

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** SHOICHIRO NAKAI

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Appeal No. 96-3368  
Application No. 07/735,020<sup>1</sup>

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HEARD: June 11, 1999

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Before MARTIN, JERRY SMITH, and DIXON, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the Examiner's final rejection of claims 1, 2, 3, 5 and 6, which are all of the claims pending in this application.

We REVERSE.

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<sup>1</sup> Application for patent filed July 25, 1991.

## **BACKGROUND**

The appellant's invention relates to a hierarchically distributed network management system which uses OSI protocols. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A management system for a communications network containing a plurality of network nodes interconnected by transmission lines, said management system providing management control on said communications network using OSI (Open System Interconnection) protocols, and comprising:

a central management station comprising a central-station memory for storing attributes of managed objects which are supervised by the central management station, request entry means for issuing an access request, and control means responsive to the access request for making access to the central-station memory if the access request is concerned with the attributes stored in the central-station memory or transmitting a request to one of a plurality of first control lines if the access request is not concerned with the attributes stored in the central-station memory; and

a plurality of remote management stations respectively coupled to said central management station through said first control lines and respectively coupled through a plurality of second control lines to said network nodes,

each of the remote management stations comprising:

a remote-station memory for storing attributes of managed objects supervised by the remote management station;

a syntax analyzer for analyzing formal-description managed object definitions according to syntax rules and transforming the formal-description managed object definitions into transformed definitions which can be translated into machine instructions;

means for establishing reference relationships between said formal-description managed object definitions;

verification means for verifying the transformed definitions against said established reference relationships and producing verified definitions;

output means for receiving the verified definitions and applying part of the verified definitions as feedback to the verification means to allow the verification means to perform verification on the transformed definitions against said feedback;

definitions entry means for receiving the verified definitions from the verification means as received definitions and separating the received definitions into OSI-based definitions and non-OSI-based definitions;

OSI-based definitions storage means coupled to the definitions entry means for storing said OSI-based definitions;

non-OSI-based definitions storage means coupled to the definitions entry means for storing said non-OSI-based definitions; and

control means responsive to the request from the central management station for making a search through the stored OSI-based definitions to determine the executability of said request, reading a non-OSI-based definition from said non-OSI-based definitions storage means if said request is determined to be executable, and making access to the remote-station memory or transmitting a request to one of said network nodes in accordance with the non-OSI-based definition.



complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 16, filed March 13, 1995), reply brief (Paper No. 18, filed August 21, 1995) and supplemental reply brief (Paper No. 21, filed February 8, 1996) for the appellant's arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the Examiner. As a consequence of our review, we make the determinations which follow.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as

shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Similarly, the examiner must address the explicit limitations set forth in the claim to set forth the *prima facie* case of lack of novelty or obviousness.

After a careful review of the record in this case, we are compelled to agree with appellant that the Examiner's conclusion of obviousness is not supported by the types of factual findings necessary to reach this conclusion. Our reading of the Examiner's reasons for the determination of obviousness causes us to conclude that the Examiner merely believes the claimed invention to be obvious because it seems that it would have been obvious. This is not the test upon which determinations of obviousness are to be made.

The Examiner has set forth merely general propositions concerning the prior art teaching. These general propositions do not clearly address the limitations set forth in

claim 1. Appellant argues that the Examiner was requested to “specifically” identify the elements in Foster which correspond to the claim limitations. (See brief at page 7, referencing paper No. 11.) Appellant further argues that “one can only speculate as to how the Examiner believes that Foster discloses or makes obvious these elements of claim 1.” (See brief at page 7.) We agree with appellant.

Again, the Examiner generally asserts that Foster teaches all of the elements except that

Foster did not specifically teach a remote management station retransmitting a request from the central station to another remote management station. However, the capability to provide such retransmission is inherent/self-evident in Foster's system which uses powerful workstations and the LOOPS programming language, and one of ordinary skill in the DP art would be motivated to implement such a system modification (such as chaining remote management stations or clustering them around one communications server) when communication costs outweighed in importance the need for immediate communication. [See answer at pages 3-4.]

Here, the Examiner has merely asserted that the capability exists in the system of Foster, but not provided a motivation to include such a feature into the system. Furthermore, the Examiner argues that the system of Foster could provide for the “retransmission” of a request from a central station from one remote station to another remote station, but the claim recites:

each of the remote management stations comprising:

control means responsive to the request from the central management station for making a search through the stored OSI-based definitions to determine the executability of said request, reading a non-OSI-based definition from said non-OSI-based definitions storage means if said

request is determined to be executable, and making access to the remote-station memory or transmitting a request to one of said network nodes in accordance with the non-OSI-based definition.

Here, the Examiner has not addressed the specific language of claim 1, but merely addressed general propositions which may or may not correspond to the claimed invention when taken as a whole. The Examiner characterizes the “nodes” as “merely switches in the communications network” and cites to the specification at page 4, lines 13-25. (See answer at page 8.) This specific passage does not describe the nodes as merely switches, but discusses the “network node is made up of communications ‘equipment’ which are the objects of network management and will be referred to as such in the following description in so far as managed objects are concerned.” Clearly the Examiner has oversimplified the “node” and the associated communication therewith. Furthermore, appellant asserts that “[i]n the present invention, the same message is not retransmitted.” (See reply brief at page 1.) The Examiner continues to discuss retransmission in the supplemental Examiner's Answer at page 3, but this line of reasoning is not on point with respect to the transmission as discussed above.

Claim 5 contains similar machine/structural limitations which have not been addressed by the Examiner. Similarly, the controller in claim 5 contains limitations concerning determining if the “request is concerned with attributes stored in the remote

station or concerned with attributes supervised by the network nodes.” Clearly, the Examiner has not addressed this limitation in the rejection of the claim. Similarly the Examiner has not provided correspondence of the applied references to the invention set forth in claim 5.

With respect to the rejection based upon Schelvis in view of Harvey, appellant summarily relies upon the arguments provided with respect to the rejection based upon Foster. (See brief at pages 8-9.) We agree with appellant, as stated above. The Examiner has provided similar broad propositions without citing corresponding support in the references applied against the claims.

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the Examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the Examiner is not sufficient to establish a *prima facie* case of obviousness with respect to independent claims 1 and 5. Accordingly, we will not sustain the Examiner's rejection of claims 1 and 5 under 35 U.S.C. § 103.

Since all the limitations of independent claims 1 and 5 are not suggested by the applied prior art, we cannot sustain the Examiner's rejection of appealed claims 2, 3 and 6, which depend therefrom, under 35 U.S.C. § 103.

**CONCLUSION**

To summarize, the decision of the Examiner to reject claims 1-3, 5 and 6 under 35 U.S.C. § 103 is reversed.

REVERSED

JOHN C. MARTIN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JERRY SMITH	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JOSEPH L. DIXON	)	
Administrative Patent Judge	)	

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