

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MARK C. BRIEL and P. FRANK WYNHAMER

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Appeal No. 1998-0062  
Application No. 08/252,896

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ON BRIEF

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Before THOMAS, KRASS, and DIXON, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1-7, 10-17 and 19, which are all of the claims pending in this application.

We REVERSE.

## BACKGROUND

The appellants' invention relates to a multi-port switching system and method for a computer bus. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A multi-port switching system for a computer bus, said multi-port switching system being operative for selectively coupling one of  $n$  bus initiator devices to a bus target device, said switching system comprising:

a plurality  $m$  of initiator buses, wherein  $m$  and  $n$  are integers, and wherein  $n$  is greater than  $m$ ,

a plurality  $m$  of switching circuits,

each of said switching circuits having a bus initiator interface that is coupled through an initiator bus to a subset of said  $n$  bus initiator devices, each of said switching circuits having a bus target interface that is coupled to said bus target device through said computer bus,

each of said switching circuits being responsive to one of said subset of said  $n$  bus initiator devices connected to said bus initiator interface for coupling said one bus initiator device to said bus target device by way of said bus target interface and said computer bus; and

each of said switching circuits generating a busy signal to a remainder of said other switching circuits while said one bus initiator device is coupled to said bus target device.

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

House et al. (House)

5,274,783

Dec. 28, 1993

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Claims 1-7, 10-17 and 19, stand rejected under 35 U.S.C. § 103 as being unpatentable over House.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 10, mailed Feb. 19, 1997) and the supplemental examiner's answer<sup>1</sup> (Paper No. 12, mailed June 24, 1997) for the examiner's reasoning in support of the rejections, and to the appellants' brief (Paper No. 9, filed Dec. 3, 1996) and reply brief (Paper No. 11, filed Apr. 11, 1997) for the appellants' arguments thereagainst.

### **OPINION**

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

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." **In re Keller**, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion

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<sup>1</sup> We note that the rejection remains the same as that set forth in the examiner's answer and the Response to Argument section merely verbatim recites portions of the rejection without addressing the substance of the arguments in the reply brief.

supporting the combination." **ACS Hosp. Sys., Inc. v. Montefiore Hosp.**, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." **Id.** Here, the prior art reference contains no motivation to modify the teachings as the examiner has maintained in the answers. In fact, the advantages of providing a multi-port switching system to a target device with a disable signal is not suggested in the prior art applied by the examiner and the examiner has not provided a convincing line of reasoning why one skilled in the art would have been motivated to modify the prior art system.

Here, the examiner has extended the teachings of the prior art system to House with multiple variations and combinations of the embodiments in Figures 1, 2 and 3 of House with an ultimate conclusion that the claimed invention would have been obvious. We disagree with the examiner. Here, the examiner is manipulating the prior art in an attempt to meet the language of the claim. This is not a reasonable interpretation of the prior art teachings of House, as a whole.

Instead, the examiner relied on hindsight in reaching his obviousness determination. However, our reviewing court has said, "[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."

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**W. L. Gore & Assoc. v. Garlock, Inc.**, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13

(Fed. Cir. 1983), **cert. denied**, 469 U.S. 851 (1984). It is essential that:

the decision maker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art. **W.L. Gore**, 721 F.2d at 1553, 220 USPQ at 313.

Appellants argue "assumptions that must be made by the examiner" in the prior art rejection of the claims and provides responses to the examiner's assumptions. (See reply brief at pages 2-8.) We accept appellants arguments rebutting the examiner's *prima facie* case since the examiner has not responded to these arguments. (See footnote 2.) Some of appellants' arguments in the reply brief go beyond the express language of the claims 1, 15 and 19, for example "common-connected" on page 5, but taking the claim language as a whole, the arguments are supported by the language of the claims. Moreover, we agree with appellants with respect to the "fatal flaws" in the examiner's rejection of the claims. (See reply brief at page 8.)

Appellants argue that the examiner's rejection ignores the express limitations found in the language of claim 1. (See reply brief at page 5.) Specifically, the embodiment of figure 1 does not teach the bus extender connected to a subset of the initiators. House, teaches that the extender has access to all of the hosts, 14 and 16, rather than to a subset. We agree with appellants. Appellants argue that House provides a busy signal on the bus,

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but that the means does not provide the signal to the remainder of the switching circuits. (See reply brief at page 7.) We agree with appellants. Moreover, appellants generally disagree with the combination of the embodiments of Figures 1 and 2 applied by the examiner and that this combination is not well founded with the various combinations and modifications which the examiner has set forth. (See reply brief at pages 2-8.) We agree with appellants.

Since the limitations are not taught or suggested by the applied prior art, we will not sustain the 35 U.S.C. § 103 rejection of independent claims 1, 15 and 19, and of dependent claims 2-7, 10-14, 16 and 17.

### **CONCLUSION**

To summarize, the decision of the examiner to reject claims 1-7, 10-17 and 19, under 35 U.S.C. § 103 is reversed.

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**REVERSED**

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
ERROL A. KRASS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
JOSEPH L. DIXON	)	
Administrative Patent Judge	)	

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