

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN E. BAKKE, RONALD L. BILLAU,
LEE D. CLEVELAND and WILLIAM S. GARTMANN

Appeal No. 1999-0261
Application 08/703,496

ON BRIEF

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

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-20, which are all of the claims pending in the present application. Claim 21 has been canceled. An amendment filed February 9, 1998 after final rejection was approved for entry by the Examiner.

The claimed invention relates to a method and apparatus

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for preventing data corruption caused by a device connection transition on an active data communication bus. A shutdown signal is transmitted from a bus initiator over the bus to a power controller while bus communication is paused permitting communication only by the bus initiator. After a connection transition of an electrical device in the device slot corresponding to the received shutdown signal, power is restored to the device slot after receipt of a power reset signal transmitted from the bus initiator. Communication on the data bus by all peripherals is again permitted after release of the data bus from the pause condition by the bus initiator.

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

1. A method of device connection transition on an active data communication bus, said method comprising the steps of:

pausing communication on the data communication bus such that only communication by a first electrical device is allowed over the data communication bus;

following said pausing of communication on said data communication bus, transmitting a shutdown

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signal over data lines within said data communication bus from said first electronic device to a third electronic device, said shutdown signal instructing said third electronic device to eliminate power to a device slot; and

releasing the data communication bus from being paused such that all communication on the data communication bus by electrical devices is allowed after a connection transition of a second electrical device in said device slot.

The examiner relies upon the following references as evidence of obviousness:

Herrig et al. (Herrig) 1989	4,835,737	May 30,
Parrett 1996	5,586,271	Dec. 17,

(filed Sep. 27, 1994)

Claims 1-20 stand finally rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner offers Herrig alone with respect to claims 1-3, 6-9, 12-14, and 16-20, and adds Parrett to Herrig with respect to claims 4, 5, 10, 11, and 15.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (Paper No. 11) and Answer (Paper No. 12) for the respective details.

OPINION

We have carefully considered the subject matter on

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appeal, the rejection advanced by the Examiner, the arguments in support of the rejection and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Brief along with the Examiner's rationale in support of the rejection 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 1-20. 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.

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17-18, 148 USPQ 459, 467 (1966), and to provide a reason why
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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 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 Hospital Systems, Inc. v.
Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933
(Fed.

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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).

With respect to each of the appealed independent claims 1, 6, and 13, the Examiner proposes to modify the circuit board module removal and insertion system disclosed by Herrig. In the Examiner's analysis, it is suggested (Answer, page 3) that Herrig discloses the claimed invention except for the permitting of only a first electrical device to communicate over a bus during the pausing of data communications over the bus. Nevertheless, the Examiner asserts the obviousness to the skilled artisan "...to have a control circuit to provide the efficient communication control on the bus during the connection transition of a second device." (Id).

In response, Appellants assert several arguments in support of their position that the Examiner has not

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established proper motivation for the proposed combination of references so as to set forth a prima facie case of obviousness. After careful review of the applied prior art references in light of the arguments of record, we are in agreement with Appellants' position as stated in the Brief. As argued by Appellants (Brief,

page 5), the Examiner has pointed to no disclosure in Herrig that would suggest any support for the Examiner's assertion that Herrig's system could be modified to allow communication by only one device while bus communication is paused. Our interpretation of the disclosure of Herrig coincides with that of Appellants, i.e., when bus communication is paused, the generation of required bus communication clock signals is stopped, thereby inhibiting all communication over the bus (Herrig, column 6, lines 1-9). We find no evidence provided by the Examiner that would support the obviousness to the skilled artisan of making the modification suggested by the Examiner. 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

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desirability of the modification. In re Fritch, 972 F. 2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

We are further of the opinion that even assuming, arguendo, that proper motivation were established for the Examiner's proposed modification of Herrig, the resulting system would fall far short of meeting the specific requirements of the claims on appeal. As pointed out by Appellants (Brief, page 6), the transmission of a control signal by actuation of a switch on the circuit board module in Herrig occurs before the pausing of bus communication not after the bus communication pausing as set forth in the appealed claims. Further, we find in Herrig no transmission of a shutdown signal from a first device to a third device to eliminate power to a slot assigned for the removal or insertion of a second device. In order for us to sustain the Examiner's rejection under 35 U.S.C. § 103, we would need to resort to speculation or unfounded assumptions or rationales to supply deficiencies in the factual basis of the rejection before us. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied,

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389 U.S. 1057 (1968), rehearing denied, 390 U.S. 1000 (1968). Accordingly, since the Examiner has not established a prima facie case of obviousness, the rejection of independent claims 1, 6, and 13, and claims 2, 3, 7-9, 12, 14, and 16-20 dependent thereon, based on Herrig is not sustained.

Turning to a consideration of the Examiner's 35 U.S.C. § 103

rejection of dependent claims 4, 5, 10, 11, and 15 in which the Parrett reference is added to Herrig, we do not sustain this rejection as well. It is apparent from the Examiner's analysis

(Answer, pages 4 and 5) that Parrett is relied on solely to address the claimed SCSI and bus initiator features. We find nothing, however, in the disclosure of Parrett which would overcome the innate deficiencies of Herrig discussed supra.

In conclusion, since the Examiner has not established a prima facie case of obviousness, the 35 U.S.C. § 103 rejection of independent claims 1, 6, and 13, and claims 2-5, 7-12, and 14-20 dependent thereon, cannot be sustained. Therefore, the decision of the Examiner rejecting claims 1-20 is reversed.

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REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
STUART S. LEVY)	
Administrative Patent Judge)	

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