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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* KAMEL M. SHAHEEN

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Appeal 2014-009164  
Application 13/412,198  
Technology Center 2600

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Before ST. JOHN COURTENAY III, CARLA M. KRIVAK, and  
JOYCE CRAIG, *Administrative Patent Judges*.

CRAIG, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–4, 6–7, and 10–17, which are all of the claims pending in this application.<sup>2</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

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<sup>1</sup> According to Appellant, the real party in interest is InterDigital Technology Corporation. App. Br. 3.

<sup>2</sup> According to Appellant, claims 5, 8, 9, and 18 have been canceled. App. Br. 14–17.

## INVENTION

Appellant's invention relates to a method and system for the interworking of cellular networks and wireless local area networks.

Abstract. Claim 1 is illustrative and reads as follows:

1. A wireless transmit/receive unit (WTRU) comprising:  
at least one transceiver configured to receive a user service from an Internet Protocol (IP) multimedia subsystem (IMS) via a wireless local area network (WLAN); and  
a handover controlling entity configured to:  
initiate a handover of the user service from the WLAN to a cellular network; and  
perform the handover while continuously receiving the user service from the IMS during the handover and maintaining a connection to the WLAN and a connection to the cellular network simultaneously.

## REJECTIONS<sup>3</sup>

Claims 1–3, 6, 11, and 12 stand rejected under 35 U.S.C. § 102(a) as anticipated by Salkintzis, "WLAN/3G Interworking Architectures for Next Generation Hybrid Data Networks" IEEE International Conference on Communications, Vol. 7, pp. 3984–88 (June 2004) ("Salkintzis").

Claims 4, 7, 10, and 13–17 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Salkintzis and Marsh et al. (US 2004/0266426 A1; published Dec. 30, 2004).

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<sup>3</sup> The Examiner also rejected claims 5, 9, and 18, which were pending at the time of the Final Action. Those claims were subsequently canceled and are not at issue in this appeal. *See* App. Br. 14–15.

## ANALYSIS

Appellant argues Salkintzis fails to disclose the limitation “perform the handover while continuously receiving the user service from the IMS during the handover,” recited in claim 1. App. Br. 8. Appellant acknowledges Salkintzis describes that users may access “the same set of services” while roaming, but Appellant disagrees that such disclosure teaches performing a handover while continuously receiving a user service from the IMS, as claim 1 requires. *Id.* at 9.

In response, the Examiner explains that Salkintzis discloses “the subscriber is able to maintain access to the same set of services as the subscriber roam[s] between WLAN and 3G radio network[s], which is considered as the handing over from one network to another network while continuously receiving the same set of service[s].” Ans. 3 (citing Salkintzis p. 3987–88). The Examiner further explains that “the user services can have access to services such IP multimedia services from its operator’s IP Network,” which “is considered as the recited ‘IMS’.” *Id.* (citing Salkintzis Fig. 4). Therefore, the Examiner finds Salkintzis discloses performing the handover by roaming between WLAN and 3G, while still receiving the service from the operator's IP network. *See id.*

“A claim is anticipated only 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. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) (citations omitted).

We are persuaded by Appellant’s arguments that the Examiner erred. *See App. Br.* 11–12. The Examiner finds Salkintzis discloses (1) access to services such as IP multimedia services from its operator’s IP Network; and

(2) the subscriber is able to maintain access to the same set of services as the subscriber roams between WLAN and 3G radio networks. Final Act. 3; Ans. 3). Based on these findings, the Examiner asserts Salkintzis anticipates claim 1. The Examiner's finding, however, is based on speculation and lacks the supportive evidence needed to establish a *prima facie* case of anticipation. See Ans. 3. The Examiner has not identified, nor do we find, any express or inherent description in Salkintzis of “*continuously* receiving the user service from the IMS *during the handover*,” as claim 1 recites (emphasis added). See *Verdegaal Bros.* 814 F.2d at 631.

Accordingly, on the record before us, we do not sustain the 35 U.S.C. § 102(a) rejection of independent claim 1, independent claim 6, which recites similar limitations, or claims 2, 3, 11, and 12, dependent therefrom.<sup>4</sup> See App. Br. 11–12. We also do not sustain the 35 U.S.C. § 103(a) rejection of the remaining claims because the Examiner has not identified any teachings in the other applied prior art to overcome the above-noted deficiency of Salkintzis.

## DECISION

We reverse the decision of the Examiner rejecting claims 1–4, 6–7, and 10–17.

## REVERSED

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<sup>4</sup> We do not address Appellant’s other contentions in support of the patentability of claim 1 because the argument discussed above is dispositive of the issue in this appeal.