

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JAMES E. TOGA

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Appeal No. 2003-0425  
Application 08/773,692

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ON BRIEF

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Before JERRY SMITH, BARRETT, and RUGGIERO, 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 rejection of claims 1, 3, 4, 6, 8-23 and 25-29, which constitute all the claims remaining in the application. The disclosed invention pertains to a method of controlling data transfers between a first and a second computer network. The invention restricts access to certain resources within the first

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and second computer networks based on the type of communication protocol being used and the type of protocol commands exchanged between the first and second computer networks, wherein restricting access is determined dynamically based on environmental changes.

Representative claim 1 is reproduced as follows:

1. A method of controlling data transfers between a first and a second computer network, the method comprising:

monitoring protocol commands by a proxy coupled between the first and second computer networks;

interpreting protocol commands exchanged between the first and second computer networks;

determining the type of protocol being used; and

restricting access to certain resources within the first and second computer networks based on the type of communications protocol being used and the type of protocol commands exchanged between the first and second computer networks, wherein restricting access is determined dynamically based on environmental changes.

The examiner relies on the following references:

Baker et al. (Baker)	5,678,041	Oct. 14, 1997 (filed Aug. 25, 1995)
Shwed et al. (Shwed)	5,835,726	Nov. 10, 1998 (filed June 17, 1996)
Dascalu	5,958,015	Sep. 28, 1999 (filed Oct. 29, 1996)

Claims 1, 3, 4, 6, 8-23 and 25-29 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers

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Baker in view of Dascalu with respect to claims 1, 3, 4, 6, 8, 19, 22, 23 and 25-29, and Shwed is added to this combination with respect to claims 9-18, 20 and 21.

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 rejections. 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.

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 the claims on appeal. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to

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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 (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). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of

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the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 1.192(a)].

We consider first the rejection of claims 1, 3, 4, 6, 8, 19, 22, 23 and 25-29 based on the teachings of Baker and Dascalu. Claims 1, 4, 6, 8 and 19 stand or fall together as a first group [brief, page 3], and we will consider independent claim 1 as the representative claim for this group. With respect to representative claim 1, the examiner essentially finds that Baker teaches the claimed invention except that Baker does not teach restricting access based on the determination of the type of protocol. The examiner finds that restricting access to specific clients, resources and protocols is well known in the art as disclosed by Dascalu. The examiner finds that it would have been obvious to the artisan to restrict access based on the type of protocol being used [answer, pages 3-4].

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Appellant argues that neither Baker nor Dascalu teaches restricting access to certain resources based on (1) the type of communication protocol and (2) the type of protocol commands exchanged between the first and second networks. Appellant also argues that neither Baker nor Dascalu teaches that restricting access is dynamically based on environmental changes. Appellant argues that the examiner has failed to provide a proper motivation for combining the teachings of Baker and Dascalu [brief, pages 7-13].

The examiner responds that Baker teaches restricting access based on protocol and that Baker teaches dynamic restricting such as restrictions based on certain resources, ratings and time of day. The examiner also responds that protocol commands are associated with protocols and are inseparable. Thus, the examiner finds that restricting access based on protocols necessarily includes the associated protocol commands [answer, pages 11-13].

Appellant responds that restricting access based on determination of a specific protocol as taught by Dascalu does not include restricting access based on protocol commands as claimed. Appellant argues that the examiner's findings are tantamount to a reliance on inherency which is improper [reply brief].

We will not sustain the examiner's rejection of independent claim 1 or of dependent claims 4, 6, 8 and 19 which are grouped with claim 1. The examiner has failed to establish a prima facie case of obviousness because the examiner has failed to properly consider all the limitations of the claimed invention.

Specifically, we agree with appellant that the suggestion in Dascalu that access can be restricted based on the type of communication protocol being used does not, by itself, suggest that access is also restricted based on the protocol commands. The suggestion in Dascalu is that as long as the protocol is acceptable, then the access will be permitted. The claimed invention, however, can restrict access even though the protocol is acceptable if the command within the protocol is not acceptable. The examiner's failure to treat the access limitation based on protocol commands as a separate requirement results in the examiner having failed to consider all the limitations of the claimed invention. While we cannot say whether there is prior art which teaches restricting network access based on both the type of communications protocol and the type of protocol commands, we can say that the prior art relied on by the examiner fails to support the examiner's findings.

Although appellant has argued the appealed claims in eight different groups, each of independent claims 9, 14, 22 and 25

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contains limitations similar to independent claim 1. Therefore, the evidence relied on by the examiner fails to support the rejection of these claims for the same reasons discussed above with respect to claim 1. Although independent claims 9 and 14 were rejected using the additional teachings of Shwed, Shwed does not overcome the deficiencies in the basic combination of Baker and Dascalu discussed above.

In summary, we have not sustained either of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1, 3, 4, 6, 8-23 and 25-29 is reversed.

REVERSED

JERRY SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
LEE E. BARRETT	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
JOSEPH F. RUGGIERO	)	
Administrative Patent Judge	)	

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