

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC CORPORATION,
Requester,

v.

IPCOM GMBH,
Patent Owner.

Appeal 2015-007683
Reexamination Control 95/001,192
Patent 6,879,830 B1
Technology Center 3900

Before STEPHEN C. SIU, MICHAEL R. ZECHER, and
THOMAS L. GIANNETTI, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*

DECISION

In an earlier Decision, Appeal No. 2012-007843, mailed January 10, 2013 (“Decision”), we reversed the Examiner's decision favorable to the patentability of claims 1 and 5–30 over Anderson¹ and McDonald.² Decision 6–7. Our reversal of the Examiner's decision not to reject claims 1

¹ U.S. Patent No. 6,088,590, issued July 11, 2000 (“Anderson”).

² U.S. Patent No. 5,222,248, issued June 22, 1993 (“McDonald”).

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and 5–30 as unpatentable over Anderson and McDonald was designated as a new ground of rejection pursuant to 37 C.F.R. 41.77(b). *Id.* Patent Owner elected to reopen prosecution under 37 C.F.R. § 41.77(b)(1) (“Response Pursuant to 37 C.F.R. § 41.77(b)(1),” filed March 11, 2013, “PO Request”); submitted the “Declaration of Dr. Vijay Madiseti,” dated March 8, 2013 (“Madiseti Dec.”); cancelled claim 27; and proposed amendments to claims 5, 12, 16, 18, 23, 25, 30, and 34. Requester filed comments pursuant to 37 C.F.R. § 41.77(c) in response to Patent Owner's request to reopen prosecution (“Requester's Comments under 37 C.F.R. § 41.77(c),” filed April 10, 2013, “3PR Comments”), a “Declaration of Dr. Michael Kotzin Under 37 C.F.R. § 1.132,” dated April 10, 2013 (“Kotzin Dec.”), and argued that claims 1 and 5–30 are unpatentable over the combination of Anderson and McDonald or, alternatively, the combination of Anderson, McDonald and any one of GSM³ or PACS.⁴ In the Order Remanding Inter Partes Reexamination Under 37 C.F.R. § 41.77(d) to the Examiner, dated June 12, 2013 (“Remand” at 2), the matter was remanded to the Examiner for consideration of Patent Owner's and Requester's comments and evidence as they pertain to grounds of rejection.

In accordance with 37 C.F.R. § 41.77(e), the Examiner “determined that the Request to Reopen Prosecution overcomes the new ground[] of reject[ion] stated in the Board’s decision” (“Examiner's Determination

³ Global System for Mobile Communications, “Digital Cellular Telecommunications System (Phase 2+); Mobile Radio Interface Layer 3 Specification (GSM 04.08 version 6.1.1.1 Release 1997).” (“GSM”).

⁴ American National Standards Institute, “American National Standard for Telecommunications – Personal Access Communications System Air Interface Standard,” 1998 (“PACS”).

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Under 37 C.F.R. § 41.77(d),” dated July 31, 2014, “Examiner's Determination” at 11). The Examiner also does not appear to adopt the proposed rejection(s) of any of the claims over the combination of Anderson, McDonald, and any one of GSM or PACS. Hence, the Examiner does not adopt the rejection of any of claims 1, 5–26, and 28–30 as unpatentable over Anderson and McDonald or, alternatively, over the combination of Anderson, McDonald, and any one of GSM or PACS.

In response to Examiner’s Determination, Requester filed “Requester’s Comments Under 37 C.F.R. § 41.77(e),” filed November 26, 2014 (“3PR Comments on Exr’s Determ.”), and Patent Owner filed “Patent Owner’s Response to Requester’s Comments Under 37 C.F.R. § 41.77(e),” filed December 22, 2014 (“PO Comments on Exr’s Determ.”).

Pursuant to 37 C.F.R. § 41.77(f), the proceeding has been returned to the Board so that we may reconsider the matter and issue a new decision.

Preliminary Issues

Requester argues that Patent Owner’s request to reopen prosecution is improper because Patent Owner’s claim amendments and arguments are supposedly not “confine[d] . . . to the subject matter of the new ground of rejection.” 3PR Comments 2. Patent Owner “may file a response requesting reopening of prosecution before the examiner. Such a response must be either an amendment of the claims so rejected or new evidence relating to the claims so rejected, or both.” 37 C.F.R. § 41.77(b). In the Decision, claims 1 and 5–30 were rejected as obvious over the combination of Anderson and McDonald. Decision 6. Hence, claims 1 and 5–30 are the

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“claims so rejected” and, according to 37 C.F.R. § 41.77(b), Patent Owner may request to reopen prosecution if the request contains either an amendment of any of the “claims so rejected” or new evidence relating to the “claims so rejected” (i.e., any of claims 1 or 5–30).

As stated above, in the Decision, claims 1 and 5–30 are the “claims so rejected.” Claim 34 was not a “claim so rejected.” Therefore, Patent Owner’s proposed claim amendments to claim 34 are improper under 37 C.F.R. § 41.77(b) and will not be entered. Also, pursuant to 37 C.F.R. § 41.77(b), we consider Patent Owner’s arguments pertaining only to the “claims so rejected” in the Decision (i.e., claims 1 and 5–30) and, thus, do not consider any issues with respect to claims other than claims 1 and 5–30 (such as claim 34).

Patent Owner argues that Requester’s reliance on newly presented prior art references is impermissible because “Requester did not explain why the additional prior art could not have been presented earlier and thus failed to comply with the Board’s express requirements,” and that “[t]he Examiner’s refusal to consider the additional prior art [based on wording in the Remand] was thus entirely reasonable.” PO Comments on Exr’s. Determ. 27–28. As described above, Patent Owner elected to file a request to reopen prosecution under 37 C.F.R. § 41.77(b). Pursuant to 37 C.F.R. § 41.77(c), and in response to Patent Owner’s request to reopen prosecution under 37 C.F.R. § 41.77(b) and the claim amendments associated therewith, Requester filed “comments on the response” pertaining to “issues raised by . . . the owner’s response.” Patent Owner does not demonstrate sufficiently that the proposed rejections of amended claims involving additionally cited

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prior art references by Requester do not pertain to “issues raised by . . . the owner’s response” under 37 C.F.R. § 41.77(c). Patent Owner argues that Requester failed to “explain why the additional prior art could not have been presented earlier,” but fails to explain sufficiently the basis for this alleged requirement. We note that 37 C.F.R. § 41.77(c) does not require Requester to “explain why the additional prior art could not have been presented earlier” in response to Patent Owner’s request to reopen prosecution under 37 C.F.R. § 41.77(b), for example.

Therefore, we assume the Examiner has considered the additionally cited references and has determined not to adopt the proposed rejection(s) of disputed claims involving those references.

Claims 5–17

Claim 5, as amended, recites “informing the mobile station whether the network is capable of transferring the link data from the first base station to the second base station.” Patent Owner argues claims 5, 12, and 16 as a group and contends that the combination of Anderson and McDonald fails to disclose or suggest this feature. PO Request 28, PO Comments on Exr’s Determ. 10–11. Requester argues that either one of McDonald or Anderson discloses this feature. 3PR Comments 24–28 (citing McDonald 1:43–46, 1:27–2:3, 2:66–3:17, 3:54–66, Fig. 2; Anderson 16:61–17:4); 3PR Comments on Exr’s Determ. 23–25 (citing McDonald 1:27–2:3, 1:43–46, 2:66–3:17, 3:54–66; Anderson 16:61–17:4).

As Requester points out, McDonald discloses a “subscriber” who “transmits . . . an inbound signaling word (ISW) to the central controller”

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and that, “[i]f a channel is not available,” the central controller “transmits an outbound signaling word (OSW)” that may be “a site busy signal” that “indicates that the group call was not placed because at least one site did not have an available channel.” McDonald 1:30–33, 42–48. McDonald also discloses a “subscriber” who “issues an ISW to the new site” for a “next best control channel” in a “second coverage area.” In this example, “both voice channels are occupied at the site in the second coverage area” so “the central controller . . . issues a busy OSW.” McDonald 3:1–4, 8–14. In each of these examples disclosed by McDonald, a central controller informs a subscriber (or “mobile station”) (by transmitting an “OSW”) whether the network is capable of transferring the link data from the first base station to the second base station via an “OSW” (or busy signal) that informs the subscriber that the network is not capable of performing the transfer.

Likewise, Anderson discloses that “the terminal base station . . . sends a message . . . to its base station controller . . . requesting that the original circuit be switched from the originating base station . . . to the terminal base station” and that, in response, the controller “requests an inter-cluster handoff at the network level.” Anderson 16:64–17:4. In this example disclosed by Anderson, a handoff is performed, thus “informing” the requesting mobile station whether the network is capable of such a transfer (in this case, the network is capable of performing the transfer).

Patent Owner argues that “Anderson and MacDonald fail to teach or fairly suggest informing the mobile station if the network cannot support the handover.” PO Request 28 (citing Action Closing Prosecution). However, Patent Owner does not explain sufficiently a difference between

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McDonald's disclosure of a central controller informing a mobile station (via an "OSW" or busy signal) of the incapability of a transfer and the disputed claim limitation.

The Examiner states that this issue "was not contested on appeal" and was "previously identified by the Examiner as allowable subject matter" (Examiner's Determination 9–10), but does not explain how an issue not raised previously negates an issue that is raised subsequently by Patent Owner's reopening of prosecution under 37 C.F.R. § 41.77(b). Therefore, we find insufficient support for Examiner's position that this issue should not be considered because the issue was not presented prior to reopening of prosecution under 37 C.F.R. § 41.77(b). Patent Owner does not provide additional arguments in support of independent claims 5, 12, or 16, or claims 6–11, 13–15, and 17 that depend from claim 5, 12, or 16.

The Examiner erred in refusing to adopt the rejection of claims 5–17 as unpatentable over the combination of Anderson and McDonald. We need not consider additional proposed rejections of claims 5–17 over other references (e.g., GSM or PACS). *Cf. In re Gleave*, 560 F.3d 1331, 1338 (Fed. Cir. 2009).

Claim 30

Claim 30, as amended, recites "receiving in the mobile station a forced handover request message from the first base station indicating that the link is to be handed over," "sending a handover query to the second base station," and "receiving a rejection message from the second base station in the event the second base station is not able to support traffic of the mobile

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station.” Patent Owner argues that Anderson and McDonald fail to disclose or suggest these features. PO Request 25–27 (citing Madisetti Dec. 33, 34, Anderson 2:30–33, 17:45–67; McDonald 1:58–64, 2:66 – 3:2); PO Comments on Exr’s. Determ. 9–10 (citing Specification 1:7–11, 37–41, 53–56, 2:24–31). Requester argues that Anderson, McDonald, PACS, or GSM each discloses these features. 3PR Comments 22–24 (citing Kotzin Dec. ¶¶ 46, 48, 49; Anderson 2:30–32, 17:45–62; 3PR Comments on Exr’s Determ. 20–23 (citing Kotzin Dec. ¶¶ 46, 48, 49; Anderson 2:30–32, 16:61–17:4, 17:45–62; McDonald 1:27–2:3, 1:43–46, 2:66–3:17, 3:54–66, Fig. 2)). Hence, Requester proposes that claim 30 is unpatentable over the combination of Anderson and McDonald or, alternatively, over the combination of Anderson, McDonald, and any one of GSM or PACS.

Regarding “receiving in the mobile station a forced handover request message from the first base station indicating that the link is to be handed over,” as Requester points out, Anderson discloses a “user station,” that “the originating base station **405** signals the user station **102** to transfer to the terminal base station **406**,” and that “[w]hen the user station **102** receives the signal . . . the user station **102** switches to the terminal base station **406**.” Anderson 17:19–23. In other words, Anderson discloses receiving in the mobile station (i.e., the user station) a request from the first base station (i.e., originating base station 405) indicating that the link is to be handed over (i.e., to terminal base station 406).

Patent Owner argues that Anderson discloses that “handoffs are preferably initiated from the user station,” but fails to disclose or suggest that “handovers are initiated by the base station.” PO Request 22 (citing

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Anderson 2:30–33). We are not persuaded by Patent Owner’s arguments for at least the reasons set forth by Requester. 3PR Comments 22. In any event, we note that claim 30, for example, recites “receiving in the mobile station a forced handover request message from the first base station indicating that the link is to be handed over,” but does not appear to recite or otherwise require that “handovers are initiated by the base station.”

Requester argues that GSM discloses a “handover command” or “forced handover message” “in the context of handover and a ‘RR-cell change order’ message to the mobile station in the context of a cell change.” 3PR Comments 22–23 (citing GSM §§ 3.4.4.1, 3.4.20.1). As Requester indicates, GSM discloses that the “network” (or base station) “initiates the handover procedure by sending a HANOVER COMMAND message to the mobile station” and, in response, the mobile station “initiates . . . the release of link layer connections . . . and establishment of lower layer connections.” GSM 58–59. In other words, GSM discloses receiving in the mobile station a forced handover request message (i.e., a handover command message) from the first base station (i.e., network) indicating that the link is to be handed over. Patent Owner argues GSM discloses an “RR-cell change order” in the context of “the process of finding a channel on which to start transmitting,” rather than in the context of a “handover.” However, Patent Owner does not explain sufficiently how a network sending a handover command message to a mobile station, as disclosed by GSM, differs from the disputed claim limitation. PO Comments on Exr’s. Determin. 33.

Requester argues that PACS discloses “an ALT or handover can ‘be stimulated by the network by the transmission of a PERFORM_ALT

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message.” 3PR Comments 23 (citing PACS 116). Patent Owner argues that “the PERFORM_ALT message is forced,” but that “there is no[] possibility of reactivating the link if the handover is unsuccessful” such that PACS fails to disclose or suggest “reactivat[ing] the link with the first base station if the handover is unsuccessful, as required by claims . . . 30 . . . and 34.” PO Comments on Exr’s. Determ. 34 (citing PACS 135). Hence, Patent Owner argues that PACS fails to disclose or suggest reactivating a link with a first base station if the handover is unsuccessful. We need not consider whether PACS discloses reactivating a link with a first base station if the handover is unsuccessful or not because, as previously discussed, McDonald discloses this feature (e.g., “. . . allow the user the option of returning to the old channel . . . for call completion” McDonald 3:25–26). One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Regarding the claim limitations “sending a handover query to the second base station” and “receiving a rejection message from the second base station in the event the second base station is not able to support traffic of the mobile station,” Requester argues that McDonald discloses that the “subscriber sends an ISW message requesting handover,” but that “the new site to which the subscriber seeks to be handed over ‘may not have any communication resources available’” or “are occupied at the site in the second coverage area.” In this case, “the radio . . . is issued a busy message.” 3PR Comments 19. We agree with Requester that one of skill in the art would have understood that a “busy signal,” as disclosed by

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McDonald, would constitute a “rejection message” because, in both cases, a signal (or message) indicates that a handover cannot be accomplished. We also agree with Requester that one of skill in the art would have understood that a query is sent to the second base station because, if such a query was not sent to the second base station in McDonald, there could be no indication that the base station is “occupied at the site in the second coverage area.” This would be in contrast with McDonald that explicitly discloses that an indication that the base station is occupied is provided. Patent Owner does not explain adequately how McDonald, for example, differs from the disputed claim limitations. *See, e.g.*, PO Comments after Exr. Determ. 22.

In addition, Requester argues that GSM discloses a “handover query” and a “rejection message,” as claimed. 3PR Comments 19–20 (citing GSM §§ 3.4.20.3, 7.3.1, 9.1.20). As Requester indicates, GSM discloses a mobile station that “initiates immediate assignment” by “using the LOCATION UPDATING REQUEST message” that is sent to the “network.” GSM 207–208. In other words, GSM discloses “sending a handover query (or “location updating request message”) to the second base station (or “network”). GSM also discloses an “immediate assignment reject” that is a “message [that] is sent . . . by the network . . . to . . . mobile stations to indicate that no channel is available for assignment.” GSM 256. Hence, GSM discloses receiving a rejection message (e.g., immediate assignment reject message) from the second base station (e.g., network) in the event the second base station is not able to support traffic of the mobile station (i.e., no channel is available for assignment).

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Patent Owner argues that GSM discloses a “handover procedure [that] is not one that involves a mobile station,” but instead “involves a mobile station setting a timer” and “does not involve a rejection message from the new base station.” PO Comments on Exr’s. Determ. 33 (citing GSM 3.4.4.4). However, Patent Owner does not explain sufficiently a difference between the disclosure of GSM, as indicated by Requester, and the disputed claim limitations.

Requester argues that PACS also discloses a handover query or request (i.e., “ALT_REQ message”) and a rejection message (i.e., “ALT_DENY message”). 3PR Comments 20–22 (citing Kotzin Dec 44; PACS 123, Fig. 6.7.2.1.3); *see also* 3PR Comments on Exr’s. Determ. 33–34. Patent Owner does not appear to contest Requester’s characterization of PACS in this regard.

Patent Owner argues that it would not have been obvious to one of ordinary skill in the art to combine the teachings of either of GSM or PACS with those of Anderson and McDonald because such a combination “would clearly result in an inoperable system” because “the references are lengthy and combining only specific unspecified features would result in innumerable permutations of feature combinations.” PO Comments 29. Hence, Patent Owner contends that the combination of GSM or PACS with Anderson and McDonald would not have been obvious to one of ordinary skill in the art because “the references are lengthy.” We are not persuaded by Patent Owner’s argument for at least the reasons set forth by Requester (*see, e.g.*, 3PR Comments 13–15), and at least because Patent Owner does not provide adequate support that the length of references has any specific

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bearing on whether or not it would have been obvious to one of ordinary skill in the art to have combined the (allegedly lengthy) references.

Rather, both Anderson and McDonald disclose methods of “handoff” of communications in a “mobile telephone system” or “multi-site trunked communication system.” Anderson 1:49, 15:48; McDonald 1:12–13, 2:25–27. GSM discloses a “Technical Specification” “for the call control of circuit switched connections” and handover procedures involving, for example, sending a HANOVER COMMAND message to the mobile station. GSM 27, 58–59. PACS also discloses “[m]obile applications [that] include communications between” communication network components and handover procedures (i.e., “automatic link transfer”). PACS 23, 116–17. Combining the known system and method of handover of mobile stations in a communication system of Anderson or McDonald with the system and methods of handover of mobile stations in a communication system of either GSM or PACS would have resulted in no more than the predictable result of a method and system of handover of mobile stations in a communication system. We agree with Requester that such a combination would have been obvious to one of ordinary skill in the art. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).

The Examiner erred in refusing to adopt the rejection of claims 30 as unpatentable over the combination of Anderson and McDonald or, alternatively, the combination of Anderson, McDonald, and any one of GSM or PACS.

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Claims 1, 19–22, and 24

Claim 1 has not been amended and recites, in relevant part, “an arrangement for reactivating the link with the first base station if the handover is unsuccessful.” Patent Owner (and Patent Owner’s expert, Dr. Vijay Madiseti) argues that this recited claim feature “invokes . . . ‘means-plus-function’ claiming,” “thus requires a processor and a transceiver configured to perform the steps of an algorithm for reactivating a link with the first base station,” and, therefore, according to Patent Owner, must include “receiving a rejection from the second (i.e., target) base station; sending a message to the first (i.e., old) base station to maintain the link with the first base station, and re-establishing the link with the first base station by receiving a message from that first base station.” PO Request 19–20 (citing Spec. 6:32–40, Fig. 5; Madiseti Dec. 17–18; *HTC Corp. v. ICom GmbH & Co.*, 667 F.3d 1270 (Fed. Cir. 2012)).

Even assuming Patent Owner to be correct that specific, selected method steps disclosed in the Specification must be imported into a claim as an alleged “algorithm structure” when that claim recites “means-plus-function,” we note that, even if Patent Owner is correct that the Specification discloses an example of an “algorithm structure” that involves “receiving a rejection from the second base station,” the Specification also recites an example of an “algorithm structure” that does *not* involve receiving a rejection from the second base station. For example, the Specification discloses an “algorithm structure” in which “the mobile station was unable to register at another base station (in this case due to a rejection, but in some

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cases this is because no other base station is receiving).” Spec. 7:66 – 8:1. Hence, in “some cases” there is no receipt of a “rejection.”

Patent Owner also argues that the combination of Anderson and McDonald fails to disclose or suggest “sending a message to the first (i.e., old) base station to maintain the link with the first base station,” as purportedly part of the alleged “algorithm structure” corresponding to the “arrangement” recited in claim 1. Even assuming Patent Owner is correct that the Specification discloses an example of an “algorithm structure” that involves sending a message to the first base station to maintain the link, we note that the Specification discloses an example of an “algorithm structure” in which a message is *not* first sent to the first base station to maintain the link with the first base station. For example, the Specification discloses an “algorithm structure” in which “in the case of a handover the base station initially continue[s] to hold the data and resources” via a “timer.” In this “algorithm structure,” “[t]he base station holds the resources of the mobile station in reserve until it receives the request to redirect the links or until the timer runs out.” Spec. 7:41–43, 46–48. There does not appear to be a disclosure (in this “algorithm structure”) of first sending a message to the first base station to maintain the link. In other words, the first base station, in this “algorithm structure” disclosed in the Specification “maintains the link,” but no message is disclosed as being first sent to the first base station.

Patent Owner also argues that the combination of Anderson and McDonald fails to disclose or suggest “re-establishing the link with the first base station by receiving a message from that first base station,” as purportedly part of the alleged “algorithm structure” corresponding to the

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“arrangement” recited in claim 1. Even assuming Patent Owner is correct that the Specification discloses an example of an “algorithm structure” that involves re-establishing a link by receiving a message from the first base station, we note that the Specification discloses at least one “algorithm structure” in which a link is re-established with *no* disclosure of receiving a message from the first base station. For example, the Specification discloses an “algorithm structure” in which, “[i]f the search for a new base station is unsuccessful, the MS re-registers at its old BS and keeps its previous settings.” Spec. 7:50–52. In this “algorithm structure,” there is no disclosure of a step in which a link is re-established by receiving a message from the first base station.

Patent Owner does not explain sufficiently why alleged “algorithm structures” disclosed in the Specification that involve *none* of receiving a rejection, first sending a message to a first base station, or re-establishing a link by receiving a message from the first base station, indicates that the “algorithm structure” supposedly disclosed in the Specification must *include* these specific (missing) steps, much less why these steps that are missing from the “algorithm structure” must further be imported into the claims.

We are not persuaded by Patent Owner that any of the purported steps of receiving a rejection, first sending a message to a first base station, or re-establishing a link by receiving a message from the first base station are required elements of an allegedly disclosed “algorithm structure.” As such, we are not persuaded by Patent Owner that any of these purported method steps must be imported into claim 1. Therefore, we need not consider

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whether or not the combination of Anderson and McDonald discloses or suggests these method steps.

Patent Owner does not provide additional arguments in support of claims 19–22, or 24, which depend from claim 1.

The Examiner erred in refusing to adopt the rejection of claims 1, 19–22, and 24 as unpatentable over Anderson and McDonald. We need not consider additional proposed rejections of claims 1, 19–22, and 24 over other references (e.g., GSM or PACS). *Cf. In re Gleave*, 560 F.3d 1331, 1338 (Fed. Cir. 2009).

Claim 18

Claim 18, as amended, recites “an arrangement for sending a handover query to the second base station and for receiving messages, the messages including a forced handover request message from the first base station indicating that the link is to be handed over, wherein the second base station responds to the handover query with a rejection message in the event the second base station is not able to support traffic of the mobile station.” Patent Owner provides similar arguments in support of claim 18 as previously presented for claims 1 and 30. We are not persuaded by Patent Owner’s arguments for at least the previously discussed reasons, as well as the reasons provided by Requester. *See, e.g.*, 3PR Comments 8–24; 3PR Comments on Exr’s. Determ. 13–23.

Patent Owner does not provide additional arguments in support of claims 26 and 28, which depend from claim 18.

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The Examiner erred in refusing to adopt the rejection of claims 18, 26, and 28 as unpatentable over the combination of Anderson and McDonald or, alternatively, the combination of Anderson, McDonald, and any one of GSM or PACS.

Claims 23 and 25

Claims 23 and 25, as amended, recite base stations “using different generations of radio communications standards for radio communication with the mobile station.” Requester argues that the combination of Anderson, McDonald, and GSM discloses this feature. 3PR Comments 28–32 (citing Kotzin Dec. ¶¶ 58, 59, 61; Anderson 4:40–61, Fig. 1; McDonald 1:24–26); 3PR Comments on Exr’s Determ. 25–27 (citing Kotzin Dec. ¶¶ 58, 59, 61; Anderson 4:40–61, Fig. 1; Appendix B; McDonald 1:24–26). For example, Requester argues that GSM discloses “a mobile station that is capable of communicating with upgraded GPRS or 2.5G base stations, as well as pre-existing GSM or 2G-only base stations.” 3PR Comments 30 (citing Kotzin Dec. 57; GSM §§ 0.7.2, 3.4.20).

Patent Owner argues that GSM fails to disclose or suggest “base stations being incapable of communicating among themselves to a sufficient degree to facilitate a handover.” PO Comments on Exr’s Determ. 36. As previously indicated, claims 23 and 25, as amended, recite base stations “using different generations of radio communications standards for radio communication with the mobile station.” We do not observe, and Patent Owner does not demonstrate sufficiently, that claims 23 and 25, as amended, also recite the “base stations being incapable of communicating among

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themselves to a sufficient degree to facilitate a handover.” Patent Owner argues that the Specification discloses an example in which base stations are allegedly incapable of communicating among themselves to a sufficient degree to facilitate a handover. PO Comments on Exr’s Determ. 36 (citing Spec. 6:57–64). However, even if the Specification discloses such an example, Patent Owner does not explain why this one example allegedly disclosed in the Specification should be imported into the claims. Without such a showing, we decline to import one selected example allegedly disclosed in the Specification into the claims. “Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.” *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004).

Patent Owner does not provide additional arguments in support of claims 23 and 25. The Examiner erred in refusing to adopt the rejection of claims 23 and 25 as unpatentable over Anderson, McDonald, and GSM. We need not consider additional proposed rejections of claims 23 and 25 over other references (e.g., PACS). *Cf. In re Gleave*, 560 F.3d 1331, 1338 (Fed. Cir. 2009).

DECISION

We reverse the Examiner’s non-adoption of the rejection of claims 1, 5–17, 19–22, and 24 under 35 U.S.C. § 103(a) as unpatentable over

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Anderson and McDonald; claims 23 and 25 under 35 U.S.C. § 103(a) as unpatentable over Anderson, McDonald, and GSM; claims 18, 26, 28, and 30 under 35 U.S.C. § 103(a) as unpatentable over the combination of Anderson and McDonald or, alternatively, the combination of Anderson, McDonald, and any one of GSM or PACS.

Pursuant to 37 C.F.R. § 41.77(a), the above-noted reversal constitutes a new ground of rejection. Section 41.77(b) provides that “[a] new ground of rejection . . . shall not be considered final for judicial review.” That section also provides that Patent Owner, WITHIN ONE MONTH FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal proceeding as to the rejected claims:

- (1) *Reopen prosecution.* The owner may file a response requesting reopening of prosecution before the examiner. Such a response must be either an amendment of the claims so rejected or new evidence relating to the claims so rejected, or both.
- (2) *Request rehearing.* The owner may request that the proceeding be reheard under § 41.79 by the Board upon the same record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

In accordance with 37 C.F.R. § 41.79(a)(1), the “[p]arties to the appeal may file a request for rehearing of the decision within one month of the date of: . . . [t]he original decision of the Board under § 41.77(a).” A request for rehearing must be in compliance with 37 C.F.R. § 41.79(b).

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Comments in opposition to the request and additional requests for rehearing must be in accordance with 37 C.F.R. § 41.79(c)-(d), respectively. Under 37 C.F.R. § 41.79(e), the times for requesting rehearing under paragraph (a) of this section, for requesting further rehearing under paragraph (c) of this section, and for submitting comments under paragraph (b) of this section may not be extended.

An appeal to the United States Court of Appeals for the Federal Circuit under 35 U.S.C. §§ 141–144 and 315 and 37 C.F.R. § 1.983 for an *inter partes* reexamination proceeding “commenced” on or after November 2, 2002 may not be taken “until all parties’ rights to request rehearing have been exhausted, at which time the decision of the Board is final and appealable by any party to the appeal to the Board.” 37 C.F.R. § 41.81. *See also* MPEP § 2682 (8th ed., Rev. 8, July 2010).

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

Requests for extensions of time in this *inter partes* reexamination proceeding are governed by 37 C.F.R. § 1.956. *See* 37 C.F.R. § 41.79.

In the event neither party files a request for rehearing within the time provided in 37 C.F.R. § 41.79, and this decision becomes final and appealable under 37 C.F.R. § 41.81, a party seeking judicial review must timely serve notice on the Director of the United States Patent and Trademark Office. *See* 37 C.F.R. §§ 90.1 and 1.983.

AFFIRMED

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FOR PATENT OWNER:

Michael S. Pavento
KILPATRICK TOWNSEND & STOCKTON LLP
1100 Peachtree Street, Suite 2800
Atlanta, GA 30309-4530

FOR THIRD-PARTY REQUESTERS

Chun M. Ng
PERKINS COIE LLP
Patent - SEA
P.O. Box 1247
Seattle, WA 98111-1247