

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. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** MANOHAR MURTHY, JOHN F. WAKERLY and ARTHUR I. LAURSEN

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Appeal No. 2000-2282  
Application 08/713,046

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ON BRIEF

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Before KRASS, JERRY SMITH, and FLEMING, **Administrative Patent Judges**.

FLEMING, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of claims 25-31. Claims 1-24 have been cancelled.

The invention relates to the monitoring of packet traffic arriving at the bridges and routers. See Appellants' specification, page 1, lines 3-13. Appellants disclose that according to the invention, monitoring of any or all network segments on a multi-port bridge or router may be carried out from

a network segment on one port, referred to as a monitoring port. In Appellants' system of Figure 1, a single monitoring device (9) can monitor traffic on multiple network segments (2) connected to bridge (1). See Appellants' Specification Page 3, lines 27-30 and Figure 1. The bridge (1) forwards packets to their normal destination ports (ports 0,1,2,3, or 5 in Figure 1), and also to the monitoring port (port 4 in Figure 1), to which monitoring device (9) is connected.

Independent claim 25 and dependent claim 27 present in the application are reproduced as follows:

25. A method for monitoring a network comprising an apparatus interconnecting a plurality of network segments at least one of which comprises a network monitor, the method comprising:

(a) obtaining, from each packet received by the apparatus, forwarding information to be used in determining the packet destination;

(b) if a packet destination specified by the forwarding information includes a station other than the apparatus, then conducting one or more first transmissions of the packet to one or more of the network segments in order to deliver the packet to the packet destination; and

(c) conducting a second transmission of the packet to a network segment comprising the network monitor, wherein said second transmission is separate from said one or more first transmissions.

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27. The method of Claim 25 further comprising specifying which packets are to be delivered to a network monitor, wherein the specifying step is performed more than once to yield different specifications of packets to be delivered to a network monitor.

#### **References**

The references relied on by the Examiner are as follows:

Bosack	5,088,032	Feb. 11, 1992
Douglas	5,097,469	Mar. 17, 1992

#### **Rejections at Issue**

Claims 25-31 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bosack and Douglas.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the brief<sup>1</sup> and the answer<sup>2</sup> for the details thereof.

#### **OPINION**

We will sustain the rejection of claim 25 and 26 and 28-31, and reverse the rejection of claim 27.

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<sup>1</sup>Appellants filed an amended Appeal Brief on February 8, 2000. We will refer to this appeal brief as simply the Brief. Appellants filed a reply brief on July 13, 2000. We will refer to this reply brief as the Reply Brief.

<sup>2</sup> The Examiner responded to Appellants' Appeal Brief on May 11, 2000. We will refer to this answer as simply the Answer.

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At the outset, we note that Appellants have provided a statement, on page 5, lines 9 and 10, that claims 25 and 26 and claims 28-31 stand or fall together. Claim 27 stands or falls together separately from the first group of claims. 37 CFR §1.192 (c) (7) (July 1, 1999), which was controlling at the time of Appellants' filing the brief, states:

For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c) (8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider claims 25, 26 and 28-31 as standing or falling together as a group, and we will treat claim 25 as a representative claim of that group. Further, we will consider claim 27 as its own group.

With regards to claim 25, Appellants argue that "attaching Douglas' monitor to Bosack's system would not provide the invention of Claim 25 because this would not provide two separate steps (b) and (c)." See Appeal Brief page 6, lines 2-4. Specifically, Appellants argue that "Bosack's broadcast cannot be interpreted to include step (c) of claim 25. At best, Bosack's

broadcast might be interpreted to include step (b) (delivery of a packet to packet destination)." See Brief page 6, lines 18-21. Appellants argue that Bosack does not teach or suggest step (c) because "Bosack does not teach or suggest a separate transmission of the same packet in addition to his broadcast." See Brief page 7, lines 3-6. In response to the Examiner's argument that Bosack's multiple transmissions of a packet meet steps (b) and (c), Appellants argue that Bosack's multiple transmissions would be conducted "in order to deliver the packet to the packet destination" and none would be "separate," as recited in step (c). See Reply Brief page 2, lines 14-17.

In response to the Appellants' argument that Bosack does not teach the step (c) of claim 25, the Examiner, in reference to Bosack's Figure 4, argues that Bosack's packet broadcasting could anticipate both the limitation "one or more transmissions" in step (b) and the limitation "a second transmission" in step (c) of claim 25. See Answer, page 7, lines 1-5. The Examiner provides an example to explain his position:

Let us say [Bosack's] packet broadcasting comprises three transmissions in all. The first two transmissions of the broadcast would anticipate the limitation "one or more first transmissions" in step (b) and the last transmission of the broadcast would anticipate the limitation "a second transmission" in step (c).

See Answer page 7, lines 6-9.

Thus, the question presented before us is whether the Examiner reasonably interpreted claim 25 steps (b) and (c) so as to be met by Bosack's multiple transmissions of a packet.

Claims will be given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims. *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985).

We find nothing in the claims or in the specification that precludes an interpretation of steps (b) and (c) of claim 25 to include multiple transmissions of a packet as conducted in Bosack's packet broadcasting. Step (b) of Claim 25 recites:

if a packet destination specified by the forwarding information includes a station other than the apparatus, then conducting one or more first transmissions of the packet to one **or** more of the network segments in order to deliver the packet to the packet destination.

*Stress added.* Step (b) requires sending the packet via one or more transmissions to the packet's destination, which is a

station (ports 0,1,2,3, or 5 in Figure 1) on a network segment (2). Since the claim language employs an "or", step (b) is met when "one" first transmission of the packet to a network segment in order to deliver the packet to the packet destination is made. A typical Bosack gateway circuit (76), shown in Bosack's Figure 3, makes at least a first transmission of the packet in order to deliver the packet to its destination station (for example 110). We find that Bosack teaches the limitation of "conducting one or more first transmissions of the packet to one or more of the network segments in order to deliver the packet to the packet destination."

Step (c) of Claim 25 recites:

conducting a second transmission of the packet to a network segment comprising the network monitor, wherein said second transmission is separate from said one or more first transmissions.

Step (c) requires conducting a separate transmission of the packet to a network segment (2) comprising the network monitor (9). Bosack's specification discloses on column 8, lines 46-53, in reference to Bosack's Figure 4, that Step E computes the path of the packet and if more than one path is acceptable, multiple transmissions are made using several such paths in a weighted form of a round robin alternation. A first of such multiple

transmissions would satisfy step (b) and a second of such multiple transmissions would satisfy step (c), since the second transmission is separate from the first. Thus, a typical Bosack gateway circuit (76), shown in Bosack's Figure 3, makes a separate transmission of the packet, as recited in step (c).

Implicit in Appellants' argument that Bosack's multiple transmissions of the packet only satisfy step (b) and do not meet step (c) because step (b) is performed in order to deliver the packet to its destination, is the argument that the transmission in step (c) occurs not for delivery of the packet to its destination, but for delivery of the packet to the network monitor for monitoring purposes. However, step (c) does not state why the second transmission is being made. As such, the scope of step (c) includes a second transmission being made for the purposes of delivering the packet to its destination, that is for broadcasting. We appreciate that Appellants' invention relates to a single monitoring device (9) which obtains a copy of a packet that is transmitted to its destination so that the monitoring device (9) can monitor traffic on multiple network segments (2). However, the language of step (c) of claim 25 is broad enough to read on Bosack's multiple transmissions of a packet in order to deliver the packet to its destination station.

Therefore, we find that Bosack teaches the limitation of "conducting a second transmission of the packet to a network segment."

We thus find that the claimed first (step (b)) and second transmissions (step (c)) read on the prior art teaching of conducting more than one transmission by Bosack. For instance, in case of two separate transmissions of a packet by Bosack's gateway circuit to network segments, both steps (b) and (c) would be met. Specifically, there would be a first transmissions of the packet to one network segments in order to deliver the packet to the packet destination, and a second transmission of the packet to a network segment comprising the network monitor. Therefore, we affirm the Examiner's rejection of claim 25.

Regarding claim 27, Appellants argue that Douglas does not teach or suggest either "specifying which packets are to be delivered to a network monitor" or that "the specifying step is performed more than once to yield different specifications of packets to be delivered to a network monitor," as recited in claim 27. See Appeal Brief page 7, lines 25-30.

The Examiner argues on page 8, lines 13-23 of the Answer that Bosack's system gateway specifies which packet is to be delivered to which network segment based on the destination

address of the packet. Thus, the Examiner argues the gateway would specify which packet is to be delivered to the monitoring port based on the destination address of the packet. With regard to the requirement in claim 27 that the specifying step is performed more than once, the Examiner argues that if the destination network monitor is not on a network that is directly connected to the gateway, the gateway will also specify more than one transmission (first and second transmissions) using the round robin technique to try all possible paths to deliver the packet to the destination network monitor. See Answer, page 3, lines 19-22. These different transmissions to the network segments, according to the Examiner, would yield different specifications of packets. See Answer, page 3, lines 22-23.

We note that the Examiner, by arguing that the gateway would specify which packet is to be delivered to the monitoring port based on the destination address of the packet and that different transmissions to the network segments would yield different specifications, has tried to establish that the claimed invention of claim 27 is inherent in Bosack.

"The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness." *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782,

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1784 (Fed. Cir. 1995). See also *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). However, the Examiner must show rationale or evidence tending to show inherency. The fact that a certain result or characteristic **may** occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The Examiner has failed to provide such extrinsic evidence as to make clear that Bosack's gateway (bridge) would specify which packets are to be delivered to a network monitor. In fact, there is an equally likely possibility that Bosack's gateway would deliver all packets to a network monitor, thus making no specifications as to which packets are to be delivered to a

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network monitor. The fact that a characteristic of specifying which packets are to be delivered to a network monitor may be present in Bosack is not sufficient to establish the inherency of that characteristic.

Thus, we find that the Examiner has not met the burden of establishing that the specification steps as recited in Appellants' claim 27 are necessarily present in Bosack. Therefore, we cannot sustain the Examiner's rejection of claim 27. However, we affirm the Examiner' rejection of claims 25, 26 and 28-31.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

***AFFIRMED-IN-PART***

ERROL A. KRASS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
JERRY SMITH	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
MICHAEL R. FLEMING	)	
Administrative Patent Judge	)	

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