

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL JOHN MCCARTHY

Appeal No. 2001-2052
Application No. 08/943,427

ON BRIEF

Before BARRETT, FLEMING and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-3, 5, 7-9, 11, 13-15, 17, and 19-22, which are all of the claims pending in this application.

We REVERSE.

Appellant's invention relates to a method for minimizing transmitter power levels within a cellular telephone communications network. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method for maintaining optimal transmitter power levels within a cellular communications network, wherein said cellular communications network includes a plurality of cellular base stations and a plurality of cellular telephones, said method comprising the steps of:

periodically performing a carrier-to-interference ratio measurement between a first cellular base station and a cellular telephone;

in response to a determination that said measured carrier-to-interference ratio is higher than a carrier-to-interference ratio upper bound, reducing an optimal transmitter power at said cellular base station by one step;

in response to a determination that said measured carrier-to-interference ratio is lower than said first carrier-to-interference ratio upper bound, determining whether or not said measured carrier-to-interference ratio is lower than a carrier-to-interference ratio lower bound;

maintaining said optimal transmitter power at said first cellular base station if said measured carrier-to-interference ratio is between said carrier-to-interference ratio lower bound and said carrier-to-interference ratio upper bound; and

handing off said cellular telephone to a different channel within a same cell when said measured carrier-to-interference ratio is lower than said carrier-to-interference ratio lower bound.

The prior art of record relied upon by the examiner in rejecting the appealed claims are as follows:

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Eriksson et al. (Eriksson)

5,448,750

Sep. 5, 1995

Claims 1-3, 5, 7-9, 11, 13-15, 17, and 19-22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kanai in view of Eriksson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 21, mailed Nov. 21, 2000) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 20, filed Sep. 5, 2000) and reply brief (Paper No. 22, filed Dec. 20, 2000) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Appellant argues that the examiner has not resolved the conflicting teachings of Kanai and Eriksson regarding the action to be performed when the carrier-to-interference ratio is lower than a lower bound. (See brief at pages 5-6.) We agree with appellant and find that the examiner has not provided a convincing line of reasoning supported by substantial evidence that it would have been obvious to one of ordinary skill in the art to use the teaching of Eriksson with respect to handing off an on-going

call in light of Kanai's alternative teaching of increasing the transmission power to improve the carrier-to-interference ratio.

In the statement of the rejection at pages 4 and 5 of the answer, the examiner does not address the alternatives, but rather concludes that it would have been obvious to one of ordinary skill in the art to handoff the call with a low carrier-to-interference ratio so that the call would not be lost in place of the teaching of Kanai which teaches increasing the power so that the call will not be lost. The examiner maintains that there is no conflict between the teachings. (See answer at page 6.) The examiner maintains "the teachings of Eriksson as just another way to solve the common problem of a reduced quality signal shared by both references" and that the examiner does not see any conflicting teachings between the two references. (See answer at page 7.) While appellant and the examiner dispute over whether there is a "conflict," there is still the issue of why would it have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Kanai. The mere fact that Eriksson teaches an alternative, does not make it *ipso facto* a reason to modify the teachings of Kanai unless there is a recognized benefit to make this change. We find no such teaching or suggestion in either reference and do not find a convincing line of reasoning set forth by the examiner in the answer.

Appellant argues that the examiner has relied upon impermissible hindsight to reconstruct the claimed invention by picking and choosing among the two disclosures.

(See brief at page 8.) The examiner maintains that it would have been obvious to one of ordinary skill in the art to modify the teaching of Kanai to handoff calls as taught and suggested by Eriksson and merely makes the substitution and discusses the substitution at pages 7-8 of the answer without actually setting forth a line of reasoning why it would have been obvious to one of ordinary skill in the art at the time of the invention. The examiner's rationale that one viable option is to handoff the call and the other viable option is to increase power. (See answer at pages 9-10.) We do not find that the mere fact that each is a viable option is a motivation to modify one teaching without something more to suggest the change. Here, we do not find that the examiner has provided such a teaching, suggestion or line of reasoning. Therefore, we cannot sustain the rejection of independent claim 1 and its dependent claims 2, 3, and 5. Since we find similar limitations in independent claims 7, 13, and 19, we will not sustain the rejection of these claims and their dependent claims.

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CONCLUSION

To summarize, the decision of the examiner to reject claims 1-3, 5, 7-9, 11,13-15, 17, and 19-22 under 35 U.S.C. § 103 is reversed.

REVERSED

LEE E. BARRETT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JOSEPH L. DIXON)	
Administrative Patent Judge)	

JD/RWK

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