

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte J. PATRICK KAWAMURA

Appeal No. 1997-3936
Application No. 08/449,409

ON BRIEF

Before HAIRSTON, JERRY SMITH, and GROSS, Administrative Patent Judges.

GROSS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 16 and 18, which are all of the claims pending in this application.

Appellant's invention relates to a voltage generator for biasing a semiconductor chip substrate. Claim 13 is illustrative of the claimed invention, and it reads as follows:

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13. A charge pump circuit for providing a plurality of substrate bias voltages, said pump circuit comprising:

a pump switch for supplying a plurality of voltages, wherein levels of said voltages are determined in response to control signals; and

a pump unit including a transfer component, each voltage providing a supply voltage for said pump unit, said pump unit responsive to levels of said plurality of voltages and to an oscillating signal having a determined frequency for providing said plurality of substrate bias voltages.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Alvarez et al. (Alvarez)	5,362,990	Nov.
08, 1994		

Prior art references of record relied upon by the examiner as evidence in rejecting the appealed claims are:

Scade et al. (Scade)	4,843,256	Jun. 27,
1989		
Hirayama et al. (Hirayama)	5,461,338	Oct. 24,
1995		
		(filed Apr. 16, 1993)
Arakawa	5,489,870	Feb. 06,
1996		
		(filed Mar. 17, 1994)

Claims 13 and 18 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.¹

¹ We note that on page 2 of the Answer, the examiner withdrew the rejection of claims 6 through 8 and 14 through 16 under 35 U.S.C. § 112, second paragraph.

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Claims 1 through 16 and 18 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Alvarez.

Reference is made to the Examiner's Answer (Paper No. 13, mailed April 21, 1997) for the examiner's complete reasoning in support of the rejections, and to appellant's Brief (Paper No. 12, filed March 10, 1997)² for appellant's arguments thereagainst.

OPINION

We have carefully considered the claims, the applied prior art reference, and the respective positions articulated by appellant and the examiner. As a consequence of our review, we will affirm the indefiniteness rejection of claims 13 and 18 and reverse the obviousness rejection of claims 1 through 16 and 18.

Regarding claims 13 and 18, appellant presented no arguments in the Brief against the rejection under 35 U.S.C. § 112, second paragraph. Consequently, we will affirm the indefiniteness rejection of claims 13 and 18.

² We note that a Reply Brief was filed as Paper No. 14 on June 26, 1997, but was refused entry by the examiner. Accordingly, we will not consider the Reply Brief in rendering our decision.

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"It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim." In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986); See also Lindemann Maschinenfabrik [GMBH] v. American Hoist and Derrick [Co.], 730 F.2d 1452, 1457, 221 USPQ 481, 485 (Fed. Cir. 1984). Claim 9 recites a method "for providing a plurality of substrate bias voltage levels" and includes a step of "generating a plurality of substrate bias voltage levels" by the substrate charge pump. The examiner, in rejecting claim 9, refers to the circuit disclosed by Alvarez and asserts (Answer, page 4) that "the recited method can be accomplished by the ... circuit to Alvarez et al." However, nowhere does the examiner point to any discussion in Alvarez of generating substrate bias voltages, and we find no such disclosure. Thus, since Alvarez lacks the step of generating a plurality of substrate bias voltage levels, Alvarez cannot anticipate claim 9 or its dependents, claims 10 through 12.

As to claims 1 and 13, claim 1 recites in the preamble, a VBB voltage generator unit "for biasing of the semiconductor chip substrate" and claim 13 recites a charge pump circuit

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"for providing a plurality of substrate bias voltages." The examiner asserts (Answer, page 7) that such claim language "can only be seen to be 'intended use' because such clearly states that the circuit is 'for biasing of the semiconductor chip substrate.'"

We agree that terms in the preamble which merely set forth the intended use for an otherwise old method or device do not differentiate the claimed method or device from those known to the prior art. See In re Pearson, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974). However, in deciding whether such terms are merely intended use, we must "determine whether the preamble breathes life and meaning into the claim, and is incorporated by reference because of language appearing later in the claim, making it a limitation of the claim." General Electric Co. v. Nintendo Co., 179 F.3d 1350, 1361, 50 USPQ2d 1910, 1918 (Fed. Cir. 1999). In the present case, we do not agree that the terms are merely intended use. In the last couple lines of the body of each of claims 1 and 13, the language of providing a plurality of semiconductor substrate bias levels is repeated, therefore making it a limitation of the claim. Since Alvarez fails to disclose providing

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substrate bias levels, we cannot sustain the anticipation rejection of claims 1 and 13 and their dependents, claims 2 through 8, 14, 15, and 18.

Regarding claim 16, the language in question, "for providing a plurality of substrate bias voltages," appears twice in the body of the claim. Therefore, it is a limitation which must be considered and met for the reference to anticipate the claim. As Alvarez has already been found lacking in this regard, we must reverse the anticipation rejection of claim 16.

CONCLUSION

We have affirmed the rejection of claims 13 and 18 under 35 U.S.C. § 112, second paragraph. We have reversed the rejection of claims 1 through 16 and 18 under 35 U.S.C. § 102. Accordingly, the decision of the examiner rejecting claims 1 through 16 and 18 is affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JERRY SMITH)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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