

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 45

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MICHAEL E. BURKE, KENNETH A. FELIX, DANIEL TELL and  
JAMES M. WILLIAMS

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Appeal No. 98-0886  
Application No. 07/506,638

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ON BRIEF

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Before HAIRSTON, JERRY SMITH, and RUGGIERO, Administrative  
Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 27 in the application for reissue of U.S. Patent No. 4,737,978.

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The disclosed invention relates to a method of controlling handoff of radiotelephones moving from source cells of one radiotelephone system toward an adjacent radiotelephone system.

Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A method of controlling handoff of radiotelephones moving from source cells of one radiotelephone system toward an adjacent radiotelephone system, each radiotelephone system covering a different geographical area and having a plurality of cells for providing radiotelephone service to its corresponding geographical area, each cell having a plurality of radio channels and a radio coverage area established by fixed site radio apparatus, and each radiotelephone capable of handoff from a radio channel of one cell to a radio channel of another cell, said method comprising the steps of:

requesting a handoff in a source cell when the radiotelephone signal strength is less than a predetermined signal strength;

identifying adjacent cells of said one radiotelephone system when a handoff is requested;

determining if one of the identified adjacent cells is available for handoff;

determining if the adjacent radiotelephone system is available for handoff if one of the identified adjacent cells is not available; and

executing a handoff to the available one of the identified adjacent cells and the adjacent radiotelephone system.

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Claims 1 through 27 stand rejected under 35 U.S.C. §  
102(b) based upon public use or sale of the claimed invention.

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

#### BACKGROUND

In the reissue declaration filed April 9, 1990 (Appendix  
D, page 10), declarants stated inter alia that:

On June 14, 1985, Motorola executed a contract for  
delivery of DMX (inter-switch handoff) with  
MetroOne, the New York Cellular Telephone Co. This  
is the earliest domestic order accepted (although  
the British Telecom order was accepted earlier).

On August 5, 1985, Motorola accepted an order for  
DMX (inter-switch handoff) from GTE Mobilenet,  
Houston, Texas.

On or about August 27, 1985, Motorola executed a  
contract for delivery of DMX (inter-switch handoff),  
with American Cellular Network Corp for  
Longbranch/New Brunswick/Wilmington systems.

Sometimes in or about August, 1985 (but certainly on  
October 25, 1985), DMX (inter-switch handoff) was  
successfully demonstrated on an in-house, laboratory  
system to L.A. Cellular. The mere accomplishment of  
interswitch handoff, but not the details of the  
handoff algorithm itself, was important to the  
customer. No order resulted.

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From about September, 1985 up to October 25, 1985, DMX (inter-switch handoff) software was tested in off-hours on British Telecom's system in England.

On October 25, 1985, software enabling inter-switch handoff was successfully installed and demonstrated with British Telecom in England. Various problems were pursued over the next week or so. This represents the earliest of these activities.

Critical Date: October 30, 1985; more than one year prior to the filing date.

On October 31, 1985, three-switches (London2, Bristol & Birmingham) were connected in a DMX (inter-switch) configuration.

Declarants also stated (Appendix D, page 11) that "British Telecom, GTE Mobilenet, American Cellular Network Corp, and New York Cellular Telephone Co. were then and throughout, by blanket written agreement, under a general obligation of confidentiality to Motorola."

The foregoing instances of public use/sale of the DMX system were repeated in the Supplemental Declaration (Appendix C, page 9).

Based upon the noted instances of public use/sale of the DMX system, the examiner found that they constitute a bar under 35 U.S.C. § 102(b) (Answer, pages 4 and 5).

OPINION

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The instances of public use/sale of the DMX system described in the reissue declarations provided the examiner with enough evidence to reject the claims on appeal for public use/sale under 35 U.S.C. § 102(b). The burden of proof, therefore, shifted to appellants to prove otherwise.

The examiner's assessment (Answer, page 5) of the declaration submitted by Larry Svec (Appendix E) is repeated as follows:

Svec declares the testing of the product that incorporated the invention was not completed until after the critical date. It is unclear how the "testing" done by Svec relates to the subject matter as claimed in claims 1-27. From the Reissue Declaration of 4/90/1990 [sic, 4/9/1990] (page 10) it is clear that the DMX switch was offered for sale more than one year prior to the critical date. The Declaration of Svec establishes that some testing/modification occurred after the critical date, however, it is unclear how such modifications are embodied in the present claims, if at all.

We agree with the examiner that the Svec declaration fails to address the relevancy of the testing done in the U.K. to the claims on appeal. We also agree with the examiner (Answer, page 5) that:

Applicant makes no reference to "contract for delivery" on 6/14/1985 to MetroOne, the "order" for DMX from GTE MobileNet, or to "contract for delivery" on 8/27/95 to the American Cellular

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Network Corp (see Reissue Declaration, page 10).  
These activities constitute an offer for sale one  
year prior to the critical date [sic, filing date]  
and were not addressed in applicant's arguments or  
in the Svec Declaration.

Other than a discussion of contract work in the U.K.  
(presumably for British Telecom), the declaration and evidence  
submitted by appellants are totally silent as to the other  
public uses/sales of the claimed invention. The statements in  
the declarations concerning confidentially agreements between  
Motorola and the above-noted corporations are of little value  
in the absence of details from each of the agreements. For  
example, were the sales for the purpose of testing/refining  
the initial DMX design? What exactly had to be kept in  
confidence by the purchaser?

Appellants' arguments (Brief, pages 11 through 17) to the  
contrary notwithstanding, we find that the examiner's finding  
of public use/sale of the claimed invention has not been  
rebutted by the evidence submitted by appellants. Thus, we  
will sustain the 35 U.S.C. § 102(b) rejection of claims 1  
through 27.

DECISION

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The decision of the examiner rejecting claims 1 through 27 under 35 U.S.C. § 102(b) is affirmed.

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

AFFIRMED

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
JERRY SMITH	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JOSEPH F. RUGGIERO                    )  
Administrative Patent Judge         )

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APJ HAIRSTON

APJ JERRY SMITH

APJ RUGGIERO

DECISION: AFFIRMED  
Send Reference(s): Yes No  
or Translation (s)  
Panel Change: Yes No  
Index Sheet-2901 Rejection(s):

Prepared: January 12, 2001

Draft            Final

3 MEM. CONF.    Y            N

OB/HD           GAU

PALM / ACTS 2 / BOOK  
DISK (FOIA) / REPORT