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 PAUL S. MECHE

Appeal No. 2002-2000
Application No. 08/933,911

ON BRIEF

Before THOMAS, FLEMING, and KRASS, Administrative Patent Judges.
THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 1-12.

Representative claim 9 is reproduced below:

9. A method for operating a wireless telecommunications system, comprising the steps of:

providing a telephone number of a called party:

receiving said telephone number in a serving system;

determining if said telephone number is for a mobile station potentially roaming in the serving system, without interrogating another serving system;

if yes, determining if said telephone number is stored in a Visitor Location Register of the serving system; and

if yes, paging the mobile station in the serving system.

The following references are relied on by the examiner:

Reininghaus	5,898,922	Apr. 27, 1999
		(§ 102(e) date Nov. 19, 1996 and PCT Pub. Date Nov. 30, 1995)
Lee (PCT Patent Application)	WO 96/20574	Jul. 4, 1996

Claims 1-12 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Lee in view of Reininghaus.

Rather than repeat the positions of the appellant and the examiner, reference is made to the brief and reply brief for appellant's positions and to the final rejection and answer for the examiner's positions.

OPINION

We reverse the examiner's stated rejection and institute a new rejection under the provisions of 37 CFR § 1.196(b).

There appears to be no dispute between appellant and the examiner with respect to the teachings in Lee. On the other hand, as appellant points out generally in the brief and reply brief, the examiner's position with respect to Reininghaus according to the rejection set forth in the final rejection focuses upon a Mobile

Station (MS) moving from an area of Cell C1 of the local region MA1 into the Cell C2 of the local region MA2 as shown in the left portion of the Figure 1 showing in Reininghaus. We agree with the appellant's basic urging in the brief that this interpretation of the reference in this manner relates to a transition of a call between cells of local regions within the HLR or home register region. Thus, even if Lee and Reininghaus were properly combineable within 35 U.S.C. § 103 according to the examiner's reasoning, the result would essentially read on the prior art and the same "serving system" to the extent recited on the claims on appeal. Since the claims require a caller to be considered to be roaming in a particular serving system, the caller must be served by a different serving system and have a different home register HLR. Since, according to the examiner's reasoning in the final rejection, a common home register HLRA serves both cells C1 and C2, the overall requirements of the claims on appeal cannot be met.

On the other hand, it appears to us that both the appellant and the examiner do not considered the full teaching value of Reininghaus as to the claims on appeal and its combinability with Lee within 35 U.S.C. § 103. Therefore, we institute a new ground of rejection of claims 1, 2, 4, 5 and 7-12 under 35 U.S.C. § 103 as being obvious over Reininghaus in view of Lee. It may be

separately stated as well that the subject matter of claims 9-12 may be considered obvious over the teaching value of Reininghaus alone.

Beginning with representative independent claim 9 on appeal, this claim and claims 10-12 appear to read upon appellants second embodiment disclosed in Figure 4. In the approach in this embodiment, there's no requirement of an identifier as in claims 1-8.

The discussion in the long paragraph in column 1 beginning at line 21 through line 57 of Reininghaus appears to us to have been consistent with the prior art alleged by appellant in the disclosed invention. When a mobile station or user moves from a first mobile radio station region into another mobile station region, it is considered to be a roaming situation and the appropriate home register information of the mobile station is transferred to the new mobile radio region "when setting up a radio contact in the new region" or, as stated otherwise, when a call is made by the user of the mobile station in the new region. On the other hand, the focus of the disclosure in Reinginghaus as set forth substantially in column 2 is that before the user transfers the mobile station to a new region, it is the user who transfers the home register identifying data to the new home register in the new mobile radio

region. Alternatively, the user of the mobile station may wait until actually in the destination mobile region to affect this transfer. This is most aptly discussed at lines 25-56.

This is shown in Figure 1 by the transfer of a mobile station MS from mobile radio system MFA to mobile radio system MFB. By doing so, the user has identified the mobile station in the new radio region as a roaming mobile radio station. The overall system then operates “without interrogating another serving system” as required by claims 9-12 in these words or corresponding words. Stated differently, there is no need for mobile station MS in the new region MFB to have the switching circuitry in that region contact the home register HLRA because the identifying information of the mobile station ms has been made resident in the home register HLRB. Once that transfer from home register has been effected, the use of the visitor location register VLR in the new system MFB functions normally and in accordance with the requirements of these claims.

The fact that the user performs these various control information transfers of information is discussed in detail at various points of the discussion beginning at column 8 though column 10. Note also the particular discussion of control commands in the paragraph bridging columns 9 and 10. The manner in which

these commands may be implemented obviously would have been effected according to the use of the prefix according to Lee. The function of this prefix is to identify a foreign mobile subscriber within a local network, which is the same effective function achieved by the teaching value of Reininghaus. Obviously, within 35 U.S.C. § 103, since the actual coding is not discussed in Reininghaus, the manner in which the functionality of the transfer of the control information from one home register HLRA to a new home register HLRB in different mobile radio regions would have been effected in Reininghaus by the use of the prefixing approach taught in Lee. In this manner, the claimed identifier of claims 1, 2, 4, 5, 7 and 8 would have been obvious in light of the collective teachings and suggestions of both references. The teaching value of both references is considered consistent when it is taught in the paragraph bridging column 8 and 9 that mobile radio regions MFA and MFB in Reininghaus may be countries or continents, which is consistent with the examples of Australian and Germany given in Lee.

The prefixes in Lee are shown in Figures 8, 9, 10A and 10B, with the new prefix identifier shown in Figures 9 of Lee. Thus, the subject matter in dependent claims 2 and 5 would have been

obvious in view of the straight forward teachings of Lee in combination with Reininghaus.

On the other hand, the recitation in dependents claims 3 and 6 requires the entering of the telephone number of the called mobile station followed by the identifier character. There is no teaching or suggestion explicit as to such appending function in Lee and Reininghaus. The examiner’s view expressed at the bottom of page 4 of the final rejection that the examiner considers the order of entry to be obvious because it is not critical to the invention and that it would have been obvious in order to provide the user convenience of entering the numbers, is not, in our view, based on substantial evidence before us. The examiner, however, is free to provide additional evidence of obviousness by the use of pertinent teachings or suggestions from additional prior art to meet the features of these dependent claims.

Lastly, we turn to the futures of independent claims 7 and its dependent claim 8. Claim 7 requires, in addition to the use of the paging function when the mobile station is correctly identifiable within the new serving system, when it is not correctly identifiable within the new serving system, performing completing the call using conventional calling completion techniques or sending a message to the mobile station indicating the telephone

number is not one that is associated with the valid roaming mobile station as set forth at the end of claim 7. At least with respect to the first option, the teaching at column 8, lines 50-52 and the discussion in the paragraph bridging columns 8 and 9 of Reininghaus indicate that it was known in the art to complete a call using conventional call completion techniques in addition to the prior art teaching already discussed earlier with respect to column 1 of Reininghaus. As to dependent claim 8, it clearly would have been obvious to the artisan and is well know in the telephonic art that if a particular called telephone number is determined not to be within a given call region, the call itself is or may be terminated.

In summary, we have reversed the examiner's stated rejection of claims 1-12 under 35 U.S.C. § 103. On the other hand, we have instituted a new rejection of claims 1, 2, 4, 5 and 7-12 under 37 U.S.C. § 103 as being obvious over the teachings of Reininghaus in view of Lee and, as to claims 9-12, separate reliance upon Reininghaus alone.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "[a] new ground of rejection shall not be considered final for 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 ground 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....
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeal 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;(196b)

JAMES D. THOMAS Administrative Patent Judge	)	
MICHAEL R. FLEMING Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ERROL A. KRASS Administrative Patent Judge	)	

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