

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte NIGEL LOBLEY and JOHN M. CULLEN

Appeal No. 2001-2055
Application No. 08/750,870

HEARD: Dec. 12, 2002

Before RUGGIERO, BARRY, and SADDAT, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claims 1-10 and 13-21. The appellants appeal therefrom under 35 U.S.C. § 134(a). We affirm.

BACKGROUND

The invention at issue on appeal concerns call setup and service invocation in an intelligent network- ("IN-") based mobile telecommunications network. "Put simply, the basis of an [IN] is to separate service provision from switching functionality. . . . Typically, the processing required to implement network services is provided by processors," (Spec. at 1), that are separate from a switching infrastructure.

Figures 1a and 1b of the appellants' specification depict their conception of "known techniques for IN call set-up. . . ." (Appeal Br. at 4.) As shown thereby, when a user has a call or other service request, a communications connection is established between the user's terminal 1 and a switch 2 via communications link 4. The connection can carry both signaling and call traffic. If a request requires further processing, the switch 2 directs the request to a service control unit 3 (step 23) via a control link 6. The service control unit 3 provides the further processing required to complete the call request or to perform some other service request (step 24).

When the switch 2 requests further processing from the service control unit 3, the latter may fail the call and cause the switch 2 to release the communication connection due to a service mismatch, customer specific service (e.g., outgoing calls barred), or called party terminal state (e.g., a busy condition). Consequently, besides a signaling channel, a traffic channel will have been connected on the communications link 4 from the user terminal 1 to the switch 2 and in the switch 2 itself, and then not used. Because the traffic channel was allocated to the failed call attempt, it could not

be used for other call attempts, "which may then fail for lack of available capacity."
(Spec. at 4.)

In contrast, the disclosed invention enables a mobile user terminal to request a call or other service directly from a service processor, without involving a switch unless the service processor instructs the switch to participate. (*Id.*) The initial call or service set-up uses signaling channels only, deferring the establishment and allocation of traffic channels until an associated request is validated. (*Id.* at 7.)

A further understanding of the invention can be achieved by reading the following claim.

6. A method of operating a switched mobile telecommunications network, the method being such that all service requests are initially directed from their originating network terminations by establishing a signalling connection to a service processing means, without establishment of a communications connection with a mobile network termination, and the service processing means provides services to a network termination over the signalling connections, the service processing means also controlling switching means to establish a communications connection with the network termination only if required by the service requested.

Claims 1-10 and 13-21 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 5,440,614 (“Sonberg”).¹

OPINION

At the outset, we recall that claims that are not argued separately stand or fall together. *In re Kaslow*, 707 F.2d 1366, 1376, 217 USPQ 1089, 1096 (Fed. Cir. 1983) (citing *In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979)). Furthermore, “[m]erely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.” 37 C.F.R. § 1.192(c)(7).

Here, although the appellants point out differences in what claims 1-10 and 13-21 cover, (Appeal Br. at 12-13), this is not an argument why the claims are separately patentable. Furthermore, they argue the claims 1-10 and 13-21 as a group. (*Id.* at 14-21.) Therefore, claims 1-5, 7-10, and 13-21 stand or fall with representative claim 6.

With this representation in mind, rather than reiterate the positions of the examiner or the appellants *in toto*, we address the main point of contention therebetween. The examiner makes the following assertion.

¹We advise the examiner to copy his rejections into his examiner’s answers rather than merely referring to a “rejection . . . set forth in prior Office Action. . . .” (Examiner’s Answer at 3.)

Sonberg et al. do disclose the features of: central host computer 14 that is initially accessible by a call routing option entered by roamer via signaling path without establishing a communications connection, and Home MTSO Site 10 controlled by central host computer 14 is to establish a communications connection with the caller only when the call routing option entered by the roamer is the code of *31, which is to activate transparent call forwarding. See column 3, lines 10-58.

(Examiner's Answer at 6.) The appellants argue, "[n]owhere in Sonberg do any of the service requests lead directly to the establishment of a voice or other communication connection, as part of the same transaction. Sonberg merely describes an enabling transaction that allows subsequent (separate and independent) transactions to make voice calls." (Reply Br. at 6.)

"Analysis begins with a key legal question -- *what is the invention claimed?* Claim interpretation . . . will normally control the remainder of the decisional process." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "the Board must give claims their broadest reasonable construction. . . ." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Here, claim 6 specifies in pertinent part the following limitations: "service requests are initially directed from their originating network terminations by establishing a signalling connection to a service processing means . . . and the service processing means provides services to a network termination over the signalling connections, the service processing means also controlling switching means to establish a communications connection with the network termination only if required by the service requested." Despite the appellants' aforementioned argument, the claim neither recites that the service requests lead "directly" to the establishment of a communication connection nor recites that a communications connection is established "as part of the same transaction" as the service request.² Giving the representative claim its broadest, reasonable construction, the limitations require directing a request for a service from a network termination to a service processing means via signaling connections, responding to the service request via the signaling connections, and establishing a communications connection with the network termination if required by the requested service.

²Furthermore, we agree with the examiner that other "argued features such as subsequent connection and concurrent request are not recited in the rejected claim[]." (Examiner's Answer at 5.) At oral hearing, the appellants' counsel offered to amend the claims to more clearly specify the invention. We leave such matters to the appellants' prosecution before the examiner.

"Having construed the claim limitations at issue, we now compare the claims to the prior art to determine if the prior art anticipates those claims." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002). "[A]nticipation is a question of fact." *Hyatt*, 211 F.3d at 1371, 54 USPQ2d at 1667 (citing *Bischoff v. Wethered*, 76 U.S. (9 Wall.) 812, 814-15 (1869); *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). "A claim is anticipated . . . if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (citing *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 715, 223 USPQ 1264, 1270 (Fed. Cir. 1984); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983); *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983)).

Here, Sonberg discloses a "cellular telephone system," col. 2, ll. 27-28, which offers "a variety," *id.* at l. 9, of services. Among these services are "transparent call notification," *id.* at l. 13, and "caller notification." *Id.* at l. 14. Turning to the limitations at issue, it is uncontested that the reference's cellular telephone system directs requests for service from a network termination, i.e., "a roamer," col. 3, l. 5, to service processing means, which is "shown in FIG. 1," *id.* at ll. 31-32, via signaling connections

and responds to the requests via the signaling connections. To wit, the appellants admit that one type of "service request takes place when the roamer . . . requests call forwarding." (Reply Br. at 4.)³ They emphasize, "it is true that the setting up of call forwarding uses only signaling connections," (*id.* at 3), admitting that "establishing a call forwarding setting in the Home MTSO site is carried out by a multi-frequency signaling path (i.e., not a communications connection)." (*Id.*) For its part, Sonberg's description of "the activating of transparent call forwarding," col. 3, ll. 20-21, corroborates their admissions. Specifically, "[w]hen a roamer dials *31, the foreign MTSO switch 16 sends the mobile identification number (MIN) and the code for the selected call routing option to the VRS 12. In a preferred embodiment the physical interface is a T-1 (DS1 span), and multi-frequency (MF) signalling is utilized to pass the information from the switch 16 to the VRS 12." *Id.* at ll. 21-28.

In addition, it is uncontested that the reference's cellular telephone system can establish a communications connection with its roamer by forwarding a user's call thereto. To wit, the appellants admit, "[a] communications connection is . . . established if a call from another user is made to the roamer." (Reply Br. at 4.) More specifically,

³Another type of service request takes place when the roamer requests call notification.

they admit that "the Home MTSO site . . . establishes a communication connection when a call is *subsequently* made to the intended subscriber. . . ." (*Id.* at 3.)

Furthermore, we find that the aforementioned communications connection between the caller and the roamer is established if required by the service requested by the roamer. More specifically, when the caller attempts to call the roamer, the communication connection is established therebetween only if the roamer has requested the aforementioned service of transparent call forwarding. If the roamer has not requested that service, but has instead requested the service of caller notification, no communication connection is established between the caller and the roamer. Instead, "calls to the roamer will be routed to the VRS 12 located at the home site." *Id.* at ll. 6-7. "The VRS is programmed to analyze this digit spill and play a message to the caller which indicates where the roamer is located, and the roamer port access number that should be used to call the roamer." *Id.* at ll. 21-25. "An example of a message that would be played is: 'The person that you have called is out of the local area. If you wish to reach this person, please call 609-226-7626 in Atlantic City, N.J.'" *Id.* at ll. 25-28.

In summary, Sonberg's system directs requests for its call forwarding service and its call notification service from a roamer to service processing means and responds thereto via signaling connections. When a user attempts to call the roamer, the

reference's system establishes a communications connection between the caller and the roamer only if the service requested by the roamer was transparent call forwarding. If the service requested by the roamer was call notification, in contrast, the system will not establish such a communication connection between the caller and the roamer. Therefore, we affirm the anticipation rejection of claim 6, and of claims 1-5, 7-10, and 13-21, which fall therewith.

CONCLUSION

In summary, the rejection of claims 1-10 and 13-21 under § 102(e) is affirmed. "Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences. . . ." 37 C.F.R. § 1.192(a)(2002). Accordingly, our affirmance is based only on the arguments made in the briefs. Any arguments or authorities not included therein are neither before us nor at issue but are considered waived. No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

JOSEPH F. RUGGIERO
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

MAHSHID D. SADDAT
Administrative Patent Judge

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Appeal No. 2001-2055
Application No. 08/750,870

Page 12

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