

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ERIK P. STAATS

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Appeal No. 2003-1539  
Application No. 09/027,400

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ON BRIEF

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Before HAIRSTON, KRASS and BLANKENSHIP, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1, 2, 8-10, 16-18 and 24-33.

The invention is directed to the computation of a speed map for an IEEE-1394 Network.

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Representative independent claim 1 is reproduced as follows:

1. A method of computing a speed map for a digital network, comprising:

determining whether or not a first speed between a first node and a second node of the digital network is already computed, the second node being on a network path between the first node and a third node of the digital network; and

computing a second speed between the first node and the third node of the digital network using the first speed.

The examiner relies on appellant's admitted prior art [APA] at page 3, line 26 through page 4, lines 1-3.

Claims 1, 2, 8-10, 16-18 and 24-33 stand rejected under 35 U.S.C. § 103 as unpatentable over APA.

Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

#### OPINION

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under § 103, the examiner must produce a factual basis supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a

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prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The examiner must not only identify the elements in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

The question of obviousness is "based on underlying factual determinations including...what th[e] prior art teaches explicitly and inherently..." In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (citing Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); In re Dembiczak, 175 F.3d 994, 998, 50 USPQ 1614, 1616 (Fed. Cir. 1999); In re Napier, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995)).

Moreover, "[d]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" In re Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697 (Fed. Cir. 2001). Furthermore, "the Board's findings must extend to all material facts and must be documented on the record, lest the 'haze of so-called expertise' acquire

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insulation from accountability." In re Lee, 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

With these principles of law in mind, we turn to the examiner's rejection and rationale therefor.

The examiner points to the following statement at pages 3-4 of the instant specification:

According to the IEEE 1394 Serial Bus Standard, the speed map is an array of vectors, where each vector entry indicates the maximum data transfer rate supported between two nodes. The IEEE 1394 Serial Bus Standard specifies a format for a SPEED\_MAP register but does not specify how the bus manager is to compute the vector entries for the speed map.

From this APA disclosure, the examiner concludes that skilled artisans

would have been motivated to use the mathematical skills that they have acquired through many years of schooling and work experience to compute the vector entries for the speed map since the IEEE 1394 Standard does not specify a particular mathematical method to be used (Paper No. 12-page 2).

It is clear from the instant claim language that the claims are directed to the use of a recursive algorithm for computing vector entries of a speed map. It is also clear from the examiner's rationale that the examiner does not have any evidence of such a recursive algorithm being used by the prior art to

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compute vector entries of a speed map.

The examiner's cavalier attitude that somehow the artisan would have been motivated to "apply known mathematical techniques" (answer-page 4) to solve a particular problem, viz., the implementation of the Standard, is not persuasive in view of the lack of any supporting evidence, whatsoever, that recursive algorithms have been employed for computing vector entries of a speed map.

The best that can be said about the examiner's rationale is that the examiner may have a point about mathematical skills being required to compute a speed map of the IEEE Standard. However, since there is nothing in that Standard, or in APA, which teaches or suggests exactly how such a computation should be made, it cannot be reasonably contended that the artisan would have been led to use a recursive algorithm, as claimed.

The examiner has clearly engaged in impermissible hindsight in finding that it would have been obvious to use a recursive algorithm for computing vector entries of a speed map when there are no underlying factual determinations which can be gleaned from any specified prior art that would support the examiner's conclusion.

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The examiner's decision rejecting claims 1, 2, 8-10, 16-18  
and 24-33 under 35 U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	
ERROL A. KRASS	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
HOWARD B. BLANKENSHIP	)	
Administrative Patent Judge	)	

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