

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THEODORE F. LONGSHORE and WILLIAM P. DECLERCK

Appeal No. 1997-0624
Application No. 08/303,556

ON BRIEF

Before LALL, DIXON, and GROSS, **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, 4-10, 12, 13 and 18-21, which are all of the claims pending in this application. In the answer, the examiner allowed claims 12, 13 and 18-21 and objected to claims 9 and 10, therefore only claims 1, 2 and 4-8 remain on appeal for review.

We AFFIRM.

BACKGROUND

The appellants' invention relates to a method and apparatus for signaling interference protection in a channel reuse radio network. An understanding of the invention can be derived from a reading of exemplary claim 5, which is reproduced below.

5. In a channel reuse radio system, a method of signalling interference protection, the method comprising the steps of:

differentiating, within a reuse pattern, between a desired voice channel and an interfering voice channel, and

responding to the desired voice channel while remaining unresponsive to the interfering voice channel based on the differentiation.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Eizenhöfer	4,754,453	Jan. 28, 1988
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Claims 1, 2 and 4-8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Eizenhöfer.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 37, mailed Aug. 20, 1996) for the examiner's reasoning in support of the rejections, and to the appellants' brief (Paper No. 36, filed May 20, 1996) for the appellants' arguments thereagainst.

OPINION

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

We note that appellants have presented claims 1, 2 and 4-8 as standing or falling together and have argued all of the claims as a single group. (See Brief at page 5.) Therefore, we address claims 1, 2 and 4-8 as standing or falling together (37 CFR 1.192(c)(7)).

At the outset we note that we make our determination on the evidence of record on the issues before use at the time of the decision. We are not required to raise and/or consider such issues. 37 C.F.R. § 1.192(a). As stated by our reviewing court in **In re Baxter Travenol Labs.**, 952 F.2d. 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991), "[i]t is not the function of this court to examine the claims in greater detail than argued by an appellant." 37 C.F.R. § 1.192(a) states: "[t]he brief . . . must set forth the authorities and arguments on which appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences." Similarly, we limit our review to the arguments raised by the appellants and the examiner.

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In accordance with 37 CFR § 1.192(c)(7), we have selected claim 5 as the representative claim from the appellants' grouping of claims 1, 2 and 4-8 to decide the appeal on this rejection under 35 U.S.C. § 102. (See Brief at page 5.) Thereby, in accordance with 37 CFR § 1.192(c)(7), all claims fall with representative claim 5. Thus, it follows that the decision of the examiner to reject claims 1, 2 and 4-8 under 35 U.S.C. § 102 is affirmed for the reasons discussed below.

"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." **RCA Corp. v. Applied Digital Data Systems, Inc.**, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

It is well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office (PTO). **See In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). After the PTO establishes a *prima facie* case of anticipation based on inherency, the burden shifts to the appellants to prove that the subject matter shown to be in the prior art does not possess the characteristics of the claimed invention. **See In re Thorpe**, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); **In re King**, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986). Hence, appellants' burden before the PTO is to prove that the applied prior art reference does not perform the functions defined in the claims. The appellants have not come forward with

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any evidence to satisfy that burden. Compare **In re Best**, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); **In re Ludtke**, 441 F.2d 660, 664, 169 USPQ 563, 566-67 (CCPA 1971).

Appellants argue that Eizenhöfer has not recognized the problem that differentiation between adjacent voice channels within a cluster or reuse pattern is required. (See Brief at pages 7-8.) The examiner argues that the independent claims do not recite adjacent channel interference. We agree with the examiner.

Appellants further argue that the invention solves the problem of differentiating an undesired adjacent voice channel from a desired voice channel and that this problem is overcome by including within each voice channel, signaling interference protection information that differentiates desired voice channels from undesired or interfering voice channels. (See Brief at pages 7-8.) The examiner argues that the independent claims do not recite this distinction. We agree with the examiner. We do not find an express basis in claim 5 for requiring that each channel include signaling interference protection information that differentiates the channel. Therefore, this argument is not persuasive.

The examiner maintains that

As applied, the Eizenhofer reference anticipates claims 1-2 and 4-8 since Eizenhofer discloses the use of the mobile's ID to "differentiate" between users. The IDs are transmitted in all channels (desired, interfering, adjacent etc.) in order that the mobiles can be distinguished from each other. The

mobiles only respond to channels that carry their particular unique ID and remain unresponsive to the other channels whether these channels are adjacent or otherwise situated. This is all that is required by claims 1-2 and 4-8.

Moreover, claims 1-2 and 4-5 as presently recited even read on appellants [sic, appellants'] discussion of the use of SAT to guard against cochannel interference as discussed at page 7 of the Brief. As is well known and conceded by appellants, SAT is transmitted in the voice channels (differentiating signalling) and used by the mobile and base station to assure that a mobile is communicating with the correct base station. The correct receipt and retransmission of SAT assures the mobile and base that co-channel interference has been prevented. Therefore, SAT is "signalling information" which is transmitted in all the voice channels (desired and "interfering") where the mobile responds only to the correct anticipated version of SAT. This is all that is required by claims 1-2 and 4-5 as presently recited.

Eizenhofer and appellants [sic, appellants'] invention [sic, inventions] differ in the inclusion of signalling identifying (through the use of an odd/even bit or one of 2 states of 2 channel partitions) adjacent channels in order to prevent adjacent channel interference as specifically shown in appellants [sic, appellants'] figure 3 and, where the claims have recited such features (namely claims 9-10, 12-13, and 18-21), these claims have been indicated allowable. The broad recitations of claims 1-2 and 4-8 which do not recite such features are anticipated by Eizenhofer through the use of the mobiles [sic, mobile's] ID as the "information" which differentiates between users. (See Answer at pages 7-8.)

The examiner has interpreted the language of the claims to be limited to a single user per channel thereby having the IDs distinguish the channels. Appellants have not submitted a Reply Brief to address the examiner's clear statement of how the claims have been interpreted and how the prior art has been interpreted and applied. Therefore, we accept the examiner's reasonable interpretation of the prior art as applied to the language of

claim 5, and we agree with the examiner that Eizenhöfer anticipates the language of claim 5.

Appellants argue that Eizenhöfer does not teach that information can be added to the channel to mitigate interference between channels. (See Brief at page 9 with respect to Group II.) This argument is not persuasive since the examiner has indicated that subject matter clearly setting forth the addition of signals to the channels, such as an odd/even bit as in claim 10, would be allowable.

Clearly, the examiner has provided a discussion of the claimed invention as it relates to the applied reference and given corresponding discussions in the text of the reference. We find that the examiner has set forth a *prima facie* case of anticipation and that appellants have not rebutted the *prima facie* case by showing insufficient evidence of the *prima facie* case of anticipation. Therefore, we will sustain the rejection of claims 1, 2 and 4-8 under 35 U.S.C. § 102.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2 and 4-8 under 35 U.S.C. § 102 is affirmed.

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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

PARSHOTAM S. LALL)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH L. DIXON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
ANITA PELLMAN GROSS)	
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