

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MING-CHIANG LI

Appeal No. 1997-1236
Application 08/212,385¹

ON BRIEF

Before THOMAS, JERRY SMITH and FLEMING, Administrative Patent Judges.

¹ Application for patent filed March 14, 1994. According to appellant this application is a continuation-in-part of application 08/018,388 filed February 17, 1993, now abandoned, which is a continuation-in-part of 07/877,419 filed May 01, 1992, now United States Patent 5,294,930, issued March 15, 1994, which is a continuation-in-part of 07/787,085 filed November 04, 1991 now United States Patent 5,296,860, issued March 22, 1994.

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JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-20, which constitute all the claims in the application. An amendment after final rejection was filed on March 22, 1996 but was denied entry by the examiner.

The disclosed invention pertains to a method and apparatus for operating an optical RF support network. More particularly, the invention relates to the communication of navigation RF signals between a master supporting site such as a GPS satellite and a plurality of secondary supporting sites.

A particular feature of the disclosed invention is that the secondary supporting sites do not require sophisticated and expensive clock circuits.

Representative claim 1 is reproduced as follows:

1. An optical RF support network comprising:
a master supporting site;

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one or more secondary supporting sites; and optical RF link systems linking the secondary supporting sites to the master supporting site; wherein the secondary supporting sites comprise means for transmitting or receiving navigation RF signals; wherein the optical RF link systems comprise: (a) means for receiving navigation RF signals from one end; (b) means for up-converting the navigation RF signals to an optical signal; (c) means for transiting the optical signal from one end to a second end; (d) means for down-converting the optical signal at the second end to a navigation RF signal; and (e) means for transiting the navigation RF signals between the secondary supporting sites and the master supporting site.

The examiner relies on the following references:

Li	5,294,930	Mar. 15, 1994
Keolian et al. (Keolian)	5,313,266	May 17, 1994 (filed Aug. 17, 1992)
Kiasaleh	5,319,438	June 07, 1994 (filed Jan. 24, 1992)

Claims 1-20 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U. S. Patent No. 5,294,930 issued to appellant Li. Claims 1-20 also stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Keolian in view of Kiasaleh.

Rather than repeat the arguments of appellant or the

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examiner, we make reference to the brief² and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness and obvious double patenting relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the examiner has not established a prima facie case of obvious double patenting of appealed claims 1-20. We are also of the view that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the

² A reply brief was filed by appellant on September 16, 1996 which was denied entry by the examiner [Paper no. 19 sent October 21, 1996]. Accordingly, we have not considered the reply brief in rendering this decision.

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invention as set forth in claims 1-20. Accordingly, we reverse.

We consider first the rejection of claims 1-20 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of Li '960. The examiner states the following:

Although the conflicting claims are not identical, they are not patentably distinct from each other because while not exactly calmed [sic] the subject matter claimed is similar to and has been fully disclosed in the '930 patent. For example, it appears that the '930 patent discloses an optical RF network including, inter alia, a master site,

secondary supporting sites, and an optical RF link system linking the master and secondary sites [final rejection, page 4].

Appellant points out what he perceives to be several differences between the invention of the appealed claims before us and the invention of the previously granted Li patent [brief, pages 5-9]. The examiner responds that "the disclosure of the '930 [patent] sets out the claimed structure regardless of 'functional difference or physical foundation'" [answer, page 4]. The examiner also observes that "the structure disclosed [in the '930

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patent] is fully capable of such measurements. In other words, the structure exists to accomplish such a function" [id. page 6]. As with all rejections, the examiner has the burden of presenting a prima facie case of unpatentability. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In making an obvious double patenting rejection, the examiner must demonstrate that each claim of the application is unpatentable over a single claim of a patent. This demonstration should contain a showing of what is recited in each respective claim of the application and the corresponding respective single claim of the patent. An analysis of the differences between these claims should then be provided. Finally, a discussion as to why the artisan would have found it obvious to modify the claim of the patent or to combine the claim with additional prior art teachings to arrive at the application claim must be presented by the examiner. The examiner's demonstration here contains none of these showings. Additionally, the examiner relies primarily on the disclosure of Li '960 as prior art against these appealed claims. The disclosure of Li '960, however, may not be used against appellant Li in an obvious double patenting

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rejection. The disclosure of Li '960 may only be used to interpret language used in the claims of Li '960. Since the examiner has not made a proper obviousness analysis with respect to each of the appealed claims, and since the examiner has improperly relied on the disclosure of Li '960 as prior art, we will not sustain any of these rejections because the examiner has not met his initial burden of presenting a prima facie case of unpatentability.

We now consider the rejection of claims 1-20 under 35 U.S.C. § 103 as being unpatentable over the teachings of Keolian in view of Kiasaleh. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such

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reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

It is the position of the examiner that Keolian discloses the claimed device except for the RF input signal. The examiner notes that Kiasaleh teaches an interferometer system with an RF signal input and a signal conversion from RF to optical. The examiner concludes that it would have been obvious to provide RF signals to the Keolian device. The examiner also asserts that the fact that the claimed signals are navigation RF signals does not patentably distinguish over

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Kiasaleh's RF signals. The examiner makes no reference to the limitations set forth in any of the dependent claims [final rejection, pages 4-5].

Appellant argues that the systems of Keolian and Kiasaleh are completely irrelevant to the claimed invention. Appellant asserts that the examiner's position that Keolian is equivalent to the claimed invention except for the RF input signal is totally without foundation [brief, pages 9-10].

Although some of appellant's arguments are narrower than the inventions recited in independent claims 1, 9 and 17, we agree with appellant that the examiner has not made a prima facie case of the obviousness of the claimed invention. The examiner has obviously interpreted the claimed invention very broadly in order to find that Keolian teaches everything except the RF input signal. Since the examiner has not explained how he reads the claimed invention on the applied prior art, we are unable to assess the propriety of the examiner's claim interpretation. We do note that the invention of independent claim 1, for example, is recited in means plus function form yet the examiner has not explained how the circuitry of Keolian and/or Kiasaleh can perform the

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recited functions on navigation RF signals. The examiner has simply offered his bare conclusion that the claimed navigation RF signals do not patentably alter the structure. We fail to see how the teachings of Keolian and Kiasaleh would have suggested the optical RF support network for transmitting and receiving navigation RF signals as recited in the claimed invention.

We also note that there are elements in the dependent claims such as the stable clock [claim 3], means for processing navigation messages [claim 4] and means for reproducing stored navigation signals again and again [claim 6] which are nowhere suggested in the applied prior art and which have been completely ignored by the examiner in making the blanket rejection of all the claims. Thus, we are of the view that the present record does not support a prima facie case of obviousness of the claimed invention.

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In summary, we have not sustained either of the examiner's rejections of claims 1-20. Therefore, the decision of the examiner rejecting claims 1-20 is reversed.

REVERSED

James D. Thomas)	
Administrative Patent Judge)	
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Jerry Smith)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
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Michael R. Fleming)	
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