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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SOFTWARE RADIO TECHNOLOGY PLC, VESPER MARINE
LIMITED (3RD PTY REQ.), LOWE GRAHAM JONES, PLLC

Appeal 2020-000390
Reexamination Control 90/013,498
Patent 7,512,095 B2
Technology Center 3900

Before JOHN A. JEFFERY, MARC S. HOFF, and
DENISE M. POTHIER, *Administrative Patent Judges*.

POTHIER, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant has submitted a timely Request for Rehearing dated July 1, 2020 (“the Request” or “Request”),¹ requesting rehearing of our February 4, 2020 opinion (hereafter the “Opinion” or “Op.”) that affirmed the rejection

¹ Appellant filed multiple requests on April 3, 2020, May 4, 2020, and June 1, 2020, respectively, to waive the deadline for submitting the Request under the Coronavirus Aid, Relief, and Economic Security Act and the April 28, 2020 Notice of Extended Waiver of Patent-Related Timing under the Coronavirus Aid, Relief, and Economic Security Act and Other Relief Available to Patent Applicants and Patentees. On June 17, 2020, the waiver requests were denied because they did not include the reply to the outstanding response (e.g., the Request). The Request was submitted on July 1, 2020, and the waiver request was approved.

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under 35 U.S.C. § 305 of claims 1, 15, and 24–32 of U.S. Patent No. 7,512,095 B2 (“the ’095 patent”). Op. 26. Appellant does not request reconsideration of the remaining rejections under 35 U.S.C. §§ 102 and 103 of the claims that were reversed. *Id.*

“The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board.” 37 C.F.R. § 41.52(a)(1).

We have reconsidered the Opinion in light of Appellant’s contentions in the Request for Rehearing. Upon review, we grant the Request to the extent we designate the rejection based on 35 U.S.C. § 305 as a new ground. Regarding the remaining arguments, we maintain our determination that claims 1, 15, and 24–32 enlarge the scope of the claims of the ’095 patent being reexamined.

Request to Remand the Appeal

In the Reply Brief, Appellant submitted amendments to the claims and requested that we remand this proceeding to the Examiner for further consideration. Reply Br. 9; *see id.*, App. A–B. We declined to exercise our discretion to remand the proceeding in the Opinion. Op. 4–5 (noting that 37 C.F.R. § 41.35(e) indicates the Board *may* relinquish jurisdiction and that the Manual of Patent Examining Procedure (MPEP) § 1211.02 (9th Rev. 08.2017 Jan. 2018)² indicates there is *no obligation* on the Board to consider new claim amendments).

² MPEP § 1211.02 was subsequently updated in June 2020 (9th Rev. 10.2019). The update does not change the proposition that there is no obligation on the Board to consider new or amended claims.

Appellant requests once again that we remand this proceeding to the Examiner for consideration of an amendment to the claims. Request 2, 11–13. Appellant specifically argues that “with respect to a reexamination, Appellant would have no opportunity to present its proposed amended claims to the Examiner unless the Board were to exercise its discretion to remand.” Request 2; *see id.* at 11 (stating “remand[ing] the application to the Examiner . . . represents Appellant’s *only* chance to present amended claims that would satisfy the Examiner as to both the 305 rejections and the prior art. *No other mechanism* is available to Appellant to do so because this appeal is with respect to a reexamination application.”)

We are not persuaded. First, Appellant has not demonstrated in the Request how we overlooked or misapprehended points in the briefing or in U.S. Patent and Trademark Office (“Office”) regulations and guidance. *See* 37 C.F.R. § 41.52(a)(1). Second, when the Board enters a new ground of rejection in *ex parte* proceedings, including *ex parte* reexaminations, Office regulations permit Appellant to reopen prosecution and to:

Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

37 C.F.R. § 41.50(b)(1). As explained below, we designate the rejection of claims 1, 15, and 24–32 under 35 U.S.C. § 305 as a new ground. As such,

Appellant will have the opportunity to amend the claims, such as those presented in Appendices A and B, and to have the amendments considered by the Examiner pursuant to 37 C.F.R. § 41.50(b).

Request to Withdraw the § 305 Rejection

In the Opinion, we sustained the rejection of claims 1, 15, and 24–32 under 35 U.S.C. § 305 as enlarging the scope of the claims of the '095 patent. *See* Op. 6–14. We found that the scope of claim 1 (along with commensurate limitations in claims 15 and 26) has broadened with regard to the recited “transmission detector,” specifically noted that the Federal Circuit has found that the term “detector,” in one instance, is “not a generic structural term, such as ‘means,’” and “is a sufficiently definite structural term to preclude the application of § 112, ¶ 6.” *Id.* at 9 (quoting from *Personalized Media Commc’ns LLC v. ITC*, 161 F.3d 696, 704–05 (Fed. Cir. 1998), *cited in* Reply Br. 6). We addressed that the term “transmission detector . . . capable of detecting the predetermined time slots utilized by the first group of radios’ may include a variety of structure (e.g., circuitry)” (*id.*) and found this phrase “appears to broaden claim 1.” *Id.* at 10; *see id.* at 10–12. Additionally, we determined

Based on the above constructions and depending on the length of the recited “predetermined portion of a time slot,” scanning *during* a predictable window of time (e.g., before the end of the window) can be viewed as narrow in scope than scanning *throughout* a predetermined portion of a time slot.

Id. at 13. We further found the amendment from “several moving participants . . . that are each equipped with a communication device” to “two groups of mobile radios” in claim 1 (and commensurate limitations in

claims 15 and 26) broadens the scope of the claims of the '095 patent. *Id.* at 16–17.

Appellant requests that we reconsider our determinations and requests that we withdraw the § 305 rejection. Request 2. Appellant contends that “a transmission detector . . . capable of scanning throughout a predetermined portion of a time slot for the appearance of transmissions” and “two groups of mobile radios” found in claim 1 as amended does not enlarge the scope of the '095 patent's claims. *Id.* at 3–11. Appellant also seeks clarification as to whether the recited “transmission detector . . . is capable of scanning throughout a predetermined portion of a time slot for the appearance of transmissions” is a means-plus-function limitation under 35 U.S.C. § 112, sixth paragraph,³ which Appellant “believes it should be.” *Id.* at 6; *see id.* at 6–7. If construed as argued, Appellant contends the Board misapprehended or overlooked the phrases “a predetermined portion of a time slot” and “scanning throughout” in claim 1 as broader in meaning than the previously recited “a predetermined time period” and “scanning within” respectively. *Id.* at 6–10. Appellant further argues the Board incorrectly concluded the term “mobile radios” in claim 1 is broader in scope than the previously-recited “several moving participants . . . that are each equipped with a communication device” because “[t]he term ‘mobile radios’ . . . indicate[s] more than the communication device,” including that the “devices are used

³ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. § 112. Changes to § 112 apply to applications filed on or after September 16, 2012. Because the '095 patent has a filing date before this date, we refer to the pre-AIA version of § 112 in this decision.

in connection with various ‘participants.’” *Id.* at 10–11 (citing the ’095 patent 1:61–63, 2:51–56).

1. “[T]ransmission detector . . . is capable of scanning throughout a predetermined portion of a time slot for the appearance of transmissions”

In the original briefing, Appellant argued the recited “transmission detector . . . is capable of scanning throughout a predetermined portion of a time slot” (“the ‘transmission detector’ phrase”) should be construed as “structure [that] is now limited to hardware, i.e., a transmission detector, rather than the broader coverage of both hardware and an algorithm.”

Appeal Br. 17; *see* Op. 8 (quoting Appeal Br. 17). For the first time in the Reply Brief, Appellant offered an *alternative* construction for the “transmission detector” phrase as a “non-structural” recitation (i.e., “[a]ssuming, *arguendo*, that the ‘transmission detector’ is non-structural”) that “would also invoke § 112(f).” Reply Br. 6. Now, in the Request, Appellant argues the “transmission detector” phrase *is* a means-plus-function limitation pursuant to 35 U.S.C. § 112, sixth paragraph. *Id.* at 6–7.

Given Appellant’s departure in the Request from the briefing related to how the “transmission detector” phrase should be construed, we could not have overlooked or misapprehended points made by the Appellant in the briefing that the recitation *necessarily* invokes § 112, sixth paragraph. *Compare* Request 6 (arguing the “transmission detector” recitation invokes 35 U.S.C. § 112, sixth paragraph), *with* Appeal Br. 17 (arguing the “‘transmission detector’ that is ‘capable of detecting predetermined time slots’ is limited to hardware).

When addressing this recitation, we stated:

Based on the above understanding, the newly recited ‘transmission detector . . . capable of detecting the predetermined time slots utilized by the first group of radios’ may include a variety of structures (e.g., circuitry), which are not those described in the ’095 patent’s Specification or an equivalent to the previously recited ‘means’ in claim 1. From this perspective, we agree with the Examiner that the newly recited ‘detector’ appears to broaden claim 1.

Op. 9–10.

In the Opinion, we further noted our concerns regarding what hardware would be encompassed by the recited “transmission detector” in claim 1 consistent with the ’095 patent’s Specification and contemplated whether the phrase is a means-plus-function limitation. Op. 10–12. We, however, did not conclusively determine whether or not the “transmission detector” phrase invoked 35 U.S.C. § 112, sixth paragraph. Op. 11 (noting “we are left to question whether the new ‘transmission detector’ recitation (i.e., ‘capable of detecting the predetermined time slots utilized by the first group of radios’) should be construed as a means-plus-function limitation”); *see also id.* at 11–12 (discussing what structure, material, or act (or its equivalent) may perform both the originally and the currently recited function within the “transmission detector” phrase in claim 1). In the Request, Appellant seeks that we clarify whether the “transmission detector” phrase invokes 35 U.S.C. § 112, sixth paragraph. Request 6–7.

Given the invitation, we specify that the “transmission detector” phrase does *not* invoke 35 U.S.C. § 112, sixth paragraph, but rather is limited to hardware as explained in the Opinion. Op. 9–10 (quoting from *Personalized Media*, 161 F.3d at 704–05 and indicating the recitation may

include a variety of structure). We therefore withdraw any discussion in the Opinion concerning the recited “transmission detector,” including the “transmission detector” phrase, invoking 35 U.S.C. § 112, sixth paragraph. *See, e.g.*, Op. 11–12.

Nonetheless, we maintain that the “transmission detector” phrase broadens the scope of the original claims of the ’095 patent. Op. 9–10, 12–14. Specifically, we found:

the newly recited claim limitation recites “a predetermined portion of *a* time slot” (Appeal Br. i (Claims App.) (emphasis added)), which does not have antecedent basis back to the divided, “predetermined time slots” (*id.*). We thus disagree that the recited “a predetermined portion of a time slot” as newly recited is limited to time slots within a TDMA^[4] protocol as argued (*see id.* at 18–19), such that the scope of claim 1 is narrower than the previously recited “predictable window of time” (the ’095 patent 5:1–2). Rather, the record does not demonstrate adequately whether or not “a predetermined portion of a time slot” as now recited in claim 1 is narrower in scope than the generally recited “predictable window of time” as previously claimed.

Id. at 12–13 (citing the ’095 patent 1:25–26).

In the Request, Appellant argues that neither the “transmission detector” nor its function of being “capable of scanning throughout a predetermined portion of a time slot for the appearance of transmission” “broadens the claims.” *Id.* at 8; *see id.* at 7–8. Appellant particularly contends we overlooked that the recited “‘a time slot’ is limited to time slots within a TDMA protocol in claim 1” (*id.* at 8) and misapprehended that the

⁴ Time Division Multiple Access (TDMA).

“‘time slot’ did not have an antecedent basis in the claim” (*id.* at 9).

Appellant further points to dependent claim 27 to support its position, asserting that “[w]ere the antecedent basis for ‘time slot’ in claim 27 not the same ‘predetermined time slots,’ the recitation of ‘another’ would make little sense.” *Id.* at 8.

We are not persuaded.

Above, we addressed that the “transmission detector” phrase does not invoke 35 U.S.C. § 112, sixth paragraph and thus should not be construed as a means-plus-function limitation. Also, despite arguments to the contrary (*see* Request 8–9), we maintain that the recited “a predetermined portion of a time slot” as currently recited in claim 1 is not limited to time slots within a TDMA protocol. *See* Op. 12 (stating “[w]e thus disagree that the recited ‘a predetermined portion of a time slot’ as newly recited is limited to time slots within a TDMA protocol as argued”). That is, the currently recited “a time slot” has no antecedent basis to the “first group of mobile radios utilizes a time division multiples access (TDMA) protocol . . . divided into *predetermined* time slots” recitation in claim 1. Appeal Br. i (Claims App.) (emphasis added).

Appellant points to claim 27’s “another time slot” recitation in arguing that we misapprehended the antecedent basis for “a time slot” in claim 1. Request 8. But, the “another time slot” found in claim 27, which depends from claim 1, also has no antecedent basis to the recited “*predetermined* time slots” in claim 1. Appeal Br. i–ii (Claims App.) (emphasis added). Although both the recited “a time slot” in claim 1 and the “another time slot” in claim 27 are recited as a “*predetermined portion*” of a

time slot, neither refers to the previously recited “predetermined time slots.”

Id. (emphasis added).

Without any further evidence to counter our determination, Appellant asserts that:

There would be no substantive difference between stating ‘a predetermined portion of a time slot’ than stating, for example, ‘a pre-determined portion of a time slot within the TDMA protocol’ or ‘a predetermined portion of one of the predetermined time slots’: the antecedent basis in any case is the same ‘predetermined time slots,’ and each ‘time slot’ is one within a TDMA protocol.

Request 8. We disagree.

Claim 1 recites the “first group of mobile radios utilizes a time division multiple access (TDMA) protocol . . . divided into predetermined time slots” and “the mobile radios of the second group each comprise: . . . the transmission detector . . . capable of scanning throughout a predetermined portion of a time slot for the appearance of transmissions initiated by other radios,” without specifying the *other* radios’ (e.g., the first, second, *or* other group) transmissions for which the transmission detector is scanning. Appeal Br. i (Claims App.). Thus, the transmissions initiated by other radios are not necessarily those from the first group of mobile radios that use a TDMA protocol to divide a radio channel into “predetermined time slots” as recited. *Id.* Moreover, the ’095 patent discusses mobile radios (e.g., different groups) can use protocols other than TDMA protocol.⁵ For example, the ’095 patent discusses using “pure RAT-DMA Aloha system”

⁵ Notably, independent claims 15 and 26 do not recite specifically a TDMA protocol. Request 6 n.1.

or protocol (the '095 patent, 3:51–54; *see id.*, 1:53–54, 4:24–25) but also addresses a boat that uses “another protocol . . . that may have allotted slots for users.” *Id.*, 3:62–64; *see id.* at 3:2–8 (discussing Group I and II in Figure 1 have “two different protocols”).

Based on the foregoing and when construed in light of the Specification, claim 1 does not clearly refer to the first group of mobile radios’ initiated transmissions, which use a TDMA protocol to divide a radio channel into predetermined time slot, when reciting the transmission detector’s “scanning” capabilities. An ordinarily skilled artisan thus would not have necessarily understood that the later-recited “a time slot” in claim 1 recited in the limitation of the “mobile radios of the second group,” each having a “transmission detector” that “is capable of scanning throughout a predetermined portion of a time slot for the appearance of transmissions initiated by other radios,” refers to the previously recited “predetermined time slots” related to a TDMA protocol as argued. *See* Request 8–9.

For the above-stated reasons, Appellant fails to demonstrate with persuasive evidence that there is no substantive difference between in the claim language “predetermined time slots” and “a time slot” in claim 1.

Even if we were to presume, without deciding, that the recited “a time slot” refers back to the divided, predetermined time slots concerning a TDMA protocol in claim 1, we further concluded:

Based on the above constructions and *depending on the length* of the recited “predetermined portion of a time slot,” scanning *during* a predictable window of time [as claim 1 previously recited] (e.g., before the end of the window) can be viewed as narrow in scope than scanning *throughout* a predetermined portion of a time slot [as claim 1 now recites]. *See* Ans. 8–9

(addressing the “scanning” limitation and stating the new recitation is viewed as broader in scope than what claim 1 previously recited).

Op. 13 (citing *Throughout*, Merriam-Webster.com, available at <https://www.merriamwebster.com/dictionary/throughout> (defs. 1 and 2) (last visited Jan. 15, 2020)) (first emphasis added).

Stated differently, we indicated that the previously recited “predictable window of time” and the currently recited “predetermined portion of a time slot” in claim 1 are not necessarily the same time length and may include *different* time lengths. *See id.* at 13. For instance, we disagreed that “a predetermined portion of a time slot” as now recited in claim 1 “is limited to time slots within a TDMA protocol.” *Id.* at 12. We further disagreed that the “predetermined portion of a time slot” recitation is narrower than the previously recited phrase “a predictable window of time,” explaining “[t]he Specification provides no examples of ‘a predictable window of time,’ but rather just discusses listening for ‘a predetermined time period.’ The ’095 patent, 1:25-26.” *Id.* The ’095 patent also does not discuss how long “a predetermined time period” is. *See* the ’095 patent, 1:25–26 (merely describing this as “a so called Detection Period”); *see id.* at 1:41, 1:44, 3:29–30, 3:35 (also describing only a “detection period” or “detection period of silence”). Similarly, the ’095 patent provides no examples of the length of “a time slot,” let alone “a predetermined portion of a time slot.” *See id.*, at 3:64–4:3.

Thus, given the Specification provides little guidance as to length of the “a time slot” or “predictable window of time,” the scope of (1) the recited “a time slot” in claim 1 can include, for instance, 8 milliseconds and

(2) the previously recited “predictable window of time” in claim 1 can include, for instance, 4 milliseconds, resulting in the newly recited “a time slot” that is broader in scope (e.g., 8 milliseconds) than the previously recited “predictable window of time” (e.g., 4 milliseconds). We therefore disagree with Appellant that the newly recited “a predetermined portion of a time slot” (Appeal Br. i (Claims App.)) is narrower in scope than the previously recited “predictable window of time” (the ’095 patent, 5:1–2). *See* Request 9 (arguing “the Board should . . . hold that ‘a predetermined portion of a time slot’ is *not* broader than ‘a predefined time period.’⁶”); *see also* Op. 12–13 (stating “the record does not demonstrate adequately whether or not ‘a predetermined portion of a time slot’ as now recited in claim is narrower in scope than the generally recited ‘predictable window of time’ as previously claimed.”)

Appellant further argues that we “incorrectly determined ‘throughout’ is broader than ‘within,’ when ‘throughout’ is clearly narrower based on the Board’s construction of the terms.” Request 9; *id.* at 9–10. We are not persuaded because Appellant fails to consider this phrase in the context of claim 1. The newly recited phrase in claim 1 further recites “transmission detector . . . is capable of scanning throughout a predetermined portion of a time slot for the appearance of transmissions” (Appeal Br. i (Claims App.)) versus the previously recited “transmission detector (8) scanning, within a predictable window of time, for the appearance of transmissions” (the ’095 patent 5:1–2). Using the above example where “a time slot” includes 8

⁶ We note claim 1 originally recited “a predictable window of time.” The ’095 patent 5:1–2.

milliseconds, “scanning throughout a predetermined portion of a time slot” includes scanning for 6 milliseconds where a “predetermined portion” of the time slot is three-quarters (e.g., $\frac{3}{4}$) of the time slot. Similarly, using the above example where “a predictable window of time” includes 4 milliseconds, “scanning[] within a predictable window of time” includes scanning for 2 milliseconds (e.g., during the predictable window, such as before the end of the time as explained in the Opinion (*see* Op. 13)). As illustrated above, the newly recited “transmission detector . . . is capable of scanning throughout a predetermined portion of a time slot for the appearance of transmissions” (Appeal Br. i (Claims App.)) includes embodiments that are broader in scope than the previously recited “transmission detector (8) scanning, within a predictable window of time, for the appearance of transmissions.” The ’095 patent, 5:1–2.

Appellant further states that “it seems the Board based its conclusion that the current claim language broadened the function carried out by the structure, rather than broadening the structure.” Request 8. We reiterate what the Federal Circuit has stated regarding 35 U.S.C. § 305 and underscore that:

[the court] ha[s] strictly interpreted § 305 to prohibit any broadening amendments. The reexamined claim cannot be broader *in any respect*, even if it is narrowed in other respects. *Predicate Logic, Inc. v. Distributive Software, Inc.*, 544 F.3d 1298, 1303 (Fed. Cir. 2008). Therefore, while reexamination can make certain changes in the patent, such changes are strictly circumscribed by the original patent’s disclosure and claim scope.

Op. 8 (quoting *Senju Pharm. Co., Ltd. v. Apotex, Inc.*, 746 F.3d 1344, 1352–53 (Fed. Cir. 2014)) (first emphasis added). As such, if claim 1 is *functionally* broader (e.g., “the transmission detector . . . is capable of scanning through a predetermined portion of a time slot for the appearance of transmissions initiated by other radios”) in scope than its previously recitation as (e.g., “transmission detector (8) scanning, within a predictable window of time, for appearance of transmission initiated by other participants”⁷) as articulated above, this can be viewed as a reexamined claim that is broader in *any aspect* than claim 1 of the ’095 patent being reexamined.

For the above reasons, we did not overlook or misapprehend Appellant’s points related to the recited “transmission detector” and conclude, as we did in the Opinion (Op. 13–14), that claim 1’s “the transmission detector . . . is capable of scanning through a predetermined portion of a time slot for the appearance of transmissions” (and similar limitations found in independent claims 15 and 26) is broader in scope than the recited “transmission detector (8) scanning, within a predictable window of time, for appearance of transmission” in claim 1 of the ’095 patent being reexamined.

2. “[M]obile radios”

Regarding the disputed recited “mobile radios” recitation found in claim 1, we previously found that

the recited ‘two groups of mobile radios’ in claim 1, as well as commensurate limitations (Appeal Br. i-ii (Claims App.)) in independent claims 15 and 26, broaden aspects of the claims

⁷ We discuss “radios” and “participants” in the next part of this opinion.

over the previously recited ‘several moving participants . . . that are each equipped with a communication device’ in original claim 1 (the '095 patent 4:57–59).

Op. 17.

In the Request, Appellant argues we incorrectly concluded the term “mobile radios” is broader than the previously-recited “several moving participants . . . that are each equipped with a communication device” because “the term ‘mobile radios’ . . . indicate[s] more than the communication device,” including that the “devices are used in connection with various ‘participants.’” Request 10; *id.* at 10–11 (citing the '095 patent 1:61–63, 2:51–56). Appellant further contends that “if not expressly a limitation of the claims, ‘moving participants’ are necessarily integrated with mobile radios” based on the definition of “mobile radio” presented in the Opinion that includes that the mobile radio “is installed in a vessel, vehicle, or airplane.” *Id.* at 11.

We are not persuaded by Appellant’s arguments. First, the term “mobile radios” as recited in claim 1 does not include more than a communication device (e.g., 10) when considered in light of the '095 patent’s disclosure. As explained in the Opinion and consistent with the '095 patent, “moving participants” are described as elements 20–25 (e.g., boats and ships). Op. 15–16 (citing the '095 patent 1:61–62, 2:48–50, 2:52–54, 2:66–67, Figs. 1–2). On the other hand, “mobile radios” are “like communication device 10 described in the Specification” (*id.* at 17), which performs “functions separate from the boat or ship and is intended to be mounted on a moveable object (e.g., a boat).” *Id.* at 16 (citing the '095 patent 1:61–63, 2:48–54, 2:51–52, Fig. 3).

We thus determined:

the newly recited “mobile radios” (Appeal Br. i (Claims App.)) encompass communication devices, like communication device 10 . . . , whereas the previously recited “moving participants[,] . . . each equipped with a communication device[,]” encompassed *both* vessels *and* communication devices (the '095 patent 4:57-59). That is, the presently recited “mobile radios” now omits the previously recited “moving participants,” which includes ships, boats, and other objects, and only encompasses the previously recited “communication device.” *Compare* Appeal Br. i (Claims App.), *with* the '095 patent 4:57-59.

Id. at 17. In other words, we failed to see how omitting the “moving participants” from claim 1 did not result in broadening claim 1’s scope.

In this regard, Appellants contends that “[m]obile radios are not used in isolation” and the Specification “reflects that the recited communication devices are used in connection with various ‘participants.’” Request 10 (citing the '095 patent 1:61–63, 2:51–65). Appellant also asserts the definition of “mobile radio” that we presented and relied upon in the Opinion supports Appellant’s position that moving participants are necessarily integrated with mobile radios. *Id.* at 10–11. These arguments are unavailing.

Although the Specification informs our construction of the claims and may describe a communication device intended to be mounted on participants, such as a buoy (*see, e.g.*, the '095 patent 1:59–63), we decline to import a described embodiment from the '095 patent into claim 1. *See In re Trans Texas Holdings Corp.*, 498 F.3d 1290, 1298–99 (Fed. Cir. 2007) (indicating that *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc), found that “it is improper to ‘confine the claims to th[e]

embodiments’ found in the specification, as Trans Texas asks us to do.”); *see also Personalized Media Commc ’ns, LLC v. Apple Inc.*, 952 F.3d 1336, 1343 (Fed. Cir. 2020) (noting “a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.”). Additionally, the Opinion explained the described moving participants (e.g., elements 20–25) in the ’095 patent can include communication devices (e.g., 10). Op. 16 (citing the ’095 patent 2:51–52). But, the converse—a communication device (e.g., a mobile radio) includes a moving participant—does not necessarily follow from the ’905 patent’s discussion. *See* the ’095 patent 1:59–63, 2:51–65.

The technical definition provided in the Opinion for “mobile radio” (i.e., “[r]adio communication in which the transmitter is installed in a vessel, vehicle, or airplane and can be operated while in motion”⁸) also does not support Appellant’s argument that recited “mobile radios” necessarily include “moving participants” (e.g., vessels). *See* Request 10–11. Instead, as the Opinion discussed, the ’095 patent’s Specification and the definition support that the recited “mobile radios” are separate components from the described moving participants because they are radios “that communicate[] using a transmitter and [are] installed in a vessel, vehicle, or airplane.” Op. 16; *see id.* at 16–17. We therefore are not persuaded that the term “mobile radios” in claim 1 include more than the communication devices discussed in the ’095 patent or that the term implicitly claims moving participants,

⁸ *Mobile Radio*, MCGRAW-HILL DICTIONARY OF COMPUTING & COMMUNICATIONS 240 (2003), *cited in* Op. 16.

each having a communication device as claim 1 of the '095 patent being reexamined recites.

Additionally, in the Opinion, we stated that *Gemstar-TV Guide Int'l, Inc. v. ITC*, 383 F.3d 1352, 1368 (Fed. Cir. 2004) determined the phrase “moving” includes “that is marked by or capable of movement” and thus, the phrase “moving participants” in claim 1 of the '095 patent “*may* be construed to include those participants capable of movement, and thus have a similar scope to the term ‘mobile.’” Op. 15 (emphasis added). Even so, *Gemstar-TV* also found “moving” to mean “that is not fixed or stationary” (*Gemstar-TV*, 383 F.3d at 1368), which unlike one definition of “mobile”,⁹ only includes participants that are not fixed or stationary. From this perspective, and to the extent the phrase “moving participants” in claim 1 of the '095 patent is limited to latter meaning, we further agree with the Examiner the recitation “mobile radios” (i.e., includes both movable and stationary objects) in the current claims is broader in scope than the previously recited “moving participants” (e.g., includes only participants that are not fixed or stationary). *See* May 4, 2016 Final Act. 3; *see also* Jan. 17, 2019 Final Act. 6–7 (citing the '095 patent 1:59–63); Ans. 15–16 (citing the '095 patent 1:59–63).

Appellant further contends that (1) the claims are not method claims, (2) removing “participants” from the claims make clear that the claims do not recite users or an impermissible “mixed claim type,” and (3) “the claims

⁹ As indicated in the Opinion (Op. 15 n.8), Appellant states Oxford English Dictionary defines “mobile” as “able to move or be moved freely or easily.” Appeal Br. 21.

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should not be construed in such a matter [sic].” Request 11 (citing *Modine Mfg. v U.S. Int’l Trade Comm’n*, 75 F.3d 1545, 1557 (Fed. Cir. 1996)) (quoting “When claims are amenable to more than one construction, they should when reasonably possible be interpreted so as to preserve their validity.”). We are not persuaded.

As explained above, the previously recited “participants” have not been construed to include users of the claimed system, but rather to include boats, ships, masts, and buoys consistent with the ’095 patent’s Specification. *See also* Op. 15–16 (citing the ’095 patent 1:61–63, 2:52–54). Thus, we do not view the scope of the “participants” in claim 1 of the ’095 patent as requiring users to use the system.¹⁰ Nor do we see the need to remove the term “participants” from the ’095 patent’s claims to clarify that they do not recite a user or impermissibly mix statutory claim categories.

Also, claim 1 currently recites “[a] radio communication *system* comprised of two groups or mobile *radios*,” and further recites structural and functional details about “the first group of mobile radios” and “the mobile radios of the second group.” Appeal Br. i (Claims App.) (emphases added). We do not interpret this claim, or current independent claims 15 and 26 (*see id.* at i–ii (Claims App.) for that matter, as method claims or mixed claim types.

Lastly, “[i]n a reexamination proceeding, . . . there is no presumption of validity and the ‘focus’ of the reexamination ‘returns essentially to that

¹⁰ *See IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005); *see also HTC Corp. v. IPCom GmbH & Co., KG*, 667 F.3d 1270, 1277 (Fed. Cir. 2012) (discussing *IPXL Holdings*).

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present in an initial examination,”” *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (quoting *In re Etter*, 756 F.2d 852, 857 (Fed. Cir. 1985)); *see also In re Swanson*, 540 F.3d 1368, 1377–78 (Fed. Cir. 2008) (indicating reexaminations are conducted according to initial examination procedures and claims are to be given their broadest reasonable interpretation consistent with the specification). As such, any concerns raised in *Modine Manufacturing*, 75 F.3d 1545, 1557, that Appellant may have related to preserving the claims’ validity in the ’095 patent do not hold in this reexamination proceeding.

For the above reasons, we did not overlook or misapprehend Appellant’s points related the recited “mobile radios” presented in the briefing (*see* Request 6, 10–11) and conclude, as we did in the previous Opinion (Op. 14–17), that claim 1’s “mobile radios” are broader in scope than the previously recited “moving participants . . . that are each equipped with a communication device.”

Request to Designate the § 305 Rejection a New Ground of Rejection

Appellant argues we relied upon “new factual findings that change the thrust of the rejection originally proffered by the examiner.” Request 3; *see id.* at 2–5, 10 n.2, 11. Upon further consideration in light of these circumstances, we designate the rejection under 35 U.S.C. § 305 as a new ground to afford Appellant the opportunity to respond fully to the rejection.

We have considered the arguments raised by Appellant in the Request for Rehearing and grant the Request to the extent indicated. Based on the record, we are still of the view that claims 1, 15, and 24–32 enlarge the scope of the claims of the ’095 patent being examined under 35 U.S.C.

§ 305.¹¹ We, however, designate this rejection as a new ground under 37 C.F.R. § 41.50(b).

Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

¹¹ This “decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its decision for appeal, except for those portions specifically withdrawn on rehearing[.]” 37 C.F.R. 41.52(a)(1).

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Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

REHEARING GRANTED
37 C.F.R. § 41.50(b)