

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte YUEN-YIN L. KOO, ESHWAR PITTAMPALLI  
and DAVID ALBERT ROSSETTI

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Appeal No. 2004-1613  
Application No. 09/686,024<sup>1</sup>

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ON BRIEF

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Before HAIRSTON, LEVY, and SAADAT, Administrative Patent Judges.  
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1, 3, 7, 9 and 10, which are all of the claims pending in this application.

We reverse.

BACKGROUND

Appellants' invention is directed to mobile communications and to addressing the possibility of incompatibility between wireless base stations and mobile stations.

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<sup>1</sup> Application for patent filed October 11, 2000.



OPINION

Appellants argue that Müller merely discloses a system in which the base station instructs the mobile stations when or under what conditions they may transmit (brief, page 8). Additionally, Appellants assert that what the Examiner characterizes as the step of "identifying" in Criss is, in fact, a determining process that the mobile station is using old software and then, sends a newer version to the mobile station (brief, pages 8 & 9). Additionally, Appellants point out that the claims actually require that the base station, instead of knowing the software status of the mobile station, transmit a message that identifies the mobile stations that should use the constrained protocol (brief, page 9).

In response, the Examiner asserts that the timing restriction disclosed by Müller (col. 4, lines 11-19) is actually the same as the claimed constrained protocol imposed on the mobile station (answer, page 6). The Examiner further equates the software upgrades of Criss to the claimed requirement of identifying mobile stations restricted to using a constrained protocol (answer, page 7).

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of

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obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under § 103, the examiner must produce a factual basis supported by teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Such evidence is required in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The Examiner must not only identify the elements in the prior art, but also show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Upon a review of Müller, we remain unpersuaded by the Examiner's characterization of the disclosed access restriction as the claimed restriction of using a constrained protocol. Müller, in fact, provides a period of access interval to each group of the mobile stations such that only that group can access the base station (col. 4, lines 2-19). On the other hand, what the Examiner characterizes in Criss as the claimed restriction to using a constrained protocol is merely a determination by the host of what software upgrade the mobile stations need (paragraph

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0050). Criss merely discloses that a request is sent from the host to the mobile terminal in order to update its (paragraph 0051) which neither allows any mobile terminal with anything less than the most recent protocol revision, nor provides any communication services to the mobile terminals subject to a constrained protocol.

Based on our findings above, we agree with Appellants that by merely sending software upgrades or assigning mobile stations to rotating access-restricted groups, the combination of the applied prior art does not teach or suggest the claimed constrained protocol and communicating messages subject to such constrained protocol, as recited in independent claims 1 and 7. Accordingly, as the Examiner has failed to establish a prima facie case of obviousness, we do not sustain the rejection of claims 1, 3, 7, 9 and 10 under 35 U.S.C. § 103 over Müller and Criss.

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CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1, 3, 7, 9 and 10 under 35 U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
STUART S. LEVY	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
MAHSHID D. SAADAT	)	
Administrative Patent Judge	)	

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