, 1997. In response to Remand from the Board, the Examiner mailed a Supplemental Examiner's Answer on May 9, 2001.

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available to one of ordinary skill in the art suggests the claimed subject matter. ***In re Fine***, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. ***Oetiker***, 977 F.2d at 1445, 24 USPQ at 1444. ***See also Piasecki***, 745 F.2d at 1472, 233 USPQ at 788 ("After a ***prima facie*** case of obviousness has been established, the burden of going forward shifts to the applicant.").

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. ***See In re Oetiker***, 977 F.2d at 1445, 24 USPQ at 1444. ("In reviewing the examiner's decision on appeal, the Board must necessarily weigh all of the evidence and arguments."). With these principles in mind, we commence review of the pertinent evidence and arguments of Appellants and Examiner.

The Examiner argues that Appellants' Figure 6 shows all the claimed elements other than the control circuitry electrically coupled to said second current generator and to said output power transistor, said control circuitry being

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connected to prevent passage of the current through the second current generator when the output power transistor is not conducting, said control circuitry being controlled by a voltage at said driving node of said output power transistor. The Examiner argues that Takahashi teaches and discloses the main concept of using an output signal which is an input signal to an associate stage to prevent unnecessary current within a certain section of the circuit when the section is no longer required for operation. The Examiner points us to Figure 5 of Takahashi which shows output N12 of inverter 16 being fed back to control element of transistor 14. See page 5 of the Examiner's Answer. The Examiner argues that it would have been obvious to one skilled in the art to use the basic concepts taught and disclosed by Takahashi to place a transistor/switch in the current path of the second current generator 12 shown in Figure 6 of the prior art submitted by the Appellants. See page 6 of the Examiner's Answer.

Appellants argue that the Examiner initially used impermissibly the Appellants' inventive teachings that the current consumption in the driver circuit may be intolerable for certain applications as the basis for selectively

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modifying the circuit of Figure 6. See page 5 of the Reply Brief. Appellants argue that Takahashi must be viewed for what the patent teaches as a whole and not what portions of Takahashi that the Examiner can selectively choose from the patent to somehow construct Appellants' claimed invention. Appellants point out that Takahashi is a power-on-set circuit and has nothing to do with Appellants' invention of a low-side driver circuit. Appellants submit that there is no proper motivation to combine the circuit of Appellants' Figure 6 with Takahashi in any manner. See Reply Brief, pages 6 and 7.

The Examiner admits that Takahashi discloses a power-on reset circuit and nothing to do with power transistors. See page 3 of the Supplemental Examiner's Answer. The Examiner further argues that Appellants have admitted that the problem of unnecessary current consumption of the prior art Figure 6 circuit was known. The Examiner points us to page 5, lines 18 through 24, for this submission.

The Federal Circuit state that "[t]he 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**

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**re Fritch**, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), **citing In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). It is further established that "[s]uch a suggestion may come . . . from the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem." **Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.**, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), **citing In re Rinehart**, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976) (considering the problem to be solved in a determination of obviousness). The Federal Circuit reasons in **Para-Ordnance Mfg. Inc. v. SGS Importers Int'l Inc.**, 73 F.3d 1085, 1088-89, 37 USPQ2d 1237, 1239-40 (Fed. Cir. 1995), that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop the prior art, would have been reasonably expected to use the solution that is claimed by the Appellants. However, "[o]bviousness may not be established using hindsight or in view of the teachings or suggestions of the invention." **Para-Ordnance Mfg. v. SGS**

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*Importers Int'l*, 73 F.3d at 1087, 37 USPQ2d at 1239, *citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13. In addition, our reviewing court requires the PTO to make specific findings on a suggestion to combine prior art references. *In re Dembiczak*, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

On our review of page 5 of the specification, we find that Appellants have not admitted that the problem of unnecessary current consumption of the prior art Figure 6 was known. We agree that on page 5 of the specification Appellants state that the Figure 6 circuit has a draw back represented by the fact that when the power transistor Pw is off, a certain current consumption occurs. However, we do not find that the Appellants have stated that this fact was known to others. Appellants are simply stating that they have recognized the problem. Furthermore, even if we agreed with the Examiner that somehow this was an admission by the Appellants, there still is no admission that it was known what the source of the problem was or the circuitry to correct the

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problem; all of which is disclosed in later pages of Appellants' specification.

Looking to Takahashi which discloses a disabling circuit for a power-on event, we fail to find that this would lead those skilled in the art to lift the transistor 14 shown in Figure 5 and somehow modify Figure 6 to arrive at Appellants' claimed invention which is shown in Figure 9. Even if we could agree with the Examiner that the basic concept is taught by Takahashi, we fail to find a teaching or suggestion on how to connect the Takahashi transistor 14 into Appellants' Figure 6. We fail to find any suggestion or reason from the admitted prior art, Figure 6, that there is a problem with power consumption of the second current generator. Certainly, there is no suggestion in Takahashi of this problem since Takahashi is dealing with a completely different circuit. Therefore, we find that the only suggestion for making a modification of Appellants' Figure 6 is the Appellants' specification itself. Therefore, we fail to find that the Examiner properly found evidence of reasons or desirability of making the modification in the prior art.

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We have not sustained the rejection of claims 1 through 37 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

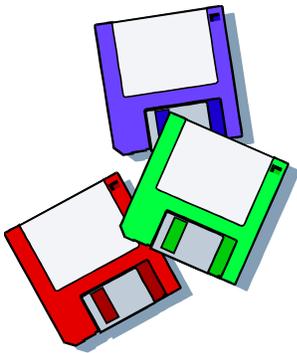
**REVERSED**

MICHAEL R. FLEMING	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
ANITA PELLMAN GROSS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
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	)	
STUART S. LEVY	)	
Administrative Patent Judge	)	

MRF/LBG

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APJ FLEMING

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APJ LEVY

DECISION: REVERSED

Prepared: July 19, 2002

Draft            Final

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PALM / ACTS 2 / BOOK

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