

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

**Ex parte** PAUL D. FILLIMAN and MARK F. RUMREICH

---

Appeal No. 1999-1848  
Application No. 08/532,177

---

ON BRIEF

---

Before JERRY SMITH, LALL, and DIXON, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claim 1, which is the only claim on appeal. Claims 3-18 have been indicated by the examiner to be allowable over the prior art of record.

We REVERSE.

## BACKGROUND

The appellants' invention relates to a phase shift apparatus. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. Phase shift apparatus, comprising:

a source providing an input signal to be phase shifted;

summing means for summing first, second and third intermediate signals derived from said input signal and having differing phase shifts to form a phase shifted output signal;

first amplitude control means responsive to a phase control signal supplied thereto for varying the amplitudes of said second and third intermediate signals concurrently and in opposite directions for controlling the phase of said phase shifted output signal; and

second amplitude control means responsive to said phase control signal, for varying the amplitude of said first intermediate signal.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Metz

5,157,276

Oct. 20, 1992

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Metz.

Appeal No. 1999-1848  
Application No. 08/532,177

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 17, mailed Dec. 22, 1998) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 16, filed Nov. 2, 1998) for appellants' arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claim, to the applied prior art reference, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

"Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention." **RCA Corp. v. Applied Digital Data Systems, Inc.**, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

It is well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office (PTO). **See In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). After the PTO establishes

Appeal No. 1999-1848  
Application No. 08/532,177

a *prima facie* case of anticipation based on inherency, the burden shifts to the appellant to prove that the subject matter shown to be in the prior art does not possess the characteristics of the claimed invention. **See In re Thorpe**, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); **In re King**, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986). Hence, appellants' burden before the PTO is to prove that the applied prior art reference does not perform the functions defined in the claims. Compare **In re Best**, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); **In re Ludtke**, 441 F.2d 660, 664, 169 USPQ 563, 566-67 (CCPA 1971). Here, we find that appellants have met this burden and we will not sustain the rejection of claim 1.

Appellants argue that Metz does not disclose a "first amplitude control means responsive to a phase control signal supplied thereto for varying the amplitudes of said second and third intermediate signals concurrently and in opposite directions for controlling the phase of said phase shifted output signal; and second amplitude control means responsive to said phase control signal, for varying the amplitude of said first intermediate signal." (See brief at page 4.) We agree with appellants. From our understanding of Metz, Metz does not teach (2) signals which are controlled concurrently and in opposite directions due to the fact that one of the multipliers is turned off while the other is turned on. Therefore, the examiner has not established a *prima facie* case of anticipation, and we will not sustain the rejection of claim 1.

Appeal No. 1999-1848  
Application No. 08/532,177

**CONCLUSION**

To summarize, the decision of the examiner to reject claim 1 under 35 U.S.C. §  
102(b) is reversed.

**REVERSED**

JERRY SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	
PARSHOTAM S. LALL	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS
	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JOSEPH L. DIXON	)	
Administrative Patent Judge	)	

Appeal No. 1999-1848  
Application No. 08/532,177

JOSEPH S. TRIPOLI  
PATENT OPERATIONS GE AND RCA  
LICENSING MANAGEMENT OPERATION INC  
CN 5312  
PRINCETON , NJ 08543-0028