

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAY BENASH and KENNETH P. D'ANDREA

Appeal No. 2001-1851
Application No. 08/815,363

ON BRIEF

Before JERRY SMITH, LEVY, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, 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 1-29 and 31, which are all the claims remaining in the application.

We affirm-in-part.

BACKGROUND

The invention is directed to a system and method for providing Internet services using a public switched telephone network. Claim 16 is reproduced below.

16. A wide area communications network for serving a plurality of defined geographic areas served by a switched telephone network comprising:

a plurality of central office switching systems in said telephone network in said geographic areas connected to a plurality of terminals in premises served by said switching systems in said geographic areas;

a switched multimegabit data service (SMDS) network spanning said geographic areas, said SMDS network having a plurality of connection points coupled to a respective one of a plurality of Internet Service Providers (ISPs);

at least one data hub node in each said geographic area;

each said at least one data hub node being connected to said SMDS network;

each said at least one data hub node including a gateway router connected via a packet switch and at least one access server to one of said central office switching systems, said access server being connected to one of said plurality of premises terminals via a switched path through a central office switching system in response to a dial up call from said one terminal;

each of said at least one data hub node routing signals therethrough at least partially by source routing.

The examiner relies on the following references:

Sistanizadeh et al. (Sistanizadeh)	5,790,548	Aug. 4, 1998 (filed Apr. 18, 1996)
Norris et al. (Norris)	5,805,587	Sep. 8, 1998 (filed Nov. 27, 1995)

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Claims 1-29 and 31 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sistanizadeh and Norris.

We refer to the Final Rejection (Paper No. 7) and the Examiner's Answer (Paper No. 16) for a statement of the examiner's position and to the Brief (Paper No. 15) and the Reply Brief (Paper No. 17) for appellants' position with respect to the claims which stand rejected.

OPINION

Appellants point out (Brief at 5) that claim 1 requires that the access server be connected to the premises terminal via a switched path through the central office switching system in response to a dial-up call from a terminal. Appellants contend that it would not have been obvious to modify the Sistanizadeh system to implement a dial-up connection to the data network. In particular, appellants allege that the modification proposed by the rejection would destroy the purpose of the Sistanizadeh system, relying on express teachings of the reference. (Reply Brief at 2-3.)

We find that Sistanizadeh discloses that the invention is directed to meeting bandwidth requirements much greater than those of conventional dial-up modems. See, e.g., col. 2, l. 65 - col. 3, l. 55; col. 4, ll. 5-9; col. 6, ll. 37-44. Further, the reference expresses recognition that most home computers at the time connected to public networks via a dial-up or an ISDN line. Col. 18, ll. 35-43. Yet, the inventors did not disclose any integration of the existing dial-up modems into their system.

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In view of the express teachings of Sistanizadeh, we believe there would need to be a strong showing from the prior art of some particular reason to modify the system of the reference such that prima facie obviousness of the subject matter as a whole of instant claim 1 is established. However, the reasons for combining the references offered by the rejection (e.g., Answer at 5-6) appear to be based on speculation, rather than arising from the prior art. For example, appellants submit (Brief at 8) that existing telephone service could have been used for dial-up access, resulting in no need for combining the features of the references as proposed by the rejection. We are unable to point to concrete evidence in the record in support of the examiner's findings underlying the proffered combination. See In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (in a determination of unpatentability "the Board must point to some concrete evidence in the record in support of...[the]...findings").

We thus consider appellants' arguments to be persuasive with respect to the requirements of instant claim 1. We do not sustain the section 103 rejection of the claim.

Appellants further submit that "[e]ach of independent claims 1, 16, 25, and 27" requires features including "the access server being configured for nondedicated switchable connection to any of the plurality of premises terminals in response to a dialed call therefrom." (Brief at 9.) Appellants do not, however, point to language in claims 16, 25, or 27 deemed to correspond to the arguments.

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Claim 16 sets forth that the access server is connected to a terminal via a switched path through a central office switching system in response to a dial up call from the terminal. We do not sustain the rejection of independent claim 16, for substantially the same reasons that we do not sustain the rejection of claim 1.

However, we do not consider appellants' arguments to be commensurate with the requirements of claim 25 and claim 27. Neither claim sets forth any connection in response to a "dial up call" from a terminal. Each claim recites "routing a data call from one of said premises to a central office switching system" to which it is connected. In view of appellants' disclosure (e.g., spec. at ¶¶ bridging pages 29 and 30; Fig. 4, ref. num. 16), the "routing" may require nothing more than twisted pairs of conductors from a user's computer to the central office switching system.

We compare the "routing" requirement expressed by claim 25 and claim 27 with the teachings of Sistanizadeh and find it met by the reference. Sistanizadeh at column 8, lines 23 through 33 reveals that customer premises 1010 and 1012 (Fig. 10) may be connected to a central office (CO) by copper loops 1014 and 1016.

Appellants have thus not persuaded us that the evidence relied upon by the examiner fails to show prima facie obviousness of the subject matter as a whole of claim 25 and claim 27. We therefore sustain the section 103 rejection of each of the claims.

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Dependent claims 26, 28, 29, and 31 fall with independent claims 25 and 27. Appellants have, at best, merely repeated limitations of the dependent claims, which does not rise to the level of separate arguments for patentability. See 37 CFR § 1.192(c)(7):

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.

Moreover, appellants have not addressed the examiner's findings (e.g., Final Rejection at 5-6) with respect to where the features of dependent claims 26, 28, 29, and 31 are taught by the references. Thus, even if appellants had met the requirements for separate consideration of the claims, appellants have not shown error in the examiner's findings underlying the rejection.

For the foregoing reasons, we sustain the rejection of claims 25 through 29 and 31. Since we have not sustained the rejection of claim 1 or claim 16, we do not sustain the rejection of claims 2-13 and 17-24, which incorporate the limitations of base claim 1 or 16.

We have considered all of appellants' arguments in making our determinations. Arguments not relied upon are deemed waived. See 37 CFR § 1.192(a) ("Any

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arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.”) and § 1.192(c)(8)(iv) (the brief must point out the errors in the rejection).

CONCLUSION

The rejection of claims 25-29 and 31 under 35 U.S.C. § 103 is affirmed. The rejection of claims 1-24 under 35 U.S.C. § 103 is reversed. The examiner’s decision in rejecting claims 1-29 and 31 is thus affirmed-in-part.

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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

JERRY SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
STUART S. LEVY)	APPEALS
Administrative Patent Judge)	AND
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