

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SAMUEL G. MUNOZ-GARCIA, PATRICK CHOMET,
and DENNIS ROY MULLINS

Appeal No. 2001-1185
Application No. 08/915,597

HEARD: February 11, 2002

Before THOMAS, BARRY, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 3-6, 8, and 10-13. Claims 2 and 9 have been objected to as being allowable if rewritten in independent form. Claims 7 and 14 have been canceled.

BACKGROUND

Appellants' invention relates to a satellite communications gateway management system. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced as follows:

1. A communication system wherein a user terminal can communicate with a plurality of satellites;

wherein each of said plurality of satellites can communicate with a plurality of earth stations;

wherein each of said plurality of earth stations is operable to provide a gateway into a terrestrial communication system; and

wherein said user terminal is registered at a selected one of said plurality of earth stations as its gateway station; wherein said gateway station, in the event of being unable to establish contact with said user terminal, is operative to select and instruct another earth station to establish contact with said user terminal to act as an alternative earth station and being further operative to pass messages to and from said user terminal through said alternative earth station while acting as said gateway into said terrestrial communication system.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hatano et al. (Hatano)	5,355,511	Oct. 11, 1994
Azer	5,481,592	Jan. 2, 1996
Sowles et al. (Sowles)	5,561,836	Oct. 1, 1996

Claims 1, 3, 4, 6, 8, 10, 11, and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sowles in view of Hatano.

Claims 5 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sowles in view of Hatano and further in view of Azer.

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. 21, mailed September 27, 2000) for the examiner's complete reasoning in support of the rejections, and to appellants' brief (Paper No. 20, filed September 11, 2000) and reply brief (Paper No. 23, filed November 27, 2000) for appellants' arguments thereagainst. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered. See 37 CFR 1.192(a).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs 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 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 invention as set forth in claims 1, 3, 4-6, 8, and 10-13. Accordingly, we reverse.

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 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. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ

657, 664 (Fed. Cir. 1985); 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). If that burden is met, the burden then shifts

to the applicant to overcome the prima facie case with argument

and/or evidence. Obviousness is then determined on the basis of

the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038,

1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745

F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re

Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

We consider first the rejection of claims 1, 3, 4, 6, 8, 10, 11, and 13 based on the teachings of Sowles considered with Hatano. Appellants present three basic arguments. It is asserted (brief, pages 4 and 5) that Sowles fails to disclose or suggest "said gateway station ... being further operative to pass messages to and from said user terminal through said alternative earth station while acting as said gateway into said terrestrial communication system" as required by claim 1. Appellant further asserts (brief, pages 6 and 7) that in Hatano, mobile stations 14 do not act as gateways. It is additionally asserted (brief, page

7) that the examiner has failed to provide any motivation for combining the references.

Beginning with the first issue, the examiner's position (answer, pages 14 and 15) is that:

1) Sowles discloses that the assignment of the subscriber unit to the home SIM (28) is permanent, as disclosed at column 11, line 67 through column 12, line 1; 2) The home SIM (28), more specifically the gateway (30), is connected to the PSTN for use by various subscriber units, as exhibited in FIG. 1. Based on these two reasons it can be concluded that the home SIM (28), more specifically the gateway (30), still acts as a gateway to the PSTN even though the home SIM has selected and instructed another gateway (30) to communicate with the subscriber unit (24). Since any communication to the subscriber unit is directed through its home SIM and since the home SIM continues to communicate with all subscriber units that it is responsible for, the examiner maintains that the home SIM still acts a gateway to the PSTN.

From our review of Sowles, we find that Sowles discloses a radio communications system 10 which includes a plurality of satellites 14 (figure 1). Switching Offices (SOs) 16 reside on the surface of the earth and are in communication with the satellites. An SO may direct communications with any region of the earth, but each SO preferably associates with one or more countries. SOs couple to public switched telecommunications networks (PSTNs) (col. 2, line 65 - col. 3, line 10). SOs perform circuit switching and control call setup, call record keeping, call knockdown and other management functions (col. 3,

lines 37-41). Subscriber units 24 communicate with nearly satellites through communication links 26 (col. 3, lines 21 and 22). Subscriber information managers (SIMS) maintain a subscriber database that is relevant only to its own portion of the population of subscriber units 24. Each subscriber unit is assigned to a "home" SIM (col. 3, lines 25-36). The functions of SIMS 28 and SOs 16 take place at gateways 30 (col. 3, lines 41-44). Boundaries 40 separate service control areas 42. One more SOs control a single service control area, and no SOS service an area that extends over a boundary (col. 5, lines 5-11). Figure 5 illustrates a flow chart of a satellite request handler 90. Upon receiving a request for services from a subscriber unit 24, the home gateway of the subscriber unit is identified. In task 94, communication path ends are assigned. By assigning path ends, satellite 14 allocates communications links 18, 20, and 26 so that communications may be routed between the subscriber unit and the home gateway (col. 9, lines 4-8). The path between the subscriber unit 24 and the home gateway 30 desirably remains open until the satellite receives a response to the service request (col. 9, lines 28-32). Even though subscriber units 24 are permanently assigned to home SIMS (col. 11, lines 38 and 39) Sowles discloses (col. 11, lines 59-67) that

"subscriber units **24** are also assigned temporarily to serving SOs **16**. The SOs **16** are selected in response to the current location of the subscriber unit **24**. As the subscriber unit **24** moves from one service control area **42** to another service control area **42** (see FIG. 2), this temporary assignment changes so that the subscriber unit **24** is temporarily assigned to the SO **16** within whose service control area **42** the subscriber unit **24** currently resides." If communication services are allowed, task 112 may alter the path ends previously established to indicate a connection between the subscriber unit and an SO 16. After a change path message is sent future communications will be then be directed through satellite 14 between the SO 16 and the subscriber unit 24 rather than between the home SIM and the subscriber unit 24 (col. 15, lines 4-10). The serving SO updates its records to reflect the temporary assignment of subscriber unit 24, the subscriber unit's location, and any other data relevant to the service of the subscriber unit 24 through an SO 16 (col. 15, lines 15-18).

In sum, from the disclosure of we Sowles, we find that (a) when outside their home area, subscriber units 24 are temporarily assigned to the SO that serves the current location of the subscriber unit; (b) when temporarily assigning the subscriber

unit to a different SO, the end path previously established is changed; (c) each SO is connected to the PSTN 22; (d) no SO services an area that extends over a boundary 40; (e) future communications are directed through the temporarily assigned SO rather than between the home SIM and the subscriber unit 24, and (f) the serving SO updates its records to include the subscriber unit location and any other data relevant to the service of the subscriber unit through the SO.

From these teachings of Sowles, we find that when an alternative SO is temporarily assigned in response to a call to/from an a location outside of the subscriber units' home SIM area, that the temporarily assigned SO (temporarily assigned by the home SIM (col. 10, lines 7-14)) passes messages to and from the alternative gateway or earth station, but that the home SIM does not pass messages to and from the alternative earth station while acting as the gateway into the terrestrial communication system, as required by claim 1. Based upon our findings, supra, that Sowles does not disclose the home SIM passes messages to/from the alternative earth station while acting as gateway to the terrestrial communication system, we consider the examiner's conclusion to the contrary to be speculation, unsupported by

evidence in the record. The examiner may not resort to speculation or unfounded assumptions to supply deficiencies in establishing a factual basis. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). Stated differently, the subjective opinion of the examiner as to what is or is not obvious, without evidence in support thereof, does not provide a factual basis upon which the legal conclusion of obviousness can be reached.

Because we agree with appellants that Sowles does not teach or suggest that the home SIM pass messages to and from the alternative earth station while acting as the gateway into the terrestrial communication system as required by claim 1, and additionally find that Hatano does not make up for the basic deficiencies of Sowles, we do not reach the additional arguments presented by appellants. The other independent claim 8 contains limitations similar to claim 1.

From all of the above, we find that the examiner has failed to establish a prima facie case of obviousness. The rejection of claims 1, 3, 4, 6, 8, 10, 11, and 13 under 35 U.S.C. § 103(a) is therefore reversed.

We turn next to the rejection of claims 5 and 12 under 35 U.S.C. § 103(a). As evidence of obviousness, the examiner offers Sowles considered with Hatano and Azer. We reverse the rejection

of claims 5 and 12 under 35 U.S.C. § 103(a) because Azer does not make up for the basic deficiencies of Sowles and Hatano.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3-6, 8, and 10-13 under 35 U.S.C. § 103(a) is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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