

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 A. DORSEY,
SHARADA RAGHURAM, AND CHARLES P. BINZEL

Appeal No. 2006-1882
Application No. 10/431,617

ON BRIEF

Before JERRY SMITH, 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 1-20.

Invention

Appellants' invention relates to a method to allow a mobile unit to search for the home Public Land Mobile Network (PLMN) and higher priority PLMNs in only those radio access technologies and frequencies of higher priority networks that have not already been discounted (i.e. determined to be not of the Home PLMN (HPLMN) or higher priority PLMNs) during previous scans performed in the same geographic area.

Appeal No. 2006-1882
Application No. 10/431,617

This saves time and battery power in the mobile unit. Additionally, the present invention can be implemented in a communication system with a relatively simple software modification and no additional hardware, therefore limiting any cost penalty.

Appellants' specification at page 3, lines 10-17.

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

1. A method for a radiotelephone to search for higher priority public land mobile networks, each network having a plurality of cells for providing radiotelephone service to a radiotelephone within a corresponding geographic area, each cell having a radio communication coverage area established by fixed site base stations, and each base station operable to send messages to radiotelephones, the method comprising the steps of:

camping the radiotelephone on a cell of a visited public land mobile network;

uniquely identifying the cell;

searching for public land mobile networks with a higher priority than the visited public land mobile network; and

storing a history of those frequencies found during the scanning step that are not of a higher priority public land mobile network, the history being associated with the uniquely identified cell.

References

The references relied on by the Examiner are as follows:

Raffel

6,223,042

April 24, 2001

Appeal No. 2006-1882
Application No. 10/431,617

Rejections At Issue

Claims 1-20 stand rejected under 35 U.S.C. § 102 as being anticipated by Raffel.

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 affirm the Examiner's rejection of claims 1-20 under 35 U.S.C. § 102.

For purposes of this appeal, Appellants have argued the claims together in three groupings:

Claims 1-8 as Group I;

Claims 9-15, as Group II; and

Claims 16-20 as Group III.

We will, thereby, consider Appellants' claims as standing or falling together in the three groups noted above, and we will treat:

¹ Appellants filed an appeal brief on September 28, 2005. Appellants filed a reply brief on February 16, 2006. The Examiner mailed an Examiner's Answer on December 27, 2005.

Appeal No. 2006-1882
Application No. 10/431,617

Claim 1 as a representative claim of Group I;

Claim 9 as a representative claim of Group II; and

Claim 16 as a representative claim of Group III.

I. Whether the Rejection of Claims 1-8 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Raffel does fully meet the invention as recited in claims 1-8. Accordingly, we affirm.

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, Appellants argue at page 5 of the brief and page 3 of the reply, claim 1 is patentable because the IDLE of Raffel is comparable to the step of camping in claim 1. Thus, Raffel's step 33 of Fig. 9 (corresponding to the claimed searching step) does not have camping as a prerequisite as required by claim 1. We disagree. Appellants provide no evidence and point to nothing in the record to support their position that camping must be read as the IDLE function of Raffel. To the contrary, we find at pages 4-5 of Appellants' specification that "camping" appears to be a broad term meaning that the mobile station is locked onto a visited public land mobile network. Such locking is shown at step 34 of Fig. 9 of Raffel.

Appellants also argue at page 7 of the brief that claim 1 is patentable because “[s]toring a SOC or SID code is not equivalent to ‘storing a history of [frequencies]’” because “[a] SOC or SID code is simply not a frequency or frequency band.” We disagree. Column 11, lines 29-35, of Raffel explicitly disclose, “the SOC or SID is stored in memory ... with the spectral location of the SOCs or SIDs control channel.” We read “spectral location” as “frequency” as required by claim 1. We read column 10, lines 48-51, as also teaching this storage operation.

Therefore, we will sustain the Examiner’s rejection under 35 U.S.C. § 102.

II. Whether the Rejection of Claims 9-15 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Raffel does fully meet the invention as recited in claims 9-15. Accordingly, we affirm.

With respect to dependent claim 9, Appellants argue at page 8 of the brief, claim 9 is patentable because Raffel fails to disclose, “skipping a scan of frequencies listed in the history ...as recited in claim 9.” We disagree. Column 10, lines 56-62, of Raffel explicitly disclose, “bands searched in the search routine ... are removed from the search schedule.”

Therefore, we will sustain the Examiner’s rejection under 35 U.S.C. § 102.

III. Whether the Rejection of Claims 16-20 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Raffel does fully meet the invention as recited in claims 16-20. Accordingly, we affirm.

Appellants fail to separately argue claims 16-20. Rather, at page 8 of the brief, Appellants merely state features of claim 16 and allege, without explaining why, that the additional features render the claim separately patentable. The rules in effect at the time the brief was filed specifically address the weight to be given the statements and allegations presented by Appellants. See 37 CFR § 41.37 (c) (1) (vii) (2005):

A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

Appellants have not discussed why the evidence would support a holding that claims 16-20 are patentable apart from claim 1. Therefore, we will sustain the Examiner's rejection of claims 16-20 under 35 U.S.C. § 102 as standing or falling with the patentability of claim 1.

Conclusion

In view of the foregoing discussion, we have sustained the rejection under 35 U.S.C. § 102 of claims 1-20.

Appeal No. 2006-1882
Application No. 10/431,617

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

AFFIRMED

JERRY SMITH)	
Administrative Patent Judge)	
)	
)	
)	
)	
)	BOARD OF PATENT
MAHSHID D. SAADAT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
ALLEN R. MACDONALD)	
Administrative Patent Judge)	

ARM/kis

Appeal No. 2006-1882
Application No. 10/431,617

MOTOROLA, INC.
600 NORTH US HIGHWAY 45
LAW DEPARTMENT
LIBERTVILLE, IL 60048