

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HERMAN RODRIGUEZ, JAMES NEWTON SMITH  
and CLIFFORD JAY SPINAC

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Appeal No. 2004-0716  
Application No. 09/544,275

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ON BRIEF

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Before HAIRSTON, DIXON, and LEVY, Administrative Patent Judges.  
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-18, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to the reduction of transmission bandwidth by providing a minimum bandwidth state during an on-hold condition. An understanding of the invention

can be derived from a reading of exemplary claim 1, which is reproduced as follows:

1. In a telecommunications system providing communication channels for the transmission of data between system stations, a setup for reducing transmission bandwidth use comprising:

means for connecting a plurality of stations through said communication channels;

means for providing an active state for at least one of said connecting channels granting maximum bandwidth for the transmission of data;

means for detecting an on-hold condition in said connecting channel; and

means responsive to a detection of on-hold, for providing a minimal activity state for said connecting channel granting a minimal bandwidth.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Sawyer	5,828,737	Oct. 27, 1998
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Brakefield et al. (Brakefield)	6,047,006	Apr. 4, 2000
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Claims 1-3, 6-8, 11-14 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sawyer.

Claims 4, 5, 9, 10, 15, 16 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sawyer in view of Brakefield.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 7, mailed August 25, 2003) for the examiner's complete reasoning in support of the rejections, and to appellants' brief (Paper No. 6, filed June 16, 2003) for appellants' arguments thereagainst. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered. See 37 CFR 1.192(a).

#### OPINION

In reaching our decision in this appeal, 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, appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer. Upon consideration of the record before us, we reverse, essentially for the reasons set forth by the appellants.

We note at the outset that appellants assert (brief, page 4) that claims 1-16 stand or fall together and that claims 17 and 18 form a separate group which stand or fall together. Because appellants are entitled procedurally to review of at least one claim for each ground of rejection, we select claim 1 as representative of the group of claims rejected over Sawyer, and select claim 18 as representative of the claims rejected over Sawyer in view of Brakefield.

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. 1988); Ashland Oil, Inc. v. Delta Resins &

Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); 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 the evidence as a whole. 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).

Turning to claim 1, the examiner's position (answer, pages 3-5) is that Sawyer teaches all the limitations of claim 1, including the limitation of detecting an on-hold condition, and means responsive to the detection of an on-hold condition. The examiner argues that because Sawyer discloses providing minimal bandwidth when the parties to a call are silent, detecting an on-hold condition and providing a minimal bandwidth during periods of on-hold would have been obvious to one of ordinary skill in the art. The examiner also argues (answer, page 9) that because

Sawyer discloses that bandwidth varies during a call, relatively little bandwidth used during times of silence and more during times of packets transmission, this teaches the limitations of minimal and active activity states, respectively.

Appellants assert (brief, page 5) that the only aspect of Sawyer in common with the appellants' system is that Sawyer "recognizes and addresses the problem of billing the user at maximum bandwidth rates irrespective of actual usage".

Appellants further assert that Sawyer does not: (a) suggest that the bandwidth levels are distinct states, (b) detect on hold-conditions, or c) switch to a minimum activity state on detection of an on-hold condition. Appellants further argue (brief, page 6) that an artisan would not have equated silent periods with an on-hold condition.

We begin our analysis with claim interpretation. Before addressing the examiner's rejections based upon prior art, it is an essential prerequisite that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. See Smithkline

Diagnosics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988). Accordingly, we will initially direct our attention to appellants' claim 1 to derive an understanding of the scope and content thereof.

Before turning to the proper construction of the claim, it is important to review some basic principles of claim construction. First, and most important, the language of the claim defines the scope of the protected invention. Yale Lock Mfg. Co. v. Greenleaf, 117 U.S. 554, 559 (1886) ("The scope of letters patent must be limited to the invention covered by the claim, and while the claim may be illustrated it cannot be enlarged by language used in other parts of the specification."); Autogiro Co. of Am. v. United States, 384 F.2d 391, 396, 155 USPQ 697, 701 (Ct. Cl. 1967) ("Courts can neither broaden nor narrow the claims to give the patentee something different than what he has set forth [in the claim]."). See also Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U.S. 405, 419 (1908); Cimiotti Unhairing Co. v. American Fur Ref. Co., 198 U.S. 399, 410 (1905). Accordingly, "resort must be had in the first instance to the words of the claim" and words "will be given their ordinary and accustomed meaning, unless it appears that the inventor used them differently." Envirotech Corp. v. Al George, Inc., 730 F.2d 753,

759, 221 USPQ 473, 477 (Fed. Cir. 1984). Second, it is equally "fundamental that claims are to be construed in the light of the specification and both are to be read with a view to ascertaining the invention." United States v. Adams, 383 U.S. 39, 49, 148 USPQ 479, 482 (1966).

Furthermore, the general claim construction principle that limitations found only in the specification of a patent or patent application should not be imported or read into a claim must be followed. See In re Priest, 582 F.2d 33, 37, 199 USPQ 11, 15 (CCPA 1978). One must be careful not to confuse impermissible imputing of limitations from the specification into a claim with the proper reference to the specification to determine the meaning of a particular word or phrase recited in a claim. See E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1433, 7 USPQ2d 1129, 1131 (Fed. Cir.), cert. denied, 488 U.S. 986 (1988).

What we are dealing with in this case is the construction of the limitations recited in the appealed claims. As stated by the court in In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) "[t]he name of the game is the claim." Claims will be given their broadest reasonable interpretation consistent with the specification, and limitations appearing in

the specification are not to be read into the claims. In re Etter, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985).

We find that the claim language of claim 1 encompasses two distinct states of operation, an active state where a maximum bandwidth is granted for transmitting data, and a minimal activity state that grants a minimal bandwidth when the station is on-hold.

Sawyer discloses a system for monitoring bandwidth usage in a telecommunication system by measuring the amount of bandwidth through periodic instantaneous bandwidth measurements (col. 2, lines 12-14). In the system of Sawyer, the bandwidth use varies during the course of a call (col. 1, lines 56-57). Little bandwidth is needed during times of silence (col. 1, lines 62-63) or to maintain the communication over the communications link when packets are not being transmitted (col. 4, lines 41-45), while a greater amount is needed when packets are being transmitted (col. 4, lines 17-21). Sawyer measures this amount of bandwidth use through periodic instantaneous measurements (col. 2, lines 12-14). These periodic measurements are used to determine the maximum amount of bandwidth used during a predetermined time interval (col. 5, lines 36-42). A periodic instantaneous measurement made during a time interval is labeled

$T_m$  (col.6, line 22), if this is greater than the current maximum that has been measured for this interval ( $T_{max}$ ), then  $T_{max}$  is set to  $T_m$  (col. 6, lines 24-28). At the end of the communication, these  $T_{max}$  amounts for each interval are summed to arrive at the total bandwidth used (col. 6, lines 47-54).

From our review of Sawyer, we agree with the examiner (answer, page 3-4) that Sawyer teaches a telecommunications system providing a means for connecting a plurality of stations through communication channels. We also agree with the examiner, based on the disclosure of Sawyer regarding the minimal amount of bandwidth needed during times of silence, that Sawyer teaches a means for detecting an on-hold condition in the connecting channels, and means responsive to the detection of an on-hold condition.

However, we disagree with the examiner that Sawyer teaches a bandwidth monitoring system with two distinct states, an active state that grants a maximum bandwidth, and a minimal activity state that grants a minimal bandwidth. Although Sawyer discloses that bandwidth use will vary from a small or minimal amount to larger amounts, we find these are not recognized as distinct states. The use of two distinct states allows the appellants

system to simplify the monitoring of bandwidth usage (See specification page 4, lines 24-31 and page 5, lines 1-6).

From all of the above we find that Sawyer does not disclose an active state that grants a maximum bandwidth, and a minimal activity state that grants a minimal bandwidth. We therefore find that the examiner has failed to establish a prima facie case of obviousness of claim 1. Accordingly the rejection of claim 1, and claims 2, 3, 6-8, 11-14 and 17, which stand or fall with claim 1, under 35 U.S.C. § 103(a) is reversed.

We turn next to claim 18. The examiner's position (answer, page 6) is that Brakefield discloses means for detecting the end of an on hold condition, and that it would have been obvious to one of ordinary skill in the art at the time of the invention, to modify the teachings of Brakefield with the teachings of Sawyer.

Appellants argue (brief, page 8) that Sawyer does not disclose an on-hold condition, let alone detecting the beginning or ending of such a condition. Appellants further argue that there would have been no motivation to combine Sawyer with Brakefield, because Brakefield is directed toward allocating bandwidth, not for commencing or ending a minimum or high activity state.

Brakefield discloses a system for dynamically allocating bandwidth between a data and an audio device connected to the same communications line (col. 1, lines 11-15). This dynamic allocation is done at various times, including when an on-hold condition is detected on the audio device (col. 10, lines 21-31). The end of the on-hold condition can be detected by monitoring the communication line for a signal (cols. 7-8, lines 61-67 and lines 1-2).

From our review of Brakefield, we agree with the Examiner (answer, page 6) that the reference teaches a means for detecting the end of an on-hold condition. However, because Brakefield does not teach or suggest the two claimed states, we find that Brakefield does not make up for the deficiencies of Sawyer. Accordingly, the rejection of claim 18, and claims 4, 5, 9, 10, 15 and 16, which stand or fall with claim 18, under 35 U.S.C. § 103(a) is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-18 under 35 U.S.C. § 103(a) is reversed.

Reversed

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JOSEPH L. DIXON	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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STUART S. LEVY	)	
Administrative Patent Judge	)	

Appeal No. 2004-0716  
Application No. 09544,275

Page 14

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