

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JULIE FOUQUET and DATONG CHEN

Appeal 2007-1114
Application 10/314,687
Technology Center 2600

Decided: June 28, 2007

Before KENNETH W. HAIRSTON, JOSEPH L. DIXON, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.
DIXON, *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 21-31. Claims 1-20 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

BACKGROUND

Appellants' invention relates to systems and methods for selectively diverting data from nodes in an optical network. An understanding of the invention can be derived from a reading of exemplary claim 21, which is reproduced below.

21. A communication system comprising:

a switching node for switching data packets; and

an optical bypass system configured to receive an optical signal comprising a data packet and a header, the optical bypass system operable to selectively divert the optical signal away from the switching node, the optical bypass system comprising:

an optical switch configured to receive a first portion of the optical signal, and selectively divert the optical signal away from the switching node in response to an optical switch control signal provided thereto;

an optical-to-electrical (O/E) converter configured to receive a second portion of the optical signal and generate an electrical signal comprising the header;

a bypass control system configured to generate a bypass control signal; and

a switching control system communicatively coupled to the bypass control system and the O/E converter, the switching control system configured to receive at least one of the bypass control signal and the electrical signal comprising the header, and to generate in response thereto, the optical switch control signal for controlling the optical switch.

PRIOR ART

The prior art reference of record relied upon by the Examiner in rejecting the appealed claims is:

Yoo	6,519,062 B1	Feb. 11, 2003 (Filed Sept. 1, 2000)
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REJECTIONS

Claim 21 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Yoo.

Claims 22-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoo.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants regarding the above-noted rejection, we make reference to the Examiner's Answer (mailed Nov. 16, 2006) for the reasoning in support of the rejections, and to Appellants' Brief (filed Sep. 14, 2006) and Reply Brief (filed Jan. 16, 2006) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellants' Specification and claims, to the applied prior art reference, and to the respective positions articulated by Appellants and the Examiner. As a consequence of our review, we make the determinations that follow.

35 U.S.C. § 102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), it is only necessary for the claims to “‘read on’ something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or ‘fully met’ by it.” While all elements of the claimed invention must appear in a single reference, additional references may be used to interpret the anticipating reference and to shed light on its meaning, particularly to those skilled in the art at the relevant time. *See Studiengesellschaft Kohle v. Dart Indus., Inc.*, 726 F.2d 724, 726-727, 220 USPQ 841, 842-843 (Fed. Cir. 1984).

Here, we find that the Examiner has interpreted the claims in a reasonable manner in light of the express limitations recited in the language of independent claim 21. Appellants argue that the Appellants may be their own lexicographer and that it is reasonable to look to Appellants’ Specification to interpret the claim language (Br. 13). The Examiner counters that Appellants have not defined the term “control signal” in the Specification. (Answer 9). The Examiner maintains that Yoo teaches control signals which cause optical signals to be routed around faulty nodes or links where the optical signal is bypassing the node or link. The

Examiner maintains that signals which cause this to happen would constitute bypass control signals (Answer 10). We agree with the Examiner's interpretation that the nodes or links are bypassed by the routing and find that Yoo teaches at column 9, lines 30-35, that the traffic is monitored and updates the routing table and to correct the routing table to route around faulty nodes and links.

The Examiner further maintains that the routing information or table 322 of Yoo would have been control signals since it is used to route the optical signals. Again, we agree with the Examiner's interpretation (Answer 10).

The Examiner maintains that independent claim 21 does not require the switching control system to receive the bypass control signal and only requires "the switching control system configured to receive at least one of the bypass control signal and the electrical signal comprising the header, and to generate in response thereto, the optical switch control signal for controlling the optical switch." We agree with the Examiner that the language of independent claim 21 does not state that both signals are received and only one is used in the control. Therefore, we find the Examiner's claim interpretation to be reasonable in light of the express limitations as recited in independent claim 21. Therefore, Appellants' argument that the switch controller of Yoo always uses the header information as contrasted with Appellants' invention (Br. 11; Reply Br. 4-7), is not commensurate in scope with the language of independent claim 21. Therefore, Appellants' argument is not persuasive.

Appellants reproduce portions of the original Specification and argue that the Examiner has dismissed Appellants' argument regarding claim

interpretation (Br. 12-13). Appellants' contention is that the Examiner must interpret the bypass control signal as Appellants intended to claim the invention rather than how it is actually recited in the express language of independent claim 21. We disagree with Appellants, and we will sustain the rejection of independent claim 21.

35 U.S.C. § 103

At the outset, we note that to reach a proper conclusion under § 103, the Examiner, as finder of fact, must step backward in time and into the mind of a person of ordinary skill in the art at a time when the invention was unknown, and just before it was made. In light of all the evidence, we review the specific factual determinations of the Examiner to ascertain whether the Examiner has convincingly established that the claimed invention as a whole would have been obvious at the time of the invention to a person of ordinary skill in the art. When claim elements are found in more than one prior art reference, the fact finder must determine “whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims.” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1337 (Fed. Cir. 2006). With respect to the role of the Examiner as finder of fact, the Court of Appeals for the Federal Circuit has stated: “the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The Court of Appeals for the Federal Circuit has also noted: “[w]hat the prior art teaches, whether

it teaches away from the claimed invention, and whether it motivates a combination of teachings from different references are questions of fact.” *In re Fulton*, 391 F.3d 1195, 1199-1200, 73 USPQ2d 1141, 1144 (Fed. Cir. 2004) (internal citations omitted). 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 must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). Furthermore, ““there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d at 988, 78 USPQ2d at 1336 (Fed. Cir. 2006)).

With respect to dependent claims 22-25, Appellants argue that the Examiner is in error in rejecting these claims under 35 U.S.C. § 103 since the independent claim has been rejected only under 35 U.S.C. § 102 and not under obviousness (Br. 13-15). Appellants' argument is not persuasive. Additionally, Appellants contend that an affidavit is needed for the Examiner to support the Examiner’s rejection (Br. 15). We disagree with Appellants and find that the Examiner’s rejection is supported by the Examiner’s claim interpretation. Here, we agree with the Examiner’s common sense analysis of the prior art that if there is a faulty node or link which is being routed around or bypassed then that would also be a time

when the switching node would be going under a maintenance procedure. While we agree with Appellants that this limitation is not expressly taught by Yoo, we still find that it is suggested by Yoo under the Examiner's reasonable claim interpretation. Additionally, we find that the rejection could have been formulated under anticipation. Therefore, Appellants' argument is not persuasive. We find no need for an affidavit by the Examiner to evidence what is taught or fairly suggested by Yoo. Therefore, Appellants' argument is not persuasive, and we will sustain the rejection of dependent claim 22.

With respect to dependent claim 23, Appellants rely upon the arguments advanced with respect to dependent claim 22 since dependent claim 23 depends from dependent claim 22 (Br. 15-16). We cannot agree with Appellants and find that dependent claim 23 depends from independent claim 21. We find that the Examiner has set forth the statement of the rejection at pages 5-6 of the Answer, and Appellants have not shown any error therein. Therefore, Appellants' argument is not persuasive, and we will sustain the rejection of dependent claim 23.

With respect to dependent claims 24 and 25, Appellants maintain that the Examiner is in error to rely upon inherency to enable and disable the bypassing of a switching node (Br. 16). We disagree with Appellants and conclude that the table 322 of Yoo would include bypass information in the signal therefrom if the table was updated to route around or through certain switching nodes as the Examiner has interpreted the claim language. Therefore, Appellants' argument is not persuasive, and we will sustain the rejection of dependent claims 24 and 25.

With respect to independent claim 26, Appellants contend that Yoo does not teach every element of the claimed invention and requests an affidavit from the Examiner (Br. 17). Again, we find no need for an affidavit for what is taught or fairly suggested by Yoo. Appellants argue that the method need not be implemented by a computer and that Yoo does not teach a computer for all the claimed elements (Br. 17). We find that the Examiner has set forth a sufficient rational why it would have been obvious to one skilled in the art at the time of the invention to have used stored computer instructions for the recited functions. (Answer 6 and 18-21). We find the Examiner's rejection sufficient to establish a prima facie case of obviousness. Appellants contend that the Examiner has not shown that Yoo teaches "enabling an optical switch to switch a second portion of the optical signal away from the switching node upon determining from the header that the optical signal is not destined for the switching node." The Examiner relies upon figures 6 and 7 and column 10 of Yoo to teach that the larger part of the optical signal is delayed and ready to be forwarded to the switch fabric now set up according to the header information. We agree with the Examiner that Yoo teaches this limitation. Therefore, we do not find that Appellants have shown error in the Examiner's initial showing of obviousness, and we will sustain the rejection of independent claim 26.

With respect to dependent claims 27-28, Appellants appear to contend that since the Examiner has relied upon a single reference under 35 U.S.C. § 103 the rejection is deficient since all of the express elements are not shown in Yoo (Br. 18-19). We cannot agree with Appellants and do not find this argument persuasive of an error in the prima facie case of obviousness of dependent claims 27-28. With respect to generating the bypass control

signal independent of the header information (Reply Br. 7-8), we find that the updated table 322 of Yoo would perform this function independent of the individual headers. Therefore, Appellants' argument is not persuasive, and we will sustain the rejection of dependent claims 27-28 and dependent claim 30 which depends therefrom.

With respect to dependent claims 29 and 31, Appellants argue that the Examiner has not shown a control signal received from the switching node to determine if the switching node is ready to receive the optical signal. We disagree and find that the information from the table is updated from the switches. Therefore, Appellants' argument is not persuasive, and we will sustain the rejection of dependent claims 29 and 31.

CONCLUSION

To summarize, we have sustained the rejection of claim 21 under 35 U.S.C. § 102, and we have sustained the rejection of claims 22-31 under 35 U.S.C. § 103(a).

Appeal 2007-1114
Application 10/314,687

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

AFFIRMED

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