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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/697,053	04/05/2007	Yoshitaka Hara	306610US2	5627

22850 7590 11/25/2016
OBLON, MCCLELLAND, MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

BURD, KEVIN MICHAEL

ART UNIT	PAPER NUMBER
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2632

NOTIFICATION DATE	DELIVERY MODE
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11/25/2016

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte YOSHITAKA HARA, DAMIEN CASTELAIN, and
NORIYUKI FUKUI

Appeal 2016-001542
Application 11/697,053
Technology Center 2600

Before ALLEN R. MacDONALD, MICHAEL M. BARRY and
MICHAEL J. ENGLE, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 25–29. Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

Exemplary Claim

Claim 25 under appeal reads as follows (emphasis/brackets added):

25. A method for transferring to a first telecommunication device channel quality indication information determined by a second telecommunication device for a plurality of frequency sub-bands, the telecommunication devices being linked through a wireless telecommunication network using an uplink and a downlink, the wireless telecommunication network using the plurality of frequency sub-bands, the method comprising steps executed by the second telecommunication device of:

[(A)] determining at least one ***first channel quality indication*** for at least one of the ***plurality*** of frequency sub-bands of the downlink;

[(B)] determining a ***second channel quality indication*** which is a ***single*** representative quality for the plurality of frequency sub-bands of the downlink;

[(C)] transmitting, through the uplink, the first channel quality indication to the first telecommunication device ***in a first time period***; and

[(D)] transmitting, through the uplink, the second channel quality indication to the first telecommunication device

[(i)] ***in a second time period different from the first time period***,

[(ii)] a length of the second time period ***being shorter*** than a length of the first time period, and

[(iii)] positions within one time-frame of both the first time period for transmitting the first channel quality indication and the second time period for transmitting the second channel quality indication being unchanged through at least two consecutive cyclic time-frames of the uplink.

Rejections

The Examiner rejected claims 25–29 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Khan (US 2007/0026813 A1; Feb. 1, 2007), and Matthews et al. (US 2006/0004938 A1; Jan. 5, 2006).¹

*Appellants' Contentions*²

1. Appellants contend that the Examiner erred in rejecting claim 25 under 35 U.S.C. § 103(a) because:

[The] Office Action at the bottom half of p. 5 acknowledges that Khan does not disclose transmitting and receiving the first channel quality indication and the second channel quality indication in different time periods. For this feature, the outstanding Office Action relies on Matthews et al. at the bottom of p. 5 and the top of p. 6. However, applying Matthews et al. in the manner stated in the outstanding Office Action is reading features into Matthews et al. which do not exist in Matthews et al. and it is improper to assert that Matthews et al. discloses or suggests the feature of transmitting two different channel quality indications in different time periods.

App. Br. 8.

¹ Separate patentability is not properly argued for claims 26–29. Rather, Appellants address these claims by referencing the arguments for claim 25. App. Br. 11–13. Then, Appellants merely assert the cited prior art does not teach or render obvious broadly stated claim limitations (e.g., “transmission method” (App. Br. 12)). Without more, this fails to constitute a sufficient argument on the merits. See 37 C.F.R. § 41.37(c)(1)(iv); *In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011). Thus, the rejection of these claims turns on our decision as to claim 25. Except for our ultimate decision, these claims are not discussed further herein.

² Appellants' Appeal Brief argues the remarks in the Advisory Action (paragraph bridging 8–9). This argument (and the Examiner's response thereto) is not relevant to the Final Rejection on appeal before us as the Advisory Action remarks are not the basis for that rejection. This argument is not discussed further herein.

The outstanding Office Action has extensive speculation regarding what *can* occur in Matthews et al., but this is not supported by the teaching of Matthews et al. or other prior art. For example, the top of p. 6 of the Office Action states, “The CQIs for each or all sub bands can comprise time slot 210A and the CQI for the average value of the sub bands can comprise a subsequent time slot such as time slot 210C.” This is not based on any teaching in the prior art but is merely unsupported speculation. Because the prior art neither discloses nor suggests the use of different time periods for transmitting channel quality indications of the “at least one of the plurality of frequency sub-bands of the downlink,” independent Claim 25 is patentable over the prior art.

App. Br. 9.

2. Appellants contend that the Examiner erred in rejecting claim 25 under 35 U.S.C. § 103(a) because:

A purpose[in Khan] of transmitting the total average CQI and the relative difference in a CQI feedback message is to minimize the amount of feedback overhead. In view of this desire to minimize the amount of feedback overhead, there is no reason to transmit the total average and the relative differences *separately*, because transmitting them separately requires more bits to transmit the average CQI and the difference in *separate messages* as compared to one message.

Moreover, Matthews et al. merely discloses that there are plural isolated RF time slots that are separated by periods of signal processing during which the radio is inactive. Even if information about the CQI is transmitted *separately*, the next information to be transmitted is also information in the form of one message comprised of both the average CQI and the difference.

App. Br. 10, emphasis added.

3. Appellants also contend that the Examiner erred in rejecting claim 25 under 35 U.S.C. § 103(a) because:

Modifying Khan based on the teachings of Matthews et al. results in a performance degradation, and therefore there would be no motivation to modify Khan in the manner set forth in the outstanding Office Action.

App. Br. 10.

4. Appellants also contend that the Examiner erred in rejecting claim 25 under 35 U.S.C. § 103(a) because:

Claim 25 recites:

positions within one time-frame of both the first time period for transmitting the first channel quality indication and the second time period for transmitting the second channel quality indication ***being unchanged through at least two consecutive cyclic time-frames of the uplink.***

Emphasis added. Thus, Claim 25 clearly requires that positions within one time-frame “be unchanged through at least two consecutive cyclic time-frames of the uplink.” If there is a stopping of the transmission of data when there is no more data to be transmitted and then a starting, ***there is no expectation that positions within one time-frame would be unchanged through at least two consecutive cyclic time-frames of the uplink, as claimed.***

Reply Br. 2–3.

Issues on Appeal

Did the Examiner err in rejecting claim 25 as being obvious?

ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellants’ arguments (Appeal Brief and Reply Brief) that the Examiner has erred. We

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disagree with Appellants' conclusions. Except as noted herein, we adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in the Examiner's Answer in response to Appellants' Appeal Brief. We concur with the conclusions reached by the Examiner. We highlight the following additional points.

As to Appellants' above contention 1, we disagree. Excluding the findings that "Khan does not disclose the data content to be transmitted is sent at a first and second time period where the second time period is different than the first time period (Ans. 19) and that "Khan does not disclose separating this [CQI feedback] data content into multiple transmissions at different time periods" (Ans. 21) as discussed below, and excluding the paragraph bridging pages 21–22 of the Answer in response to Appellants' Advisory Action argument, we otherwise agree with the Examiner's response at pages 18–23.

Although not necessary for our decision, we conclude that the Examiner (and Appellants) has (have) adopted an unnecessarily restrictive construction of the time periods of claim 25. We find no particular limitation in Appellants' Specification beyond what an artisan of ordinary skill would understand the term to mean on its face, i.e., a time of some non-zero length. We determine nothing more to be required by the term. Although we agree with the Examiner that Matthews teaches time slots for transmitting data at different time periods, we disagree with both the Examiner's and Appellants' conclusions that Khan does not disclose the data content to be transmitted is sent at a first and second time period where the second time period is different than the first time period. Rather, we find that Khan explicitly teaches this limitation at paragraphs 45–47. The overall

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message of Khan (with an overall time period) when transmitted is divided into plural bits (or groups of bits) which each have their own time period when transmitted. That the CQI message in Khan is a single message is of no moment. This is consistent with Appellants' Specification which discloses that a frame "is . . . constituted at least by a header field and a payload field which comprises classical data" Spec. 12:1–2. We understand this description of a frame to be a single message. Further, Appellants' Specification teaches that a single frame can have two time slots TS1 and TS2, each for different data content (e.g., CQI 20₁ in the first time slot and Ave 20₁ in the second time slot). Spec. 22:3–11. Therefore, the multi-bit CQI message in Khan is consistent with such a multiple time slot frame. *See also* Claim 25 ("one time-frame of both the first time period . . . and the second time period").

As to Appellants' above contention 2, we disagree. Appellants' arguments are not commensurate with the scope of the claim language. Contrary to Appellants' argument that the claim requires "separate messages" (App. Br. 10), the claim language "first time period" and "second time period different from the first time period" in no way requires the information about the CQI be transmitted in separate messages. Only different time periods are required and as discussed above, Khan has multiple different time periods within its one message.

As to Appellants' above contention 3, we disagree. We are not persuaded because essentially Appellants' argument is premised on a "physical" or "bodily" incorporation of method step limitations of one reference into the method of the other reference. This is not the standard. *See In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983) ("[I]t is not necessary that the inventions of the references be physically combinable to render

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obvious the invention under review.”); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (The “test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.”). Moreover, “[a] reference must be considered for everything it teaches by way of technology and is not limited to the particular invention it is describing and attempting to protect.” *EWP Corp. v. Reliance Universal Inc.*, 755 F.2d 898, 907 (Fed. Cir. 1985) (emphasis omitted).

The Examiner did not suggest the method steps of Matthews should be bodily incorporated into the method of Khan. Rather, the Examiner relied on Matthews to show it is known in the prior art to use time slots for transmitting data at different time periods. Final Act. 5–6. Appellants go beyond this to incorporate limitations (e.g., discontinuity) from Matthews which were not relied upon by the Examiner, and then argues the limitations the Examiner did not rely upon. We are unpersuaded by this form of argument.

As to Appellants’ above contention 4, contrary to Appellants’ statement (“This Reply Brief is responsive to the Examiner’s Answer” (Reply Br. 1)), Appellants present for the first time a new argument against the rejections. Appellants’ previous mention of the “unchanged through at least two consecutive cyclic time-frames” was in the Claims Appendix presentation of claim 25, and was not as any particularized argument directed to the “unchanged through at least two consecutive cyclic time-frames” limitation.

In the absence of a showing of good cause by Appellants, we decline to consider an argument raised for the first time in the Reply Brief. This is

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because, as the Examiner has not been provided a chance to respond, and in the absence of a showing of good cause by Appellants, these arguments are deemed waived. *See* 37 C.F.R. § 41.41(b)(2) (2012); *In re Hyatt*, 211 F.3d 1367, 1373 (Fed. Cir. 2000) (noting that an argument not first raised in the brief to the Board is waived on appeal); *Ex parte Nakashima*, 93 USPQ2d 1834, 1837 (BPAI 2010) (informative) (explaining that arguments and evidence not timely presented in the principal Brief, will not be considered when filed in a Reply Brief, absent a showing of good cause explaining why the argument could not have been presented in the Principal Brief); *Ex parte Borden*, 93 USPQ2d 1473, 1477 (BPAI 2010) (informative) (“Properly interpreted, the Rules do not require the Board to take up a belated argument that has not been addressed by the Examiner, absent a showing of good cause.”). Appellants have provided this record with no such showing of good cause.³

CONCLUSIONS

- (1) The Examiner has not erred in rejecting claims 25–29 as being unpatentable under 35 U.S.C. § 103(a).
- (2) Claims 25–29 are not patentable.

³ Although not necessary for our decision, if we were to consider Appellants’ argument, we would be unpersuaded. We conclude the argued limitation merely requires that a message frame be identically consecutively repeated. We deem this to be well within the skill in the art. Moreover, “[i]t is well settled that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced, and we are of the opinion that such is not the case here.” *In re Harza*, 274 F.2d 669, 671 (CCPA 1960).

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DECISION

The Examiner's rejection of claims 25–29 is affirmed.

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).

AFFIRMED⁴

⁴ As the Examiner has shown that all the claims are unpatentable, we do not further reject Appellant's claims 25–29 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. However, should there be further prosecution of these claims, the Examiner's attention is directed to our following concerns.

On September 3, 2014, Appellants filed an amendment adding similar language to each of claims 25–29. All pending claims now include language requiring “a length of the second time period ***being shorter*** than a length of the first time period” (Claim 25, emphasis added). We have reviewed Appellants' Specification and have not found sufficient support for the above bold-italicized limitation.

Appellants identify Figure 7b as supporting this claim language (App. Br. 4). While the “being shorter” limitation may be obvious in view of Figure 7b, our review finds Figure 7b does not provide proper written description support for the limitation. *See Ariad Pharms., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010) (“[A] description that merely renders the invention obvious does not satisfy the [written description] requirement.”)

Rather, Appellants' use of the proportions shown only in Figure 7b to justify the claim limitation is misguided. “[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.” *Hockerson-Halberstadt, Inc. v. Avia Group Int'l, Inc.*, 222 F.3d 951, 956 (Fed. Cir. 2000); *In re Wright*, 569 F.2d at 1124, 1127 (CCPA 1977) (“Absent any written description in the specification of quantitative values, arguments based on measurement of a drawing are of little value.”).