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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte SOUAD DAMIEN

_____

Appeal No. 2000-0330
Application No. 08/684,871

_____

ON BRIEF

_____

Before THOMAS, GROSS, and BARRY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

The examiner rejected the claims 18-37. The appellant appeals therefrom under 35 U.S.C. § 134(a). We reverse and enter a new ground of rejection under 37 C.F.R. § 1.196(b).

BACKGROUND

The invention at issue in this appeal relates to rerouting

network. ATM cells received at the first switching node are duplicated to be transmitted to the second switching node via both paths. Normally, only cells arriving via the main path are forwarded by the second node; cells arriving via the substitute path are suppressed. Upon a malfunction of the main path, however, cells arriving by the substitute path are forwarded by the second node; cells arriving by the main path are suppressed.

The different routes of the main and substitute paths can cause the paths to operate with different network transit times, which results in a "shift" in the reception of cells arriving via the paths. The appellant explains that for a high-rate network featuring optical fibers, a 100 km route difference between the two paths can cause a shift in transit time of a millisecond. (Spec. at 1-2). For ATM cells comprising 53 octets and paths having a rate of several Mbit/s, he adds, such a shift can cause the loss or duplication of ten cells when a switch is made from main to a substitute path. (*Id.* at 2.) To avoid such loss or

Claim 18, which is representative for present purposes, follows:

> 18. A packet switching telecommunications network comprising:
>
> a plurality of switching nodes between which packets are transported by logic paths, one of said logic paths being a main path between a first and a second switching node, and
>
> means for linking at least a substitute logic path to said main path for transporting the same packets as packets transported by said main path,
>
> said second node comprising switching means for switching from the main path to the substitute path,
>
> characterized in that the second node further comprises:
>
> calculation means for calculating a time shift between packets received on said main path and on said substitute path, and
>
> check means, responsive to said time shift, for checking the switching to avoid packet losses or packet duplications.

(Paper No. 9 at 1-2.)

The prior art applied by the examiner in rejecting the

Claims 18-37 stand rejected under 35 U.S.C. § 112, ¶ 2, as indefinite. **Claims 18-20 and 23-31 stand rejected under 35 U.S.C. § 102(e) as anticipated by Foglar.** Claims 21, 22, and 32-37 stand rejected under 35 U.S.C. § 103(a) as obvious over Foglar in view of Edmaier.

OPINION

After considering the record, we are persuaded that the examiner erred in rejecting claims 18-37. Accordingly, we reverse. However, we enter a new ground of rejection under 37 C.F.R. § 1.196(b). We address the following rejections:

- indefiniteness rejection
- anticipation and obviousness rejections
- new ground of rejection.

We start with the indefiniteness rejection.

I. Indefiniteness Rejection

Rather than reiterate the arguments of the examiner or appellant *in toto*, we address the two points of contention

argues, "[o]ne of ordinary skill would recognize this 'linking' involves connection within a module of the first switching node between the main and substitute logic paths, and another connection within the second switching node between these same paths." (Appeal Br. at 8.)

"The test for definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification. *Orthokinetics Inc., v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, Section 112 demands no more. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385, 231 USPQ 81, 94 (Fed. Cir. 1986)." *Miles Labs., Inc. v. Shandon Inc.*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993).

Here, claims 18 and 19 specify in pertinent part the

ensured by duplicating certain virtual paths VP." (Spec. at 4.) More specifically, "cells arriving at said first switching node are duplicated to be transmitted to said second switching node by the main path and by the substitute path." (*Id.* at 1.) We are persuaded that one skilled in the art would understand that the limitations, when read in light of the specification, require duplicating cells that are to be transported over a main path and then transmitting the duplicated cells over a substitute path.

Second, the examiner asserts, "it is not clear what is meant by 'a rank' in the statement of 'at least some packets are assigned a rank.'" (Examiner's Answer at 3.) The appellant argues "[t]he clearest examples of rank of cells is the distinction between OAM cells and data cells." (Appeal Br. at 8)

Claims 26, 27, and 34 specify in pertinent part the following limitations: "at least some packets are assigned a rank . . . comparing means for comparing packets of a same rank

respectively, are compared." (Spec. at 5.) In describing a second method for determining a shift, it further discloses that "the information fields of these [OAM] cells are compared." (*Id.* at 7.) We are persuaded that one skilled in the art would understand that the limitations, when read in light of the specification, require different types of cells, including data cells and OAM cells, and comparing cells of the same type to each other. Therefore, we reverse the rejection of claims 18-37 as indefinite. We proceed to the anticipation and obviousness rejections.

II. Anticipation and Obviousness Rejection

Rather than reiterate the positions of the examiner or appellant *in toto*, we address the main point of contention therebetween. The examiner asserts, "the message cells in a slower path are determined to be delayed if the calculated difference of receiving cells in two paths is larger than the threshold." (Examiner's Answer at 9.) The appellant argues,

"Analysis begins with a key legal question -- *what* is the invention *claimed*?" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). Here, claims 18 and 19 specify in pertinent part the following limitations: "calculation means for calculating a time shift between packets received on said main path and on said substitute path. . . ." Accordingly, the claims require *inter alia* calculating a shift **in time** between packets received via a main path and packets received via a substitute path.

"[H]aving ascertained exactly what subject matter is being claimed, *In re Wilder*, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970), we the turn to the anticipation and obviousness of the subject matter. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (citing *Structural Rubber*

Kimberly-Clark Corp., 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983)). Furthermore, "'[a] *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.'" *In re Bell*, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, although Foglar calculates a shift between cells received via an active path and cells received via an alternate path, the shift is not a shift in time. To the contrary, it is a shift in the number of cells received via each path. Specifically, "the plurality of message cells arriving via the active path and via the alternate path is separately and continuously acquired at this interface means. Due to differences in running time and due to the fluctuations in running time that are unavoidable in the asynchronous transfer mode, a difference between the acquired values will generally

between the momentary counter readings." Col. 6, ll. 15-19. As admitted, by the examiner, Foglar's shift is "the difference between the two calculated numbers of message cells. . . ." (Examiner's Answer at 9.)

Relying on Edmaier merely to teach a "buffer memory P5 . . . for storing packets on alternate path," (Examiner's Answer at 4), the examiner fails to allege, let alone show, that the secondary reference cures the defect of the primary reference. Because Foglar calculates a shift in the number of packets received via two paths rather than a shift in time, we are not persuaded that the applied prior art discloses or would appear to have suggested the limitations of "calculation means for calculating a time shift between packets received on said main path and on said substitute path. . . ." Therefore, we reverse the rejection of claims 18 and 19 and of claims 20 and 23-31, which depend from claim 19, as anticipated by Foglar. We also reverse the rejection of claims 21, 22, and 32-37, which depend from

III. New Ground of Rejection

Under 37 C.F.R. § 1.196(b)(2001), we enter a new ground of rejection against claims 18-37. "'Although [the applicant] does not have to describe exactly the subject matter claimed, . . . the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.'" *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991)(quoting *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989)). "[T]he test for sufficiency of support . . . is whether the disclosure of the application relied upon 'reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.'" *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985)(quoting In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)). "Application sufficiency under §112, first paragraph, must be judged as of the filing date [of the application]." *Vas-Cath*, 935 F.2d at 1566, 19 USPQ2d at 1119 (citing *United States*

Here, the appellant added claims 18-37 to his specification by an amendment. (Paper No. 9.) Claims 18 and 19, the independent claims among the added claims, specify in pertinent part the following limitations: "calculation means for calculating a **time** shift between packets received on said main path and on said substitute path, and check means, responsive to said **time** shift, for checking the switching to avoid packet losses or packet duplications." (Emphasis added.) In summary, the amendment added means for calculating and means for responding to a shift in time.

The appellant fails to show that the original specification, which includes the original claims, disclosed the limitations. In the amendment, he alleged that a description of the added limitations could be found in the passage of the specification spanning "line 28 of page 4 through line 20 of page 5. . . ." (Paper No. 9 at 7.) The passage, however, teaches calculating a shift between the <u>number</u> of cells received via a main path and

. . ." (*Id.*) The "shift between the main path and the substitute path," (*id.* at 5) "is equal to the difference between the two counters CVPP and CVPS." (*Id.*)

Accordingly, we are not persuaded that when the appellant's application was filed, the appellant had possession of "calculation means for calculating a time shift between packets received on said main path and on said substitute path, and check means, responsive to said time shift, for checking the switching to avoid packet losses or packet duplications." Therefore, we reject claims 18-37 as lacking an adequate written description.

CONCLUSION

In summary, the rejection of claims 18-37 under 35 U.S.C. § 112, ¶ 2, is reversed. The rejection of claims 18-20 and 23-31 under 35 U.S.C. § 102(e) and the rejection of claims 21, 22, and 32-37 under 35 U.S.C. § 103(a) are also reversed. A new rejection of claims 18-37 under 35 U.S.C. § 112, ¶ 1, is added.

purposes of judicial review." It also includes the following provisions.

> [T]he appellant, withing two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:
>
> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time for taking any action in connected with this appeal may be extended under 37 C.F.R. § 1.136(a).

REVERSED
37 C.F.R. § 1.196(b)

JAMES D. THOMAS Administrative Patent Judge	)	
ANITA PELLMAN GROSS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
LANCE LEONARD BARRY Administrative Patent Judge	)	

BARBARA KINNEY
U.S. PHILIPS CORP.
CORPORATE PATENT COUNSEL
580 WHITE PLAINS ROAD
TARRYTOWN, NY 10591