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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KYLE JUNG-LIN PAN, ROBERT LIND OLESEN, and
DONALD M. GREICO

Appeal 2015-005316
Application 11/746,330
Technology Center 2600

Before CATHERINE SHIANG, TERRENCE W. McMILLIN, and
NORMAN H. BEAMER, *Administrative Patent Judges*.

SHIANG, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 41–48, which are all the claims pending and rejected in the application. We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part.

STATEMENT OF THE CASE

Introduction

The present invention relates to wireless communications. *See generally* Spec. 1. Claim 41 is exemplary:

41. A wireless transmit/receive unit (WTRU) comprising a processor configured to select a pre-coding codeword from a first codebook, the first codebook comprising a plurality of pre-coding codewords divided into a plurality of subsets of precoding codewords, wherein the selected pre-coding codeword is selected from a selected one of said subsets of pre-coding codewords, wherein the selected subset is selected based on rank.

References and Rejections

Claims 42, 43, and 47 are rejected under 35 U.S.C. § 112, second paragraph for indefiniteness.

Claims 41, 43, 44, and 46–48 are rejected under U.S.C. §102(e) as being anticipated by Wang (U.S 2007/0174038 A1; July 26, 2007).

Claims 42 and 45 are rejected under 35 U.S.C. §103(a) as being unpatentable over Wang and Li (U.S 2006/0092054 A1; May 4, 2006).

ANALYSIS

35 U.S.C. § 112, Second paragraph

Claims must “particularly point[] out and distinctly claim[] the subject matter which the applicant regards as his invention.” 35 U.S.C. § 112, second paragraph.

Because Appellants do not contest the merits of the Examiner’s rejection, we summarily affirm the Examiner’s rejection of claims 42, 43, and 47 under 35 U.S.C. § 112, second paragraph.

Anticipation

We have reviewed the Examiner’s rejection in light of Appellants’ contentions and the evidence of record. We concur with Appellants’ contention that the Examiner erred in finding Wang discloses “the first codebook comprising a plurality of pre-coding codewords divided into a plurality of *subsets* of precoding codewords,” as recited in independent claim 41 (emphasis added).¹ See App. Br. 4–6; Reply Br. 1–5.

The Examiner finds:

Wang mentions that original precoding matrices in a codebook could be altered to yield a modified codebook of updated precoding matrices (see, [0043-44]; whereby *the precoding matrices are being associated with the “pre-coding codewords” and the modified codebook is being associated with the “subset of precoding codeword”*). Thus, *the modified codebook of updated precoding matrices is a byproduct/“subset” of the original precoding matrices in the codebook.*

Ans. 5 (emphases added, original emphases omitted); see also Final Act. 2–4.

During examination, claims are given their broadest reasonable interpretation consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art, but without importing limitations from the specification. See *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (citations omitted); *SuperGuide Corp. v. DirecTV Enters., Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004).

We agree with Appellants that the Examiner’s interpretation of “subset” is unreasonable, and the Examiner’s finding that “the **modified**

¹ Appellants raise additional arguments. Because the identified issue is dispositive of the appeal, we do not reach the additional arguments.

codebook of updated precoding matrices is a **byproduct**/"subset" of the **original precoding** matrices in the codebook" (Ans. 5) is unsupported by evidence. *See* App. Br. 4–6; Reply Br. 1–5. Specifically, the Examiner has not shown one skilled in the art would consider Wang's "*modified* codebook of *updated* precoding matrices" constitutes a *subset* of the "*original* precoding matrices in the codebook." Ans. 5 (emphases added, original emphases omitted). *See* App. Br. 4–6; Reply Br. 1–5. Therefore, the Examiner has not shown Wang discloses "the first codebook comprising a plurality of pre-coding codewords divided into a plurality of subsets of precoding codewords," as required by claim 41.

Because the Examiner fails to provide sufficient evidence or explanation to support the anticipation rejection, we are constrained by the record to reverse the Examiner's rejection of claim 41, and corresponding dependent claims 43 and 47.

Independent claim 44 recites a claim limitation that is substantively similar to the disputed limitation of claim 41. *See* claim 44. Therefore, for similar reasons, we reverse the Examiner's rejection of independent claim 44, and corresponding dependent claims 46 and 48.

Obviousness

The Examiner cites an additional reference for the obviousness rejection of claims 42 and 45. The Examiner relies on Wang in the same manner discussed above in the context of claim 41, and does not rely on the additional reference in any manner that remedies the deficiencies of the underlying anticipation rejection. *See* Final Act. 6–7.

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Accordingly, we reverse the Examiner's obviousness rejection of claims 42 and 45.

DECISION

We reverse the Examiner's decision rejecting claims 41–48 under 35 U.S.C. §§ 102, 103.

We affirm the Examiner's decision rejecting claims 42, 43, and 47 under 35 U.S.C. § 112, second paragraph.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART