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EXAMINER
BHATTI, HASHIM S

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex Parte JINHUA LIU, YU QIAN, and HAI WANG

Appeal 2018-003626
Application 14/430,595
Technology Center 2400

Before ERIC FRAHM, BETH Z. SHAW, and
SCOTT C. HOWARD, *Administrative Patent Judges*.

SHAW, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner's Final Rejection of 1, 3, 5–9, 11, 13–16, 18, 20–26, 27, 29, and 31–36, which represent all the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

INVENTION

Appellants' invention is directed to methods for performing link adaptation in a cellular radio system and related base stations. *See* Spec. 1:2–3.

Claim 1 is illustrative and is reproduced below:

> 1. A method for performing link adaptation in an uplink subframe for a first cell, the method comprising:
>
> obtaining information indicating interference to the uplink subframe of the first cell from at least one neighboring cell's downlink subframe occupying a time interval same as the uplink subframe;
>
> determining whether the interference exceeds a predetermined threshold;
>
> applying to the uplink subframe a first link adaptation loop by selecting a Modulation and Coding Scheme (MCS) based on a SINR measured in the uplink subframe and a first SINR compensation factor, when the interference exceeds the predetermined threshold; and
>
> applying to the uplink subframe a second link adaptation loop when the interference is below the predetermined threshold.

REJECTION

The Examiner rejected claims 1–3, 5–11, 13–18, 20–29, and 31–36 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Ans. 2–3; Final Act. 2–3.

In the Answer, the Examiner withdrew the rejection of claims 2, 10, 17, and 28. Ans. 3. Accordingly, the only pending rejection is of claims 1, 3, 5–9, 11, 13–16, 18, 20–26, 27, 29, and 31–36 for a lack of enablement.

ANALYSIS

We have reviewed Appellants' arguments in the Brief, the Examiner's rejection, and the Examiner's response to the Appellants' arguments. We concur with Appellants' conclusion that the Examiner erred in rejecting the claims as failing to comply with the enablement requirement. "[T]he PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by that claim is not adequately

enabled by the description of the invention provided in the [S]pecification of the application." *In re Wright*, 999 F.2d 1557, 1561–62 (Fed. Cir. 1993), (citing *In re Marzocchi*, 439 F.2d 220, 223–24 (CCPA 1971)).

"Furthermore, a patent need not teach, and preferably omits, what is well known in the art." *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1463 (Fed. Cir. 1984)). Appellants argue that the Specification enables adapting links, and that adapting links was well known in the art at the time of the invention. Br. 15–16 (citing Spec. ¶¶ 78–84). In particular, Appellants argue the algorithm, formula, or way to select Modulation and Coding Scheme (MCS) based on the measured SINR and SINR compensation factor was well known in the prior art, such that one of ordinary skill with the benefit of the disclosure would have been able to implement the invention without undue experimentation. *Id.* Appellants also refer to evidence in the form of extrinsic references to show that one skilled in the art would have been able to implement the invention without undue experimentation. *Id.* The Examiner does not respond to these arguments or evidence in the Answer. The findings enumerated by the Examiner (Ans. 3, 4) fail to demonstrate that undue experimentation would have been necessary on the part of one of ordinary skill in the art to perform the invention.

For these reasons, we do not sustain the rejection of the claims as failing to comply with the enablement requirement.

DECISION

The decision of the Examiner to reject claims 1, 3, 5–9, 11, 13–16, 18, 20–26, 27, 29, and 31–36 is reversed.

REVERSED