

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

This opinion (1) was not written for publication and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BERND K.F. KOENEMANN

Appeal No. 95-4603
Application 08/101,641¹

ON BRIEF

Before FLEMING, TORCZON, and CARMICHAEL, Administrative Patent Judges.

TORCZON, Administrative Patent Judge.

DECISION ON APPEAL

BACKGROUND

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1-4, all of the pending claims. We reverse.

The application is entitled "System for test data storage reduction". The subject matter of the invention is directed to a reduced set of test-related data for automatic test

¹ Attorney docket no. P0989020X

equipment for logical circuitry. Claim 4 (emphasis added) is representative of the claims on appeal:

4. A method for testing a digital circuit device, said method comprising the steps of:
 - simulating test results, for a model of a digital circuit to be tested, using simulated test pattern bit streams generated in accordance with a weighted, pseudo-random process having selectable seed values;
 - determining from said simulating step which seed values from a sequence of seed values produce test results which are effective for detecting error conditions in said digital circuit;
 - storing, in a memory element, values which are indicative of which seed values in said sequence are to be skipped as a result of said effectiveness determining step; and
 - applying a weighted, pseudo-random test pattern bit stream to an actual digital circuit device, said test pattern being generated using a reduce seed sequence based upon said skipping indicators in said memory element.

The examiner relied on the following references in combination to reject all of all the pending claims under 35 U.S.C. § 103:

Jacobson	4,715,034	22 Dec. 1987
Eichelberger et al. (Eichelberger)	4,801,870	31 Jan. 1989

According to the examiner, Eichelberger teaches the subject matter of the invention except for the seed-skipping function.

(Paper 4 at 4.) We take this finding as a given in reaching our decision. The examiner finds that Jacobson inherently teaches skipping ineffective seeds. (Paper 14 at 5.)

DISCUSSION

The combination of Jacobson and Eichelberger would not have led a person having ordinary skill in the art to the claimed subject matter. Jacobson teaches the virtue of better-quality seeds, but he also teaches generating these seeds by masking a random source for seed values. (10:9-38.) This teaching is inimical to the claimed invention, which identifies useful seeds from an existing sequence. Assuming, arguendo, that a person having ordinary skill in the art would have combined the references, the combination suggested by the references would not have included seed skipping in the sense taught in the specification and set forth in the claims. Although we are to read claims broadly during prosecution, our reading must be reasonable in light of the claim as a whole and in light of the specification.

DECISION

The examiner's rejection of all of the claims on appeal
is

REVERSED

MICHAEL R. FLEMING)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
RICHARD TORCZON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JAMES T. CARMICHAEL)	
Administrative Patent Judge)	

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