

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte STEPHEN C. THEOBALD

Appeal No. 95-0907  
Application 07/774,757<sup>1</sup>

ON BRIEF

Before JERRY SMITH, FLEMING and LEE, Administrative Patent Judges.

LEE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-20 under 35 U.S.C. § 103 as being unpatentable over prior art. No claim has been allowed.

References in the Stated Ground of Rejection

Rattan et al.            U.S. Patent No. 4,698,770            Oct. 6, 1987  
(Rattan)

Wang et al. (Wang)  
"Protocol Testing Techniques," Computer Communication, Vol. 10,

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Application for patent filed October 8, 1991.

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No. 2, April 1987, pp. 79-87.

Appellant's Disclosed Prior Art

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### The Rejections on Appeal

Claims 1-10 and 12-19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wang and Rattan.

Claims 11 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wang and Rattan and further in view of the appellant's disclosed prior art.

The examiner has withdrawn a rejection of claims 1-20 under 35 U.S.C. § 112, first paragraph, as being without adequate written description in the specification. See advisory Office action (Paper No. 14). Thus, that rejection is a non-issue.

### The Invention

The invention relates to a testing apparatus for verifying the conformity of a device under test with a standard communications protocol. It sends a sequence of messages to a device under test, which messages include a request for the device to send back messages indicating which functions are supported by the device under test. The testing apparatus analyzes the return messages to determine conformity with the standard application protocol. Claim 1 is representative and reads as follows:

1. A test apparatus for verifying the conformity of a device under test with a standard application protocol defining the format, meaning and applicability of messages to be received and transmitted by the

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device under test, the apparatus comprising test sequencing means for generating and supplying to the device under test a test sequence of messages, including messages requesting messages to be transmitted by the device under test in response indicating whether functions of predetermined definition are present or absent in the device under test, and for analyzing messages transmitted by the device under test in response, to determine conformity or not with the standard application protocol.

#### Opinion

We do not sustain the rejection of claims 1-10 and 12-19 under 35 U.S.C. § 103 as being unpatentable over Wang and Rattan.

We also do not sustain the rejection of claims 11 and 20 under 35 U.S.C. § 103 as being unpatentable over Wang, Rattan, and the appellant's disclosed prior art.

The appellant has argued claims 1 and 4-11 as a first group, claims 2 and 12 as a second group, and claims 3 and 13-20 as a third group. Claim 1 is the only independent claim.

At the outset, we reject the appellant's argument that Wang is nonenabling prior art reference. First, it is noted that Wang has not been relied on by the examiner to show much at all. With respect to Wang, the examiner stated (answer at 3-4):

Wang teaches a protocol testing technique which provides to a device under test a sequence of operations to drive the protocol implementation through a set of tests. This will determine whether a product under test conforms to a protocol standard.

The examiner has relied on Wang to show nothing more

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specific than the general background noted above. It is not apparent how the generic feature of simply driving the device under test through a sequence of testing procedures would require undue experimentation on the part of one with ordinary skill in the art. Not every implementation detail has to be described in a prior art reference. Even a patent specification need not disclose what would be well known in the art. In re Buchner, (Fed. Cir. March 1991); Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).

It is also the appellant's burden to establish that the prior art is nonenabling. In re Payne, 606 F.2d 303, 314-15, 203 USPQ 245, 255-56 (CCPA 1979). Here, no declaration evidence has been submitted by the appellant from anyone with an opinion on whether the background and generic teachings of Wang would have been nonenabling with respect to one with ordinary skill in the art. Without such evidence and in light of the general nature of Wang's teaching, the appellant has not established that Wang is nonenabling with respect to what it has been relied on to show.

However, we agree with the appellant that it is highly artificial to regard Rattan's peripheral units as subdevices of a system or overall device under test. The plurality of

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peripherals in Rattan are simply operational units controlled by the computer of Rattan and are not reasonably deemed any part of a device under test, where the test is, as claimed, "for verifying the conformity of a device under test with a standard application protocol defining the format, meaning and applicability of messages to be received and transmitted by the device under test." The examiner's contrary view is unreasonable. As is stated by the appellant (Br. at 9):

[T]he plurality of peripherals controlled by the computer of Rattan et al. are not fairly a device under test, either individually or in combination. They are a collection of peripherals to be controlled by the computer.

Rattan's sensing what type of unit is connected, whether it is turned on, and what it is doing, in our view, does not reasonably constitute a test for determining conformity with a communication protocol defining the format, meaning and applicability of messages to be received and transmitted by the device under test. We agree with the appellant that the "control" aspect of Rattan is not reasonably combinable with the "testing" aspect of Wang regarding conformity to a standard protocol. The two cannot be equated as being the same or equivalent to each other.

Even assuming that Rattan's controlling is a form of testing for communications protocol defining the format, meaning and

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applicability of messages to be received and transmitted by the device under test, a combination of Rattan and Wang still would not satisfy a central feature of the appellant's claimed invention. Note that claim 1 requires a test sequencing means for generating and supplying to the device under test a test sequence of messages, "including messages requesting messages to be transmitted by the device under test in response indicating whether functions of predetermined definition are present or absent in the device under test."

Evidently, the examiner presumed or speculated that Rattan's system does generate and supply to its peripheral units (device under test) such a sequence of messages, and did not explain where in Rattan or Rattan in combination with Wang is such disclosure or suggestion. In that regard, we do not find in Rattan, Wang, or a combination thereof a suggestion for sending messages which request return messages to be sent from the device under test. Claim 1 further requires that the testing apparatus analyze the return messages from the device under test for determining conformity with the standard protocol. The examiner has not shown where in Rattan arises a suggestion for messages which are returned "in response" to requesting messages sent from the testing apparatus.

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The cable or control lines described in Rattan's column 6, lines 17-27 and column 16, lines 10-48, provide Rattan's intelligent interface the ability to sense whether something is connected to it through which lines. For instance, if a type 1 VCR is connected, then line 64E would be connected to ground through the VCR, and if a type 2 VCR is connected, then line 64F would be connected to ground through the VCR. (Column 16, lines 22-33). However, such "sensing" of whether a particular control or sense line is connected to ground through an external device cannot be reasonably regarded as sending messages from the testing apparatus, which messages request return messages to be transmitted by the device under test and in response to which the device under test sends return messages. Insofar as the examiner has apparently considered them to be the same, that is erroneous.

The examiner stated (answer at 4):

Rattan teaches in column 4, lines 5-20 that "... error messages are sent to the computer 14 in response to commands with invalid communication protocol or format, commands that select a peripheral of a category or device type that is not connected etc. . . .".

(Emphasis in original.)

The foregoing text would not have reasonably suggested the sending of a sequence of messages including messages requesting return messages to be transmitted by the device under test. To go from that disclosure to the appellant's claimed feature

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amounts to either improper speculation or hindsight in light of the appellant's own disclosure. The examiner may not, of course, because he or she may doubt the invention is patentable, resort to "speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in [the] factual basis." In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

Claim 2 depends from claim 1 and claim 3 depends from claim 2. Thus, both claims 2 and 3 include all limitations and

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features of independent claim 1. Because Wang and Rattan cannot support the examiner's rejection of claim 1, the rejection of claims 2 and 3 based also on Wang and Rattan also cannot stand.

In discussing claim 2, the examiner made reference (answer at 5) to U.S. Patent No. 4,937,825 (Ballard et al.) and U.S. Patent No. 5,157,782 (Tuttle et al.). However, neither Ballard et al. nor Tuttle et al. has been included in the examiner's stated ground of rejection. The appellant is correct that it is inappropriate for the examiner to rely on references which have not been included in the examiner's stated ground of rejection to supply features missing from the applied prior art. Indeed, all references on which the examiner relies should be positively recited in the rejection. See, e.g., In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970); Ex parte Movva, 31 USPQ2d 1027, 1028 n.1 (Bd. Pat. App. & Int. 1993); Ex parte Hiyamazu, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Int. 1988). Thus, Ballard et al. and Tuttle et al. cannot be properly relied on by the examiner to meet the features added by claim 2. Moreover, because the examiner has not relied on or discussed Ballard et al. or Tuttle et al. in the context of the rejection of claim 1, whether the features of claim 1 would have been suggested by Wang and Rattan in combination with Ballard et al.

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and/or Tuttle et al. is not an issue before us in this appeal.

Claims 11 and 20 each depend directly or indirectly from claim 1. The examiner has applied the appellant's own disclosed prior art to satisfy the features added by claims 11 and 20. However, as applied by the examiner, the disclosed or admitted prior art does not make up for the deficiencies of Wang and Rattan insofar as the features of claim 1 are concerned.

Accordingly, the rejection of claims 1-10 and 12-19 under 35 U.S.C. § 103 as being unpatentable over Wang and Rattan cannot be sustained.

The rejection of claims 11 and 20 under 35 U.S.C. § 103 as being unpatentable over Wang, Rattan, and the appellant's disclosed prior art cannot be sustained.

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Conclusion

The rejection of claims 1-10 and 12-19 under 35 U.S.C. § 103 as being unpatentable over Wang and Rattan is reversed.

The rejection of claims 11 and 20 under 35 U.S.C. § 103 as being unpatentable over Wang, Rattan, and the appellant's disclosed prior art is reversed.

REVERSED

JERRY SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
MICHAEL R. FLEMING	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
JAMESON LEE	)	
Administrative Patent Judge	)	

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