

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(2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK R. SESTAK

Appeal No. 96-2854
Application 08/119,980¹

ON BRIEF

Before THOMAS, JERRY SMITH, and HECKER, Administrative Patent Judges.

HECKER, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final
rejection of claims 1 through 3, all of the claims pending in

¹ Application for patent filed September 10, 1993.

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the application.

The invention relates to a method of reporting faults in communication switching system networks.

The only independent claim, claim 1, is reproduced as follows:

1. A method of reporting an event to a monitoring station in a network of communication switching exchanges comprising:
 - (a) monitoring in each exchange for events to be reported,
 - (b) upon detection of the event, the exchange in which the event occurred automatically dialing a gateway network node to which a network monitoring station is connected,
 - (c) upon the network node responding to the automatic dialing, sending at least one DTMF signal containing a report of the nature of the event and an identification of the exchange in which the event occurred to the network node for provision to the network monitoring station with an identification of the network node.

The references relied on by the Examiner are as follows:

Okanda 1988 ²	63-189040	Aug. 4,
Okurano	2-13054	Jan. 17, 1990 ²

² Our understanding of this reference is based on a translation obtained by the USPTO, copy enclosed.

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Butler et al. (Butler) 4,837,811 Jun. 6,
1989

Claims 1 through 3 stand rejected under 35 U.S.C. § 103 as being unpatentable over Okurano in view of Okanda and Butler.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the brief and the answer for the details thereof.

OPINION

After a careful review of the evidence before us, we agree with the Examiner that claim 1 is properly rejected under 35 U.S.C. § 103. Thus, we will sustain the rejection of this claim but we will reverse the rejection of claims 2 and 3 on appeal for the reasons set forth *infra*.

Appellant argues at page 14 of the Brief:

Appellant respectfully submits that the modification proposed by the Examiner of the system of Okurano is contrary to the very purpose of the Okanda system, of providing the operator with immediate display of maintenance information of all of the exchanges.

Where one document, here the reference to Okurano, states that its objective and configuration is to provide with continuous information, the fact that another reference [Okanda] describes providing

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fault information from a remote device to a maintenance device only when the fault occurs is not a teaching to modify the first reference, since to do so would prevent the objective of the first device from being accomplished.

We note that Appellant ascribes "immediate display" and "continuous information" to Okurano. Neither phrase is found in the reference, instead "immediately detect" (page 3), "immediately countermeasured" (page 3), "immediately recognizes" (page 7), and "immediately countermeasure" (page 7) are the closest phrases found. We therefore discern that Okurano wants the quickest possible response to a remote fault (in a communication network), and accomplishes this with a dedicated fault monitoring line. Okanda on the other hand wishes to save the overhead cost of a dedicated line in monitoring remote faults (in a non designated system), and uses an automatic dialing system to report faults, precisely

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as disclosed and claimed by Appellant. Note Appellant's specification at page 3, lines 16-18, where it recites "Dedicated trunks are not required, and excessive trunk resource is not consumed."

The Examiner's combination of Okanda with Okurano saves resources at the expense of some delay. How much delay is tolerable in Okurano is not addressed by the references, Appellant or the Examiner, and would be a necessary consideration in deciding to implement the Okanda teaching. The Federal Circuit reasons in Para-Ordnance Mfg. Inc. v. SGS Importers Int'l., 73 F.3d 1085, 1088-89, 37 USPQ2d 1237, 1239-40 (Fed. Cir. 1995), cert. denied, 117 S.Ct. 80 (1996), that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop the prior art, would have been reasonably expected to use the solution that is claimed by the Appellants. We find the cost savings advantage of Okanda to be an obvious improvement to Okurano since both systems achieve a relatively **quick** recognition and response to remote faults. Also, since Okurano is monitoring faults on its own (internal) communication system, automatic

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dialing would be expected to be quicker than in Okanda, which uses a public (external) communication system to transmit fault information.

As to Appellant's remarks that there is no teaching or suggestion to combine Okurano and Okanda, we agree with the Examiner that there is no requirement that a motivation to make the modification be expressly articulated. As the Court has stated, "It should be too well settled now to require citation or discussion that the test for combining references is not what the individual references themselves suggest but rather what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art." In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Appellant has not contested the combination of Butler as teaching the use of DTMF for reporting fault information over communication lines. Appellant only protests that Butler does not supply the perceived deficiencies of the Okurano/Okanda combination. For the above reasons, we will sustain the Examiner's rejection of claim 1.

With regard to dependent claims 2 and 3, it is the

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burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. In re Sernaker, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). In addition, the Federal Circuit states that "[t]he 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 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Appellant argues that the Examiner has supplied no teaching or suggestion of the comparing step of claim 2 nor the monitoring data processed by a processor of claim 3. The

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Examiner responds, at page 6 of the Answer:

With respect to claim 2 applicants argue that examiner speculates, with no evidence, that Okanda's system would generate fault by comparing the previous condition and the present condition of an exchange office. Though Okanda's system or Okurano's system lacks an explicit showing of such a fault generating step, generation of a fault alarm based on the comparison of a previous condition, which must have been normal prior to the occurrence of fault, with a current status is a well known method not just gleaned from the disclosure of the appellants and thus is considered to have been one of obvious ways to generate a fault alarm to be used in Okurano's system. Further with respect to claim 3, again it is well known that a fault of a system can be detected by monitoring data to see whether it is normal or abnormal and thus would have been obvious if not used by Okanda or Okurano. [emphasis added]

We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference, common knowledge or unquestionable demonstration. Our reviewing court requires this evidence in order to establish a ***prima facie*** case. In re Knapp-Monarch Co., 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); In re Cofer, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966). We will therefore not sustain the rejection of claims 2 and 3.

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In view of the foregoing, the decision of the Examiner rejecting claim 1 under 35 U.S.C. § 103 is affirmed; however, the decision of the Examiner rejecting claims 2 and 3 under 35 U.S.C. § 103 is reversed.

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

	James D. Thomas)	
	Administrative Patent Judge)	
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PATENT)	BOARD OF
	Jerry Smith)	APPEALS
AND	Administrative Patent Judge)	
)	
INTERFERENCES)	
)	
	Stuart N. Hecker)	
	Administrative Patent Judge)	

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Charles E. Wands
5240 Babcock Street, N.E., Ste. 306
Palm Bay, FL 32905