

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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDDIE CORBETT and BILLY HOGAN

Appeal No. 2002-0137
Application 09/069,765

ON BRIEF

Before HAIRSTON, SAADAT, and MACDONALD, **Administrative Patent Judges**.

MACDONALD, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-19.

Invention

Appellants' invention relates to an apparatus and method for soft handoff in a radio communication system. More particularly, in the situation where a mobile station receives identical

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signals from multiple transmission sources, the invention determines if the station is substantially stationary. If the station is determined to be substantially stationary, then the signal strength of each of the multiple transmission sources is compared to a threshold and the weakest transmissions are terminated. Appellants' specification at page 1, lines 7-8, and page 5, lines 3-6.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A method for performing handoff in a radio communication system comprising the steps of:

transmitting substantially the same information from a plurality of sources to a remote station;

determining if said remote station is substantially stationary;

evaluating transmissions from each of said plurality of sources using a result of said determining step; and

selectively terminating transmissions from at least one of said plurality of sources based upon a result of said evaluating step.

References

The references relied on by the Examiner are as follows:

Weaver, Jr. et al. (Weaver) 5,848,063 Dec. 8, 1998
(Filed May 23, 1996)

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Rejections At Issue

Claims 1-19 stand rejected under 35 U.S.C. § 102 as being anticipated by Weaver.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.¹

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claims 1-19 under 35 U.S.C. § 102.

We also use our authority under 37 CFR § 1.196(b) to enter a new grounds of rejection of claims 15-17. The basis for this is set forth in detail below.

¹Appellants filed an appeal brief on September 8, 2000. Appellants filed a reply brief on April 9, 2001. The Examiner mailed an Examiner's Answer on February 9, 2001.

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I. Rejection of Claims 15-17 Under 37 CFR § 1.196(b).

We make the following new grounds of rejection using our authority 37 CFR § 1.196(b).

Claims 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention.

The term "function" in claim 15 is used by the claim in a way that does not correspond to any accepted meaning of the term. The term is indefinite because the specification does not clearly redefine the term. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. **Process Control Corp. v. HydReclaim Corp.**, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999).

**II. Whether the Rejection of Claims 1-14, 18 and 19 Under
35 U.S.C. § 102 is proper?**

It is our view, after consideration of the record before us, that the disclosure of Weaver does not fully meet the invention as recited in claims 1-14, 18 and 19. Accordingly, we reverse.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. **See In re King**, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and **Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.**, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

With respect to independent claim 1, which is representative of claims 1-14, 18 and 19, Appellants argue at the top of page 6 of the brief, "there is no disclosure or suggestion in Weaver of terminating transmissions based upon the evaluation of the transmission and the determination that the mobile station is stationary." The Examiner responds at page 15 of the answer that, "[e]valuating transmissions from each plurality of sources and selectively terminating transmissions reads on Weaver's invention." We agree. However, we fail to see how this fully

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meets the language of claim 1, which recites that, the "evaluating transmissions" requires "using a result of the determining step" where the determining is "if said remote station is substantially stationary." Even if we fully accept the Examiner's position in the rejection on appeal that all the steps/components of claim 1 are found in Weaver, the reference does not show those steps/components connected and interacting in the way required by the claim language. We find Appellants' argument persuasive.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 102.

We do not reach a determination on whether Weaver teaches the step in claim 1 of "determining if said remote station is substantially stationary." Such is not required for our decision. We find that Weaver does not anticipate claim 1 even if we were to assume that Weaver does teach the determining step.

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**III. Whether the Rejection of Claims 15-17 Under
35 U.S.C. § 102 is proper?**

It is our view, after consideration of the record before us, that the disclosure of Weaver does not fully meet the invention as recited in claims 15-17. Accordingly, we reverse.

With respect to independent claim 15 that is representative of claims 15-17, we find that the Examiner has not addressed the meaning of the limitation in Appellants' claim 15 that requires a "function for comparing." See the discussion at Section I above. It would be improper to rely on speculative assumptions regarding the meaning of claim 15 and then base a rejection under 35 U.S.C. § 102 on these assumptions. **See In re Steele**, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). For this reason alone, we find that the Examiner has not met the initial burden of establishing a **prima facie** case of anticipation with respect to the rejection based on Weaver.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 102.

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Conclusion

In summary we have not sustained the rejection under 35 U.S.C. § 102 of claims 1-19. We have entered a new grounds of rejection against claims 15-17 under 37 CFR § 1.196(b).

As indicated **supra**, this decision contains a new grounds of rejection pursuant to 37 CFR § 1.196(b) (amended effective December 1, 1997, by final rule notice, 62 Fed. Reg 53131, 53197 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (October 21, 1997)). 37 CFR § 1.196(b) provides that, "[a] new grounds of rejection shall not be considered final for the purposes of judicial review."

37 CFR § 1.196(b) also provides that the Appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (§ 1.197 (c)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner . . .

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(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record . . .

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

REVERSED 37 CFR § 1.196(b)

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MAHSHID SAADAT)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
ALLEN R. MACDONALD)	
Administrative Patent Judge)	

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ERICSSON INC.
6300 Legacy Drive
M/S EVR C11
Plano, TX 75024