

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DONALD C. D. CHANG, ALAN G. CHA and YING FERIA

Appeal No. 2006-0246
Application No. 09/652,862

ON BRIEF

Before RUGGIERO, BARRY, and NAPPI, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the Examiner's rejection of claims 1-22. Claim 23 has been allowed.

The claimed invention relates to a method and apparatus for the rapid acquisition of a particular subscriber in which a coverage area is defined as an arrangement of a plurality of cells wherein one of the cells includes the particular subscriber. More particularly, a partition of cell clusters is defined in which one of the cell clusters includes the particular subscriber. A beam is formed which corresponds to an area of one of the cell clusters, the

beam sequentially scanning each of the cell clusters until the particular subscriber is identified.

Claim 1 is illustrative of the invention and reads as follows:

1. A method for rapid acquisition of a specific subscriber comprising the following steps:

(a) defining a coverage area as an arrangement of a plurality of cells wherein one of the plurality of cells includes the specific subscriber;

(b) defining a partition of cell clusters wherein one of the cell clusters includes the one of the plurality of cells that includes the specific subscriber;

(c) forming a beam that corresponds to an area of one of the cell clusters; and

(d) sequentially scanning the beam to each of the cell clusters until the one of the cell clusters that includes the specific subscriber is identified.

The Examiner relies on the following prior art:

Wissinger	5,475,520	Dec. 12, 1995
Diekelman et al. (Diekelman)	5,555,444	Sep. 10, 1996
Martinez et al. (Martinez)	5,584,046	Dec. 10, 1996
Lo et al. (Lo)	6,240,072	May 29, 2001 (filed Apr. 06, 1998)
Chang et al. (Chang)	6,388,615	May 14, 2002 (filed Jun. 06, 2000)

Claims 1-22, all of the appealed claims, stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner offers the combination of Chang, Wissinger, and Martinez with respect to claims 1, 3-8, 10-12, and 14-19, and adds Diekelman to the

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basic combination with respect to claims 2, 13, and 20-22. In further rejections under 35 U.S.C. § 103(a), Claims 8, 10 and 11 also stand rejected as being unpatentable over the combination of Chang, Wissinger, Martinez and Lo, while claim 9 stands finally rejected over the combination of Chang, Wissinger, Martinez, Lo, and Diekelman.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs, the Office action mailed April 21, 2004, and Answer (Supplemental) for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, 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 and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 1-22. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner

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is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note: In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of appealed independent claims 1, 8, 12, 15, 19, and 20, Appellants assert that the Examiner has failed to set forth a prima facie case of obviousness since proper motivation for the proposed combination of references has not been established. After reviewing the arguments of record from Appellants and the Examiner, we are in general agreement with Appellants' position as stated in the Briefs.

The Examiner proposes (Office action mailed April 21, 2004, page 3) to modify the system of Chang as modified by Wissinger by adding the sequential scanning feature disclosed by Martinez. In our view, however, the system described by Martinez has little relevance to those described by Chang and Wissinger and, at best, provides only a disclosure that sequential scanning may be known in the art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F. 2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

Our review of the disclosure of Martinez reveals that, while a sequential scanning procedure may be involved in the operation of the system of Martinez, the disclosure of Martinez is directed to the synchronization of satellite space based and terrestrial ground based communication systems to prevent interference between the two services. The problem addressed by Martinez, i.e., interference between land and space based systems, however, does not appear to exist in either of the systems of Chang or Wissinger.

Further, while it is well settled that features of prior art references may be combined for a different reason than that of a claimed invention, the Examiner has the burden of showing that the stated rationale for a proposed combination has some basis in fact. In the present factual situation, no evidence is forthcoming from the Examiner that would indicate how the stated motivation rationale, i.e., the sharing of an electromagnetic spectrum by terrestrial and satellite communication systems would result from the

modification of the combination of Chang and Wissinger with the teachings of Martinez. The Examiner must not only make requisite findings, based on the evidence of record, but must also explain the reasoning by which the findings are deemed to support the asserted conclusion. See In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002). In our view, given the disparity of problems addressed by the applied prior art references, and the differing solutions proposed by them, any attempt to combine them in the manner proposed by the Examiner could only come from Appellants' own disclosure and not from any teaching or suggestion in the references themselves.

We have also reviewed the Diekelman and Lo references cited by the Examiner to address the traffic model and ground station beamformer features of several of the dependent claims. We find nothing, however, in either of the Diekelman or Lo references which would overcome the innate deficiencies of the Chang, Wissinger, and Martinez references as discussed supra.

In view of the above discussion, since we are of the opinion that the prior art applied by the Examiner does not support the obviousness rejection, we do not sustain the rejection of independent claims 1, 8, 12, 15, 19, and 20, nor of claims 2-7, 9-11, 13, 14, 16-18, 21, and 22 dependent thereon. Therefore, the decision of the Examiner rejecting claims 1-22 under 35 U.S.C. § 103(a) is reversed.

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DECISION ON APPEAL

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

REVERSED

JOSEPH F. RUGGIERO
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

ROBERT NAPPI
Administrative Patent Judge

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