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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOERG BORCHERT, JURIJUS CIZAS,
SHRINATH ESWARAHALLY, MARK STAFFORD, and
RAJAGOPALAN KRISHNAMURTHY

Appeal 2015-004474
Application 12/363,863
Technology Center 2400

Before NORMAN H. BEAMER, JOHN D. HAMANN, and
JOYCE CRAIG, *Administrative Patent Judges*.

CRAIG, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants request rehearing of the August 30, 2016 Decision on Appeal (“Decision”), wherein we affirmed the rejections of claims 1–21 under 35 U.S.C. § 103(a). We have reconsidered the Decision in light of Appellants’ arguments but, for the reasons given below, we are not persuaded we misapprehended or overlooked any points in our Decision.

ANALYSIS

As an initial matter, Appellants are incorrect that the Decision did not address the rejections of claims 4–7, 14, 15, and 17. *See* Req. Reh’g 1, 3.

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The Decision affirmed the Examiner's decision rejecting those claims.
Decision 12.

Rejection of Claims 4 and 14 under 35 U.S.C. § 103(a)

Appellants contend the Decision is incorrect because it overlooked Appellants' arguments regarding the rejections of dependent claims 4 and 14 as obvious over Oesterreicher, Yan, and Swanson. Req. Reh'g 5–6.

Appellants argue:

the Final Office Action fails to make it clear which references are being applied and does not even identify one of the references that is apparently central to the rejections, it is not possible for either the Appellant or the Board to properly review the rejections, and it is impossible for the Appellant to provide a substantive response.

Id. at 5.

Appellants acknowledge that the Examiner in the Answer explained that the prior art was identified correctly in the rejection header, which reads as follows:

Claims 4 and 14 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Oesterreicher et al. U.S. PG-Publication No. (2004/0197073) and Yan et al. U.S. PG-Publication No. (2010/0050241) and in further view of Swanson et al. U.S. PG-Publication No. (2006/0248329).

Id. at 6; *see also* Ans. 2; Final Act. 24.

Appellants further acknowledge that the Examiner explained that the statement “Camarata in combination with Obereiner” in the body of the rejection was a typographical error and should have read “Oesterreicher in combination with Yan.” *Id.* at 6; *see also* Ans. 2. Appellants, however,

presented no additional arguments in the Reply Brief to address the Examiner's rejection in light of the Examiner's clarification.

Now, for the first time in their Request for Rehearing, Appellants argue the Examiner's explanation:

“still fails to address how to interpret the Final Office Action's argument, at page 25, that it would have been obvious ‘to use Swanson's Electronic device configuration management systems and methods with *Camarota's* Programmable logic device with on-chip nonvolatile user memory,’ especially given that nowhere does the Final Office Action contend that either Oesterreicher or Yan disclose a programmable logic device with onchip nonvolatile “user memory.”

Req. Reh'g 6.

These arguments were not presented in the Appeal Brief, nor the Reply Brief, and thus, are waived. It is inappropriate for Appellants to discuss for the first time in a Request for Rehearing matters that could have been raised in the Appeal Brief or Reply Brief. *See* 37 C.F.R. §41.42 (a)(1). “The failure to raise all issues and arguments diligently, in a timely fashion, has consequences.” *Ex parte Borden*, 93 USPQ2d 1473, 1475 (BPAI 2010) (informative decision).

Moreover, we note that claims 4 and 14 depend from independent claims 1 and 11, respectively. App. Br. 22, 24. In rejecting claims 1 and 11, the Examiner made findings directed to the teachings of Oesterreicher with regard to “a partitionable programmable logic device having two or more independently programmable partitions.” Final Act. 20–21. Oesterreicher was identified in the rejection heading (Final Act. 24) and was intended in place of Camarota in the body of the rejection (Ans. 2). Appellants referred

to Oesterreicher's disclosure of a "partitionable PLD" elsewhere in the Appeal Brief. *See, e.g.*, App. Br. 14 (citing Oesterreicher ¶ 81). Thus, although the Examiner made a typographical error, we are not persuaded that Appellants could not "properly review the rejections" or "provide a substantive response" (Req. Reh'g 5) to the Examiner's rejection of claims 4 and 14.

Rejection of Claims 5–7, 15, and 17 under 35 U.S.C. § 103(a)

Appellants contend the Decision is incorrect because it overlooked Appellants' arguments regarding the rejections of dependent claims 5–7, 15, and 17 as obvious over Oesterreicher, Yan, and Gueron. Req. Reh'g 6–7. As they did for the Examiner's rejection of claims 4 and 14, discussed above, Appellants argue "it is impossible for the Appellant to provide a substantive response" to the Examiner's rejection of claims 5–7, 15, and 17. *Id.* at 7.

Appellants acknowledge that the Examiner in the Answer explained that the prior art was identified correctly in the rejection header, which reads as follows:

Claims 5–7 and 15 and 17 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Oesterreicher et al. U.S. PG-Publication No. (2004/0197073) and Yan et al. U.S. PG-Publication No. (2010/0050241) and in further view of Gueron U.S. PG-Publication No. (2008/0104403).

Id. at 7; *see also* Ans. 3; Final Act. 26.

Appellants further acknowledge that the Examiner explained that the statement "Camarata in combination with Obereiner and Kondajeri" in the body of the rejection was a typographical error and should have read "Oesterreicher in combination with Yan and Gueron." *Id.* at 7; *see also* Ans.

3. Appellants, however, presented no additional arguments in the Reply Brief to address the Examiner's rejection in light of the Examiner's clarification.

Now, for the first time in their Request for Rehearing, Appellants argue:

this correction “still fails to address how to interpret the Final Office Action's argument, at page 26, that it would have been obvious “to use Gueron's methods for data authentication with multiple keys with *Camarota's* Programmable logic device with on-chip nonvolatile user memory,” given that nowhere does the Final Office Action contend that either Oesterreicher, Yan, or Gueron disclose a programmable logic device with on-chip nonvolatile “user memory.”

Req. Reh'g 7.

Because these arguments were not presented in the Appeal Brief, nor the Reply Brief, they are waived. *See* 37 C.F.R. §41.52 (a)(1); *Borden*, 93 USPQ2d at 1475.

Moreover, we note that claims 5–7 depend from independent claim 1 and claims 15 and 17 depend from independent claims 11. App. Br. 23, 25. In rejecting claims 1 and 11, the Examiner made findings directed to the teachings of Oesterreicher with regard to “a partitionable programmable logic device having two or more independently programmable partitions.” Final Act. 20–21. Oesterreicher was identified in the rejection heading (Final Act. 26) and was intended in place of *Camarota* in the body of the rejection (Ans. 3). Appellants referred to Oesterreicher's disclosure of a “partitionable PLD” elsewhere in the Appeal Brief. *See, e.g.*, App. Br. 14 (citing Oesterreicher ¶ 81).

Thus, although the Examiner made a typographical error, we are not persuaded that Appellants could not “properly review the rejections” or

“provide a substantive response” (Req. Reh’g 7) to the Examiner’s rejection of claims 5–7, 15, and 17.

Rejection of Claims 1, 11, and 21 under 35 U.S.C. § 103(a)

Appellants contend the Decision is incorrect because it did not consider Appellants’ argument in the Reply Brief shown in italics below because it was belated and therefore waived:

the Final Office Action and the Examiner's Answer are incorrect in asserting that Oesterreicher discloses any particular control of programming of the two or more partitions at all. According to the Examiner's Answer, “Oesterreicher teaches that partitions on a programmable logic device are controlled to be separately reprogrammed.” (Examiner's Answer at p. 7.) This overstates Oesterreicher’s actual teachings, which instead are that “[p]artitionable programmable logic device 720 preferably includes a plurality of partitions, . . . each of which may be separately reprogrammed while the other partitions continue to operate.” (Oesterreicher ¶ 0081.) *Oesterreicher here is not describing control of the reprogramming - rather, if anything, Oesterreicher is teaching that reprogramming of the partitions is uncontrolled, since any given partition can be reprogrammed while other partitions continue to operate.*

Reply Br. 9; Req. Reh’g 10.

In the Final Action, the Examiner found that paragraphs 17 and 81 of Oesterreicher teach or suggest the limitation “control programming of the two or more partitions control operation of and interconnection between the two or more partitions during operation of the programmable logic device,” recited in claim 1. Final Act. 20–21. In particular, the Examiner found:

Oesterreicher, Paragraph 0081, recites “In this embodiment, a digital media delivery pipeline 700 preferably comprises a data path 710 and a partitionable reprogrammable logic device 720. Partitionable programmable logic device 720 preferably includes a plurality of partitions, (e.g., 722, 724, 726) each of which may be separately reprogrammed while the other partitions continue

to operate.” It is interpreted that a plurality of partitions, (e.g., 722, 724, 726) each of which may be separately reprogrammed while the other partitions continue to operate reads on controlling interconnection and operation of the one or more partitions. This is supported by Paragraph 0017 of the Specification).

Final Act. 20–21.

In the Appeal Brief, Appellants argued:

the Final Office Action is factually incorrect with respect to the teachings of Oesterreicher. Oesterreicher teaches only that a partitionable PLD has multiple partitions that can be separately reprogrammed while the other partitions continue to operate. (Oesterreicher ¶ 0081.) Oesterreicher thus describes a particular capability of a PLD, but teaches nothing about the control of programming of the two or more partitions. More particularly, Oesterreicher does not describe a PLD that includes a logic unit having operating instructions that control programming of two or more partitions during operation of the PLD. Thus, the Final Office Action is simply wrong when it finds, at page 20, that Oesterreicher discloses “control programming of the two or more partitions [and] control operation of and interconnection between the two or more partitions during operation of the programmable logic device.”

App. Br. 14.

The Examiner’s explanation in the Answer is substantially the same as the findings in the Final Rejection:

The claim recites “control programming of the two or more partitions and control operation of and interconnection between the two or more partitions during operation of the programmable logic device.” Oesterreicher, Paragraph 0081, recites “In this embodiment, a digital media delivery pipeline 700 preferably comprises a data path 710 and a partitionable reprogrammable logic device 720. Partitionable programmable logic device 720 preferably includes a plurality of partitions, (e.g., 722, 724, 726) each of which may be separately reprogrammed while the other partitions continue to operate.” Oesterreicher teaches that partitions on a programmable logic device are controlled to be

separately reprogrammed, which should read on the claimed limitation of controlling programming of the two or more partitions. Oesterreicher, further teaches that each partition is separately reprogrammed while the partitions continue to operate. By doing so Oesterreicher also teaches controlling the interconnection of its partitions during operation.

Ans. 6–7.

Appellants’ argument in the Reply Brief that Oesterreicher in paragraph 81 is not describing control of the reprogramming, but instead “is teaching that reprogramming of the partitions is uncontrolled, since any given partition can be reprogrammed while other partitions continue to operate” could have been made in the Appeal Brief to rebut the Examiner’s rejection. As explained above, the reply brief is not an opportunity to make arguments for the first time that could have been made in the Appeal Brief, but were not. *Ex Parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010). Thus, Appellants’ new argument is belated.

With respect to whether Appellants have shown good cause for the belated argument, we are not persuaded by Appellants’ assertion that the new argument was “directly responsive to the Examiner’s new arguments in the Examiner’s Answer.” Req. Reh’g 11. Appellants refer to the Examiner’s explanation that, because Oesterreicher teaches the “control programming” limitation, “it would be inherent that the steps of grouping to have two or more partitions and inserting instructions to would have already been performed,” as the Examiner’s new argument. *Id.* at 10. Appellants, however, have not explained how their new argument directed to whether paragraph 81 describes control of the reprogramming is “directly responsive” to the Examiner’s statement in the Answer, and we do not see that it is. Thus, we are not persuaded that Appellants have shown good

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cause to raise the new argument in the Reply Brief. Appellants, therefore, have waived the belated argument.

Additionally, even if Appellants' argument in the Reply Brief had been considered, it would not have persuaded us of Examiner error. Appellants argue in a conclusory manner that Oesterreicher in paragraph 81 teaches that "reprogramming of the partitions is uncontrolled, since any given partition can be reprogrammed while other partitions continue to operate." Appellants, however, present no persuasive explanation or evidence to support their position. *See* Reply Br. 9.

DECISION

Based on the foregoing, we have granted Appellants' request to the extent that we have reconsidered our Decision, but we deny Appellants' request to make any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v).

REHEARING DENIED