

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DAVID E. JACKSON

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Appeal 2008-0137  
Application 10/313,858  
Technology Center 2600

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Decided: June 4, 2008

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Before JOSEPH F. RUGGIERO, ANITA PELLMAN GROSS, and  
SCOTT R. BOALICK, *Administrative Patent Judges*.

GROSS, *Administrative Patent Judge*.

DECISION ON APPEAL  
STATEMENT OF THE CASE

Jackson (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's Final Rejection of claims 1 through 14, which are all of the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

Appellant's invention relates to a method of evaluating a particular message for two-way communication to determine which means of communication would be best for that particular message. *See generally*

Spec. paragraphs [7] and [8]. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A control system for a mobile communication system including:

a control operable to receive messages for transmission through any one of several types of communication systems, said control being provided with weighting factors to evaluate the particular message and particular available communication systems, and to select an optimum communication system based upon several weighting factors, said control including a prioritization of each of the several types of communication systems for each of several types of messages, and said prioritization being utilized to select an optimum type of communication system, and at least a second most favored type of communication system, and said control utilizing said optimum type if said optimum type is available, and switching to said second most favored type if said optimum type of communication system is not available.

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Spaur	US 6,122,514	Sep. 19, 2000
Sant	US 6,169,896 B1	Jan. 02, 2001
Tennison	US 6,522,884 B2	Feb. 18, 2003 (filed Feb. 21, 2001)

Claims 11, 12, and 14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1 through 4, 6 through 11, 13, and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Spaur in view of Tennison.

Claims 5 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Spaur in view of Tennison and Sant.

We refer to the Examiner's Answer (mailed May 16, 2006) and to Appellant's Brief (filed February 17, 2006 and June 25, 2007) and Reply Brief (filed October 18, 2006) for the respective arguments.

#### SUMMARY OF DECISION

As a consequence of our review, we will affirm both the indefiniteness rejection of claims 11, 12, and 14 and also the obviousness rejections of claims 1 through 14.

#### OPINION

As indicated by the Examiner (Ans. 8), although Appellant amended line 6 of claim 11 to change "control" to "computer," since "said control lacks antecedent basis, claim 11 still lacks antecedent basis for "said control" at lines 7 and 10. Therefore, we will sustain the indefiniteness rejection of claim 11 and its dependents, claims 12 and 14.

With regard to the art rejection of claims 1 through 4, 6 through 11, 13, and 14 over Spaur and Tennison, the Examiner asserts (Ans. 5) that Spaur discloses all claim limitations except switching to a second best type of communication system if the optimum type is not available. The Examiner further asserts (Ans. 5-6) that Tennison teaches switching to a second best communication system when the best one is unavailable. Appellant contends (App. Br. 4) that Tennison determines which systems are available first and then selects the optimum one from the remaining systems. Appellant contends (App. Br. 5) that neither reference teaches the claim limitation of switching to the second most preferred system if the optimum system is unavailable, and, therefore, the combination fails to teach this

limitation. Appellant also contends (App. Br. 5) that there is no motivation to combine the two references. The issues before us are whether the two references are properly combinable and whether the switching to a second most preferred communication system would have been obvious in view of the combined teachings of Spaur and Tennison.

Spaur (col. 9, ll. 62-63) discloses a database containing operating parameters of various network channels. Spaur further discloses (col. 11, ll. 45-48 and l. 64-col. 12, l. 3) that suitability values are determined for each network channel, the values are compared with each other, and the optimum channel is selected. Thus, Spaur teaches prioritizing several network channels and selecting the optimum channel.

Tennison discloses (col. 3, l. 64-col. 4, l. 3) that the best network is selected "from amongst the available wired and/or wireless data networks." Tennison determines which networks are available and then, of the remaining networks, determines which network is best for transmitting the message. Tennison does not teach "switching" to a second most favored type if the optimum type is unavailable. However, the effect of Tennison's method is to use a second most favored type if the most favored type is unavailable.

Since Spaur discloses evaluating all of the systems and prioritizing them first, it would have been obvious in view of the effect of Tennison's method to use the second most preferred network channel of Spaur if the optimum network channel is found to be unavailable. The Supreme Court has held that in analyzing the obviousness of combining elements, a court need not find specific teachings, but rather may consider "the background knowledge possessed by a person having ordinary skill in the art" and "the

inferences and creative steps that a person of ordinary skill in the art would employ." *See KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-41 (2007). As Spaur and Tennison are directed to similar systems, the skilled artisan would have inferred from Tennison the step of using a second most preferred communication system if the optimum one were unavailable in Spaur. Accordingly, the two references are properly combinable, and the switching to a second most preferred communication system would have been obvious in view of the combined teachings of Spaur and Tennison. Therefore, we will sustain the obviousness rejection of claims 1 through 4, 6 through 11, 13, and 14 over Spaur and Tennison.

As to claims 5 and 12, the Examiner adds Sant to the combination of Spaur and Tennison. Since Appellant provides no arguments regarding Sant, the rejection of claims 5 and 12 is affirmed for the same reasons discussed above with respect to claims 1 through 4, 6 through 11, 13, and 14.

#### ORDER

The decision of the Examiner rejecting claims 11, 12, and 14 under 35 U.S.C. § 112, second paragraph, and claims 1 through 14 under 35 U.S.C. § 103 is affirmed.

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

AFFIRMED

gvw

SIEMENS CORPORATION  
INTELLECTUAL PROPERTY DEPARTMENT  
170 WOOD AVENUE SOUTH  
attn: VDO - CGO docketing migration  
ISELIN, NJ 08830