

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASANORI KUWAHARA

Appeal No. 2001-2100
Application No. 08/833,302

ON BRIEF

Before FLEMING, RUGGIERO, and SAADAT, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-10, which are all of the claims pending in the present application.

The claimed invention relates to control equipment for an asynchronous transfer mode (ATM) communication system in which a test cell generating circuit is provided within a transmission

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system in the control equipment. Further provided is a loop back circuit which permits test cells generated within the transmission system to be supplied to a receiving system in the control equipment. According to Appellant (specification, pages 6 and 7), since the ATM control equipment provides its own testing functionality, the time and expense of providing dedicated external testing equipment is avoided.

Claim 1 is illustrative of the invention and reads as follows:

1. A communication control equipment used for ATM communication including a transmission system adapted so that data cell sent from an ATM layer control unit is inputted thereto to convert the data cell into frame data to transmit the frame data to transmission line, a receiving system adapted so that the frame data sent from the transmission line is inputted thereto to convert the frame data into data cell to transmit the data cell to the ATM layer control unit, and a loop-back line or circuit for carrying out loop-back of the data cell inputted to the transmission system to deliver the data cell to the receiving system,

wherein the transmission system comprises a transmission cell processing section including:

an idle cell generating circuit for generating and outputting idle cell;

a test cell generating circuit for generating and outputting test cell; and

selector means operative so that when data cell sent from the ATM layer control unit is delivered thereto, the selector means outputs the data cell, when output of test cell is designated and no data cell exists, the selector means outputs

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the test cell which the test cell generating circuit outputs, and when no data cell exists and output of the test cell is not designated, the selector means outputs the idle cell which the idle cell generating circuit outputs.

The Examiner relies on the following prior art:

Takizawa et al. (Takizawa)	5,515,386	May 07, 1996 (filed Sep. 23, 1994)
Yoshimura et al. (Yoshimura)	5,602,826	Feb. 11, 1997 (filed Nov. 30, 1995)

Claims 1-10, all of the appealed claims, stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshimura in view of Takizawa.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs¹ and Answer for the respective details.

OPINION

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

¹ The Appeal Brief was filed October 16, 2000 (Paper No. 17). In response to the Examiner's Answer dated January 2, 2001 (Paper No. 18), a Reply Brief was filed February 8, 2001 (Paper No. 19), which was acknowledged and entered by the Examiner as indicated in the communication dated March 7, 2001 (Paper No. 20).

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Appellant's arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the 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 1-10. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825

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(1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of independent claims 1, 3, 6, and 7 based on the proposed combination of Yoshimura and Takizawa, Appellant asserts that the Examiner has failed to establish a prima facie case of obviousness since all of the limitations of claims 1, 3, 6, and 7 are not taught or suggested by the applied prior art references, either separately or in combination. At pages 11-13 of the Brief, Appellant's arguments focus on the contention that neither Yoshimura nor Takizawa disclose the particular claimed protocol for selecting among data cells, idle cells, and test cells.

After careful review of the applied Yoshimura and Takizawa references, in light of the arguments of record, we are in general agreement with Appellant's position as stated in the Briefs. We note that independent claim 1 sets forth the three

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condition cell selection protocol in the following language
(similar recitations of which appear in the other independent
claims 3, 6, and 7):

... when data cell sent from the ATM layer control unit is delivered thereto, the selector means outputs the data cell, when output of test cell is designated and no data cell exists, the selector means outputs the test cell which the test cell generating circuit outputs, and when no data cell exists and output of the test cell is not designated, the selector means outputs the idle cell which the idle cell generating circuit outputs.

We find no disclosure in the Yoshimura reference, primarily relied on by the Examiner as teaching the claimed selection protocol, that would satisfy the requirements of the appealed claims. In particular, although Yoshimura suggests (e.g., column 3, lines 36-39) that test cells are generated in relation to the timing of idle cells, we find no apparent disclosure in Yoshimura of the generation of idle cells on the condition that no data cell exists and there is no designation of the output of test cells as claimed.

We also agree with Appellant (Reply Brief, pages 2 and 3) that the Examiner has improperly disregarded the claim language directed to the claimed loop-back circuit feature. Our reviewing courts have held that, in assessing patentability of a claimed invention, all the claim limitations must be suggested or taught

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by the prior art. In re Royka, 490 F.2d 981, 984-85, 180 USPQ 580, 582-83 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Further, although the Examiner asserts (Answer, page 6) that the "loop back" language appears only in the claim preamble, we find this to not be the case. Our review of the language of claim 1, for example, reveals that the loop-back circuit is positively recited as one of the elements included in the communication control equipment along with a transmission system and a receiving system.

We also recognize that the Examiner argues that, regardless of whether the "loop back" language is considered a positive recitation, "'loop back' is a well known technique for testing and checking channels." (Answer, page 6). We find, however, no evidence forthcoming from the Examiner that would support such a conclusion. The Examiner must not only make requisite findings, based on the evidence of record, but must also explain the reasoning by which the findings are deemed to support the conclusion of obviousness. See In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002).

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We have also reviewed the Takizawa reference which is applied by the Examiner to supply a teaching of the use of an idle cell generating circuit for generating idle cells. We find nothing, however, in the disclosure of Takizawa that would overcome the deficiencies of Yoshimura discussed supra.

In view of the above discussion, it is our view that, since all of the limitations of the appealed claims are not taught or suggested by the applied prior art Yoshimura and Takizawa references, the Examiner has not established a prima facie case of obviousness. Accordingly, the 35 U.S.C. § 103(a) rejection of independent claims 1, 3, 6, and 7, as well as claims 2, 4, 5, and 8-10 dependent thereon, is not sustained.

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In conclusion, we have not sustained the Examiner's 35 U.S.C. § 103(a) rejection of any of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-10 is reversed.

REVERSED

MICHAEL R. FLEMING)
Administrative Patent Judge))
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JOSEPH F. RUGGIERO) BOARD OF PATENT
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