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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARKO TAPANI AKSELIN, JARKKO TUOMO KOSKELA,
JUSSI-PEKKA KOSKINEN, and MARKO TAPANI NIEMI

Appeal 2015-005957
Application 13/319,315¹
Technology Center 2400

Before BRUCE R. WINSOR, ADAM J. PYONIN, and
SHARON FENICK, Administrative Patent Judges.

FENICK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner's Final Rejection of claims 20–36, all the pending claims in the present application. (Appeal Br. 1.) We have jurisdiction over the appeal under 35 U.S.C. § 6(b)(1).

We AFFIRM.

¹ According to Appellants, the real party in interest is Nokia Corporation. (Appeal Br. 2.)

Invention

Appellants' invention relates to handling a legacy circuit-switched communication. A determination is made that a received service request message includes a request to establish communication requiring a circuit-switched connection, where an end point of the communication is user equipment (UE) connected to and engaged in communication over a packet-switched network as an end point of the communication. Based on this determination, the UE releases itself from the packet-switched network by autonomously re-selecting the UE to a circuit switched network. (Spec. Abstract, ¶¶ 59–62.)

Representative Claim

Claim 20, reproduced below, is representative:

20. A method, comprising
determining, in a user equipment connected to a packet switched network that does not support circuit switched fallback, that the user equipment is an end point for a communication requiring a circuit switched connection; and
initiating a release of the user equipment from the packet switched network by autonomously re-selecting, by the user equipment, the user equipment to a circuit switched capable cell, wherein the user equipment is engaged in an active packet switched communication when the determining takes place.

Rejection

Appellants appeal the following rejection:

Claims 20–36 are rejected under 35 U.S.C. § 103(a) as unpatentable over Tenny et al. (US 2010/0113010 A1; May 6, 2010) and Fox et al. (WO 2008/023162 A2; Feb. 28, 2008). (Final Action 3–9.)

Issues

Appellants raise the following issues:

(A) Did the Examiner err in finding that the combination of Tenny and Fox discloses “determining . . . that the user equipment is an end point for a communication requiring a circuit switched connection . . . wherein the user equipment is engaged in an active packet switched communication when the determining takes place,” as in claim 20?

(B) Did the Examiner err in finding that the combination of Tenny and Fox discloses “initiating a release of the user equipment from the packet switched network by autonomously re-selecting, by the user equipment, the user equipment to a circuit switched capable cell,” as in claim 20?

(C) Did the Examiner err in combining Tenny and Fox?

ANALYSIS

(A) “determining. . . that the user equipment is an end point for a communication requiring a circuit switched connection . . . wherein the user equipment is engaged in an active packet switched communication when the determining takes place”

The Examiner finds that the combination of Tenny and Fox discloses all the elements of claim 1, including the determination that the UE is an end point, wherein the user equipment is engaged in an active packet switched communication during the determination. (Final Action 3–4; Answer 11–14.) Specifically, the Examiner finds that Tenny discloses the determination in UE that the UE is an end point for a communication requiring a circuit-switched network. (Final Action 3–4, citing Tenny ¶¶ 26–29, 56–58.) The Examiner further finds that Fox teaches the handing off to a circuit-switched

network may occur when UE is engaged in a packet-switched communication. (*Id.* at 4, citing Fox pages 15, 16, 22.)

Appellants argue that Tenny fails to explicitly recite the claimed determination occurring at a time when the user equipment is engaged in an active packet-switched communication, as claimed. (Appeal Br. 14–16; Reply Br. 7–8.) Additionally, Appellants argue that Fox, at best, discloses a transfer of a call from a packet-switched network to a circuit-switched one. (*Id.*) However, Appellants fail to provide any arguments addressing the Examiner’s findings with respect to the teaching of the combination of Tenny and Fox. With respect to this issue, we adopt the findings and conclusions of the Examiner. (Answer 13–14.)

Specifically, we agree that Appellants’ argument focuses on the references individually instead of addressing the Examiner’s rejection, which is based upon what the combined teachings would have suggested to the ordinary artisan. *See* Answer 13; *see also In re Keller*, 642 F.2d 413, 425 (CCPA 1981). We evaluate whether the claim as a whole would have been obvious to an ordinarily-skilled artisan in light of the proffered combination of the prior art, accounting for “the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Appellants argue each reference is deficient regarding claim limitations that the Examiner has found taught or suggested by the other reference. That is, Appellants do not address the combination in this argument, but only the individual teachings of the references, and thus we are not persuaded of error in the Examiner’s finding that the disputed limitation is taught or suggested by the prior art combination.

(B) “initiating a release of the user equipment from the packet switched network by autonomously re-selecting, by the user equipment, the user equipment to a circuit switched capable cell”

The Examiner finds this claim limitation to be taught or suggested in Tenny’s UE performing “reselection” (Tenny ¶ 57) of the network to be used, and originating a voice call with a second wireless network if circuit-switched fallback is not supported by a first wireless network. (Final Action 4–5.)

Appellants argue that Tenny does not disclose the release of equipment from a packet switched network, because Tenny’s UE is not engaged in active communications with a network during the determination and therefore “there would be no reason to release . . . the user equipment from the packet switched network” in Tenny. (Reply Br. 7–8; Appeal Br. 16–17.) However, we agree with the Examiner (Answer 14–15) that the language of the claim does not require the UE to be in an active (or other non-idle) mode during the initiation of the release. While Appellants attempt to connect the release to the fact that the claimed determination occurs while the UE is engaged in an active communication, the wherein clause of the claim specifies only that there be active communications during the determination. Thus, we do not find the Appellants arguments persuasive of error in the Examiner’s findings with reference to this disputed limitation. Additionally, Appellants have not persuaded us that Tenny’s reselection, when combined with Fox’s teaching of handoff during an active packet switched communication, would not “release . . . the user equipment” as claimed.

(C) Combination of Tenny and Fox

Appellants argue in a conclusory fashion that the combination of Tenny and Fox would require a fundamental change in the principle of operation of Tenny, because Tenny is concerned with circuit-switched fall back in idle mode, and Fox with handovers. (Appeal Br. 18–19.)

A skilled artisan would “be able to fit the teachings of multiple patents together like pieces of a puzzle” since the skilled artisan is “a person of ordinary creativity, not an automaton.” *KSR*, 550 U.S. at 420–21. On this record, Appellant does not present sufficient evidence that the combination of the cited references was “uniquely challenging or difficult for one of ordinary skill in the art” or “represented an unobvious step over the prior art.” *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418–19).

Additionally, Appellants argue that Tenny and Fox are not analogous art, however, Appellants do not address whether (1) whether either reference is from the same field of endeavor as the invention, or, if not, (2) whether either reference would have been reasonably pertinent to the particular problem with which the inventor is involved. *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004).

Therefore, we sustain the 35 U.S.C. § 103(a) rejection of independent claim 20, and of independent claims 28 and 36, and dependent claims 21–27 and 29–35, not argued separately. *See* 37 C.F.R. § 41.37(c)(1)(iv).

DECISION

We affirm the Examiner’s decision rejecting claims 20–36 under 35 U.S.C. § 103(a) as obvious over Tenny and Fox.

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Pursuant to 37 C.F.R. § 1.136(a)(1)(iv), no time period for taking any subsequent action in connection with this appeal may be extended.

AFFIRMED