

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIDEYUKI OZAKI

Appeal No. 95-3678
Application 07/545,786¹

HEARD: December 11, 1997

Before THOMAS, JERRY SMITH and TORCZON, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 11, 13 and 14.

¹ Application for patent filed June 29, 1990.

Appeal No. 95-3678
Application 07/545,786

Claims 5, 6 and 12 have been cancelled. The final rejection noted that "[c]laims 2-4, 7-10 and 15 remain withdrawn from further consideration as having already been decided by the Board, Res Judicata" [page 5]. The brief indicates that the appeal is taken with respect to claims 1-4, 7-11 and 13-15 [page 1], whereas the answer indicates that the appeal only involves claims 1, 11, 13 and 14 since "[C]laims 2-4, 7-10 and 15 have already been decided by the Board in their previous decision" [answer, page 1].

The examiner's withdrawal of claims 2-4, 7-10 and 15 from the appeal on the ground of Res Judicata was improper. Res Judicata is a ground of rejection which is subject to review by the Board of Patent Appeals and Interferences. Thus, the examiner's final rejection is tantamount to rejecting claims 2-4, 7-10 and 15 on the ground of Res Judicata, and we will treat these claims as having been so rejected. Accordingly, this appeal is directed to the rejection of claims 1-4, 7-11 and 13-15 as argued by appellant.

The claimed invention pertains to a method and apparatus for controlling a semiconductor memory device. More particularly, the invention is directed to the setting of circuit means for manipulating the data to an active or inactive state

Appeal No. 95-3678
Application 07/545,786

based upon a signal applied to a respective input/output terminal.

Representative claim 1 is reproduced as follows:

1. A semiconductor memory device for storing data comprising plural bits comprising:

a plurality of terminals (I/01 to I/04) for respectively inputting or outputting said data comprising plural bits to corresponding respective groups of memory cells,

a plurality of circuit means (31 to 34) for manipulating data, said circuit means provided in respective correspondence to said plural terminals (I/01 to I/04) and said groups of memory cells, and

setting means (81 to 84; 91 to 94) for fixedly setting one of said plurality of circuit means (31 to 34) corresponding to one of said plurality of terminals to an inactive state while at least another one of said plurality of circuit means corresponding to another of said plurality of terminals remains in an active state,

wherein said setting means is responsive to application of a deactivating signal to said one of said terminals by setting the circuit means respectively corresponding thereto to an inactive state,

wherein said deactivating signal comprises a high voltage applied by a high voltage generating circuit, said high voltage being higher than a predetermined range of an operating voltage.

The examiner relies on the following references:

Kawashima et al. (Kawashima)	4,744,058	May 10, 1988
Shinoda et al. (Shinoda)	4,839,860	June 13, 1989

S. M. Sze, Physics of Semiconductor Devices, Copyright 1981 by John Wiley & Sons, Inc., pages 500-504.

Appeal No. 95-3678
Application 07/545,786

We note that the claims of this application have been the subject of a previous appeal. In the previous appeal, claims 6, 13 and 14 were rejected under 35 U.S.C. § 112, first and second paragraphs, and claims 1-15 were rejected under 35 U.S.C. § 103 as being unpatentable over a patent to Pinkham and Shinoda, cited above. The previous Board decision reversed the rejections of claims 6, 13 and 14 under Section 112 [Paper #31]. The previous Board decision also affirmed the prior art rejection with respect to claims 1-5, 7-11 and 15, but reversed the prior art rejection with respect to claims 6 and 12-14. However, the Board entered a new ground of rejection against claims 6 and 12-14 under 35 U.S.C. § 103 based upon the teachings of Sze and Shinoda. Following the Board decision, an amendment was filed on August 27, 1993 to cancel claims 5, 6 and 12, to amend claims 1-4, 7-11 and 13-15, and to add claims 16-20. This amendment was denied entry because it was not limited to the claims subject to the new ground of rejection made by the Board. Subsequently, another amendment was filed in which claims 5, 6 and 12 were cancelled and only claims 1, 11, 13 and 14 were amended. This amendment has been entered. Claim 1 now incorporates the limitations of cancelled claims 5 and 6. Claim 11 now includes the limitations of cancelled claim 12. Claim 13 was rewritten to be in

Appeal No. 95-3678
Application 07/545,786

independent form, and claim 14 depends from rewritten claim 13. Claims 2-4 and 7-9 depend from newly amended claim 1. Claims 10 and 15 remain unchanged from the claims considered in the previous Board decision.

Claims 2-4, 7-10 and 15 effectively stand rejected on the ground of Res Judicata [note discussion supra]. Claims 1, 11, 13 and 14 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Sze in view of Shinoda and Kawashima.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the obviousness rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's 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 answer.

Appeal No. 95-3678
Application 07/545,786

It is our view, after consideration of the record before us, that claims 2-4 and 7-9 have been improperly rejected on the ground of Res Judicata, although claims 10 and 15 are properly rejected on this ground. We are also of the view that the collective 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 as set forth in claims 1, 11, 13 and 14. Accordingly, we affirm-in-part.

We consider first the rejection of claims 1, 11, 13 and 14 under 35 U.S.C. § 103 as being unpatentable over the teachings of Sze in view of Shinoda and Kawashima. As we noted above, these claims now contain limitations which compelled the Board in the previous decision to reverse the rejection of these claims based on Pinkham and Shinoda, and led the Board to make a new rejection based on Sze and Shinoda. The examiner has applied Sze and Shinoda in exactly the same manner as the Board did in the previous decision and has added Kawashima to allegedly meet the additional recitations of the claims added by amendment after the previous Board decision. Appellant argues that the claims have not been properly interpreted under the last paragraph of 35 U.S.C. § 112 as required by the decision in In re Donaldson, 16 F.3d 1189, 29 USPQ2d 1845, and that when interpreted in the

Appeal No. 95-3678
Application 07/545,786

correct manner, the invention of claims 1, 11, 13 and 14 is not suggested by the applied references.

Although the examiner has argued that the Board considered Donaldson issues in the previous decision, the record in this case does not support this assertion. The court decision in Donaldson was rendered after the Board had rendered its previous decision in this case, and the Board decision does not make any reference whatsoever to the interpretation of the claims in accordance with claims drafted in means plus function form.

Although claims drafted in means plus function format were always interpreted in light of the specification as set forth in the last paragraph of 35 U.S.C. § 112, Donaldson clarified the meaning of the statutory language and how it was to be implemented during the prosecution of applications before the Patent and Trademark Office (PTO). There is no evidence in this case that the claim interpretations mandated by Donaldson have ever been considered by the PTO. On this record, it appears to us that the following two questions must still be answered: (1) what structure should be read into the claims corresponding to the claimed means plus function elements? and (2) does the applied prior art suggest the obviousness of this structure?

Appeal No. 95-3678
Application 07/545,786

Each of independent claims 1, 11 and 13 recites a plurality of circuit means, different from the memory cells per se, which can individually be set to an inactive state based on a deactivating signal. Appellant has presented a convincing argument as to why this circuit means of claims 1, 11 and 13 cannot be met by the state of the memory cells in any of the applied prior art references. The examiner has failed to respond as to how the applied prior art can be interpreted to meet the invention of claims 1, 11 and 13 when they are given the interpretation mandated by the last paragraph of 35 U.S.C. § 112 and Donaldson. The examiner's response is to simply conclude that "the Board is felt to have adequately considered such issues as the 'equivalency of means' in their previous Decision [Answer, page 3]. For reasons we have discussed above, the issue of claim interpretation under 35 U.S.C. § 112 and Donaldson has been properly raised by appellant but has not been considered by the PTO on this record. The examiner is required to make factual showings in response to properly raised Donaldson questions as to how the applied prior art teaches the structure of claimed means or an equivalent thereof. The examiner has made no such factual showings in this case.

Appeal No. 95-3678
Application 07/545,786

Appellant's arguments regarding the proper interpretation of the claims stand essentially unrebutted by the examiner, and we find these unrebutted arguments to be logical, accurate and persuasive. Thus, the invention of claims 1, 11, 13 and 14 should be construed in the manner argued by appellant. Such claim construction has not been considered by the examiner on this record. Since we are of the view that the subject matter of amended claims 1, 11, 13 and 14, when properly interpreted, is directed to an invention which has not been shown to be suggested by the collective teachings of Sze, Shinoda and Kawashima, we conclude that the examiner has failed to support his position that this subject matter would have been obvious to the artisan in view of the applied prior art. Therefore, we do not sustain the rejection of claims 1, 11, 13 and 14 as formulated by the examiner.

We now consider the implicit rejection of claims 2-4, 7-10 and 15 on the ground of Res Judicata. Claims 2-4 and 7-9 depend from claim 1 which was amended after the previous Board decision. The amendment of claim 1 added limitations which were not present in the claims considered by the Board in the previous decision. Thus, claims 2-4 and 7-9 are directed to an invention which was not considered by the Board in the previous decision.

Appeal No. 95-3678
Application 07/545,786

Res Judicata is applicable only when there are no new issues of fact or law to be resolved. Appellant specifically amended previously appealed claim 1 in response to a new ground of rejection made in the previous Board decision. Thus, claim 1 which is now on appeal before us, is not the same claim that was considered in the previous Board decision. Therefore, it is improper to hold that the patentability of claims 2-4 and 7-9, which depend from amended claim 1, is precluded by Res Judicata. See, for example, In re Craig, 411, F.2d 1333, 162 USPQ 157 (CCPA 1969). Therefore, since factual and legal considerations affecting the patentability of claims 2-4 and 7-9 have changed since the previous decision of the Board of Patent Appeals and Interferences, the failure to consider these claims based on the ground of Res Judicata was in error. To the extent that we have considered the examiner's withdrawal of these claims to be a rejection on the ground of Res Judicata, such rejection is reversed.

With respect to claims 10 and 15, these are the same claims that were considered by the Board in the previous decision. Appellant has made no arguments directed to the impropriety of the rejection on Res Judicata as it applies to these claims. Appellant has limited his arguments on this issue

Appeal No. 95-3678
Application 07/545,786

to the dependent claims [brief, page 22]. Appellant's representative at oral hearing confirmed that the arguments on this issue did not include unamended claims 10 and 15. Since claims 10 and 15 are the exact same claims that were considered by the Board in its previous decision, and since appellant has identified no new questions of fact or law which are applicable to these claims, we sustain the rejection on Res Judicata as it applies to claims 10 and 15.

In summary, we have not sustained the examiner's position on Res Judicata with respect to claims 2-4 and 7-9, but we have sustained this rejection with respect to claims 10 and 15. We also have not sustained the examiner's rejection of claims 1, 11, 13 and 14 under 35 U.S.C. § 103. Accordingly, the decision of the examiner rejecting claims 1-4, 7²-11 and 13-15 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR

² Claim 7 depends from canceled claim 5. Appellant has indicated a willingness to change its dependency to claim 1. (Paper 32 at 3, not entered.) Appellant may change the dependency accordingly, pursuant to 37 CFR § 1.196(c).

Appeal No. 95-3678
Application 07/545,786

§ 1.136(a).

AFFIRMED-IN-PART

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JAMES D. THOMAS)	
Administrative Patent Judge)	
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JERRY SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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Appeal No. 95-3678
Application 07/545,786

TORCZON, Administrative Patent Judge, concurring in result.

I do not agree that we can treat the withdrawn claims as rejected. In the interest of administrative economy, however, I would reach exactly the same result as the majority based on the instructions provided in the previous Board decision. (Paper 31 at 11.)

RICHARD TORCZON)
Administrative Patent Judge) BOARD OF PATENT
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Appeal No. 95-3678
Application 07/545,786

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