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EXAMINER

ESMAELIAN, MAJID

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte YU-CHIH JEN

Appeal 2016-000115
Application 12/052,756¹
Technology Center 2400

Before LARRY J. HUME, NORMAN H. BEAMER, and
JOHN D. HAMANN, *Administrative Patent Judges*.

HAMANN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant files this appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 69–76. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

THE CLAIMED INVENTION

Appellant's claimed invention relates to "handling random access procedure[s] in a wireless communications system, . . . [including] implementing timing alignment and resource request, so as to enhance

¹ According to Appellant, the real party in interest is Innovative Sonic Limited. App. Br. 2.

system efficiency.” Spec. ¶ 3. Claim 69 is illustrative of the subject matter of the appeal and is reproduced below.

69. A method for handling a random access procedure in a network of a wireless communications system comprising:

triggering, at a User Equipment (UE), a random access procedure;

receiving a random access response after triggering the random access procedure;

transmitting a message in response to receiving the random access response;

receiving a contention resolution from an eNB after transmitting a message in response to receiving the random access response during the random access procedure, wherein the eNB informs the UE, through the contention resolution, of an adoption of a Temporary Cell Radio Network Temporary Identifier (C-RNTI) of the UE that already has a C-RNTI other than the Temporary C-RNTI;

detecting the random access procedure success; and

deciding whether to adopt the Temporary C-RNTI based on whether the contention resolution is addressed to the Temporary C-RNTI, wherein when the contention resolution is received after receiving the random access response and is addressed to the Temporary Cell Radio Network Temporary Identifier (C-RNTI) of the UE that already has a C-RNTI, the UE adopts the Temporary C-RNTI as a new C-RNTI of the UE; and when the contention resolution is addressed to the C-RNTI of the UE, the UE keeps using the C-RNTI.

REJECTIONS ON APPEAL

(1) The Examiner rejected claims 69 and 73 under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement with respect to the following limitation: “eNB informs the UE of an adoption of a Temporary Cell Radio Network Temporary Identifier (C-RNTI).”

(2) The Examiner rejected claims 69–76 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Damnjanovic et al. (US 2010/0093386 A1; published Apr. 15, 2010) (hereinafter “Damnjanovic”) and Kitazoe (US 2010/0189071 A1; published July 29, 2010), collectively referred to hereinafter as “the combination.”

DISPOSITIVE ISSUES ON APPEAL

(1) Did the Examiner err in finding the Specification fails to provide sufficient support to comply with § 112’s written description requirement with respect to an eNB informing the UE of an adoption of a Temporary Cell Radio Network Temporary Identifier (C-RNTI)?

(2) Whether, under § 103(a), the Examiner erred in finding the cited portions of the combination, and Kitazoe in particular, teach or suggest “the eNB informs the UE, through the contention resolution, of an adoption of a Temporary Cell Radio Network Temporary Identifier (C-RNTI) of the UE that already has a C-RNTI other than the Temporary C-RNTI,” as recited in claims 69 and 73?

ANALYSIS

We find Appellant’s arguments persuasive with respect to the dispositive issues.

(1) § 112 rejection

Appellant argues the Examiner errs in rejecting claims 69 and 73 under the written description requirement of § 112, first paragraph, because the Specification supports the disputed limitation. *See* App. Br. 4; Reply Br. 4. Specifically, Appellant argues the Specification’s paragraph 83 discloses that the “eNB informs the UE of an adoption of a Temporary Cell Radio Network Temporary Identifier (C-RNTI).” App. Br. 4. Paragraph 83

states:

Preferably, in the embodiment of the present invention, the network can use a C-RNTI of the UE or a T-CRNTI corresponding to the UE, to address the message 4 to the UE. In such a situation, if the network uses the temporary C-RNTI to address the message 4 to the UE, the UE shall adopt the T-CRNTI as the C-RNTI. Oppositely, if the network uses the C-RNTI of the UE to address the message 4 to the UE, the UE keeps using the C-RNTI.

Spec. ¶ 83. Appellant argues the eNB's use of "the temporary C-RNTI informs the UE that the network has adopted a temporary C-RNTI." App. Br. 4; Reply Br. 4 (emphasizing paragraph 83 states "if the network uses the temporary C-RNTI to address the message 4 to the UE, the UE shall adopt the T-CRNTI as the C-RNTI").

The Examiner finds paragraph 83 of the Specification discloses "that it is [the] 'UE' that adopts T-CRNTI as the CRNTI, wherein the claim language is geared toward the 'Network' adopting UE's Temporary CRNTI or T-CRNTI." Ans. 14 (citing Spec. ¶ 83).

We agree with Appellant's arguments, and we find one of ordinary skill in the art would understand the network (eNB) adopts a temporary C-RNTI — and informs the UE of such — when the eNB uses the temporary C-RNTI to address a message to the UE, and would reasonably conclude, in light of the Specification, that Appellant had possession of this aspect of the claimed invention at the time the Specification was filed. *See In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989); Spec. ¶ 83.

Accordingly, we do not sustain the Examiner's § 112 rejection.

(2) § 103(a) rejection

Appellant argues the combination, and Kitazoe in particular, fails to teach or suggest “the eNB informs the UE, through the contention resolution, of an adoption of a Temporary Cell Radio Network Temporary Identifier (C-RNTI) of the UE that already has a C-RNTI other than the Temporary C-RNTI,” as recited in claims 69 and 73. App. Br. 6. Appellant contends, rather than teaching “that adoption of [a] Temporary C-RNTI is based on whether contention resolution is addressed to [the] Temporary C-RNTI,” Kitazoe instead teaches adoption of the Temporary C-RNTI depends on whether the UE already has a C-RNTI. *Id.* (citing Kitazoe ¶ 45). Appellant further contends simply having contention resolution addressed to a Temporary C-RNTI does not teach adoption of the Temporary C-RNTI based on whether contention resolution is addressed to the Temporary C-RNTI. *Id.*

The Examiner finds the combination, and Kitazoe in particular, teaches or suggests “that promotion of C-RNTI is based on whether the contention resolution is addressed to the Temporary C-RNTI.” *See* Ans. 16. Specifically, the Examiner finds Kitazoe teaches “that the Temporary C-RNTI may be promoted to the C-RNTI if the UE detects *successful random access* (i.e., message 4) and does not already have a valid C-RNTI.” Ans. 17 (citing Kitazoe ¶¶ 44–48, Fig. 4). The Examiner then finds because “[m]essage 4 is part of random access procedure, then it could be broadly understood that the promotion of Temporary C-RNTI can be based on contention resolution addressed to the Temporary C-RNTI.” Ans. 18. The Examiner, thus, finds that Kitazoe teaches or suggests the disputed limitation.

We are persuaded by Appellant’s pertinent arguments. We agree with Appellant that the Examiner cited portions of Kitazoe fail to teach or suggest “the eNB informs the UE, through the contention resolution, of an adoption of a [temporary C-RNTI].” *See, e.g.,* Kitazoe ¶ 45 (“The Temporary C-RNTI may thus be promoted to the C-RNTI if the UE detects successful random access and does not already have a valid C-RNTI. The Temporary C-RNTI may be dropped by the UE if it already has a valid C-RNTI.”). Rather, Kitazoe teaches the UE can adopt the temporary C-RNTI *if it does not have one already*, and if it does have one, then the UE can just drop the temporary C-RNTI. *See id.* Thus, Kitazoe’s teachings show that adoption depends on whether the UE has a C-RNTI – not on how the contention resolution is addressed. *See id.*

Accordingly, we do not sustain the Examiner’s § 103(a) rejection of claims 69 and 73, as well as claims 70–72 and 74–76, which depend therefrom respectively.

DECISION

We reverse the Examiner’s decision rejecting claims 69–76.

REVERSED