

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(2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHIMON MULLER

Appeal No. 1998-2709
Application No. 08/451,796

ON BRIEF

Before THOMAS, JERRY SMITH and LALL, 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 5-14 and 19-27. Claims 1-4 and 15-18 have been indicated by the examiner to contain allowable subject matter.

The disclosed invention pertains to a random number generator for use in a condition reduction protocol on a

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computer network. More particularly, the random number generator of the

invention generates first and second random numbers using two different types of random number generators. The first and second random numbers are combined to produce a third random number.

Representative claim 5 is reproduced as follows:

5. A method of generating random numbers, comprising the steps of:

A) generating a first random number using a first random number generator of a first type;

B) generating a second random number using a second random number generator of a second type different from said first type; and

C) combining said first and second random numbers to produce a third random number.

The examiner relies on the following reference:

Albers et al. (Albers) 5,153,532 Oct. 06, 1992

Claims 5-14 and 19-27 stand rejected under 35 U.S.C.

§ 103. As evidence of obviousness the examiner offers Albers

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taken alone¹.

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

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejection 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 and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 5-14 and 19-27. Accordingly, we affirm.

¹ The alternative rejection of these claims based on Lee (4,852,023) as set forth in the final rejection has been withdrawn in the examiner's answer.

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Although appellant nominally indicates that independent claims 5 and 19 stand or fall separately from dependent claims 6-14 and 20-27 [brief, page 2], appellant has presented no arguments in support of the separate patentability of the dependent claims. Appellant simply asserts that the dependent claims are patentable because they are similar to the allowed claims. Such an assertion does not properly address the rejection made by the examiner. Since the arguments section of appellant's brief only argues independent claims 5 and 19, and since these two claims are argued together, all the claims on appeal before us will stand or fall together as a single group with claim 5 selected as the representative claim for the entire group. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

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

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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 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,

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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 appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

With respect to representative, independent claim 5, the examiner notes that Albers teaches a circuit for combining the outputs of two random number generators designed to produce different outputs. The examiner finds that the recitation of first and second types of random number generators would have been obvious to the artisan in view of the teachings of Albers [answer, pages 4-5].

Appellant argues that the two random number generators in Albers are not of different types as required by claim 5.

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Appellant also argues that the circuit in Albers will eventually result in cyclic repetition [brief, page 4].

With respect to the second argument, we are not persuaded by this argument. Albers teaches forming a random number by combining the outputs of two different pseudo-random number generators. While appellant is correct that the output in Albers will eventually repeat, we do not agree that this result is precluded by the language of claim 5. The pseudo-random numbers generated in Albers are considered to be "random numbers" within the broad definition of that term as it is typically used in this art.

We do not agree with appellant's argument that Albers teaches away from using two different types of random number generators. Although the preferred embodiment of Albers uses two

pseudo-random sequence generators clocked at different frequencies, the teachings of Albers are not so limited. It is clear from the disclosure of Albers that the main requirement of that invention is that the outputs from the two random number generators must be different. This provides an

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improved random number because a first random number is modulated by a second random number [column 4, lines 28-40]. Thus, the key teaching in Albers is that the two random number generators must produce different outputs.

Albers also teaches that the random number generators can be constructed in various other ways to perform the intended function [column 5, lines 21-24]. Thus, the particular type of random number generator is not critical in Albers. The artisan would have appreciated from the teachings of Albers that the two random number generators could be of different types as long as they produced the requisite different outputs. Therefore, we find that the broad recitation of first and second types of random number generators as set forth in claim 5 would have been obvious within the meaning of 35 U.S.C. § 103 in view of the teachings of Albers.

In summary, we have sustained the examiner's rejection of claims 5-14 and 19-27 which stand or fall together as a single group. Accordingly, the decision of the examiner rejecting

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claims 5-14 and 19-27 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JERRY SMITH)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
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