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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte WILLIAM M. RADICH

Appeal 2012-008979
Application 10/607,967
Technology Center 2100

Before JEAN R. HOMERE, THU A. DANG, and GREGORY J. GONSALVES, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

In papers filed December 20, 2012, Appellant requests a rehearing under 37 C.F.R. § 41.52 from the Decision on Appeal (Decision) of the Patent Trial and Appeal Board (Board), dated October 24, 2012. In the Decision, we affirmed the Examiner's rejections of claims 1-3, 5-8, 10-13, 15-18, 21-23, and 27. (Dec. 7.)

Appellant alleges that the Board erred by overlooking Appellant's arguments presented in the Reply Brief for patentability of claim 27. (Req. Reh'g. 3.) In particular, Appellant submits that the Board erred in declining to consider arguments presented by Appellant in the Reply Brief in response to new grounds of rejection raised by the Examiner in the Answer. (*Id*. at 4.) According to Appellant, the Examiner had not presented a detailed rejection of claim 27 until the Examiner Answer. (*Id*. at 5.) Therefore, Appellant submits that because the new findings and conclusions presented in the Answer could not have been addressed until the Reply Brief, the Board should consider Appellant's arguments presented in the Reply Brief that there was insufficient rationale to combine the teachings of Kavcic and Jeon to render claim 27 unpatentable. Consequently, Appellant requests that the Board reverse the Examiner's obviousness rejections. (*Id*.)

We have carefully reviewed the Decision in light of Appellant's allegation of error. However, we find without merit Appellant's allegation that we overlooked Appellant's arguments regarding the Examiner's rejection claim 27.

In the Decision, we found untimely "Appellant's arguments in the Reply Brief that the teachings of Kavcic and Jeon are not properly combinable for lack of sufficient motivation." (Dec. 5.) First, we note that the Examiner rejected claims 23 and 27 in the Final office action over the combination of Kavcic and Jeon. (Fin. Action 3.) Thus, while the Examiner made new findings in the Answer regarding claim 27 (Ans. 12), we find that Appellant's combinability argument raised for the first time in the Reply Brief is not predicated by the Examiner's additional finding. Appellant could have raised that same argument in the Appeal Brief because the Examiner had established in the Final action that claim 27 was rejected over the combination of Kavcic and Jeon.

Further, even if we had considered Appellant's combinability argument, it would not be availing.

The U.S. Supreme Court has held that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007). The Court further instructs that:

> [o]ften it will be necessary for a court to look to interrelated teachings of multiple patents; . . . and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason for combining the known elements in a the fashion claimed by the patent at issue.

Id. at 418.

Additionally, the Court instructs that:

> "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness"…. [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

Id. (citation omitted).

As prescribed by the controlling case law, while it is often necessary for an Examiner to identify a reason for combining the familiar elements obtained from the prior art in establishing a prima facie case of obviousness, the identification of such a reason is not a *sine qua non* requirement. So long as the Examiner provides an articulated reasoning with some rational underpinning to substantiate the obviousness rejection, such a conclusion is proper. In this case, the Examiner provides more than just a mere conclusory statement. The Examiner notes that at the time of the claimed invention, an ordinarily skilled artisan would have been motivated to modify the Viterbi detector of Kavcic with the detector of Jeon because the ordinarily skilled artisan would have "recognized that by allowing the Viterbi detector to have a variable that represents, for each data symbol, a jitter or shift in discrete time with respect to a sampled symbol rate and that relates transition jitter to signal sample noise in an amplitude domain would have efficiently addressed the errors produced by transition jitter noise." (Ans. 7; Non-Final Action of 4/15/11, p. 4.) In our view, such a statement

suffices as an articulated reason with a rational underpinning to support the cited combination. As noted above, the case law allows the Examiner to look to the state of the prior art, including the knowledge of the ordinarily skilled artisan to arrive at such a reason for combining the known elements of the prior art. Consequently, the Examiner's reliance upon the cited references in order to arrive at an articulated reason with a rational underpinning to support the proffered combination is proper.

Additionally, we find no merit in Appellant's argument that the Board failed to consider all the arguments presented in the Briefs. (Req. Reh'g. 5-6.) As indicated in the Opinion, Appellant addressed only a single portion of Kavcic (column 7, ll. 24-32) and Jeon (abstract). (Dec. 5.) However, Appellant failed to address the specific teachings of the references relied upon by the Examiner in the proposed combination. (*Id.*) We therefore reiterate our initial position that Appellant's failure to address the specific portions of the references for the proffered combination is not responsive to the specific findings made by the Examiner.

Because the Decision addressed all timely presented arguments pertaining to the claims pending on appeal, we find unpersuasive Appellant's allegations of error. Consequently, we maintain our position to affirm the Examiner's rejections of claims 1-3, 5-8, 10-13, 15-18, 21-23, and 27 as set forth in the Decision.

CONCLUSION

In view of the foregoing discussion, we decline to modify our Decision. Consequently, we deny Appellant's Request for Rehearing.

REQUEST FOR REHEARING-DENIED

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