

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANZ AMTMANN

Appeal 2008-0019
Application 10/375,729¹
Technology Center 2600

Decided: June 3, 2008

Before SCOTT R. BOALICK, JOHN A. JEFFERY, and MARC S. HOFF,
Administrative Patent Judges.

BOALICK, *Administrative Patent Judge.*

¹ Application filed February 27, 2003. The real party in interest is Philips Electronics North America Corporation.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the final rejection of claims 7-9, all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellant's "invention relates to a write/read device designed for the contactless communication with at least one transponder." (Spec. 1:1-2.)

Claim 7 is exemplary:

7. A transponder for wireless communication using a physical layer, comprising:

receiving means for receiving a modulated carrier signal, said carrier signal either comprising a first start signal characteristic of a first physical layer coding method and after the first start signal coding signals representing a data block, the number of the coding signal being at the most equal to a given number N in accordance with said first coding method, or comprising a second start signal characteristic of a second physical layer coding method and after the second start signal coding signals representing a data block, the number of the coding signals being at the most equal to a given number M in accordance with said second coding method, the number M being smaller than the number N; and

detecting means for detecting the first start signal and the second start signal.

Claims 7-9 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the Brief² and the Answer for their respective details. Only those arguments actually made by Appellant have been considered in this decision. Arguments that Appellant did not make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).³

ISSUE

The issue is whether Appellant has shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 112, first paragraph. The issue turns on whether the originally-filed Specification contains a legally sufficient disclosure of a first physical layer coding method and a second physical layer coding method.

PRINCIPLES OF LAW

On appeal, all timely filed evidence and properly presented arguments are considered by the Board. *See In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984).

In the examination of a patent application, the Examiner bears the initial burden of showing a *prima facie* case of unpatentability. *Id.* at 1472. When that burden is met, the burden then shifts to the applicant to rebut. *Id.*;

² We refer to the most recent Brief, filed November 30, 2005.

³ Except as will be noted in this opinion, Appellant has not presented any substantive arguments directed separately to the patentability of the dependent claims. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See* 37 C.F.R. § 41.37(c)(1)(vii).

see also In re Harris, 409 F.3d 1339, 1343-44 (Fed. Cir. 2005) (finding rebuttal evidence unpersuasive). If the applicant produces rebuttal evidence of adequate weight, the prima facie case of unpatentability is dissipated. *In re Piasecki*, 745 F.2d at 1472. Thereafter, patentability is determined in view of the entire record. *Id.* However, on appeal to the Board it is an appellant's burden to establish that the Examiner did not sustain the necessary burden and to show that the Examiner erred. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

Under the written description requirement of 35 U.S.C. § 112, the disclosure of the application relied upon must reasonably convey to one of ordinary skill in the art that, as of the filing date of the application, the inventor had possession of the later-claimed subject matter. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991). "One shows that one is 'in possession' of the *invention* by describing the *invention*, with all its claimed limitations, not that which makes it obvious." *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) (emphasis in original).

Although "the meaning of terms, phrases, or diagrams in a disclosure is to be explained or interpreted from the vantage point of one skilled in the art, all the limitations must appear in the specification." *Id.* The Specification need not describe the claimed subject matter in exactly the same terms as used in the claims, but it must contain an equivalent description of the claimed subject matter. *Id.*

ANALYSIS

Appellant contends that the Examiner erred in rejecting claims 7-9 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Reviewing the record before us, we do not agree. In particular, we find that the Appellant has not shown that the Examiner failed to make a *prima facie* showing under 35 U.S.C. § 112, first paragraph, of failure to comply with the written description requirement. Appellant failed to meet the burden of overcoming that *prima facie* showing.

Appellant argues that claims 7-9 are adequately supported in the Specification. (Br. 3.) In particular, Appellant's entire argument is that:

The language of the claims is not intended to claim first and second layers. Rather, the language, which is believed to be *clear when read in light of the specification*, is intended to claim *first and second coding methods* (clearly and unambiguously disclosed in the specification), and *more particularly*, first and second *physical layer* coding methods. So, the adjectives "first" and "second" apply to "coding methods," *NOT TO "LAYER."* Likewise, the adjective "physical layer" applies to "coding methods."

(Br. 3(emphasis in original).)

Although Appellant is correct that a "first coding method" and a "second coding method" are disclosed (*see, e.g.*, Spec. 4:4-7 & 6:25-27), we agree with the Examiner that the originally-filed Specification does not reasonably convey to a person having ordinary skill in the art that the inventor had possession at the time of filing of the "first physical layer coding method" and the "second physical layer coding method" recited by independent claim 7. (Ans. 3-4; Final Office Action 4-5.)

Appellant does not point to, nor do we find, support in the originally-filed Specification for the claim terms "first *physical layer* coding method" (emphasis added) and "second *physical layer* coding method" (emphasis added). In the SUMMARY OF CLAIMED SUBJECT MATTER section of the Brief, Appellant states that Figs. 2B and 2C show a "first physical layer coding method" and that Figs. 2D and 2E show a "second physical layer coding method." (Br. 2.) The Examiner correctly disputes this characterization. (Ans. 2.)

The Specification teaches that "Figures 2B to 2E show signals and signal waveforms which occur in the device of Figure 1 as a result of the data block shown in Figure 2A." (Spec. 3:14-15.) The description of Figures 2B and 2C discloses a "first coding method" (Spec. 4:12 to 6:13) and the description of Figures 2D and 2E discloses a "second coding method" (Spec. 6:14 to 8:8). However, this description in the originally-filed Specification does not provide support for the claimed first *physical layer* coding method and second *physical layer* coding method. The originally-filed Specification does not disclose a physical layer or a physical layer coding method.

Therefore, the originally-filed Specification lacks an adequate written description of the "first physical layer coding method" and "second physical layer coding method" recited by independent claim 7 and incorporated into dependent claims 8 and 9, which depend from claim 7.

Moreover, Appellant did not address in the Brief, and therefore failed to rebut, the Examiner's findings (Ans. 3-4; Final Office Action 4) that

[t]he claimed "detecting means for detecting the first start signal and the second start signal" in claim 7, decoding the coded signal, "one out of K code" in claim 8 and "decoding coding

Appeal 2008-0019
Application 10/375,729

signals with a Return-To-Zero code" in claim 9 are not disclosed in the specification as originally filed.

(Final Office Action 4.)

Accordingly, we conclude that Appellant has not shown that the Examiner erred in rejecting claims 7-9 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

CONCLUSION OF LAW

We conclude that Appellant has not shown that the Examiner erred in rejecting claims 7-9.

DECISION

The rejection of claims 7-9 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

gvw

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