

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte SHIGEKI TAKAHASAH

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Appeal No. 96-2223  
Application No. 07/885,708<sup>1</sup>

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HEARD: June 9, 1999

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Before KRASS, HECKER, and LALL, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 14, all the claims pending in the application.

The invention is directed to testing subscribers accommodated to a Fiber Service Node (FSN) that is connected

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<sup>1</sup> Application for patent filed May 19, 1992.

through an optical fiber cable to a Remote Terminal (RT) connected through a multiplex transmission line to a central office exchange in order to construct a Fiber To The Home (FTTH) or Fiber In The Loop (FITL) system.

Representative independent claim 1 is reproduced as follows:

1. A method of testing subscriber sets connected to a service node, said service node connected through a first bidirectional multiplex transmission line, which provides bidirectional communication channels for each of the subscriber sets, to a remote terminal, said remote terminal connected through a second bidirectional multiplex transmission line to a central office exchange, said method comprising the steps of:

    sending a first command signal ordering a test of said subscriber sets, connected to the service node, through the central office exchange and the second bidirectional multiplex transmission line to the remote terminal;

    sending a second command signal from the remote terminal through the first bidirectional multiplex transmission line to the service node in response to the first command signal, said second command signal derived from said first command signal;

    testing and evaluating results of the test of the subscriber sets within the service node in response to the second command signal;

    sending a first return signal including results of the evaluation of the subscriber sets from the service node through the first bidirectional multiplex transmission line to the remote terminal; and

    sending a second return signal from the remote terminal through the second bidirectional multiplex transmission line

and central office exchange in response to the first return signal.

No references are relied on by the examiner.

Claims 1 through 14 stand rejected under 35 U.S.C. 112, first paragraph, as being based on an inadequate written description. More particularly, the examiner contends that there is no support in the original disclosure for the now claimed limitations of "testing and evaluating results of the test of the subscriber sets within the service mode" recited in claim 1, "the remote terminal for testing and evaluation of the subscriber sets" and "ordering a test and an evaluation" recited in claim 6 and "the service node for testing and evaluation" and "a command to test and evaluate the subscriber sets" recited in claim 10.

Rejections based on prior art have been withdrawn by the examiner and are not before us on appeal.

Rather than reiterate the arguments of appellant and the examiner, reference is made to the briefs and answer for the respective details thereof.

OPINION

In order to determine compliance with the written description requirement of 35 U.S.C. 112, first paragraph, the inquiry to be made pertains to whether the disclosure (specification, drawings, claims) as originally filed reasonably conveys to the journeyman practitioner in the art that the inventor had possession at that time of that which he now claims. In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). Literal support in the disclosure for the terms of the claims challenged by the examiner is not necessary in order to show such possession. In re Wright, 866 F.2d 422, 426, 9 USPQ2d 1649, 1652 (Fed. Cir. 1989); In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983); In re Herschler, 591 F.2d 693, 700, 200 USPQ 711, 717 (CCPA 1979); In re Lukach, 442 F.2d 967, 969, 169 USPQ 795, 797 (CCPA 1971).

There is no question that the original disclosure contains support for "testing" within the service node. Support for this recitation is rampant throughout the specification and the original claims. For example, original claim 1 recited, in part, "testing the subscriber in the service node..." What the examiner really questions is support for the service node not

only "testing," but also "evaluating" those test results, as now claimed.

The examiner contends that no evaluation of test results is found in the original disclosure and that the sending of a command indicating the test results from the service node does not inherently include evaluation of the test results at the node. We agree with the examiner that the mere disclosure of testing at the service node does not, necessarily, translate to an "evaluation" at the service node. Tests may very well be performed at one location and the test results then sent to another location for "evaluation" of those test results.

Further, appellant's reference to page 7, lines 4-21 of the specification is unpersuasive of an adequate written description to support the claimed limitations in question. The reference to page 7, lines 4-21, refers to various test items but to no "evaluation." It is not clear, from the cited portion of page 7, whether there is an "evaluation" being performed by the service node. Therefore, this portion of the specification cited by appellant does not indicate clearly that the inventor had possession, at the time of the original disclosure, of that which is now claimed.

However, we are persuaded that there is an adequate written description in the original disclosure to support "evaluation" by appellant's reference to page 10, lines 3-21. It is clear from this portion of the specification and from Figure 8, that not only are tests being performed at the service node, but that there is also an "evaluation" of the test results being performed since an output of "good" or "no good" is made. This determination, not only of a test of a voltage value, for example, but of whether that value is within a certain range, i.e., "good" or "no good," is an "evaluation." Thus, we will not sustain the rejection of claims 1 through 14 under 35 U.S.C. 112, first paragraph, as being based on an inadequate written description.

Moreover, we will not sustain the rejection of claims 1 through 14 under 35 U.S.C. 112, first paragraph, as being based on an inadequate written description, because we find support for the claim limitations in question in the last sentence on page 7 of the original disclosure. That sentence indicates that "the test/control section 44 must interpret the sequences of character codes..." Since the test/control section 44 is part of the Fiber Service Node, it is clear that the service

node not only performs the claimed testing but it also interprets, or "evaluates", the results of the test. Accordingly, "testing and evaluating results of the test" are performed "within the service node," as claimed and the artisan would have appreciated, from such disclosure, that the inventor did, indeed, have possession, at the time of the original disclosure, of that which is now claimed.

The examiner's decision is reversed.

REVERSED

ERROL A. KRASS	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
STUART N. HECKER	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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PARSHOTAM S. LALL	)	
Administrative Patent Judge	)	

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