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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RAMANATHAN T. JAGADEESAN and
CHRISTOPHER E. PEARCE

Appeal 2012-009711
Application 10/988,793
Technology Center 2600

Before CARLA M. KRIVAK, CARL W. WHITEHEAD JR., and DANIEL N. FISHMAN, *Administrative Patent Judges*.

WHITEHEAD JR., *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants are appealing the final rejection of claims 1–11 and 23–44 under 35 U.S.C. § 134(a). Appeal Brief 13. We have jurisdiction under 35 U.S.C. § 6(b) (2012).

We reverse.

Introduction

The invention is directed to a "handoff of communication sessions between cellular and desktop telephones." Appeal Brief 1.

Representative Claim (disputed limitations emphasized)

1. A method comprising:

anchoring a communication session, which involves a remote device and a cellular telephone, in an enterprise network such that signaling for the communication session passes through an element of the enterprise network;

receiving an indication to handoff the communication session from the cellular telephone to a desktop telephone coupled to the enterprise network;

placing the remote device in a holding state in response to the indication; and

handing off the communication session, which is anchored in the enterprise network, to resume the communication session between the desktop telephone and the remote device.

Rejection on Appeal

Claims 1–11 and 23–44 are rejected under 35 U.S.C. §103(a) as being unpatentable over Mohammad (US Patent Application Publication Number 2003/0119548 A1; published June 26, 2003) and Segal (US Patent Number 7,366,513 B2; issued April 29, 2008). Answer 4–17.

ANALYSIS

Rather than reiterate the arguments of Appellants and the Examiner, we refer to the Appeal Brief (filed March 8, 2012), the Answer (mailed April 16, 2012), and the Reply Brief (filed June 18, 2012) for the respective details. We have considered in this decision only those arguments Appellants actually raised in the Briefs.

Appellants contend "*Segal* merely discloses placing an active call on-hold responsive to a signal to provide an on-hold call and fails to disclose

placing an active call on-hold in response to an indication to handoff the call." Appeal Brief 14. Appellants further contend, "[I]n *Segal*, the remote device is not placed in a holding state *in response to* an indication to handoff the communication session (as required by Appellants' Claim 1), since the active calls are placed on hold before it is determined that a handoff is desired" and "*Mohammed* does not cure this deficiency, and the Final Office Action does not allege that it does." *Id*. at 14–15.

The Examiner finds Segal discloses "placing the remote device in a holding state." Answer 6 (citing Segal Figure 5, column 14, lines 40–44). The Examiner concludes that it would have been obvious to modify Mohammed by incorporating Segal's disclosure to "provide a method and/or system with ability of placing a remote device in a holding state." *Id*.

However, we find Appellants' arguments persuasive because Segal discloses "PLACE ONE OR MORE ACTIVE CALLS ON-HOLD" and then "DETERMINE THAT HANDOUT FROM NETWORK IS DESIRED" in the flowchart of Figure 5. Accordingly, one of ordinary skill in the art would not have modified Mohammed by placing the remote device in a holding state in response to an indication of a handoff as recited in claim 1 because Segal discloses determining a handoff after the call has been placed on hold. Segal Abstract.

Therefore, we do not sustain the Examiner obviousness rejection of independent claims 1, 23, and 34 as well as, dependent claims 2–11, 24–33, and 35–44.[1]

[1] Should there be further prosecution of this application (including any review for allowance), the Examiner may wish to review claims 23–33 for
(Footnote continued on the next page.)

DECISION

The Examiner's 35 U.S.C. § 103(a) rejection of claims 1–11 and 23–44 are reversed.

REVERSED

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compliance under 35 U.S.C. § 101 in light of the recently issued preliminary examination instructions on patent eligible subject matter. *See* "Preliminary Examination Instructions in view of the Supreme Court Decision in *Alice Corporation Pty. Ltd. v. CLS Bank International, et al.*," Memorandum to the Examining Corps, June 25, 2014.