

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS

AND INTERFERENCES

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Ex parte LAWRENCE RAGAN and GAROLD B. GASKILL

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Appeal No. 1997-2246  
Application 08/353,872<sup>1</sup>

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ON BRIEF

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Before SCHAFER, LEE and MEDLEY, Administrative Patent Judges.

LEE, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's rejection of appellants' claims 2, 4, 8 and 9. No claim has been allowed.

**Introduction**

This case is before a panel of this Board for the third time. On March 30, 2000, a panel remanded the case back to the examiner for action not inconsistent with the comments and

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<sup>1</sup> Application for patent filed December 9, 1994. The real party in interest is SEICO EPSON CORPORATION.

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inquiries contained in that decision. (Paper No. 19). On November 20, 2000, the examiner provided a response. (Paper No. 21). On November 29, 2000, the applicants filed a reply to the examiner's response (Paper No. 22), which reply was not entered into the file or considered by the examiner. On March 27, 2001, this panel remanded the case back to the examiner (Paper No. 23) for appropriate action concerning the appellants' reply and for certain other clarifications. On May 14, 2001, the examiner filed a supplemental answer (Paper No. 25). The supplemental answer addresses the points in appellants' reply which has now been entered in the official file.

**References relied on by the Examiner**

|                                     |           |                                  |
|-------------------------------------|-----------|----------------------------------|
| Schwendeman et al.<br>(Schwendeman) | 4,914,649 | April 3, 1990<br>(Filed 9/12/88) |
|-------------------------------------|-----------|----------------------------------|

**The Rejection on Appeal**

Claims 2, 4, 8 and 9 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Schwendeman. Claims 2 and 8 are independent claims.

**The Invention**

The claimed invention is directed to a message transmission

system. Independent claim 2 is reproduced below:

2. A message transmission system comprising in combination:

first and second transmitters located at different physical locations, said first transmitter operating at a first frequency and said second transmitter operating at a second frequency which is different than said first frequency, each of said transmitters transmitting the same messages at different times,

a plurality of radio receivers, said receivers being frequency agile,

means for setting a receiver to said first frequency and for switching to the frequency of said second transmitter if a message is not received from said first transmitter,

whereby said transmission system has time, space and frequency diversity.

### Discussion

The position of the examiner regarding the finding of anticipation is articulated on page 3 of the answer as follows:

With respect to the rejection, Schwendeman et al teaches (figures 1, 3, and 7) a radio paging system (figure 3; column 6 line 31 - column 8 line 5) using a time slot protocol (figures 1 and 7) including first and second transmitters (308, 310) located at different physical locations thereby providing spacial diversity, operating at different frequencies (note each transmitter is operating on a different channel) thereby providing frequency diversity, and transmitting the same information conforming to the time slot protocol (figure 1)

thereby providing time diversity, each stream being offset in time (note message 1 in figure 1), and the receiver can tune to the second transmitter, if it does not receive the message from the first transmitter, within the same time frame (note figure 7; column 12 lines 15-39 in reference to timing of (706)). Each time slot is represented by the wide pulse (of 706) and the time frame is represented by channels 1-8.

The appellants argue that while Schwendeman discloses that multiple transmitters may be required in each area, all transmitters in each local area operate on the same frequency. The appellants further argue that each transmitter in a local area would transmit the same messages at the same time. Thus, according to the appellants, Schwendeman discloses neither frequency nor time diversity.

The examiner's ground of rejection has been misread by the appellants. It is transmitters 308 and 310 (Figure 3 of Schwendeman) in different zones, ZONE 1 and ZONE 2, which are used to satisfy the appellants' claimed transmitters, not multiple transmitters within the same zone. The examiner's explanation of the rejection explicitly refers to transmitters 308 and 310 on Figure 3 of Schwendeman, which operate on different frequencies CH.1 and CH.2 and which transmit the same messages in different time slots offset by one unit from

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each other (see Figure 1). The appellants' argument about lack of time and frequency diversity in Schwendeman is without merit.

The appellants further argue that each of the channels shown in Figure 1 of Schwendeman transmit different information, contrary to what is required by the appellants' claims. The appellants cite to the following feature in claim 2: "[E]ach of said transmitters transmitting the same messages at different times." Similar limitation is not represented by the appellants as being present in independent claim 8 or claim 9 which depends from claim 8. Accordingly, the argument is directed only to independent claim 2 and claim 4 which depends from claim 2. Claims 8 and 9 are not affected by this argument.

The argument has merit. During examination claim terms are properly construed according to their broadest reasonable interpretation not inconsistent with the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); see also In re Pearson, 494 F.2d 1399, 1404, 181 USPQ 641, 645 (CCPA 1974). In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969). Not only does claim 2 expressly

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recite: "each of the transmitters transmitting **the same messages** at different times (emphasis added)," the specification on page five states the following:

**All of the messages** being sent to the individually addressable paging receivers 10 are broadcast on each of the transmitters 15A, 15B and 15C. Thus, each message is broadcast from three different transmitters. While each of the three stations broadcasts the same set of messages, the transmissions are offset in time thereby providing the system with time diversity. (Emphasis added)

It is not consistent with the specification to regard appellants' claim 2 as requiring only that some but not all messages transmitted by the plurality of transmitters are the same. The examiner has not pointed to any portion of the specification which would reasonably permit the broader reading of the claim language. In the context of the appellants' invention, then, the transmitters must only transmit the same messages. A broader interpretation has not been justified by the examiner, in light of the appellants' specification.

Because the transmitters in the different zones of Schwendeman transmit their own local messages, which are different, as well as any messages to be commonly transmitted

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at special times, e.g., when a subscriber travels from one zone to another, they do not transmit "the same messages."

For the foregoing reasons, the examiner has not shown that the disclosure of Schwendeman satisfies every feature of claims 2 and 4. This deficiency, however, does not extend to appellants' claims 8 and 9.

The appellants contend that Schwendeman is not an available prior art reference because the appellants have submitted an affidavit to antedate the reference under 37 CFR § 1.131. The examiner, on the other hand, found that because Schwendeman claims the same invention as does the appellants, an affidavit under 37 CFR § 1.131 is unavailable to the appellants to attempt

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to remove Schwendeman as a reference. The appellants argue that Schwendeman does not claim the same invention.

Rule 1.131 allows a reference to be antedated unless it claims "the same patentable invention" as does the appellants. The burden is on the examiner to establish that the reference and the appellants are claiming "the same patentable invention." Per 37 CFR § 1.601(n), an invention "A" is the same patentable invention as an invention "B" when invention "A" is the same as or is obvious in view of invention "B" assuming invention "B" is prior art with respect to invention "A". The appellants have pointed to several differences between what is claimed in Schwendeman and what the appellants have claimed, and correctly noted that the examiner has not properly accounted for these differences in an obviousness analysis.

The independent claims of Schwendeman are claims 1, 9 and 18. The appellants note that both claims 1 and 9 of Schwendeman include the feature of a channel selecting means which is responsive to the received channel identification information (claim 1) or detected channel identification information (claim 9), for sequentially selecting the

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predetermined coded transmission slot on each of the plurality of channels, when the channel identification information received (claim 1) or detected (claim 9) on each of the plurality of channels does not match predetermined channel identification information. With respect to Schwendeman's claim 18, the appellants note that it specifies that each coded transmission slot of the predetermined sequence is transmitted sequentially on each of the plurality of channels so as to preclude the simultaneous transmission of a correspondingly coded transmission slot on any two channels in each geographical area. The examiner has not shown that any of these features are included in any one of appellants' rejected claims. As for obviousness, the examiner has not presented any analysis as to why it would have been obvious to arrive at Schwendeman's claims 1, 9 and/or 18 in light of any one of the appellants' claims. The examiner recognized (answer on page 6) that the appellants' claims only require that the receiver switch to a second frequency when it does not receive a message on the first frequency, and does not require the receipt of a list of station frequencies in a control packet. However, that does not demonstrate

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obviousness of any Schwendeman claim in light of any claim of the appellants.

For the foregoing reasons, the examiner has not satisfied his burden of showing that Schwendeman claims the same patentable invention as does the appellants. Accordingly, the examiner's conclusion is erroneous that the appellants may not resort to an affidavit under 37 CFR § 1.131 to attempt to antedate the Schwendeman reference. The substance of the Rule 1.131 affidavit must be reviewed by the examiner.

In response to the first remand order from the board, the examiner set forth his analysis of the Rule 1.131 affidavit on pages 2-3 of Paper No. 21. The examiner concluded that the Rule 1.131 affidavit is in any event inadequate to antedate the Schwendeman reference. The appellants, in their reply (Paper No. 22), failed to demonstrate error in the examiner's conclusion.

The examiner adopted the analysis contained in parent application 07/971,693, which was directed to the same affidavit. The examiner noted that the applicants have merely stated that they were diligent from the time of the Schwendeman reference was filed (9/12/88) to the alleged time

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of actual reduction to practice (3/16/89) and that there was no presentation of facts to support the assertion of diligence.

In a reply (Paper No. 22) to the examiner's response, the appellants state:

With respect to the affidavit submitted by the applicant the examiner states:

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"The applicant has merely stated that he was diligent from the time the Schwendeman et al reference was filed (9/12/88) to the alleged time of actual reduction to practice (3/16/89)"

The above quoted statement is not correct. The affidavit submitted states:

"The subject matter was conceived and reduced to practice in the United States by simulation prior to September 12, 1988. Between September 12, 1988 and March 16, 1989 I was diligently working to reduce the invention to actual practice."

The above-quoted argument of the appellants is of no help to their case. Reasonable diligence must commence from a time just prior to the effective date of the Schwendeman reference.

37 CFR

§ 1.131. Insofar as the diligence requirement is concerned, there has been no mischaracterization by the examiner of the appellants' statement. Rather, the examiner's reference to the filing date of the Schwendeman reference adds an appropriate context to the date September 12, 1988. Also, still, there is only an assertion of diligence by the appellants, and the appellants have not pointed to specific and detailed facts which support the assertion of diligence during the critical period.

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Moreover, the diligence must begin from a time prior to  
September 12, 1988, 37 CFR § 1.131, and even the appellants'  
above-quoted

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assertion of diligence is not directed to a period commencing from a time "prior" to September 12, 1988.

The appellants' reply further states:

One of the exhibits that was submitted was:

Exhibit A5: a filed test report prepared prior to September 12, 1988 which reports on tests performed prior to September 12, 1988 of a system which incorporates the subject invention["].

The examiner in his supplemental examiner's answer (Paper No. 24) correctly notes on page 5 thereof that tests conducted prior to September 12, 1988 cannot provide evidence of diligence from September 12, 1988 to March 16, 1989. Moreover, the appellants' reply does not address how long prior to September 12, 1988 were the tests performed.

The examiner further found that the appellants have not demonstrated any actual reduction to practice of the claimed invention subsequent to the effective filing date of the Schwendeman reference (Paper No. 21 at page 3). The appellants dispute that finding (Reply Point 5 at pages 2-3). We need not and do not reach this issue, because we sustain the examiner's conclusion that the appellants have not shown reasonable diligence from a time prior to the effective filing date of the Schwendeman reference to the time of alleged

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actual reduction to practice. In that regard, arguments not made by the appellants have not been considered. The board does not take up the role of counsel or advocate to see what else, if anything, can be argued or pointed out by the appellants. Insofar as the appellants, in response to the examiner's position, have not pointed out what specific facts in their declaration support the assertion of diligence from a time prior to September 12, 1988, to March 16, 1989, we decline and are not obliged to make an independent hunt for such testimony and to characterize them in the first instance.

Finally, the appellants argue in their reply brief that the examiner had already accorded the appellants a priority date of November 27, 1985, which is long prior to the filing date of the Schwendeman reference. In support of that contention, the appellants state:

In an advisory action dated 09/04/96 (paper number 12), the examiner states:

"Applicant's response has overcome the following objection: the response, if entered for appeal, will overcome the objection to the specification and declaration re continuity".

The appellants' submission immediately prior to the advisory action dated September 4, 1996, is Paper No. 11,

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filed on July 22, 1996. In that submission, the appellants no longer claims entitlement to priority of applications filed prior to May 25, 1990. That concession, evidently, is what overcame the examiner's previous objection to the claim concerning priority.

The examiner's supplemental answer on page 4 indicates the same:

In response to "point two" of appellant's reply brief, it is respectfully submitted that the Advisory action dated 9-4-96 did not in any way state or suggest that appellant was entitled to a filing date of 11-27-85. The advisory action stated that the after final amendment submitted on 7-26-96 overcame the objections to the specification and declaration regarding proper listing of the parent applications to which appellant is entitled an effective filing date. The advisory action did not agree to an effective filing date of 11-27-85, and the examiner could not have agreed to the 1985 date because appellant has not shown copendency with common inventors to the 1985 date and because the After final amendment submitted 7-22-96 includes a claim for priority extending only to 5-25-90. It appears that there may have been some confusion between this amendment and an earlier amendment after final filed 6-26-96 which argues an earlier date, but was not deemed persuasive and therefore was not entered.

A review of the official file reflects that the response dated June 26, 1996 (Paper No. 6), in which the appellants

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challenged the examiner's decision not to grant priority to application 06/802,844, filed November 27, 1985, still remains not-entered today. This fact supports the examiner's view.

The appellants have not shown that the examiner had previously granted appellants' application priority to a date as early as November 27, 1985. Even if the examiner had previously granted priority to such an early date, it is clear that the examiner has withdrawn that alleged accordance of benefit. Consequently, the effective date of the appellants' application is May 25, 1990, a time not prior to the filing date of the Schwendeman reference.

For the foregoing reasons, The Schwendeman reference has not been antedated by the appellants by way of a Rule 1.131 affidavit.

### **Conclusion**<sup>2</sup>

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<sup>2</sup> There is no occasion for us to discuss the examiner's statement in Paper No. 21, page 2: "[I]t appears that an interference cannot be declared because the claims were not presented within 1 year after the date on which the patent issued (MPEP 2306)." We do not review a recommendation by an examiner on whether an interference should be declared. A rejection of claims under 35 U.S.C. § 135(b) has not been made and is not before us. However, in that connection, it should be noted that in discussing the appellants' reliance on a Rule 1.131 affidavit we have held that the examiner has not shown that the Schwendeman reference claims the same patentable

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The rejection of appellants' claims 2 and 4 under 35 U.S.C. § 102(e) as being anticipated by the Schwendeman reference is **reversed**.

The rejection of appellants' claims 8 and 9 under 35 U.S.C. § 102(e) as being anticipated by the Schwendeman reference is **affirmed**.

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invention as does the appellants.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

**AFFIRMED-IN-PART**

|                             |   |                 |
|-----------------------------|---|-----------------|
| RICHARD E. SCHAFER          | ) |                 |
| Administrative Patent Judge | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) | BOARD OF PATENT |
| JAMESON LEE                 | ) | APPEALS AND     |
| Administrative Patent Judge | ) | INTERFERENCES   |
|                             | ) |                 |
|                             | ) |                 |
|                             | ) |                 |
| SALLY C. MEDLEY             | ) |                 |
| Administrative Patent Judge | ) |                 |

JL/dal

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