

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEITH W. BARNES,
RORY A. SMITH and MERVIN L. GRINDAHL

Appeal No. 2002-1106
Application 09/058,687

HEARD: February 4, 2003

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

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-4, 9 and 14. Claims 5-8, 10-13 and 15-24 have been indicated to contain allowable subject matter.

The disclosed invention pertains to a method for distributing and accessing communication channels in a trunked radio repeater communication system. The method includes an aliasing function which enables a subscriber programmed for a given home channel to select another home channel in a

Appeal No. 2002-1106
Application 09/058,687

communication system where the given home channel is not otherwise available. The selected home channel serves as an alias home channel.

Representative claim 1 is reproduced as follows:

1. A method for channel assignment, comprising:
distributing candidate home channel numbers across a range of available channel numbers;
assigning a home channel to each subscriber;
scanning for an open channel corresponding to the home channel assigned the particular subscriber;
if the home channel is available, conducting communications on the home channel; and
if the home channel is unavailable, seeking a next available home channel.

The examiner relies on the following references:

George	5,203,015	Apr. 13, 1993
Alford et al. (Alford)	5,613,201	Mar. 18, 1997

Claims 1-3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of George. Claims 4, 9 and 14 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers George in view of Alford.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of

Appeal No. 2002-1106
Application 09/058,687

anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon does not support either of the rejections set forth by the examiner. Accordingly, we reverse.

We consider first the rejection of claims 1-3 under 35 U.S.C. § 102(b) as being anticipated by the disclosure of George. These claims stand or fall together as a single group [brief, page 4]. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner indicates how the invention of representative claim 1 is read on the disclosure of George [answer, page 3]. Appellants argue that the portions of George relied on by the examiner do not support the examiner's findings of anticipation. Specifically, appellants argue that there is no teaching or suggestion in George for the steps of distributing candidate home channel numbers across a range of available channel numbers and seeking a next available home channel. With respect to the latter step, appellants argue that the home channel in George remains unchanged. With respect to the former point, appellants argue that there is no mention of candidate home channel numbers in George. Appellants also argue that the assignment of idle channels in George is not the same as seeking a next available home channel as claimed [brief, pages 5-9].

The examiner responds that George teaches allowing for the use of idle channels for subscriber communication when the assigned home channel is not available. The examiner asserts that the claimed candidate home channels do not distinguish over the available idle channels of George since any of them are clearly candidates for use as the subscriber's communication or home channel [answer, pages 4-5].

Appeal No. 2002-1106
Application 09/058,687

Appellants respond that George does not teach multiple home channels and that the examiner's answer has raised new issues which have not been fully developed [reply brief].

We will not sustain this rejection. The critical question before us is whether the selection of an idle channel in George, when the home channel is not available, constitutes the selection of a next available home channel as recited in claim 1. The home channel is the channel used by the subscriber to send and receive subaudio control signals to and from the repeaters [specification, page 9, lines 23-29]. In George, if the home channel is available for voice communication, then the home channel is used for voice communication. If the home channel is not available for voice communication, then an idle channel is selected for voice communication. There is no disclosure in George, however, that the channel that is used for communication with the repeater, that is, the home channel, is changed whenever an idle channel is selected for voice communication. On the contrary, it appears likely that the same home channel in George continues to be used for subaudio control signal communications with the repeater. In other words, even though voice communications have been transferred to an idle channel in George, the control data in George would continue to be sent on

Appeal No. 2002-1106
Application 09/058,687

the assigned home channel. Since the home channel is the channel monitored for subaudio control signals from the repeater, the mere selection of an idle channel for voice communication does not suggest that a new home channel is sought and selected as claimed. Therefore, we agree with appellants that there is no disclosure in George that a next available home channel is sought when the assigned home channel is not available.

We now consider the rejection of claims 4, 9 and 14 under 35 U.S.C. § 103 as unpatentable over the teachings of George in view of Alford. These claims stand or fall together as a single group [brief, page 4]. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in

Appeal No. 2002-1106
Application 09/058,687

the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellants [see 37 CFR § 1.192(a)].

Appeal No. 2002-1106
Application 09/058,687

The examiner indicates how he finds the claimed invention to be obvious [answer, page 4]. Appellants argue that the combination of George and Alford fails to teach all the elements of the claimed invention. Appellants also argue that there is no motivation to combine the teachings of George and Alford in the manner proposed by the examiner [brief, pages 10-14]. The examiner disagrees with these arguments [answer, page 6].

We will not sustain this rejection for the reasons discussed above. The examiner's findings with respect to George are incorrect for reasons noted above. The teachings of Alford do not overcome the deficiencies in George. Since George does not support the examiner's position, the examiner's rejection fails to establish a prima facie case of obviousness.

In summary, we have not sustained either of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-4, 9 and 14 is reversed.

Appeal No. 2002-1106
Application 09/058,687

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
)	
)	BOARD OF PATENT
)	
)	APPEALS AND
JERRY SMITH)	
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
)	
)	
MICHAEL R. FLEMING)	
Administrative Patent Judge)	

JS/kis

Appeal No. 2002-1106
Application 09/058,687

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH
P. O. BOX 2938
MINNEAPOLIS, MN 55402