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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/244,761	09/26/2011	Johanna Lisa Dwyer	29717-0559002	1325

94149 7590 10/28/2016  
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EXAMINER
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ART UNIT	PAPER NUMBER
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2466

MAIL DATE	DELIVERY MODE
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10/28/2016

PAPER

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JOHANNA LISA DWYER and PAUL MARCUS CARPENTER

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Appeal 2015-006453  
Application 13/244,761  
Technology Center 2400

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Before JOHN A. JEFFERY, BRADLEY W. BAUMEISTER, and  
DENISE M. POTHIER, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's decision to reject claims 1–6, 12–17, 23, and 24. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

## STATEMENT OF THE CASE

Appellants' invention counts signaling-connection-release-indication (SCRI) messages and resets a count responsive to receiving packet-switched (PS) data. Spec. ¶ 9. One embodiment resets a counter when the user equipment has uplink PS data available or the user equipment is paged. *See, e.g., id.* ¶¶ 324, 360. Claim 1, reproduced below with our emphasis, is illustrative:

1. A method comprising:

maintaining, at a user equipment (UE), a count of signaling connection release indication (SCRI) messages sent by the UE to a network, said count maintained while a SCRI inhibit timer is not running;

determining whether a current value of the count is equal to or exceeds a predetermined value;

responsive to the determination, stopping the sending of further SCRI messages with a cause set;

receiving packet switched (PS) data at the UE; and

*resetting the count at the UE responsive to receiving the PS data.*

## THE REJECTION

The Examiner rejected claims 1–6, 12–17, 23, and 24 under 35 U.S.C. § 103(a) as unpatentable over Young (US 2009/0129339 A1; May 21, 2009), Kuramoto (US 2010/0046533 A1; Feb. 25, 2010), and 3GPP TS 25.331 ver. 8.7.0, Rel. 8 (2009) (“3GPP”). Ans. 3–7.<sup>1</sup>

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<sup>1</sup> Throughout this opinion, we refer to (1) the Final Rejection mailed June 19, 2014 (“Final Act.”); (2) the Appeal Brief filed December 2, 2014 (“App. Br.”); (3) the Examiner’s Answer mailed April 30, 2015 (“Ans.”); and (4) the Reply Brief filed June 18, 2015 (“Reply Br.”).

## CONTENTIONS

The Examiner finds that Young discloses every recited element of claim 1 except for (1) determining whether a current count value is equal to or exceeds a predetermined value; (2) stopping sending further SCRI messages responsive to this determination; and (3) resetting the count responsive to receiving PS data. Ans. 3–7. The Examiner, however, finds that Kuramoto determines whether a count’s current value is equal to or exceeds a predetermined value, and stops sending further messages. *Id.* at 5. The Examiner also finds that 3GPP resets a V308 counter responsive to receiving PS data. *Id.* at 5–6. Based on these collective teachings, the Examiner concludes that claim 1 would have been obvious. *Id.*

Appellants argue that 3GPP does not reset a count responsive to receiving PS data. App. Br. 3; Reply Br. 1–2. According to Appellants, 3GPP resets the V308 counter when sending the first “RRC CONNECTION RELEASE COMPLETE” message, not in response to receiving PS data. App. Br. 3; Reply Br. 2.

Appellants further argue that the Examiner has not demonstrated any teaching, suggestion, or motivation to combine the references. App. Br. 4; Reply Br. 2. In Appellants’ view, 3GPP resets a counter at the beginning of the connection-release process. App. Br. 4; Reply Br. 2. But according to Appellants, if Young’s UE has data to transmit, the data connection would need to be available, not released. App. Br. 4; Reply Br. 2. Accordingly, Appellants argue that combining Young and 3GPP, as the Examiner proposes, would disrupt network operations. App. Br. 4; Reply Br. 2.

## ISSUES

(1) Under § 103, has the Examiner erred in rejecting claim 1 by finding that Young, Kuramoto, and 3GPP collectively would have taught or suggested resetting a count of SCRI messages at the UE responsive to receiving the PS data?

(2) Is the Examiner's combining the teachings of these references supported by articulated reasoning with some rational underpinning to justify the Examiner's obviousness conclusion?

## ANALYSIS

We begin by noting that the Examiner's findings related to Kuramoto's determination (Ans. 5) are undisputed. Rather, as noted above, this dispute centers on (1) the Examiner's reliance on Young and 3GPP for teaching the recited reset, and (2) whether it would have been obvious to combine Young's process with 3GPP's reset. *See* App. Br. 2–5; Reply Br. 1–2.

Regarding the first issue, the key disputed limitation of claim 1 recites, in pertinent part, that the reset is “responsive to receiving” PS data. The term “responsive to receiving” is undefined in the Specification. For example, the Specification merely restates this limitation in summarizing the invention. Spec. ¶ 9, *cited in* App. Br. 1. Elsewhere, the Specification further discloses that a counter is reset when the UE has uplink PS data available or the UE is paged. *See, e.g.*, Spec. ¶¶ 324, 360. But Appellants have not defined this limitation to so limit our interpretation. So in light of this disclosure, we interpret “responsive to receiving” with its plain meaning.

The phrase “responsive to” connotes a cause-and-effect relationship between two events. *See Am. Calcar, Inc. v. Am. Honda Motor Co.*, 651 F.3d 1318, 1339–40 (Fed. Cir. 2011) (affirming the construction of “in response to” as requiring a first event to cause the second event); *see also Fujitsu Ltd. v. Belkin Int’l, Inc.*, No. 10-CV-03972-LHK, 2012 WL 4497966, at \*29 (N.D. Cal. Sept. 28, 2012) (unpublished) (construing “in response to” as requiring a cause-and-effect relationship). So a broad, but reasonable, interpretation of claim 1 requires that the PS-data reception causes the recited reset.

Given this interpretation, we are unpersuaded that the Examiner erred in concluding that it would have been obvious to reset a counter, as taught by 3GPP, responsive to Young’s data reception. Ans. 4.

In particular, the Examiner cites Young’s paragraphs 40 and 35 for teaching the recited PS-data reception. *Id.* In the cited embodiment, Young’s connection manager tracks applications and associated Packet Data Protocol (PDP) contexts and associated PS radio resources. Young ¶ 35, *cited in* Ans. 4. For example, the connection manager transitions to idle mode when applications are not expected to exchange data. Young ¶ 36, *cited in* Ans. 4. To accomplish this, the connection manager sends a transition indication—e.g., an SCRI message—for the PS domain to request a transition. Young ¶ 36. The transition indication could simply indicate that the applications have completed a data exchange or are otherwise not expected to exchange any more data. *Id.* ¶ 39, *cited in* Ans. 4. The transition indication could also report the data buffer’s status. Young ¶ 40, *cited in* Ans. 4. Accordingly, we understand the Examiner to be mapping

this exchanged data to claim 1's received PS data. Ans. 4 (explaining that Young teaches "buffer data/ packet switched (PS) resource at the UE").

The issue, then, is whether it would have been obvious to reset a count of indication messages (SCRIs) "responsive to" receiving this data.

In concluding claim 1 would have been obvious, the Examiner relies on 3GPP to teach a counter-reset procedure. Ans. 5. 3GPP's V308 counter resets when sending the first "RRC CONNECTION RELEASE COMPLETE" message. 3GPP 1424, Table 13.2. As pointed out by Appellants, this occurs as part of a process to release the connection between the UE and the network. *See* Reply Br. 2.

On this record, we are unpersuaded by Appellants' argument that 3GPP's reset is not "responsive to" receiving PS data in the proposed combination. *See* App. Br. 3; Reply Br. 1–2. Specifically, under the Examiner's proposed combination (Ans. 3–7), a cause-and-effect relationship exists between (1) Young's above-discussed data exchange involving the UE receiving PS data (Young ¶¶ 35–40), and (2) releasing that connection (*id.* ¶ 36) causing 3GPP's counter-reset procedure. That is, *but for* Young's data exchange—i.e., the PS-data receipt—there would be no connection to release and, therefore, no counter reset. Therefore, the Examiner's combination satisfies the cause-and-effect relationship required by the "responsive to" limitation.

Moreover, we note that claim 1 does not preclude resetting responsive to receiving an earlier reception of PS data that is followed by other intervening events, in the above-described manner, because the claim contains "comprising" language in the preamble that does not exclude additional, unrecited elements. *See Genentech, Inc. v. Chiron Corp.*,

112 F.3d 495, 501 (Fed. Cir. 1997) (“‘Comprising’ is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.”) (citation omitted). That is, the recited reset need not immediately follow PS-data reception so long as the cause-and-effect relationship is satisfied.

Furthermore, we are unpersuaded that the proposed combination lacks articulated reasoning with some rational underpinning to justify the Examiner’s obviousness conclusion. *See* App. Br. 4; Reply Br. 2. First, Appellants’ contention that the proposed combination would have disrupted network communications is unsubstantiated attorney argument and, therefore, has little probative value. *See In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997). Second, the Examiner does not propose to release the connection when Young has PS data to transmit, as Appellants seem to suggest. *See* App. Br. 4; Reply Br. 2.

Rather, the Examiner reasons that because resetting a counter at the end of a process to be used again for a subsequent process is known in the art as suggested by 3GPP, resetting Young’s counter when the system transitions between different data transmission modes would have been obvious. *See* Ans. 5, 11–12 (noting that 3GPP resets a counter when transitioning to a different state or mode).

Although Appellants characterize 3GPP’s reset as occurring when the connection release process *begins*—not when it *ends* (Reply Br. 2)—Appellants do not persuasively rebut the Examiner’s finding that this reset occurs when transitioning to a different state or mode, and that such a teaching would have been applicable to Young’s transitions from one data

transmission state to another. Ans. 11–12. Therefore, Appellants do not persuasively rebut the articulated basis for Examiner’s proposed combination. *See* App. Br. 4; Reply Br. 2.

Accordingly, we sustain the Examiner’s rejection of claim 1, and claims 2–6, 12–17,<sup>2</sup> 23, and 24, not argued separately with particularity. *See* App. Br. 5; Reply Br. 1–3.

### CONCLUSION

The Examiner did not err in rejecting claims 1–6, 12–17, 23, and 24 under § 103.

### DECISION

The Examiner’s decision rejecting claims 1–6, 12–17, 23, and 24 is affirmed.

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<sup>2</sup> Claim 12 has only one element: a processor configured to perform five recited functions. It is well settled, however, that the phrase “processor configured to” can be used as a substitute for “means for,” and thus, may invoke the application of § 112, sixth paragraph. *Ex parte Lakkala*, 108 USPQ2d 1392, 1397 (PTAB 2013) (informative). *See also Ex parte Erol*, 107 USPQ2d 1963, 1969 (PTAB 2013) (informative) (holding the phrase “a processor adapted to” was used as a substitute for “means for”); *Ex parte Smith*, 108 USPQ2d 1198, 1203–04 (PTAB 2013) (informative) (holding the phrase “a processor programmed to” was used as a substitute for “means for”). We leave to the Examiner to determine whether that is the case here. And if so, we further leave to the Examiner to determine whether the system is equivalent to a single means to accomplish the recited functions and, therefore, an improper single-means claim under § 112, first paragraph. *See In re Hyatt*, 708 F.2d 712, 714–15 (Fed. Cir. 1983), *cited in* Manual of Patent Examining Procedure (MPEP) § 2164.08(a) (9th ed. Rev. 07.2015, Nov. 2015).

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

AFFIRMED