

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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL D. MANCUSI, JOSEPH E. MASSERY, ROGER F.
OSMOND and MICHAEL J. FITZGERALD

Appeal No. 1997-0265
Application No. 08/294,882

ON BRIEF

Before HAIRSTON, JERRY SMITH and LEVY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-5, 7-14 and 16. Claims 6 and 15 have been indicated to contain allowable subject matter. An amendment after final rejection was filed on April 24, 1996 and was entered by the examiner.

The disclosed invention pertains to a wiring hub for interconnecting a plurality of network devices to form a local

area network. Specifically, the invention has a programmable switching mechanism having a plurality of ports corresponding to each of the network devices. The switching mechanism interconnects a programmably selectable set of said plurality of ports together in any programmably selectable ordered sequence to form a ring network.

Representative claim 1 is reproduced as follows:

1. A wiring hub for interconnecting a plurality of network components to form a local area network, each of said plurality of network components capable of sending and/or receiving digital communications signals, said wiring hub comprising:

a data signal bus; and

a programmably controlled switching mechanism connected to said data signal bus, said switching mechanism including a plurality of ports, wherein when said plurality of network components is connected to said switching mechanism each of said plurality of ports is electrically coupled to a different one of the plurality of network components so as to pass digital communications signals to and receive digital communications signals from the network component to which it is coupled, said programmably controlled switching mechanism interconnecting a programmably selectable set of said plurality of ports together through said data signal bus and in any programmably selectable ordered sequence to form a ring network.

The examiner relies on the following references:

Moran	4,032,893	June 28, 1977
Peterson	4,255,741	Mar. 10, 1981
Blount et al. (Blount)	4,633,245	Dec. 30, 1986
Franaszek	4,845,706	July 04, 1989

The following rejections are before us on appeal:

Appeal No. 1997-0265
Application No. 08/294,882

1. Claims 1, 11-14 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Peterson and Franaszek.

2. Claims 2-4 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Peterson, Franaszek and Moran.

3. Claims 5 and 7-10 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Peterson, Franaszek, Moran and Blount.

Rather than repeat the arguments of appellants or the examiner, we make reference to the main brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's

Appeal No. 1997-0265
Application No. 08/294,882

rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the 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 1-5, 7-14 and 16. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley

Appeal No. 1997-0265
Application No. 08/294,882

Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.),
cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta
Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657,
664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS
Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221
USPQ 929, 933 (Fed. Cir. 1984). These showings by the
examiner are an essential part of complying with the burden of
presenting a prima facie case of obviousness. Note In re
Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir.
1992). If that burden is met, the burden then shifts to the
applicant to overcome the prima facie case with argument
and/or evidence. Obviousness is then determined on the basis
of the evidence as a whole and the relative persuasiveness of
the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039,
228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d
1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re
Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).
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

Appeal No. 1997-0265
Application No. 08/294,882

§ 1.192(a)].

With respect to sole independent claim 1, the examiner finds that Peterson substantially discloses the claimed invention except for the connecting of the data ports in any programmable selectable ordered sequence to form a ring network. Franaszek teaches a cross point switch which can be programmed to connect any device of a network to any other device of the network. The examiner concludes that it would have been obvious to modify the switching mechanism of Peterson to be programmable as taught by Franaszek to obtain configurability advantages [answer, pages 3-4].

Appellants only address the rejection with respect to claim 1, and they make the following arguments: 1) appellants argue that Peterson does not disclose a data signal bus as recited in claim 1; 2) appellants argue that Franaszek has no suggestion of interconnecting a programmably selectable set of the plurality of ports together through the data signal bus and in any programmably selectable ordered sequence to form a ring network as recited in claim 1; and 3) appellants argue that Franaszek teaches away from the claimed invention and would not be combined with Peterson because Franaszek attempts

Appeal No. 1997-0265
Application No. 08/294,882

to avoid interconnecting network components to form a ring network [brief, pages 5-13].

Since we agree with at least the second and third arguments of appellants, we do not sustain the examiner's rejection of claims 1-5, 7-14 and 16. Even if the artisan were to modify Peterson's switching mechanism to be programmable as taught by Franaszek, the invention of claim 1 does not result. Franaszek only teaches that one selected device can be programmably connected to any other selected device. Although this would permit the components of Franaszek to be connected to form a ring network, there is no suggestion that such an interconnection should be implemented. In fact, as appellants point out, the one configuration Franaszek seeks to avoid is the pure ring network. 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, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). It is clear that the collective teachings of Peterson and Franaszek would not

Appeal No. 1997-0265
Application No. 08/294,882

lead the artisan to interconnect a programmably selectable set of said plurality of ports together through said data signal bus and in any programmably selectable ordered sequence to form a ring network.

Since we do not agree with the examiner's findings as to what the applied prior art teaches, we do not agree with the examiner's rejection of claim 1. Although the teachings of Moran and Blount are additionally applied in the rejection of some of the appealed claims, these additional teachings do not overcome the deficiency in the basic combination discussed above. Therefore, we do not sustain the rejection of any of the appealed claims as formulated by the examiner.

The decision of the examiner rejecting claims 1-5, 7-14 and 16 is reversed.

REVERSED

KENNETH W. HAIRSTON)
Administrative Patent Judge)
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) BOARD OF PATENT
JERRY SMITH) APPEALS

Appeal No. 1997-0265
Application No. 08/294,882

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) INTERFERENCES
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STUART S. LEVY)
Administrative Patent Judge)

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Appeal No. 1997-0265
Application No. 08/294,882

PAUL M. SCHWARTZ
BROOKS & KUSHMAN, PC
1000 TOWN CENTER
TWENTY-SECOND FLOOR
SOUTHFIELD, MI 48075