

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERALD P. LABEDZ
and KHALID A. HAMIED

Appeal No. 1999-0470
Application 08/639,136

ON BRIEF

Before JERRY SMITH, BARRETT and LEVY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1, 3, 6-20, 22 and 25-32, which constitute all the claims remaining in the application.

The disclosed invention pertains to a method and

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apparatus for controlling a wireless communication system.

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Representative claim 1 is reproduced as follows:

1. A method of controlling a code-division multiple access (CDMA) wireless communication system, the CDMA wireless communication system including a mobile station responsive to a plurality of base-stations, the method comprising the steps of:

simulating parameters related to the CDMA wireless communication system in a simulator;

generating location information related to an analog wireless communication system which is a potential source of interference to the CDMA wireless communication system based on the simulation; and

controlling certain aspects of the CDMA wireless communication system utilizing the data generated.

The examiner relies on the following references:

Markus	5,561,841	Oct. 1, 1996 (filed Sep. 15, 1994)
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Claims 1, 3, 6-20, 22 and 25-32 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Markus taken alone.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the

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evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1, 3, 6-20, 22 and 25-32. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references

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to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

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Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

The examiner indicates how he perceives the claimed invention to be taught by the disclosure of Markus [answer, pages 3-4]. With respect to independent claims 1 and 20, appellants argue that Markus does not teach the simulation of one type of system to determine how it will affect another type of system. Specifically, claims 1 and 20 recite that a code-division multiple access (CDMA) system is controlled based on potential interference from an analog wireless system. The examiner responds that Markus can simulate any type of communication system [answer, pages 4-7].

We agree with appellants. Markus teaches that a communication system can be simulated to determine how to achieve optimum performance of that communication system. As argued by appellants, however, Markus does not relate to modifying one communication system based on potential interference from a second communication system. Claims 1 and

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20 recite controlling a CDMA wireless communication system based on location information related to an analog wireless communication system. Markus simply does not take into account in his simulation the effect that other communication systems might have on his system. Therefore, we do not sustain the rejection of independent claims 1 and 20 and of claims 3, 6, 7, 22, 25 and 26 which depend therefrom.

With respect to independent claims 8 and 27, appellants argue that Markus does not teach or suggest controlling a mobile station to avoid interference before it occurs [brief, page 9]. The examiner responds that this feature of the invention reads on the step and apparatus in Markus for changing system control parameters on the basis of the simulation [answer, page 7].

We again agree with the position argued by appellants. Markus teaches that the movement of mobile stations within the cellular network can be simulated to determine the effect such movement might have on the communication system. As a result of this simulation, Markus changes system control parameters. These system control parameters, however, appear to relate only to aspects of the base stations. In other words,

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although Markus teaches adjusting parameters of the base stations in response to various simulations, Markus does not teach or suggest controlling the mobile stations to avoid interference before the interference occurs. Therefore, we do not sustain the rejection of independent claims 8 and 27 or of claims 9-13, 16 and 28-32 which depend therefrom.

With respect to independent claim 14, appellants argue that the recitation of simulating characteristics of signals, analyzing the simulated characteristics and entering soft handoff based on the analysis is not the same as merely claiming soft handoff as asserted by the examiner [brief, page 9]. The examiner responds that the skilled artisan would have recognized the conventionality of soft handoff as compared with hard handoff and would experience no difficulty in selecting the one appropriate for the condition [answer, page 10].

Neither of the statements of appellants and the examiner properly addresses the obviousness of the claimed invention. The proper question should be whether it would have been obvious in the simulation disclosed by Markus to simulate the effects of soft handoffs and to have a base station enter a soft handoff with a simulated mobile station in response to the results of the simulation. Since Markus never mentions a soft handoff, we do not see how one can find that Markus would have suggested the simulation of soft handoffs in order to adjust the control of base stations in handling such soft handoffs. Any other finding would be sheer

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speculation. Therefore, we do not sustain the rejection of claims 14 and 15.

With respect to independent claim 17, appellants argue that there is no suggestion in Markus of placing a new base station based on interference of other base stations with respect to first and second radii [brief, page 10]. The examiner does not respond to this argument, but the initial rejection indicated that the recited radius measuring was analogous to the distance data disclosed by Markus.

Although we agree with the examiner that Markus does take into account the distance between a mobile station and the base stations, there is no suggestion in Markus that first and second radii as claimed should be used for the placement of a new base station. Therefore, we do not sustain the rejection of claims 17-19.

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In summary, we have not sustained the examiner's rejection with respect to the any of the appealed claims. Therefore, the decision of the examiner rejecting claims 1, 3, 6-20, 22 and 25-32 is reversed.

REVERSED

JERRY SMITH)
Administrative Patent Judge)
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) BOARD OF PATENT
LEE E. BARRETT)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
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