

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JERRY WALTER MALCOM

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Appeal 2007-1630  
Application 10/422,661  
Technology Center 2600

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Decided: February 6, 2008

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Before JOSEPH L. DIXON, ANITA PELLMAN GROSS, and  
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant has filed a Request for Rehearing under 37 C.F.R.  
§ 41.52(a)(1)(2006) for reconsideration of our Decision of October 24, 2007.  
The Decision affirmed the Examiner's rejections of claims 1-18, as follows:

1. We affirmed the Examiner's rejection of claims 1-3, 7-9, and 13-15 as being anticipated by Pombo.
2. We affirmed the Examiner's rejection of claims 4, 5, 10, 11, 16, and 17 as being unpatentable over the teachings of Pombo in view of Croft.
3. We affirmed the Examiner's rejection of claims 6, 12, and 18 as being unpatentable over the teachings of Pombo in view of Ariga.

We have reconsidered our Decision of October 24, 2007, in light of Appellant's comments in the Request for Rehearing, and Appellant has not convinced us that we misapprehended or overlooked any points in rendering our Decision. We decline to change our prior Decision for the reasons discussed *infra*.

A. Appellant presents the following argument:

Applicant requests the Board to consider that Pombo's "sleep mode" is not merely slowing the rate of search for a control signal, but that Pombo's "sleep mode" includes decoupling the receiver and the transmitter from the battery (col. 11 lines 24 - 25), which is described as a "very low power mode" (col. 6 line 9) during which the mobile device is largely powered down but not turned off (col. 6 lines 14 - 15). However, as agreed by the Board in the Decision, Pombo does not enter such a "very low power mode" as a result of a signal loss, but only slows the searching process, which saves some amount of power, as agreed by Appellant.

Appellant respectfully submits, though, that Pombo's non-sleep-mode "no control activity" mode is not read upon by Appellant's claims because Appellant has not only claimed saving of power, but has claimed a "nap mode". The scope of this term is first set forth in paragraph 0038:

" . . . a special sleep mode referred to as a 'nap'."

Appellant has used the term "sleep mode" in the conventional sense (paras. 0018) in which nonessential portions of the handset are powered down (para. 0018). For example, ordinarily skilled persons would read and interpret the term "nap mode" according to the specification as being a type of "sleep mode", and thus would use a definition such as:

Dictionary: **sleep mode** An energy-saving mode of operation in which all unnecessary components are shut down . . . When a notebook computer goes into sleep mode, it shuts down the display screen and disk drive . . .

(Request 2).

In response, we find no reference to any portion of the Briefs where Appellant has previously presented the argument that the claimed "nap mode" (claim 1), when interpreted as "a special sleep mode," as disclosed in Appellant's Specification at paragraph [0038], does not read on Pombo's non-sleep-mode "no control activity" mode (*see Request 2*). Thus, after examining the arguments previously presented in the Briefs, we conclude that Appellant has presented a new argument in the Request for Rehearing. Because such a new argument is not made regarding a "recent relevant decision of the Board or a Federal Court" or in response to a new ground of rejection under 37 C.F.R. § 41.50(b), Appellant's newly advanced argument has not been considered. *See* 37 C.F.R. § 41.52.<sup>1</sup> Pursuant to

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<sup>1</sup> *See* 37 C.F.R. § 41.52(a)(1): "Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply

37 C.F.R. § 41.52(a)(1), we decline to consider Appellant's newly presented dictionary definition for "sleep mode" as extrinsic evidence. Moreover, because our Decision did not raise a new ground of rejection under § 41.50(b), we deny Appellant's request to remand the application to the Examiner for further consideration (*see* Request 3).

B. Appellant presents the following argument:

Appellant respectfully submits that in order to anticipate the claims under 35 U.S.C. §102, Pombo must teach entering a *sleep mode* by powering down portions of the mobile device upon loss of control signal detection in order to anticipate Appellant's claim of entering a "nap mode", and that merely and only meeting the claim limitation of saving some degree of power through slowed signal searching fails to teach all claim limitations.

(Request 3).

We disagree. We note that representative claim 1 is silent regarding the "sleep mode" argued by Appellant (*see* Request 3). Nor does representative claim 1 recite "powering down portions of the mobile device upon loss of control signal detection," as also argued by Appellant (*id.*). Contrary to Appellant's arguments, the language of claim 1 broadly recites

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brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section."

“entering a nap mode . . . during said nap mode *a state of lower power consumption being achieved . . .*” (claim 1, emphasis added).<sup>2</sup>

As stated in our Decision, Appellant has acknowledged in the Brief that Pombo’s “no control activity” process will result in a state of *lower power consumption* and will defeat searching for the calculated time interval, as follows:

There is no mention of entering “sleep mode” during this period, only of delaying the next search until the next search time, *which would save some battery power*, but not as much as going into “sleep mode.”

(App. Br. 5, para. 1, emphasis added).

We note again that *a particular degree or amount of battery power saving is not claimed*. Thus, we conclude that Appellant’s arguments are not commensurate in scope with what is claimed. *See In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) (“Many of appellant’s arguments fail from the outset because, . . . they are not based on limitations appearing in the claims . . .”). Moreover, limitations appearing in the specification but not recited in the claim are not read into the claim. *See E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily).

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<sup>2</sup> We respond here only regarding the express limitations of claim 1 since we selected independent claim 1 as the representative claim in our Decision.

C. Appellant presents the following argument:

With respect to the fourth point of argument presented by the Appellant regarding the length of time of the nap mode, Appellant requests rehearing because it is believed that the argument and the Pombo disclosure were misapprehended. The Board noted that determination of a "length of time" to sleep were not actually claimed in the broadest claim. Appellant concurs that a broader term — a "condition for termination" of the sleep mode — was claimed, encompasses the condition of a "length of time" (see Claim 4 for other termination conditions, as well). The discussion regarding "length of time" was intended to illustrate the Appellant's argument regarding a transient control signal scenario where length of time was the selected termination condition according to the Appellant's invention, but in which Pombo's system bounces between non-sleeping modes without going to sleep (Appeal Brief, pg. 5, last full paragraph)

(Request 3-4).

In response, we again conclude that Appellant is reading limitations from the Specification into the claims. We note that patentability is based upon the language of the claims. “It is the *claims* that measure the invention.” *SRI Int’l v. Matsushita Elec. Corp. of America*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc). Moreover, the “other termination conditions” purportedly recited in claim 4 were not argued in the Briefs and will not be considered here.<sup>3</sup> See 37 C.F.R. § 41.52(a)(1).

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(See Decision 4).

<sup>3</sup> See dependent claim 4: “The method as set forth in Claim 1 further comprising the step of providing a user interface for manipulating said event records.”

Here, we reaffirm our agreement with the Examiner's position, and we note that representative claim 1 does not require determination of a length of time of finding or losing a signal (i.e., "a transient control signal scenario"), as argued by Appellant (*see* Request 4-5). Instead, representative claim 1 broadly recites: "determining that a period of signal intermittence *has started* by detecting *threshold conditions* for a transient network signal being *intermittently found* and *intermittently lost*;" (claim 1, emphasis added). Thus, we find this portion of claim 1 broadly but reasonably reads on Pombo's detection of each control channel signal from a particular base station, since each control channel signal is intermittent, and Pombo records the time it was initially detected in the control activity table (*see* Pombo, col. 5, ll. 34-38; col. 6, ll. 31-35). Moreover, we reaffirm our finding that representative claim 1 broadly but reasonably reads on the Pombo reference, as described in detail on page 9 of our Decision of October 24, 2007.

## CONCLUSION

We have considered the arguments raised by Appellant in the Request for Rehearing, but Appellant has not convinced us that we misapprehended or overlooked any points in rendering our Decision. Because our Decision of October 24, 2007 did not raise a new ground of rejection under § 41.50(b), we deny Appellant's request to remand the application to the Examiner for further consideration (*see* Request 3).

## DECISION

We have granted Appellant's request to the extent that we have reconsidered our Decision of October 24, 2007, but we deny the request with respect to making any changes therein.

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)(2006). *See also* 37 C.F.R. § 41.52(b).

## DENIED

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