

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.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

Appeal No. 2001-0622
Application No. 08/594,202

ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-3, 7-11 and 15-18. Claims 4-6 and 12-14 have been indicated by the examiner as being directed to allowable subject matter.

The invention pertains to communication systems. More particularly, a communication unit having an identification (ID)

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within a communications system having an infrastructure detects that the unit's user initiated a communications mode change from a first communication path to a second communication path having an identity. The unit then transmits to the infrastructure a message including the ID and the identity of the second communication path.

Representative independent claim 1 is reproduced as follows:

1. A method comprising the steps of:

detecting, by a communication unit having an identification (ID) within a communications system having an infrastructure, that the communication unit's user initiated a communications mode change from a first communication path having a home system to a second communication path having an identity, wherein the infrastructure is affiliated with the home system of the first communication path;

transmitting, by the communication unit to the infrastructure, a communications mode change message including the ID and the identity of the second communication path.

The examiner relies on the following references:

Farwell et al.	5,444,766	Aug. 22, 1995
Tanaka et al.	5,493,693	Feb. 20, 1996
		(filed Apr. 12, 1994)
Henry	5,590,396	Dec. 31, 1996
		(filed Apr. 20, 1994)

Claims 1-3, 7-11 and 15-18 stand rejected under 35 U.S.C.

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103 as unpatentable over Farwell, Tanaka and Henry.

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

OPINION

It is the examiner's position that Farwell discloses a communication mode change technique in which a communication unit performs a communication mode change from a first communication path to a base station 1 to a second communication path communicating to a base station 2 having an identity in response to a received handoff message 220. According to the examiner, Farwell discloses the claimed subject matter but for the mode change being user initiated, for which the examiner relies on Tanaka, and the feature of informing the home system of the new communication path, for which the examiner relies on Henry.

We will not sustain the rejection of claims 1-3, 7-11 and 15-18 under 35 U.S.C. 103 because, in our view, the examiner has not set forth a prima facie case of obviousness.

The claims require that a user initiate a communications mode change "from a first communication path...to a second

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communication path..." The only reference alleged to teach this feature is Tanaka. However, it is clear from a review of Tanaka that that reference is only concerned with a single communication path. The "mode" selection device in Tanaka is for selecting between an analog and a digital mode.

The examiner's response is that as "broadly claimed," a communication path does not necessarily refer to another station. In the examiner's words, "[i]t is considered in the Tanaka reference that by changing the type of modulation used in the communication, the components used in transmitting and receiving this new change in modulation is changed and therefore essentially changes the 'path' in which the communication takes place" [answer-page 6].

We view the examiner's interpretation as being unreasonable. The instant claims require that a user initiate a communication mode change "from a first communication path...to a second communication path." While a change from analog to digital modes in Tanaka may be a "mode change," it is clearly not a mode change from a first communication path to a second communication path and it is not reasonable to so interpret it.

Accordingly, since Tanaka is useless as a reference suggesting a user initiated mode change from a first to a second

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communication path, a suggestion of this claim limitation is absent from the examiner's rationale and the rejection under 35 U.S.C. 103 must fall.

The examiner's decision rejecting claims 1-3, 7-11 and 15-18 under 35 U.S.C. 103 is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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MICHAEL R. FLEMING)	BOARD OF PATENT
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