

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD D. GALLAGHER,
RUSSELL B. JORGENSEN,
ROBERT J. SERKOWSKI and JAMIE C. SU

Appeal No. 2001-1926
Application 08/777,722

ON BRIEF

Before THOMAS, BARRETT, and BLANKENSHIP, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 1, 2, 12 and 13.

Representative claim 12 is reproduced below:

12. A wireless switching system for providing wireless service for a plurality of wireless handsets and the wireless switching system having a plurality of switch nodes with each of the plurality of switch nodes being connected to an individual set of a plurality of base stations, comprising:

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means for executing a first application for controlling continuously call functions of wireless calls that originated on a first one of the plurality of switch nodes;

means for executing a first application for controlling handset functions on the first one of the plurality of switch nodes and the first application for controlling handset functions provides direct control of one of the plurality of wireless handsets connected via one of a first individual set of the plurality of base stations to the first one of the plurality of switch nodes and the one of the plurality of wireless handsets engaged in a wireless call that originated on the first one of the plurality of switch nodes;

means for transferring the control of one of the plurality of wireless handsets to a second application for controlling handset functions executing on a second one of the plurality of switch nodes upon a handoff of the one of the plurality of wireless handsets to one of a second individual set of the plurality of base stations connected to the second one of the plurality of switch nodes; and

means for establishing telecommunication call between the second application for controlling handset functions and the first application for controlling call functions with the first application for controlling call functions continuing to control the wireless call.

The following reference is relied on by the examiner:

Bales et al. (Bales)	5,666,399	Sep. 9, 1997
	(filing date Mar. 31, 1995)	

Claims 1, 2, 12 and 13 stand rejected under 35 U.S.C.

§ 102(e) as being anticipated by Bales.¹

¹ The rejection of claims 3 and 14 on this statutory basis as set forth in the final rejection was withdrawn at page 2 of the answer. Similarly, an outstanding double patenting rejection set forth in the final rejection has been withdrawn as stated at
(continued...)

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Rather than repeat the positions of the appellants and the examiner, reference is made to the brief and the answer for the respective details thereof.

OPINION

We reverse, since we have concluded that the examiner has not established a prima facie case of anticipation within 35 U.S.C. § 102.

This lack of a prima facie case is initially present in the manner in which the rejection has been set forth in the answer. The examiner has not correlated specific teachings, suggestions, and showings for the various figures to each recited limitation of independent claims 1 and 12 on appeal to justify a valid rejection under 35 U.S.C. § 102. Instead, it appears that this burden has been left to us to do. The examiner has selectively quoted in the answer substantial portions of most of the 20 columns of Bales in addition to reproducing therein various figures from this reference. The examiner has not identified by column and line number most portions of Bales quoted in the

¹(...continued)
page 2 of the answer.

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answer except when certain references have been unfavorably made to the claims in Bales itself.

The examiner has also extensively quoted at pages 34-38 of the answer unidentified portions from a patent incorporated by reference within Bales and discussed at columns 10 and 11. This approach is problematic in the context of a rejection under 35 U.S.C. § 102 since it appears like the examiner is intending to actually base the rejection under 35 U.S.C. § 103 in relying upon more than one reference. The same can be said of the examiner's quotation from another identified reference at page 43 of the answer which is in the context of the responsive arguments portion of the answer. Two other references are also noted there as well.

The thrust of the reasoning is that the examiner is attempting to prove that a switchover operation, such as what is characterized in Bales, amounts to a handoff operation. The examiner may be correct in the assessment and reliance upon still additional prior art references at pages 41 and 42 of the answer as to the characterization that there exists in the art many types of handoffs. Within a rejection under 35 U.S.C. § 102, which is before us, the examiner's reliance must primarily

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focus, if not entirely, upon the teachings, suggestions and showings in Bales itself with no additional evidence. It is therefore not apparent to us that the manner in which the examiner has quoted extensively from Bales itself as well as made reference to additional references presents to us a prima facie case of anticipation, particularly without a correlation of each of the recited claimed limitations to Bales.

We also find no prima facie case of anticipation within the teachings, suggestions and showings of Bales to the subject matter set forth in representative independent claim 12 on appeal.

Even the overall architecture presented in Figure 1 of Bales does not correlate to the overall architecture of appellants' disclosed Figure 1. A brief study of the abstract and summary of the invention in Bales does not lead us to conclude that the various applications recited in representative independent claim 12 on appeal are performed by the various types of controlling functions in Bales. The examiner has made no attempt to correlate structurally the at least two switch nodes required of representative claim 12 on appeal. Even though it is readily

apparent that a plurality of switch nodes exist in Figure 1 of Bales, the examiner has not attempted to correlate teachings and suggestions of Bales to a required first application for controlling continuously various call functions of wireless calls and separately for controlling in a similar first application separately recited handset functions, both of which are recited to exist initially in claim 12 on appeal in the first recited switch node. The claim additionally requires at least second handset functions to exist but in a second switch node such as to effect a handoff of handset functions between the first to the second node. It is thus apparent at the end of the claim on appeal that the control of the call functions themselves remains with the first application stated to exist in the first node such as to continue the control of the wireless call there rather than at the second stated node.

Notwithstanding the fact that Figure 1 of Bales clearly shows plural switch nodes 101 and 130, the examiner has made no attempt to correlate these listed recited functions of representative claim 12 on appeal to the teachings and showings of Bales himself. Indeed, a labeled TMA functions within both of the switch nodes shown in Figure 1 and relates only to terminal management application functions, and the TEA portions

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within switch node 101 relate to terminal emulation application functions. Neither the TMA nor the TEA functions correlate to the claimed call functions and handset functions of representative claim 12 on appeal. At least from the abstract and the summary of the invention of Bales, these types of functions recited in the claim appear to be performed by the communications switching system 107 in Figure 1 of Bales rather than to be distributed in any manner to the respective switching nodes 101 and 130 in this figure. We read Bales in much the same manner as argued by appellants in the brief, that this reference does not indicate that it performs any handoff functions at all, let alone the specific type of handoff functions recited in representative independent claim 12 on appeal. Even if we were to agree with the examiner's view that a type of switchover operation occurs within Bales, the correlation does not exist to the functions of a handoff operation as recited in representative claim 12 on appeal.

Since we have found that the examiner has not set forth a prima facie case of anticipation within 35 U.S.C. § 102, the rejection on this basis of corresponding method and apparatus

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independent claims 1 and 12 is reversed. This reversal must therefore extend to their respective dependent claims 2 and 13 on appeal. In view of the foregoing, the decision of the examiner rejecting claims 1, 2, 12 and 13 under 35 U.S.C. § 102 is reversed.

REVERSED

James D. Thomas)	
Administrative Patent Judge)	
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Lee E. Barrett)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
Howard B. Blankenship)	
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