

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MAYUMI TANAKA and NAOZOH KADOYASHIKI

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Appeal No. 1996-4070  
Application No. 08/367,930<sup>1</sup>

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HEARD: October 20, 1999

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Before THOMAS, RUGGIERO, and HECKER, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed January 3, 1995. According to appellants, the application is a continuation of Application No. 07/774,972, filed October 15, 1991, now abandoned.

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This is a decision on appeal from the final rejection of claims 1 and 3-10, all of the claims pending in the present application. Claim 2 has been canceled.

The claimed invention relates to a method and apparatus for extracting message blocks from maintenance messages used in a communications network. More particularly, Appellants indicate at pages 3-5 of the specification that, upon detection of a message identification within a maintenance message, appropriate masks are retrieved from memory. Message blocks are extracted from the maintenance message using the masks and the extracted message blocks are stored and given an identification ID as illustrated in Figure 3 of the drawings.

Claim 1 is illustrative of the invention and reads as follows:

1. A method of processing a maintenance message applied from a telecommunications network to an integrated network maintenance system, the maintenance message including an identification code and a plurality of message blocks, the maintenance message indicating status information of the telecommunications network, the method comprising the steps of:

(a) preparing a plurality of message block extracting masks by an operator input through a console, wherein each of the message block extracting masks defines at least one position of a message block to be extracted from the maintenance message;

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(b) storing the plurality of message block extracting masks in a first memory;

(c) receiving the maintenance message, storing the maintenance message in a second memory and identifying the maintenance message based on the identification code of the received maintenance message;

(d) retrieving one of the message block extracting masks from the first memory based on the identification code of the received maintenance message, and storing the retrieved mask in the second memory;

(e) extracting one of the message blocks from the received maintenance message using the retrieved mask stored in the second memory;

(f) affixing a block identification to the message block extracted in step (e); and

(g) storing the message block with the block identification in a third memory.

The Examiner relies on the following prior art:

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| Anderson et al. (Anderson) | 4,284,849 | Aug. 18,<br>1981 |
| Little                     | 4,455,455 | Jun. 19,<br>1984 |

Cronin et al (Cronin), "Network Control Center", IEEE publication, 1981, pp. G7.3.1-G7.3.6.

Claims 1 and 3-5 stand finally rejected under 35 U.S.C. § 103 as being unpatentable over Anderson in view of Cronin. Claims 6-10 stand finally rejected under 35 U.S.C. § 103 as

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being unpatentable over Anderson in view of Cronin and further in view of Little.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs<sup>2</sup> and Answers for the respective details thereof.

#### OPINION

It is our view, after consideration of the record before us, that the collective evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1 and 3-10. Accordingly, we reverse.

With respect to independent claims 1, 3, 4, and 5, the Examiner, as the initial basis for the obviousness rejection, proposes to modify the message monitoring communications system of Anderson by relying on Cronin to supply the missing teaching of preparing the message block extracting masks through an operator console. In addition, the Examiner, in

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<sup>2</sup> The Appeal Brief was filed April 18, 1996. In response to the Examiner's Answer dated June 28, 1996, a Reply Brief was filed August 26, 1996. The Examiner entered the Reply Brief and submitted a Supplemental Examiner's Answer dated December 4, 1996.

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attempting to address the claim language requiring "...affixing a block identification to the message block extracted..." (Claim 1 and similar recitations in the other independent claims 3, 4, and 5) and recognizing a lack of explicit teaching in Anderson of providing an identification for an extracted message, offers two alternative approaches. In the first, the Examiner suggests (Answer, page 6) the obviousness to the skilled artisan of adding ID bits to the extracted message to provide easier identification of the message. Alternatively, the Examiner asserts that Anderson provides for the affixing of ID information to the extracted message block simply by virtue of the address associated with the register in which the extracted message block is stored.

While Appellants have made several arguments in response, the primary thrust of the arguments centers on the alleged deficiency in any of the applied references in disclosing the aforementioned extracted message block ID affixing feature. Upon careful review of the applied prior art in light of Appellants' arguments, we are in agreement with Appellants' stated position in the Briefs. In our view, the reasoning in both of the Examiner's approaches related to the claimed ID

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affixing feature is not well founded. As to the assertion of obviousness with regard to the adding of ID bits to an extracted message block, we find that the Examiner has not established that such a teaching is taught or suggested in the prior art. We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference, common knowledge or capable of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a prima facie case. In re Knapp-Monarch Co., 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); In re Cofer, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966). Further, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266 n. 14, 23 USPQ2d 1780, 1783-84 n. 14 (Fed. Cir. 1992).

With regard to the Examiner's contention that Anderson's storage of messages in an address associated register amounts to affixing of an ID to an extracted message, we note, initially, that the Examiner has not pointed to any disclosure

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in Anderson which relates a register address to message identification. It is our view, however, that even assuming arguendo that such teaching exists in Anderson, such an arrangement would fall far short of meeting the claim requirements. We agree with Appellants' argument (Brief, page 6) that the claimed step of "... affixing a block identification to the message block ..." requires something in addition to the address of the location of the register in which the extracted message is stored.

In view of the above discussion, it is our opinion, that since all of the limitations of independent claims 1 and 3-5 are not suggested by the prior art, the Examiner has not established a prima facie case of obviousness. Accordingly, we do not sustain the 35 U.S.C. § 103 rejection of independent claims 1 and 3-5 nor of claims 6-10 which depend therefrom.

We note that, with regard to dependent claims 6-10, the Examiner has applied the Little reference solely to meet the editing features of these claims. Little, however, does not overcome the innate deficiencies of Anderson and Cronin discussed previously.

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In summary, we have not sustained either of the Examiner's obviousness rejections of the claims on appeal. Therefore, the Examiner's decision rejecting claims 1 and 3-10 is reversed.

REVERSED

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|-----------------------------|---|-----------------|
| JAMES D. THOMAS             | ) |                 |
| Administrative Patent Judge | ) |                 |
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|                             | ) |                 |
|                             | ) | BOARD OF PATENT |
| JOSEPH F. RUGGIERO          | ) | APPEALS         |
| Administrative Patent Judge | ) | AND             |
|                             | ) | INTERFERENCES   |
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| STUART N. HECKER            | ) |                 |
| Administrative Patent Judge | ) |                 |

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FOLEY & LARDNER  
SUITE 500  
3000 K STREET NW  
WASHINGTON DC 20007-5109

***Leticia***

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APJ RUGGIERO

APJ THOMAS

APJ HECKER

DECISION: REVERSED  
Send Reference(s): Yes No  
or Translation (s)  
Panel Change: Yes No  
Index Sheet-2901 Rejection(s): \_\_\_\_\_

Prepared: August 7, 2000

Draft    Final

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PALM / ACTS 2 / BOOK  
DISK (FOIA) / REPORT