

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte LORIN ALLRED, DEREK J. NELSON, and MARK MILLIMAN

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Appeal No. 2001-1125  
Application No. 08/721,184

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HEARD: May 21, 2002

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Before THOMAS, GROSS, and LEVY, Administrative Patent Judges.  
GROSS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 63, which are all of the claims pending in this application.

Appellants' invention relates to a system and method for accessing, monitoring, and testing a telecommunications network. More specifically, the invention provides restricted access to the network for a monitor-only mode. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. In a telecommunications network, a signal access system comprising:

an analyzer configured to perform testing on a service layer of a signal;

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an interface device connected to the analyzer, the interface device configured to perform at least one testing mode, including a monitor-only mode, on the signal; and

an external command source providing commands to the interface device, the external command source configured to request a testing mode on the signal, wherein the interface device determines the testing mode to be performed on the signal based on the commands and preselected criteria.

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

Fuller et al. (Fuller)	5,299,257	Mar. 29, 1994
Wallace	5,528,748	Jun. 18, 1996

Claims 1 through 63 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fuller.

Claims 52 through 60 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fuller in view of Wallace.

Reference is made to the Examiner's Answer (Paper No. 17, mailed July 31, 2000) for the examiner's complete reasoning in support of the rejections, and to appellants' Brief (Paper No. 16, filed May 8, 2000) and Reply Brief (Paper No. 18, filed October 3, 2000) for appellants' arguments thereagainst.

#### OPINION

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellants and the examiner. As a consequence of our review, we will reverse the obviousness rejections of claims 1 through 63.

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Claims 1, 27, 62, and 63 require, in pertinent part, that the interface device "determines the testing mode to be performed on the signal based on the commands and preselected criteria" (underlining added for emphasis). Appellants argue (Brief, pages 6-8) that in Fuller the testing mode is set with commands from a technician, not with preselected criteria, and that the examiner has provided no motivation for using preselected criteria for determining the testing mode. The examiner admits (Answer, page 4) that Fuller does not disclose that the interface device determines the testing mode based on preselected criteria, but asserts that the claim limitation would have been obvious because it is "well know [sic] in the art to select a criteria before testing begins."

We agree with appellants. Fuller discloses (column 2, lines 35-38) that "[t]he apparatus can obtain convenient access to a relevant part of the communication traffic flowing through a network node in response to a request from a network subscriber." Further, Fuller discloses (column 5, lines 29-31) that "user interface 36 operates in response to appropriate commands generated by a user via a peripheral device." Nowhere does Fuller suggest any criteria for selecting the testing mode beyond a user's request. Although it is common to select criteria before beginning a test, as asserted by the examiner, that

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criteria would be selected after a test mode is already set, whereas the claim requires criteria for selecting the test mode. Thus, the examiner has failed to establish a *prima facie* case of obviousness for claims 1, 27, 62, 63, and their dependents, claims 2 through 26 and 28 through 60. Consequently, we cannot sustain the rejection of claims 1 through 60, 62, and 63.

Claim 61 recites a step of "restricting the testing of the selected circuit to a non-intrusive, monitor-only mode based on preselected criteria." As discussed above, Fuller makes no mention of any criteria for determining the testing mode. Likewise, Fuller fails to suggest criteria for restricting the display mode. Again, the examiner states that it is known to select a criteria before testing begins. As the criteria for restricting the display mode differs from criteria for a particular test after that test has already been selected, the examiner has failed to establish a *prima facie* case of obviousness. Accordingly, we cannot sustain the rejection of claim 61 over Fuller.

As to the addition of Wallace for rejecting dependent claims 52 through 60, Wallace fails to cure the deficiency discussed above. Therefore, we cannot sustain the rejection of claims 52 through 60 over Fuller in view of Wallace.

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CONCLUSION

The decision of the examiner rejecting claims 1 through 63 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
ANITA PELLMAN GROSS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
STUART S. LEVY	)	
Administrative Patent Judge	)	

AG/RWK

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