

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

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ADAM BELESIMO

Appeal No. 2005-2560
Application No. 10/123,447

ON BRIEF

Before RUGGIERO, DIXON, and GROSS, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-12, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

Appellant's invention relates to a testing assembly and method for identifying network circuits. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. An apparatus for identifying at least one cable in a cabling system, said cable having a first end and a second end remote from said first end, said cable containing at least a first and second conductive wire, said apparatus comprising:

a patch panel having at least one patch jack, said patch jack in electrical communication with said at least first and second conductive wires in said first end of said cable;

at least one indicator lamp, permanently installed in said patch panel adjacent to said patch jack, said indicator lamp having a first electrical lead in electrical communication with said first conductive wire and a second electrical lead in electrical communication with said second conductive wire;

at least one wall jack in electrical communication with said at least first and second conductive wires in said second end of said at least one cable; and

means for applying a test voltage to said at least one wall jack,

whereby the applied test voltage at said at least one wall jack causes said indicator lamp adjacent to said patch jack to light, when the patch jack is electrically connected to the wall jack through said first and second conductive wires of said cable.

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

Loudermilk	5,704,802	Jan. 6, 1998
Fincher et al. (Fincher)	5,847,557	Dec. 8, 1998

Appeal No. 2005-2560
Application No. 10/123,447

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the answer (mailed Mar. 23, 2004) for the examiner's reasoning in support of the rejections, and to the brief (filed Dec. 15, 2003) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations which follow.

35 U.S.C. § 103

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). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the

Appeal No. 2005-2560
Application No. 10/123,447

claimed subject matter is ***prima facie*** obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, “the [E]xaminer can satisfy the burden of showing obviousness of the combination `only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), **citing In re Fritch**,

Appeal No. 2005-2560
Application No. 10/123,447

972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999-1000, 50 USPQ2d at 1617, **citing McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations of independent claim 1. Here, we find that the language of independent claim 1 requires "at least one indicator lamp, permanently installed in said patch panel adjacent to said patch jack, said indicator lamp having a first electrical lead in electrical communication with said first conductive wire and a second electrical lead in electrical communication with said second conductive wire." Appellant argues that neither Fincher nor Loudermilk teaches or suggests the permanent installation of LED's into a patch panel. (Brief at pages 3-4.) We agree with appellant and find that the teachings of Loudermilk would not have suggested to those skilled in the art to permanently mount the temporary LED's in Fincher to be permanent in the patch panel. Fincher teaches the reuse of the LED connectors rather than a permanent affixation.

Appellant argues that the teachings of Loudermilk teach away from the placement of LED's in electrical communication with the network wiring due to EMF radiation or transfer and that special shielding is needed. (Brief at pages 5-6.) We agree with appellant that Loudermilk tends to teach away from the modification proposed by the examiner due to EMF considerations and also to the replacement of LED's. While we find the teachings of Fincher quite good and convincing alone, we find no suggestion to replace the reuseable LED's which plug into the jacks while the connected wires are still in place in the jack so that the "permanently installed" LED may be read. Additionally, we find that the method of testing set forth in independent claim 7 is remarkably similar to the methodology of Fincher, but for the step of providing a patch panel having the permanent installed indicator lamps in communication with the wiring pairs. Here, we do not find that the step of providing the patch panel limits the method of identifying the cabling system. But for the step of causing the light on the patch panel to light, we find the method to be taught and fairly suggested by Fincher. Yet, the examiner has not bridged that gap in the prior art to establish a *prima facie* case of obviousness and we cannot sustain the examiner's rejection since a *prima facie* case has not been initially established for independent claims 1, 7, and 12 and their dependent claims.

CONCLUSION

Appeal No. 2005-2560
Application No. 10/123,447

To summarize, the decision of the examiner to reject claims 1-12 under 35
U.S.C. § 103 is reversed.

REVERSED

JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH L. DIXON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
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ANITA PELLMAN GROSS)	
Administrative Patent Judge)	

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Appeal No. 2005-2560
Application No. 10/123,447

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