

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PEKKA MARJELUND, JUHA TURUNEN,
KAISU IISAKKILA, and OSCAR SALONAHO

Appeal 2007-4436
Application 10/181,078
Technology Center 2600

Decided: April 24, 2008

Before ROBERT E. NAPPI, JOHN A. JEFFERY, and
KEVIN F. TURNER, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1-3, 5-14, 18-21, 24-30 and 32-37. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

STATEMENT OF CASE

Appellants disclose methods for cell reselection in a cellular telecommunication system. (Spec. 1: 5-6). The disclosed cell reselection method requires a small amount of signaling and allows the network to have

control over the actions of the mobile stations in a connection rejection situation. (Spec. 3: 14-17).

Claims 1-3, 5-30 and 32-37 are pending in the application. Claims 15-17, 22 and 23 were indicated as containing allowable subject matter (Ans. 8), and claims 1-3, 5-14, 18-21, 24-30 and 32-37 were rejected over prior art.

Independent claim 1 is illustrative:

1. A method for channel reselection signaling in a cellular telecommunications network, the method comprising the steps of:

generating a connection rejection message; and

sending the connection rejection message from the cellular telecommunications network to a mobile station;

wherein the connection rejection message includes information relating to a value of at least one frequency parameter relating to connection setup for use in a new connection setup attempt.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Jamal	US 5,956,368	Sep. 21, 1999
Raleigh	US 6,101,399	Aug. 8, 2000

Sophia Antipolis, TSGR2#6(99)813, *Specification of RRC procedure: RRC connection establishment*, TSG-RAN Working Group 2 (Radio layer 2 and Radio layer 3), August 16th to 20th, 1999 (hereinafter "Ericsson").

The Examiner rejected, under 35 U.S.C. § 103(a):
claims 1-7, 9, 11-14, 18, 19, 21, 25-34 and 36 as unpatentable over Ericsson and Raleigh,

claims 8, 20, and 35 as unpatentable over Ericsson and Jamal, and claims 10, 24, and 37 as unpatentable over Ericsson.¹

Regarding the independent claims, Appellants argue that Ericsson and Raleigh fail to teach or suggest that the connection rejection message includes information relating to a value of at least one frequency parameter relating to connection setup for use in a new connection setup attempt. (App. Br. 4-8; Reply Br. 2-7). The Examiner finds that Ericsson teaches most of the subject matter of the independent claims, that Raleigh supplies a rationale for supplying a frequency parameter, and that the independent claims lack definitions sufficient to support Appellants' arguments and overcome the rejection. (Ans. 8-12). Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

Have Appellants shown that the Examiner erred in finding that Ericsson and Raleigh teach or suggest that the connection rejection message includes information relating to a value of at least one frequency parameter relating to connection setup for use in a new connection setup attempt, as recited in independent claims 1, 11 and 26?

¹ We note that this rejection is made over Ericsson alone, although claims 10, 24 and 37 depend from independent claims 1, 11 and 26, which were rejected over the combination of Ericsson and Raleigh. Thus, the rejection of claims 10, 24 and 37 was technically in error. However, since this error was not raised by Appellants and does not alter the holding of our opinion, we consider this error to be harmless.

FINDINGS OF FACT

1. The application details methods and systems for channel reselection signaling in a cellular telecommunications network. After a connection attempt is made, a connection rejection message is sent from the network to the mobile station. The connection rejection message includes information relating to at least one frequency parameter, where that parameter is used in a new connection setup attempt. (Spec. 3:21 – 4:7).

2. Ericsson discloses a specification for establishing a Radio Resource Control (RRC) connection. When an RRC connection is rejected, the rejection message can include a wait time, where a new RRC connection request is not sent until after the wait time has elapsed. No frequency parameter is sent as a part of the RRC connection reject message. (§§ 2.1.6 – 2.1.8; Fig. 2).

4. Raleigh discloses a method for forming an adaptive phased array transmission beam pattern at a base station without any knowledge of array geometry or mobile feedback. The method enhances remote user received signal quality by utilizing the uplink signal energy received from the remote users. A transmit weight vector solution is evaluated on the basis of network agreement criteria, where, if the criteria are not satisfied, a new frequency can be selected for at least one of the users. After the new frequency is selected, the criteria are reevaluated, where the call may be dropped if the criteria are not satisfied. (Abstract; col. 3, ll. 11-14; col. 16, l. 61 – col. 17, l. 13).

4. Raleigh is directed to situations where at least two mobile users are experiencing simultaneous co-channel interference when they are operating

on the same channel. Raleigh does not disclose any type of connection reject messages. (Col. 1, ll. 29-46).

5. Jamal discloses processes for handling downlink channels within a spread spectrum communications system. It is pointed out that it is known in the prior art for base stations to send scrambling codes through broadcast control channel information. (Abstract; col. 2, ll. 23-50).

PRINCIPLES OF LAW

The Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). If that burden is met, then the burden shifts to the Appellants to overcome the prima facie case with argument and/or evidence. *In re Mayne*, 104 F.3d 1339, 1342 (Fed. Cir. 1997). “Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007).

“A prior patent must be considered in its entirety, i.e., as a whole, including portions that would lead away from the invention in suit.” *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1575 (Fed.Cir.1987). A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

ANALYSIS

Appellants argue that Raleigh teaches away from a combination with Ericsson because Raleigh is directed to methods applicable to mobile users that already have an established connection and would not have motivated one of ordinary skill in the art to have modified the methods disclosed in Ericsson. (App. Br. 4-7). The Examiner responds that Ericsson teaches almost all of the elements of the independent claims, that the transmission of frequency parameters is known and that Raleigh teaches the sending of a frequency parameter between a mobile unit and network. (Ans. 11).

However, the transmission of the frequency parameters in Raleigh occurs in response to potential interference, and not with the rejection of a connection. (FF 4). As discussed above, the process in Raleigh may result in a connection being dropped, (FF 3), but there is nothing in Raleigh that would suggest that any connection rejection message would provide a frequency parameter. In fact, it would appear that after attempting and failing to secure a new common frequency, as described in Raleigh, there would be no reason to provide any additional frequency parameters in a connection rejection message.

The Examiner also appears to argue that we should view the teachings of Raleigh as simply the sending of frequency parameters in a telecommunications environment, and that any further teachings of Raleigh amount to “delv[ing] down into the extreme specific details of Rayleigh [sic] and Ericsson to show differences.” (Ans. 8) We are constrained, however, in evaluating the propriety of a combination of references under 35 U.S.C.

§ 103, to consider the teachings of each of the references in their entirety, including portions that might teach away from the combination. In the instant case, we do not find Raleigh as teaching the transfer of frequency parameters in all contexts, merely the context of co-interference of units with an established connection. Taking Raleigh and Ericsson together, we cannot say that one of ordinary skill in the art would have incorporated frequency parameters into a connection rejection message to be used in a new connection setup attempt, as recited in independent claims 1, 11 and 26, based on the disclosures of Raleigh and Ericsson.

Additionally, the Examiner has indicated that Appellants' claims are broad, lack specific conditions and the Examiner "can interpret the claim in virtually any way he desires." (Ans. 8-9). While the claims may appear broad to the Examiner, the limitations must nevertheless be given their broadest *reasonable* interpretation consistent with the Specification as it would be interpreted by skilled artisans. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (citations omitted) (emphasis added).

Both the instant Specification and Ericsson refer to the claim term "connection rejection message" such that its meaning can be reasonably determined. Also, while the Examiner appears to find that Appellants are arguing that the combination of Ericsson and Raleigh fail to teach all of the elements of the independent claims, (Ans. 11), we find, as discussed above, that Appellants are arguing that the combination is improper to teach or suggest what is recited in the independent claims. We agree with Appellants.

Additionally, Jamal simply does not teach incorporating at least one frequency parameter into a connection rejection message. (FF. 5). Similarly, we do not find the disclosure of Ericsson alone or in combination with the other cited references sufficient to render any of the claims obvious to ordinarily skilled artisans. (FF. 2). Thus, we find the rejections of dependent claims 2-3, 5-10, 12-14, 18-21, 24, 25, 27-30 and 32-37 to have similarly been made in error.

CONCLUSION OF LAW

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1-3, 5-14, 18-21, 24-30 and 32-37, and we reverse the Examiner's rejections of those claims under 35 U.S.C. § 103(a).

DECISION

The decision of the Examiner is reversed.

REVERSED

KIS

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