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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JEYHAN KARAOGUZ and JAMES BENNETT

Appeal 2011-003715
Application 10/675,443
Technology Center

Before JOSEPH L. DIXON, ST. JOHN COURTENAY III, and CARLA M. KRIVAK, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Patent Examiner finally rejected claims 1-30. Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

INVENTION

This invention relates "to providing server architectures for the registering devices and the exchange of media, data, and services between devices on a media exchange network." (Spec. 2). Claim 1, reproduced below, is illustrative of the claimed subject matter:

> 1. A method for setting up devices for communication, the method comprising:
>
> [a] in a communication network comprising a headend, wherein said headend enables access to said communication network for at least a first device,
>
> [b] assigning, by said headend, an address to said first device coupled to said communication network, wherein said address is associated with said first device in said communication network at a time of said assigning;
>
> [c] transferring, by said headend, said assigned address to said first device; and
>
> [d1] *in response to said headend receiving an identifier of said first device from said first device*, [d2] *communicating, by said headend, one or both of said transferred assigned address and/or said identifier of said first device to at least one communication server coupled to said communication network.*

(Disputed limitation emphasized).

REJECTION

Claims 1-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings and suggestions of U.S. Patent No. 6,272,129 B1 ("Dynarski") and U.S. Patent No. 6,934,754 B2 ("West").

ANALYSIS

***Issue*:** Under § 103, did the Examiner err in finding that the cited references, either alone or in combination, would have taught or suggested "[d1] *in response to said headend receiving an identifier of said first device from said first device*, [d2] communicating, by said headend, one or both of said transferred assigned address and/or said identifier of said first device to at least one communication server coupled to said communication network," within the meaning of claim 1, and the commensurate language of claims 11 and 21?

The Examiner finds that Dynarski, column 6, line 55 to column 8, line 50, would have taught or suggested the limitation at issue. (Ans. 4).

In response to Appellants' contentions in the Appeal Brief, the Examiner further reasons:

> Again, appellant seems to be under the impression that, despite the device interacting only with the headend, the communication server acts on its own. In doing so, appellant glosses over communications from the headend to the server, i.e. the access-request message that includes transferred assigned addresses and/or identifiers. Without this request, the server would never provide an accept or response message, let alone one with the information the headend desires. This message is in response to the device because the headend makes the request in response to a communication from the device, i.e. a request for connection that includes the information.

(Ans. 9).

Appellants disagree:

Appellant, notes however, that home agent 22 (the alleged headend) does not issue the Access-Request message in response to a communication from the mobile device 14 (the alleged first device). Instead, Dynarski clearly teaches that home agent 22 issues the access-request message when it receives an I P packet from a terminal 10 on the network 12, which is destined for the mobile device 14.

> A presently preferred method by which a mobile wireless communications device (e.g., laptop computer 14) is automatically located and connected to the packet-switched network 20 and ultimately the remote terminal 10 will now be described. **First, an Internet Protocol (IP) packet from a terminal 10 on the network 12 and destined for the device 14 is relayed by router 18 onto the WAN 20 where it is received by the home agent 22.** At this point, the home agent 22 detects that it does not have a mobility binding record which can be used to route the packet to the device 14, since, for example, there is no current I P session in progress between the device 14 and the home agent 22. Instead of dropping the packet, as would normally be the case in the prior art, **the home agent then transmits an Access-Request message to the authentication server 28 for authentication. The Access Request message includes the destination IP address for the wireless device 14 that was included in the IP packet from the terminal 10 on the network.** The purpose of the Access-Request message is to authenticate the user who owns device 14 to be sure that they are allowed to receive the call, e.g., that they are a current subscriber with the wireless network 40, their bill is not in arrears, etc.

> *(See, e.g.,* Dynarski, 6:55-7:8.) As this passage makes clear, the Access-Request message is issued in response to a communication from the terminal 10, not the device 14 as is apparently alleged by the Examiner.

(Reply Br. 7-8).

We note that in an *ex parte* appeal, the Board "is basically a board of review—we review . . . rejections made by patent examiners." *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (BPAI 2001). "The review authorized by 35 U.S.C. Section 134 is not a process whereby the examiner . . . invite[s] the [B]oard to examine the application and resolve patentability in the first instance." *Ex parte Braeken*, 54 USPQ2d 1110, 1112 (BPAI 1999).

Because the Board is basically a board of review, and not a place of initial examination, we will not engage in the *de novo* examination required to precisely map each of Appellants' claim limitations to the Examiner's general citation covering multiple columns of text. (Ans. 4, 9).

Although the Examiner relies upon Dynarski's first device's (14) "request for connection" to teach or suggest the limitation "[d1] in response to said headend receiving an identifier of said first device from said first device" (claim 1, Ans. 9), the Examiner does not cite to a *specific* line to identify which element in the two columns of cited text corresponds to the "request for connection." (Ans. 9). To affirm the Examiner on this record would require speculation on our part. We decline to engage in speculation.

We are also persuaded by Appellants' contentions that "the Access-Request message is issued in response to a communication from the terminal 10, and not the device 14 as is apparently alleged by the Examiner" (Reply Br. 8), since Dynarski teaches:

(1) a terminal 10 sends an Internet Protocol (IP) packet to the home agent 22 (col. 6, ll. 58-61; Fig. 1A), and

(2) in response to the Internet Protocol (IP) packet from the terminal 10 (not the device 14; *see* claim 1 [d1] *supra*), the home agent 12 then transmits an Access-Request message to the authentication server 28 for authentication. (col. 6, l. 65- col. 7, l. 1; Reply Br. 8; App. Br. 15).

For essentially the same reasons argued by Appellants in the Reply Brief pages 7-8, on this record we cannot affirm the Examiner's obviousness rejection of independent claims 1, 11, and 21. Because we have reversed the obviousness rejection for each independent claim before us on appeal, we also reverse the Examiner's rejection of each dependent claim.

DECISION

We reverse the Examiner's rejection of claims 1-30 under § 103.

ORDER

REVERSED

Vsh