



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
**United States Patent and Trademark Office**  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/293,289	09/17/2008	Matthew P.J. Baker	2006P00916WOUS	9360
24737	7590	11/21/2019	EXAMINER	
PHILIPS INTELLECTUAL PROPERTY & STANDARDS			TRAN, PAUL P	
465 Columbus Avenue			ART UNIT	
Suite 340			PAPER NUMBER	
Valhalla, NY 10595			2647	
			NOTIFICATION DATE	
			DELIVERY MODE	
			11/21/2019	
			ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

katelyn.mulroy@philips.com  
marianne.fox@philips.com  
patti.demichele@Philips.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* MATTHEW P.J. BAKER and TIMOTHY J. MOULSLEY

---

Appeal 2018-000390  
Application 12/293,289  
Technology Center 2600

---

Before JOSEPH L. DIXON, JAMES W. DEJMEK, and  
MATTHEW J. McNEILL, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge*  
JAMES W. DEJMEK.

Opinion Dissenting filed by *Administrative Patent Judge*  
JOSEPH L. DIXON.

DEJMEK, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

On August 13, 2018, Appellant<sup>1</sup> timely filed a Request for Rehearing (“Req. Reh’g”) under 37 C.F.R. § 41.52 of our Decision, mailed June 11, 2018 (Decision), in which we affirmed the Examiner’s decision rejecting claims 1–17 under pre-AIA 35 U.S.C. § 103(a). On September 5, 2018 we

---

<sup>1</sup> Throughout this Decision, we use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42 (2017). Appellant identifies Koninklijke Phillips N.V. as the real party in interest. Appeal Br. 3.

issued our Decision on the Request for Rehearing (“Reh’g Dec.”) wherein we considered Appellant’s arguments but declined to modify our original Decision. Reh’g Dec. 9. Appellant appealed to the Court of Appeals for the Federal Circuit and filed an Opening Brief on February 15, 2019. As set forth, in the Opening Brief, Appellant identified errors in the Rehearing Decision in which we inadvertently attributed certain teachings of Yoon to Takano. *See, e.g.*, Opening Br. 33–35 (citing Reh’g Dec. 4). Additionally, Appellant sets forth *new arguments* disputing the proffered rationale to combine the teachings of Takano and Yoon. *See, e.g.*, Opening Br. 36, 45–46.

On March 19, 2019, the Office of the Solicitor for the United States Patent and Trademark Office (“Solicitor’s Office”) filed a Motion for Remand to allow the Board to “vacate the current rehearing decision and . . . promptly issue a revised rehearing decision that corrects the error and reconsiders the obviousness of the claimed invention.” Mot. 2. Moreover, in the Reply in support of the Motion for Remand, filed April 2, 2019, the Solicitor’s Office indicated that once the Board has an opportunity to correct its error, the Board will “reevaluate the obviousness of the claimed invention in light of that correction.” Reply 3.

The Federal Circuit granted the Motion for Remand on April 24, 2019. The court indicated that “remand would best serve judicial economy.” Order 2.

Consistent with the court’s Order, on June 5, 2019 we vacated our previous Decision on Rehearing and authorized Appellant to file a new Request for Rehearing within two months. On August 5, 2019, Appellant timely filed a Second Request for Rehearing (Second Req. Reh’g).

Consistent with the representations made to the court by the Solicitor's Office and the court's Order, we have reconsidered our Decision in light of Appellant's Second Request for Rehearing. As set forth below, we grant Appellant's Second Rehearing Request.

## DISCUSSION

The gravamen of Appellant's rehearing request is that the Board erred in adopting the Examiner's rationale for the proposed combination of Takano and Yoon. Second Req. Reh'g 4–5, 7–11. As set forth in the Final Rejection, the Examiner determined the ordinarily skilled artisan would have been motivated to combine the teachings of Yoon and Takano to “improve the reliability of uplink transmission [and] to improve channel quality measurement by reducing transmission delay for the communication system.” Final Act. 6 (citing Yoon ¶ 19).

On appeal to the Board, the totality of Appellant's argument regarding the motivation to combine Takano and Yoon is set forth on pages 12 through 14. *See* Appeal Br. 12–14. Specifically, within a section entitled “No Motivation to Combine Takano and Yoon,” Appellant argues that Yoon (alone, not in combination with Takano) requires a specific request for a channel quality indication (CQI) report for every CQI transmission—the problem allegedly addressed by Appellant's claim 1. Appeal Br. 12–13. Thus, Appellant argues “Yoon teaches away” from the claimed invention and “the combination lacks a rational basis given that one of ordinary skill in the art would not look to Yoon to solve the problem recognized by Appellant[.]” Appeal Br 13. Appellant further asserts neither reference recognizes the problem addressed by Appellant. Appeal Br. 13. Appellant

alleges Takano “does not deal with channel quality at all” and that the Examiner’s proposed modifications “are not at all suggested or contemplated by either reference and are only based on improper hindsight reconstruction.” Appeal Br. 13–14.

In the Reply Brief, Appellant argues there is no rationale to combine Takano and Yoon because “Takano is completely silent and unconcerned with CINR [(carrier to interference noise ratio)] and CQI values” and Yoon uses a Request-Response mechanism to transmit CINR values to the base station. Reply Br. 8–9. Also, Appellant raises—*for the first time*—that the Examiner’s proposed combination of Takano and Yoon frustrates the purpose of *Yoon*. Reply Br. 9–10. In particular, Appellant argues “Yoon’s purpose is to avoid the waste of resources” and adding the RTS/CTS procedure of Takano to Yoon would waste the very resources Yoon proposes to save. Reply Br. 9–10.

Only *after* we issued the Decision, in the First Request for Rehearing, Appellant asserts for the first time that the Examiner’s reasoning to combine the teachings of Takano and Yoon to improve reliability of the uplink by reducing transmission delay “has not been adequately substantiated by any explanation as to how and why one of ordinary skill in the art would modify Takano by including a CQI report from the teachings of Yoon.” Req. Reh’g 4. Moreover, Appellant questions “how including a CQI report, as generally described by Yoon, would improve reliability and reduce the delay in the combined system of Takano and Yoon as contemplated by the rejection.” Req. Reh’g 5.

In the Second Request for Rehearing, Appellant continues to allege error with the rationale for the proposed combination because “the delay that

Yoon purports to reduce is not present in Takano.” Second Req. Reh’g 4. Rather, Appellant argues “Yoon discloses that known methods of reporting CQI can introduce delay and proposes a modification to method steps other than sending the CQI report to reduce this delay.” Second Req. Reh’g 5. In other words, Appellant asserts Yoon teaches the process of CQI reporting may introduce delay, and subsequently sets forth a solution to reduce the delay. Second Req. Reh’g 8–9. Appellant argues that because Takano does not report CQI, the introduction of such reports, as proposed by the combination of Yoon with Takano, would not provide an improvement of reduced delay. Second Req. Reh’g 8–9.

As an initial matter, contrary to Appellant’s assertions (*see* Reply Br. 10), the argument that the proposed combination would frustrate the purpose of *Yoon* was not argued in the Appeal Brief. Rather, the cited portion of the Appeal Brief was directed to Appellant’s “teaching away” and “hindsight” arguments. *See* Appeal Br. 12–14. This argument was not made in the Appeal Brief, but could have been, and is not responsive to any new evidence or finding set forth by the Examiner in the Answer.

Any argument raised in the reply brief which was not raised in the appeal brief, or is not responsive to an argument raised in the [E]xaminer’s answer, including any designated new ground of rejection, will not be considered by the Board for purposes of the present appeal, unless good cause is shown.

37 C.F.R. § 41.41(b)(2); *see also Ex parte Nakashima*, 93 USPQ2d 1834, 1837 (BPAI 2010) (informative) (explaining that arguments and evidence not presented timely 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, 1474 (BPAI 2010) (informative) (“[T]he reply

brief [is not] an opportunity to make arguments that could have been made in the principal brief on appeal to rebut the Examiner's rejections, but were not.”).

A request for rehearing is not an opportunity to merely express disagreement with a decision. *See* 37 C.F.R. § 41.52(a)(1). A request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Moreover, “[a]rguments not raised, and Evidence not previously relied upon, pursuant to §§ 41.37, 41.41, or 41.47 are *not permitted* in the request for rehearing except as permitted by paragraphs (a)(2) through (a)(4) of this section.” 37 C.F.R. § 41.52(a)(1) (emphasis added). New arguments in a request for rehearing are only permitted for situations (i) based upon a recent relevant decision of either the Board or a Federal Circuit; (ii) responding to a new ground of rejection; and (iii) asserting that the Board's decision contains an undesignated new ground of rejection. 37 C.F.R. § 41.52(a)(2)–(a)(4). To the extent Appellant has advanced new arguments in the Request for Rehearing, we note that Appellant has not relied upon a recent relevant decision of either the Board or a Federal Circuit nor alleged that the Decision contains an undesignated new ground of rejection.

Rather than setting forth new arguments in a Reply Brief or Request for Rehearing, the more correct course of action for Appellant would have been to file a Request for Continuing Examination wherein Appellant would be permitted to advance new arguments of patentability. *See* 37 C.F.R. § 1.114(c).

Nonetheless, although we are mindful of our Rules proscribing consideration of untimely arguments, in this specific circumstance,

constrained by the representations made by the Solicitor's Office to the court that the Board would "reconsider[] the obviousness of the claimed invention" (Mot. 2), and that the Board will "genuinely reconsider its obviousness conclusion" (Reply 3) as well as the court's understanding (that the Board would "reconsider its position") and order (that the Board would "act expeditiously in conducting any necessary further proceedings"), we consider the merits of Appellant's arguments. *See* 37 C.F.R. § 1.183 (allowing for the suspension of rules in "an extraordinary situation").<sup>2</sup>

Yoon generally relates to "[a] method for requesting and reporting channel quality information (CQI) in a wireless portable Internet system." Yoon, Abstract. According to Yoon:

Reported information on the radio channel quality of a link to a subscriber station on the move is very important since the information is used to determine an appropriate adaptive modulation and channel coding (AMC) level for the corresponding link to the subscriber station in the system for supporting high-speed mobility.

Yoon ¶ 6. Yoon describes a system wherein a base station transmits a CQI report message to a plurality of subscriber stations and each subscriber station must request bandwidth from the base station in order to report the CQI. Yoon ¶ 8. Yoon describes an issue that because the base station does not allocate in advance an uplink resource to be used for the reported CQI

---

<sup>2</sup> We note that 37 C.F.R. § 1.183 provides that the rules may be suspended or waived "by the Director or the Director's designee, sua sponte." Under the specific circumstances of this case, we understand the Solicitor's Office to be acting as the Director's designee. *See* Mot. 1 ("Appellee, Director of the United States Patent and Trademark Office ("USPTO"), respectfully requests leave . . . to move to remand this case to the USPTO to permit further proceedings before the agency.").

from the subscriber stations, a delay may occur. Yoon ¶ 11. More particularly, Yoon describes the time delay as comprising a subscriber station bandwidth request message and the base station allocating a resource for a bandwidth request before the subscriber station transmits the channel report information to the base station. Yoon ¶ 15. According to Yoon, “a time delay is generated and it is difficult to guarantee the QoS [(Quality of Service)] because of the undesired delay.” Yoon ¶ 15. Yoon’s disclosed and claimed invention is directed to receiving CQI information quickly without an additional bandwidth request from a subscriber station to the base station and to “efficiently transmit downlink data by allocating a CQI channel to the subscriber station by a base station.” Yoon ¶ 30.

Thus, the alleged benefit (i.e., reduced transmission delay) of Yoon is realized not by merely sending a channel quality indication report, but rather by the method in which the CQI is requested and reported. *See, e.g.*, Yoon ¶¶ 24–29. We agree with Appellant (*see* Second Req. Reh’g 4–5, 9) that the Examiner has not provided sufficient technical evidence or reasoning that adding CQI information to the messaging of Takano would result in reduced transmission delay.

Moreover, although one of ordinary skill in the art may understand that two references *could be* combined as reasoned by the Examiner, this does not imply a motivation to combine the references. *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987 993–94 (Fed. Cir. 2017); *see also Belden Inc. v. Berk–Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) (“[O]bviousness concerns whether a skilled artisan not only *could have made* but *would have been motivated to make* the combinations or modifications of prior art to arrive at the claimed invention.”); *InTouch*

*Techs., Inc. v. VGO Communications, Inc.*, 751 F.3d 1327, 1352 (Fed. Cir. 2014).

Here, although, arguably, one of ordinary skill in the art *could have* modified Takano’s messaging (i.e., the reference signal) to include the CQI report taught by Yoon, because merely adding the CQI report would not result in a decreased (i.e., improved) transmission delay, as discussed above, there is insufficient support that one of ordinary skill in the art *would have been motivated* to modify Takano as proposed by the Examiner.

Because we find it dispositive that the Examiner has not provided the requisite “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (*see In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited with approval in *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007))), we do not address other issues raised by Appellant’s arguments related to these claims. *See Beloit Corp. v. Valmet Oy*, 742 F.2d 1421, 1423 (Fed. Cir. 1984) (finding an administrative agency is at liberty to reach a decision based on “a single dispositive issue”).

For the reasons discussed *supra*, we find Appellant’s arguments persuasive of error related to the stated rationale to combine Takano and Yoon. Accordingly, we do not sustain the Examiner’s rejection of independent claim 1. For similar reasons, we do not sustain the Examiner’s rejection of independent claims 6, 7, and 12, which recite similar limitations. Further, we do not sustain the Examiner’s rejection of claims 2, 3, 8, 9, and 13–15, which depend directly or indirectly therefrom.

In addition, the Examiner does not rely on Vannithamby to remedy the above-described deficiency related to the rejection of the independent

claims. Thus, for similar reasons, we do not sustain the Examiner’s rejection of claims 4, 5, 10, 11, 16, and 17.

**CONCLUSION**

Outcome of Decision on Rehearing:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Denied</b>	<b>Granted</b>
1–3, 6–9, 12–15	103(a)	Takano, Yoon		1–3, 6–9, 12–15
4, 5, 10, 11, 16, 17	103(a)	Takano, Yoon, Vannithamby		4, 5, 10, 11, 16, 17
<b>Overall Outcome</b>				1–17

Final outcome of Appeal after Rehearing:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1–3, 6–9, 12–15	103(a)	Takano, Yoon		1–3, 6–9, 12–15
4, 5, 10, 11, 16, 17	103(a)	Takano, Yoon, Vannithamby		4, 5, 10, 11, 16, 17
<b>Overall Outcome</b>				1–17

**GRANTED**

DIXON, *Administrative Patent Judge*.

## DISSENTING OPINION

I respectfully dissent from the majority's course of action to grant the rehearing and the decision to reverse the Examiner's conclusion of obviousness. Rather, I would REMAND the application to the Examiner.

The majority sets forth all the relevant rules and procedures for prosecution and rehearing:

A request for rehearing is not an opportunity to merely express disagreement with a decision. *See* 37 C.F.R. § 41.52(a)(1). A request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board . . .

the more correct course of action for Appellant would have been to file a Request for Continuing Examination wherein Appellant would be permitted to advance new arguments of patentability. *See* 37 C.F.R. § 1.114(c).

(Decision on Second Req. Reh'g 6.) I agree with the majority that the more appropriate course of action would be for Appellant to file a Request for Continuing Examination to consider the new arguments.

I find the prosecution and Briefs by Appellant to be unpersuasive to show error in the Examiner's factual findings or conclusion of obviousness during the prosecution on the merits of this application before the Examiner and before this Board. Moreover, I find Appellant's late presentation of detailed arguments and technical reasoning to be inappropriate for compact prosecution on the merits and refinement of the issues for appeal.

I find that Appellant's late presentation of arguments to the Solicitor and court to have waived these arguments, which are inappropriate for

consideration before this panel or by the court of review. Furthermore, the majority sets forth the prosecution history and the factual timeline that overwhelmingly persuade me that the Board did not err based upon the prosecution before the Board at the time of the original Decision nor in the original Request for Rehearing.

Additionally, I would agree the majority's action to be appropriate, if Appellant had set forth a showing of good cause for the late presentation of the new arguments. (*See* 37 C.F.R. § 41.41(b)(2) "Any argument raised in the reply brief which was not raised in the appeal brief, or is not responsive to an argument raised in the examiner's answer, including any designated new ground of rejection, will not be considered by the Board for purposes of the present appeal, unless good cause is shown.")

Unfortunately, Appellant has not proffered any showing of good cause for the late presentation of the new arguments before the agency. If Appellant showed any kind of "good cause," I would agree that the Board could accept the late presentation of new and refined arguments, but Appellant has not proffered any showing of good cause. Without a showing of good cause on the record, I find that the majority over extends its discretion. I find the REMAND of this application to the Examiner to fully meet the proffered intent and goal of the court to "permit further proceedings before the agency."

Therefore, I would not consider these new arguments, and I would rather REMAND the application to the Examiner to further consider the totality of the new arguments which the Solicitor has proffered that "the board will use the remand as an opportunity to correct the error [the reversal of the names of the two references in the original Decision on Rehearing,

which was vacated] and genuinely reconsider its obviousness determination.” (Reply In Support Of Motion for Remand 3.) Because the Board “review[s] adverse decisions” of the Examiner, the Board has not made a conclusion of obviousness in this appeal. (35 U.S.C. § 6.)

Rather, the Board found Appellant’s arguments were unpersuasive of error in the Examiner’s factual findings or conclusion of obviousness. Therefore, I would REMAND this application back to the Examiner to “genuinely reconsider [the Examiner’s] obviousness conclusion” based upon the new arguments. I find this course of action would be appropriate in light of the remand and the Solicitor’s motion “to permit further proceedings before the agency.” *See* Mot. 1 (“Appellee, Director of the United States Patent and Trademark Office (“USPTO”), respectfully requests leave . . . to move to remand this case to the USPTO to permit further proceedings before the agency.”). (*See* Decision on Second Req. Reh’g 7 n.2.)

Additionally, I cannot agree that the Administrative Patent Judges have authority to waive the rules without a delegation of authority from the Director. Additionally, I find nothing in the record by the Solicitor which specifically addresses a waiver of the Rules under any authority that the Solicitor may be delegated.

Moreover, the majority decides the appeal based upon a single issue rather than addressing the complete merits argued by Appellant. In light of the remand from the court for further “proceedings before the agency,” I find the more appropriate course of action is to REMAND the application to the Examiner to address the totality of all of Appellant’s new and refined arguments by the same individual who is more skilled in the relevant art and would be the more appropriate factfinder and evaluator of conclusions of

obviousness in the first instance based upon the new and refined arguments and to consider the totality of the prior art.

Therefore, I do not find the majority's consideration of these new arguments to be appropriate because the rules for controlling appeals of the Examiner's adverse decision on patentability require that the arguments "will not be considered by the Board for purposes of the present appeal, unless good cause is shown."

I find that during the original prosecution and the Briefs, Appellant provided general arguments with little substantive analysis, which amount to Attorney arguments and conclusory statements that are unsupported by factual evidence are entitled to little probative value. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *see also In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984). "Argument in the brief does not take the place of evidence in the record." *In re Schulze*, 346 F.2d 600, 602 (CCPA 1965) (citing *In re Cole*, 326 F.2d 769, 773 (CCPA 1964)).

As a result, Appellant has not identified any points misapprehended or overlooked by the Board in its decision on the merits at the time of the decision based upon the administrative record at that time as required by a Request for Rehearing under 37 C.F.R. § 41.52. Therefore, I would DENY Appellant's Request for Rehearing, and I would not modify the Decision.

But, in light of the representations by the Solicitor, I would REMAND the application back to the Examiner to further consideration of the arguments that Appellant now makes because the Solicitor has specifically represented that the Remand will "permit further proceedings before the agency." As stated above, the most appropriate course of action would be a Request for Continued Examination and the Solicitor's representation of

Appeal 2018-000390  
Application 12/293,289

further “proceedings before the agency” effectively provides Appellant with a no cost Request for Continued Examination. Furthermore, prosecution before the Examiner on the merits of all of Appellant’s new arguments fulfills this representation to our reviewing court.