

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AMOL MITRA

Appeal No. 2003-0481
Application No. 09/222,388

ON BRIEF

Before JERRY SMITH, FLEMING, and NAPPI, Administrative Patent Judges.

NAPPI, 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 through 7.

The Invention

The invention relates to a method to automatically determine the number of an IPX network number. The method includes a step where when a device which needs the network boots up, the device acts as a passive listener to the network, listening to

the network for an IPX packet that contains a predetermined address. Typically, networks contain broadcasts of the predetermined address every 60 seconds, see appellant's specification page 2. When the device locates the IPX packet with the predetermined address it extracts the network number from the packet, see appellant's specification page 3.

Claim 1 is representative of the invention.

1. A method of discovering an internet protocol exchange (IPX) network number of a network, the network communicating packets, the packets including a source and a destination address, the method comprising the steps of:

initiating a passive listener to locate an IPX packet containing a predetermined destination address;

locating said IPX packet containing said predetermined destination address;

determining whether said IPX packet is broadcast with a specific type of protocol;
and

extracting the network number from said IPX packet if an IPX header source network number equals an IPX header destination number and the network number is not zero.

References

Terry	6,061,356	May 9, 2000 (filed Nov. 25, 1996)
Kotchey et al. (Kotchey)	5,805,594	September 8, 1998

Rejections at Issue

Claims 1 through 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kotchey and Terry.¹

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 briefs² 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 claims 1 through 7. Accordingly, we reverse.

Appellant argues on page 7 of the brief that claim 1 contains the limitation of "initiating a passive listener to locate an IPX packet" and that neither Kotchey or Terry teach this limitation.

¹ The answer, on page 3, identifies that the rejection of claims 4 and 7 under 35 U.S.C. § 112, first paragraph has been withdrawn.

²This decision is based upon the Appeal Brief received August 12, 2002 (certified as being mailed on August 5, 2002 in accordance with 37 C.F.R. §1.8(a)) and the Reply Brief received November 18, 2002 (certified as being mailed on November 12, 2002 in accordance with 37 C.F.R. §1.8(a)).

Before we consider the teachings of the prior art we must first determine the scope of the claim. Claims will be given their broadest reasonable interpretation consistent with the specification, limitations appearing in the specification will not be read into the claims. *In re Etter* 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985). In analyzing the scope of the claim, office personnel must rely on the appellant's disclosure to properly determine the meaning of the terms used in the claims. *Markman v. Westview Instruments*, 52 F.3d 967, 980, 34 USPQ2d 1321 (1996). “[I]nterpreting what is *meant* by a word in a claim ‘is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.’” (emphasis original) *In re Cruciferous Sprout Litigation* 301 F.3d 1343, 1348, 64 USPQ2d 1202, 1205, (Fed. Cir. 2002) (citing *Intervet America Inc v. Kee-Vet Laboratories Inc.* 12 USPQ2d 1474, 1476 (Fed. Cir. 1989)). “[T]he terms used in the claims bear a “heavy presumption” that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art.” *Tex Digital Sys, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002). “Moreover, the intrinsic record also must be examined in every case to determine whether the presumption of ordinary and customary meaning is rebutted.” (citation omitted). “Indeed, the intrinsic record may show that the specification uses the words in a manner clearly inconsistent with the ordinary meaning reflected, for example, in a dictionary definition. In such a case, the inconsistent dictionary definition must be

rejected.” *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d at 1204, 64 USPQ2d at 1819 (Fed. Cir. 2002).

Claims 1 and 7 contain the limitation of “initiating a passive listener to locate an IPX packet.” Appellant’s specification does not provide a definition of what is meant by a “passive listener.” The plain meaning of “passive” is “not participating actively” and the plain meaning of “Listen” is “to heed or pay attention to what is said.”³ These definitions are consistent with the description in the appellant’s specification on page 2 lines 18-20 which states “[a]s a passive listener, the client listens on a network to discover an IPX packet.” We note that the appellant’s description of the “passive listener” includes no steps which are active in contrast to “forced auto discovery mechanism” which is described on page 3 of appellant’s specification as being an active discovery mechanism which generates a query to the network. Thus, we find that the scope of claim 1 includes a method step of passively, or non-actively paying attention to the communications on the network to locate an IPX packet.

Having determined the scope of the relative portions of the claims we next turn to the rejection based upon 35 U.S.C. § 103. It is the burden of the examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by the implication contained in such teachings or suggestions. **In re Sernaker** 702 F2d 989,

³ Definition taken from the Random House College Dictionary, Revised Edition, 1982.

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995, 217 USPQ 1,6 (Fed. Cir. 1983). “Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable ‘heart’ of the invention.” **Para-Ordnance MFG. v. SGS Importers Int’l Inc.**, 73 F3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) (citing **W.L. Gore & Assocs., Inc. v. Garlock, Inc.**, 721 F2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)).

The examiner states on page 4 of the answer that Kotchey teaches:

Initiating an automatic query discovery mechanism comprising means for generating a requested signal... with an IPX number of zero as the source and destination... to determine client’s... network number accuracy.

where said query initiating client listening and waiting to locate an IPX reply packet containing a predetermined destination address.

Further, on page 6 of the answer, in response to appellant’s arguments that the step of “initiating a passive listener” is not taught by Kotchey, the examiner states:

It is noted that the features upon which applicant relies (i.e., “initiating a passive listener to locate an IPX packet containing a predetermined destination address eliminating the operation of issuing a RIP general request...” are not recited in the claims.

We concur with the examiner that there is no limitation in the claims specifically directed to eliminating an RIP request. However, claims 1 and 7 clearly call for passive listening which does necessarily preclude any active steps to determine the network number.

The examiner states, on page 4 of the answer, that Kotchey initiates a query and then

listens for the reply. We find this query, prior to listening, is an active step and accordingly we find that Kotchey does not teach the claimed limitation of a “passive listener.”

The examiner has not asserted that Terry teaches the limitation of “initiating a passive listener.” Nor do we find that Terry teaches the claimed step of “initiating a passive listener.”

Thus, we find that neither Kotchey or Terry teach the claimed step of “initiating a passive listener.” We note: the issue before us is whether the references teach the limitation of a “passive listener”, the question of whether, passive listening would have been obvious to one of ordinary skill in the art, is not before us, nor has the examiner presented evidence that it would be an obvious modification of the prior art reference.

In view of the forgoing we will not sustain the rejection of claims 1 through 7 under 35 U.S.C. § 103. Therefore, the decision of the examiner rejecting claims 1 through 7 is reversed.

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Reversed

JERRY SMITH
Administrative Patent Judge

MICHAEL R. FLEMING
Administrative Patent Judge

ROBERT NAPPI
Administrative Patent Judge

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