Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CURTIS HARTMANN and OSMAN A. DUMAN

Appeal No. 2000-1250
Application No. 08/662,077

ON BRIEF[1]

Before HAIRSTON, BLANKENSHIP, 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[2] of claims 1-15, which are all of the claims pending in this application.

[1] The Oral Hearing scheduled for March 21, 2002 was waived by appellants in a communication received, via fascimile transmission, on March 15, 2002.

[2] An amendment (Paper No. 12, filed October 25, 1999) filed concurrently with the brief, has been entered by the examiner. As a result of the amendment, the rejections under 35 U.S.C. § 112, second and fourth paragraphs, have been withdrawn by the examiner (answer, page 2).

BACKGROUND

Appellants' invention relates to a method and apparatus for controlling digital communications switching equipment. An understanding of the invention can be derived from a reading of exemplary claims 1 and 11, which are reproduced as follows:

1. A method of controlling a plurality of different high speed digital telecommunications switches, each of which responds to a different set of native messages, with a single messaging protocol, said method comprising:

a) determining a global set of switch functions to be controlled;

b) categorizing at least some switch functions into first subsets of the global set;

c) defining a set of generic messages for each first subset of switch functions;

d) providing a generic message interpreter of each different switch of the plurality of different high speed digital telecommunications switches to interpret generic messages and native switch messages;

e) coupling a first generic message interpreter to a first respective switch; and

f) coupling the first generic message interpreter to a source of generic messages, wherein messages from the source of generic messages are interpreted by the first generic message interpreter to control the first switch with native switch messages.

11. An apparatus for controlling a plurality of different high speed digital telecommunications switches, each of which responds to a different set of native messages, with a single messaging protocol, said apparatus comprising:

a) at least one man/machine interface (MMI) agent;

b) an object server with predefined managed objects and a database management library;

c) an object server applications programmer interface (API) means coupled to said at least one MMI agent and coupled to said object server for hiding the internal architecture of the object server from said at least one MMI agent with respect to said predefined managed objects; and

d) a database which stores managed object related data, wherein

said API includes a set of generic messages for controlling the plurality of different high speed digital telecommunications switches, each of which responds to a different set of native messages,

said object server includes a generic message interpreter, and

said database includes data relating to native switch messages.

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

Astmann	4,853,956	Aug. 1, 1989
Ramstrom et al. (Ramstrom)	5,691,973	Nov. 25, 1997
	(Effectively filed June 28, 1991)	

Orfali et al. (Orfali), "Essential Client/Server Survival Guide", Van Nostrand Reinhold, 1994, pages 341, 344, 345, 348, 349, 422 and 423.

Claims 1-6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ramstrom in view of Astmann.

Claims 7-15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ramstrom in view of Astmann and further in view of Orfali.

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. 14, mailed November 9, 1999) for the examiner's complete reasoning in support of the rejections, and to appellants' brief (Paper No. 13, filed October 25, 1999) 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 given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with

respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1-15 under 35 U.S.C. § 103. Our reasoning for this determination follows.

We begin with the rejection of claims 1-6 based on the teachings of Ramstrom considered with Astmann. We make reference to pages 3-7 of the answer for the examiner's position.

Appellants assert (brief, pages 7 and 9) that the combination is not proper because Ramstrom and Astmann are directed to solving different problems, both from each other, and from appellants' invention. Appellants further assert (brief, page 7) that even if combined, the combination would not result in the claimed invention.

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 would have led one of ordinary skill in the art 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) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

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 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, we agree with the appellants, for the reasons set forth on page 9 of the brief, that the prior art contains none. The examiner's position (answer, page 4) is that the motivation to combine the teachings of Ramstrom and Astmann is to provide Ramstrom's system with the enhanced capability of processor overhead.

We find that the examiner's reasoning is directed to the result of modifying Ramstrom and Astmann, and not to reasons why an artisan of ordinary skill would have been motivated to make the proposed modification. Ramstrom is directed to modular application software for a telecommunications switching system. The system is designed with a control architecture which separates the system into functional blocks (col. 1, lines 15,

16, and 24-26). Added features such as call waiting, etc. require additional software (col. 1, lines 33-38). As telecommunications services have become more sophisticated over the years due to the growth of cellular phone services, ISDN lines, etc., the functionality of the system has increased, along with the need for discrete switches separately programmed for each type of service to be rendered. One approach to solving this problem was to provide the desired functionality by adding software blocks within the control modules of the switch. The problem of this approach is that while hardware costs were saved, the interaction of the different software blocks became complex, such that the addition of a new function may adversely affect or even disable the performance of an existing function. As a result, adding new functionality has increased the development time of the software to the point that the new functions are virtually outdated before they can be implemented in the switch (col. 1, line 59 through col. 2, line 38). Ramstrom's solution is to add application modules e.g., 122 and 123 (see figures 33 and 34), which access resource modules having logical switch objects 145a-145e. The logical switch objects, along with the switch hardware 156, are coordinated through resource modules 145, 146, etc. (figure 34, and col. 39, lines 23-59).

From the disclosure of Ramstrom, we find that Ramstrom is directed to adding functionality to the system, and is not directed to controlling a plurality of switches, each of which responds to a different set of native messages. Nor is Ramstrom directed to providing a generic message interpreter to interpret generic messages to control switches which respond to native switch messages.

Astmann is directed to a distributed processing message delivery system for controlling the distribution of variable length messages within a telephone system (col. 1, lines 6-15). To improve the ability of the central processor to pass messages to various remote processors, the information from the main processor, in accordance with predefined functions, is sent as an entire group of submessages within a single message packet (col. 1, lines 6-9, 21-24, 52-62). In addition, the message can consist of any number of sub-messages, provided that all of the messages are destined for the same port processor and they are all of a general type (col. 3, lines 18-20, and figure 2). From the disclosure of Astmann, we find that Astmann is directed to providing improved communications between processors in a PBX system. We find no disclosure of controlling a plurality of switches, each of which responds to a different set of native

messages. Nor is Astmann directed to providing a generic message interpreter to interpret generic messages to control switches which respond to native switch messages.

Thus, we find that neither Ramstrom nor Astmann is directed to the same problem appellant is dealing with, i.e., controlling switches, each of which responds to a different set of native messages. It is not necessary that the prior art be directed to the same problem which appellants are involved with. As long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. See In re Dillon, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990)(en banc), cert. denied, 500 U.S. 904 (1991) and In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992). However, Ramstrom and Astmann are each directed to different problems. Ramstrom is directed to adding functionality to the system while avoiding problems that the new code may have on the existing system. Astmann is directed to providing better communication between processors. Because Ramstrom and Astmann are directed to different problems, we see no reason why an artisan of ordinary skill would have been motivated to make the combination, as

advanced by the examiner. Instead, it appears that the examiner relied on hindsight in reaching the obviousness determination. Our reviewing court has said, "To 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." 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 . . . 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." Id.

In addition, with respect to appellants' assertion (brief, pages 7 and 8) that the references, even if combined, do not suggest the claimed invention, we find that because neither Ramstrom nor Astmann discloses providing a generic message interpreter of each different switch to interpret generic and native messages and interpreting generic messages to control the first switch with native switch messages, we agree with

appellants, for the reasons set forth in the first two full paragraphs of page 8 of the brief, that even if the teachings of Ramstrom and Astmann were combined, the resultant method would not meet the limitations of claim 1.

From all of the above, 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 2-6 dependent therefrom under 35 U.S.C. § 103 is reversed.

We turn next to the rejection of claims 7-15 under 35 U.S.C. § 103. The examiner additionally relies upon Orfali. We begin with claims 7-10 which depend from claim 1. We reverse the rejection of claims 7-10 because Orfali does not make up for the deficiencies of the basic combination of Ramstrom and Astmann.

We turn next to the rejection of independent claim 11. The examiner's position (answer, page 7) is that claim 11 is rejected for the same reasons as claims 1 and 7. Appellants (brief, page 12) make a similar statement, stating that the rejection should be withdrawn for at least the same reasons as claims 1 and 7. We observe that claim 11 is not quite commensurate in scope with claim 7, which depends from claim 1. Nevertheless, we reverse the rejection of independent claim 11 because Orfali does not make up for the deficiencies of the basic combination of Ramstrom

and Astmann. The combined teachings of the references do not teach or suggest that the object server includes a generic message interpreter, and that the API includes a set of generic messages for controlling the plurality of different high speed telecommunication switches, each of which responds to a different set of native messages. We therefore find that the examiner has failed to establish a prima facie case of obviousness of claim 11, and claims 12-15 which depend therefrom. Accordingly, the rejection of claims 11-15 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-15 under 35 U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)	
STUART S. LEVY Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
HOWARD B. BLANKENSHIP Administrative Patent Judge	)	

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Appeal NO. 2000-1250 - JUDGE LEVY
Application No. 08/662,077

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Decision: **REVERSED**

Prepared by: GJH

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