

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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte LARRY SWIFT, TED N. MAWHINNEY  
and RICK SILVA

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Appeal No. 2004-0505  
Application No. 09/338,812

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ON BRIEF

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Before KRASS, JERRY SMITH, and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the Examiner's rejection of claims 1, 3-7, 9-13, and 15-24, which are all of the claims pending in the present application. Claims 2, 8, and 14 have been canceled. An amendment filed December 17, 2002 after final rejection has been approved for entry by the Examiner.

The claimed invention relates to a system and method for automatically assessing the data transmission performance of a communications network. Information regarding a user's tolerance for data lost by the network along with historical information related to the performance of a plurality of network parameters is obtained. The historical information is automatically analyzed in view of the user's tolerances and a recommendation to change the committed information rate (CIR) of the communication network to a specific value based on the analysis is calculated and displayed to the user.

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

1. A system for automatically assessing the data transmission performance of a communication network having at least two communication devices and a network management system, the system comprising:

means for obtaining information regarding a user's tolerance for data lost by the network;

means for retrieving historical information regarding a plurality of network performance parameters, said historical information being collected and stored by the network management system;

means for analyzing said tolerance information and said historical information;

means for calculating a recommendation to change the committed information rate (CIR) of the communication network to a specific value based on the analysis of the analyzing means; and

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means for displaying said analysis and recommendation to the user.

The Examiner relies on the following prior art:

Riggan et al. (Riggan)	5,898,673	Apr. 27, 1999
Waclawsky et al. (Waclawsky)	5,974,457	Oct. 26, 1999
		(filed Dec. 23, 1993)

Claims 1, 3-7, 9-13, and 15-24, all of the appealed claims, stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Riggan in view of Waclawsky.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs<sup>1</sup> and the Answer for the respective details.

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner 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, Appellants' arguments set forth in the Briefs along with

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<sup>1</sup> The Appeal Brief was filed April 29, 2003 (Paper No. 11). In response to the Examiner's Answer mailed July 30, 2003 (Paper No. 13), a Reply Brief was filed September 3, 2003 (Paper No. 14), which was acknowledged and entered by the Examiner in the communication dated September 30, 2003 (Paper No. 15).

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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 recited in claims 1, 3-7, 9-13, and 15-24. 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 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.,

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776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 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 appealed independent claims 1, 7, and 13, Appellants assert that the Examiner has failed to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by any of the applied prior art references. In particular, Appellants contend (Brief, page 7; Reply Brief, page 12) that none of the applied prior art references teaches or suggests adjusting the communication rate (CIR) of a communications network to a specific value, a feature appearing in each of the appealed independent claims. Appellants conclude that, with this asserted deficiency in the applied references, the references even if combined would not result in the invention as claimed.

After reviewing the arguments of record from Appellants and the Examiner, we are in general agreement with Appellants' position as stated in the Briefs. We find nothing in either of the applied

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of the applied Riggan and Waclawsky references which discloses the changing of the explicitly claimed communication information rate (CIR) network parameter to a specific value. While the Examiner has apparently asserted correspondence between the claimed invention and Waclawsky's disclosure of controlling various network communication parameters (e.g., column 7, line 62 through column 8, lines 1-6) to bring them into line with determined normal network behavior, we find no indication from the Examiner as to how the control of any of these various parameters would satisfy the claimed limitation which recites a specific network parameter, i.e., communication information rate, adjusted to a specific value. 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 asserted conclusion. See In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002). In our view, Waclawsky, at best, describes the adjusting of various communication parameters to unspecified values in an unspecified manner, which falls well short of the claimed changing of a specific parameter (communication information rate) to a specified value.

In summary, since all of the claim limitations are not taught or suggested by the applied prior art, it is our opinion that the

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Examiner has not established a prima facie case of obviousness with respect to the claims on appeal. Accordingly, we do not sustain the Examiner's 35 U.S.C. § 103(a) rejection of appealed independent claims 1, 7, and 13, nor of claims 3-6, 9-12, and 15-24 dependent thereon. Therefore, the Examiner's decision rejecting claims 1, 3-7, 9-13, and 15-24 is reversed.

REVERSED

ERROL A. KRASS	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
JERRY SMITH	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
JOSEPH F. RUGGIERO	)	
Administrative Patent Judge	)	

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