

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DENNIS C. SMITH, JAMES R. CORLISS and ANGUS O. DOUGHTERY

Appeal No. 2002-1327
Application 09/218,247

ON BRIEF

Before THOMAS, JERRY SMITH and BARRY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-12. Claim 13 was indicated to contain allowable subject matter. An amendment after final rejection was filed on June 18, 2001 and was entered by the examiner. This amendment cancelled claim 13.

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Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the 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 does not support either of the rejections set forth by the examiner. Accordingly, we reverse.

We consider first the rejection of claims 1, 2, 4-8 and 10-12 under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Sato. 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 as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v.

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Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner has indicated how he finds the claimed invention to be fully met by the disclosure of Sato [answer, pages 3-5]. With respect to independent claim 1, appellants argue that Sato does not teach determining a preferred connection based on predetermined data associated with a subscriber nor connecting a wireless handset to a wireline switch based on a preferred connection [brief, pages 4-5]. The examiner responds that the type of service requested by the subscriber corresponds to the claimed data associated with the subscriber. The examiner also disagrees with appellants' second argument [answer, pages 5-7]. Appellants respond that the request for service in Sato cannot correspond to predetermined data associated with the subscriber as claimed. They also respond that there is no preferred connection disclosed in Sato [reply brief, pages 4-6].

We will not sustain the examiner's rejection of independent claim 1 for essentially the reasons argued by appellants in the briefs. The method of claim 1 begins by

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reciting that the identification of a subscriber is received in response to a call attempt. A preferred connection is then determined based on predetermined data associated with the subscriber. We can find no disclosure in Sato which would indicate that the identity of the subscriber is received. We agree with appellants that there is no predetermined data associated with the subscriber in Sato. The examiner's finding that the type of service requested in Sato constitutes predetermined data associated with the subscriber is unreasonable. We also agree with appellants that Sato does not disclose connecting a wireless handset to a wireline switch based on a preferred connection which has been determined from predetermined data associated with the subscriber as claimed.

Since independent claim 7 has recitations similar to the recitations of claim 1 considered above, we also do not sustain the examiner's rejection of independent claim 7. Since we have not sustained the examiner's rejection of either of the independent claims, we do not sustain the examiner's rejection of any of the dependent claims. The rejection of claims 3 and 9 under 35 U.S.C. § 103 also fails because the rejection is based on the same erroneous findings discussed above with respect to claim 1.

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In summary, we have not sustained either of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-12 is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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JERRY SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
LANCE LEONARD BARRY)	
Administrative Patent Judge)	

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Qwest Communications International, Inc.
Law Department Intellectual Property Group
1801 California Street, Suite 3800
Denver, CO 80202