

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 CHARLES W. NORMAN

Appeal No. 2006-2095
Application No. 09/899,583

ON BRIEF

Before HAIRSTON, JERRY SMITH and MACDONALD, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 35-46, which constitute all the claims pending in this application.

The disclosed invention pertains to a method and system of operating a Synchronous Optical Network (SONET) system or a Synchronous Digital Hierarchy (SDH) system.

Representative claim 35 is reproduced as follows:

35. A method of operating a Synchronous Optical Network (SONET) system, the method comprising:

receiving a first SONET signal into a first adaptor assembly, wherein the first SONET signal has section overhead information, line overhead information, and a payload;

in the first adaptor assembly, terminating the section overhead information and the line overhead information in the first SONET signal;

transferring the terminated section overhead information, the terminated line overhead information, and the payload from the first adaptor assembly;

receiving the terminated section overhead information, the terminated line overhead information, and the payload into a second adaptor assembly;

in the second adaptor assembly, generating a second SONET signal having the terminated section overhead information, the terminated line overhead information, and the payload; and
transferring the second SONET signal from the second adaptor assembly.

The examiner relies on the following references:

Jahromi	5,416,768	May 16, 1995
Furuta et al. (Furuta)	5,600,648	Feb. 04, 1997 (filed Jan. 19, 1995)

Claims 41, 42, 44, and 45 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Furuta. Claims 35-40, 43, and 46 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Furuta in view of Jahromi.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and 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 briefs 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 supports each of the examiner's rejections of the claims on appeal. Accordingly, we affirm.

We consider first the rejection of claims 41, 42, 44, and 45 as being anticipated by Furuta. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983).

The examiner has indicated how the invention of these claims is deemed to be fully met by the disclosure of Furuta [answer, pages 3-4]. Appellant argues that Furuta discloses extracting and re-inserting the same overhead data, and that this extraction and re-insertion of the same overhead data is not overhead termination as claimed. Thus, appellant argues that Furuta does not teach the transfer of terminated overhead data as claimed [brief, pages 9-10]. The examiner responds that appellant's arguments are not commensurate in scope with the claimed invention. The examiner also responds that the extraction of overhead data as taught by Furuta constitutes a termination as claimed [answer, pages 5-7]. Appellant responds that the limitations argued in the brief are clearly present in the claims so that the examiner's position is without merit. Appellant also reiterates that the artisan would understand that a termination, as understood in SONET and SDH, is not performed by the extraction taught by Furuta [reply brief].

We will sustain the examiner's anticipation rejection of claims 41, 42, 44, and 45 based on Furuta for essentially the reasons argued by the examiner in the answer. Appellant's specification does not specifically define the concept of "terminating section overhead information" and "terminating line overhead information." Although appellant provides considerable details on the definitions of these terms in the briefs, these definitions do not appear in the specification or anywhere else in the application. Arguments of appellant's representative can not take the place of evidence lacking in the record. There is no question that Furuta teaches that overhead information is removed from the signal and then re-inserted into the signal for subsequent transmission. The examiner finds that the removal of overhead information constitutes being terminated. When the term "terminated" is given its broadest reasonable interpretation, we agree with the examiner that it is met by the removal taught by Furuta. We note that claim 41 recites that the overhead information is terminated and then transferred. We fail to see on this record how this operation can be distinguished from Furuta which removes overhead information and then re-inserts the overhead information for transfer. In this sense, the argument that overhead termination requires that new overhead information has to replace the terminated overhead information is not persuasive because claim 41 does not require this by the mere use of the term "terminated" based on the evidence on this record.

We now consider the rejection of the claims under 35 U.S.C. § 103. 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). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343, 61 USPQ2d at 1433-34. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313 (Fed. Cir. 2000)). See also In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. See 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 and the relative persuasiveness of the arguments. 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). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

The examiner has indicated how the invention of these claims is deemed to be rendered obvious by the collective teachings of Furuta and Jahromi [answer, pages 4-5]. Appellant argues that neither Furuta nor Jahromi teaches the transfer of terminated overhead data as claimed [brief, pages 10-11]. Since Furuta teaches the transfer of terminated data for reasons discussed above, we will sustain the examiner's rejection of claims 35-40, 43, and 46 based on Furuta and Jahromi.

In summary, we have sustained each of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 35-46 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

Kenneth W. Hairston)
Administrative Patent Judge)
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) BOARD OF PATENT
Jerry Smith)
Administrative Patent Judge) APPEALS AND
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) INTERFERENCES
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Allen R. MacDonald)
Administrative Patent Judge)

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