

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JUAN NOGUERA-RODRIGUEZ and GORAN RUNE

Appeal No. 2002-2292
Application No. 09/139,749

HEARD: APRIL 15, 2003

Before KRASS, RUGGIERO and SAADAT, Administrative Patent Judges.
KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-7.

The invention pertains to the combining of radio signals in accordance with a technique known as diversity combining. In particular, the invention is directed to the reconfiguration of diversity legs and the establishment of transport level connections, which support the diversity legs, during a change in

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Claims 1-4 stand rejected under 35 U.S.C. 102(e) as anticipated by Muszynski.

Claims 5-7 stand rejected under 35 U.S.C. 103 as unpatentable over Muszynski in view of common knowledge.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

An anticipatory reference is one which describes all of the elements of the claimed invention so as to have placed a person of ordinary skill in the art in possession thereof. In re Spada, 911 F.2d 205, 15 USPQ2d 1655 (Fed. Cir. 1990).

It is the examiner's position, as set forth in the chart at page 4 of the answer, that Muszynski discloses elements corresponding to the steps of instant claim 1 as follows:

Column 5, lines 10-15, discusses diversity legs in a radio network; column 9, lines 25-30, discusses sending address and binding information from a first controller 14 to a second controller 12; column 10, lines 15+, discusses how the first controller releases resources that were used to support a diversity leg; column 9, lines 32-45, discusses how the second

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controller 12 sends handoff request (which includes address and binding information to the each of the new destination nodes 22); and column 10, lines 5-30, discusses how the destination nodes use the address and binding information to support a new diversity leg of communication.

Appellants' first argument is that claims 1-4 are not properly rejected under 35 U.S.C. 102(b) because Muszynski did not issue more than one year prior to the date of application for patent in the United States. The argument is not persuasive because the rejection is under 35 U.S.C. 102(e).

Appellants also argue, at page 8 of the principal brief, that Muszynski fails to disclose certain steps of claim 1, and then proceeds to list every step in the claim. Such a recitation is not helpful since it does not specify the *specific* step or steps on which appellants are focusing.

At page 9 of the principal brief, appellants are more specific, stating that "nowhere in Muszynski...is there any disclosure of CN-RNC interface streamlining, nevertheless a method for reconfiguring diversity legs during CN-RNC interface streamlining as recited in independent claim 1." The examiner points to column 5, lines 10-15, for a discussion of diversity legs in a radio network, but we agree with appellants that

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Muszynski never discusses such diversity legs "during CN-RNC interface streamlining," as claimed. That is, there is no discussion in Muszynski about any core network-radio network controller interface. However, this limitation appears only in the preamble of independent claim 1 and there is nothing within the body of the claim to tie back to this environment, the body merely reciting steps of communication between first and second radio network controllers.

Claim limitations, even in the preamble, are essential if 'necessary to give life and meaning' to the claims and properly define the invention. In re Fritch, 972 F.2d 1260, 23 USPQ2d 17870 (Fed. Cir. 1992). In the instant case, the fact that the reconfiguration is taking place "during CN-RNC interface streamlining" does not appear to give any "life and meaning" to the recited steps in the body of the claim. Accordingly, such limitation does not appear "essential." In fact, the recitation appears to be nothing more than an intended use. Statements of intended use in a preamble do not distinguish claimed structural apparatus from a reference disclosing the structure but not the intended use. In re Sinex, 309 F.2d 488, 135 USPQ 302 (CCPA 1962). This would appear to apply to claimed method steps as well as to claimed structural apparatus.

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Appellants attack the examiner's assertion that Muszynski discloses the step of transferring destination address and binding information from a first radio network controller to a second radio network controller because it discloses initiating and terminating inter-MSC soft handoff with signal diversity between MSC 14 and MSC 12. More specifically, appellants take issue with the examiner's reference to column 9, lines 25-column 10, line 30, because this portion does not disclose transferring destination address and binding information from a first radio network controller to a second radio network controller, but, rather, discloses only the transferring of information required to establish an inter-MSC connection between the mobile station 30 and the base station 22 via MSCs 14 and 12.

Appellants also attack the examiner's assertion that the first MSC releases its control over communication with the mobile station once the second MSC sets up the diversity combining. In particular, appellants point to column 10, lines 22-24, of Muszynski, wherein it is stated, "[i]t should be understood that MSC 14 is still in charge of all control and signalling functions related to the communications with MS 30."

The examiner's response is to state that the instant claims do not require transferring control of the signaling functions.

While we agree that instant claim 1 does not explicitly state that all control of signaling functions is relinquished by one radio network controller when transferring destination address and binding information, it is only reasonable to interpret the claim as so relinquishing such control. Claim 1 recites "releasing a number of transport level connections" and "establishing a new transport level connection between the second radio network controller and each of a plurality of destination nodes..." It is true that Muszynski releases resources employed in a diversity leg, but, in the absence of evidence to the contrary, we agree with appellants that "the release of a diversity leg is not equivalent to disclosing the release of a transport level connection, nor does the release of a transport level connection necessarily flow from the release of a diversity leg" [reply brief-page 4].

As explained by appellants, at page 4 of the reply brief, and supported by the instant specification, at the top of page 3, "a diversity leg represents a logical connection between two end points, whereas a corresponding transport level connection is a functional layer within a layered network architecture design that is responsible for conveying the signals associated with the network diversity leg." Our decision herein is based on this

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definition. Since a change in the logical connections of Muszynski is not equivalent to the claimed "releasing a number of transport level connections" and "establishing a new transport level connection," and the examiner has not shown any evidence of transport level connections in Muszynski, we will not sustain the rejection of claims 1-4 under 35 U.S.C. 102(e).

Moreover, we also will not sustain the rejection of claims 5-7 under 35 U.S.C. 103. The examiner takes "official notice" that it is "common in the art to have the link layer protocol between mobile switching centers be a ATM channel operating under AAL2" [answer-page 4] and contends that it would have been obvious "to have used AAL2 protocol for communication between the mobile switching centers...of Muszynski...since this is the common protocol for such communication and would have been a convenient design choice for the artisan for the advantages granted by ATM" [answer-page 5].

Since Muszynski has been held, supra, to not disclose the claimed transport level connections, we need not reach the question of obviousness of using an AAL2 protocol because the claimed subject matter is clearly not suggested by Muszynski in combination with the common knowledge asserted by the examiner

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because this common knowledge does not provide for the claimed transport level connection feature.

The examiner's decision rejecting claims 1-4 under 35 U.S.C. 102(e) and claims 5-7 under 35 U.S.C. 103 is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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JOSEPH F. RUGGIERO)	BOARD OF PATENT
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