



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/514,063	09/05/2012	Robert Baldemair	4015-8151 / P30749-US2	2438
24112	7590	11/22/2016	EXAMINER	
COATS & BENNETT, PLLC 1400 Crescent Green, Suite 300 Cary, NC 27518			GANGULY, SUMITRA	
			ART UNIT	PAPER NUMBER
			2411	
			MAIL DATE	DELIVERY MODE
			11/22/2016	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERT BALDEMAIR, DIRK GERSTENBERGER,
DANIEL LARSSON, and HENNING WIEMANN

Appeal 2016-000997
Application 13/514,063
Technology Center 2400

Before BRUCE R. WINSOR, NABEEL U. KHAN, and
AARON W. MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants¹ appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 16–18, 20–23, and 25–27, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse and enter a new ground of rejection.

THE INVENTION

The application is directed to “methods for data transmission via a plurality of carriers.” (Spec. 8.) Claim 16, reproduced below, is representative:

16. A method of data transmission via a plurality of carriers, the method being implemented by a user equipment and comprising:

determining a control element of a Media Access Control protocol, the control element being associated with a plurality of the carriers;

providing the control element with a respective identifier for each of the associated carriers; and

sending the control element with the plurality of identifiers on one of the carriers;

wherein the control element comprises a respective power headroom report for each of the associated carriers.

¹ Appellants identify Telefonaktiebolaget LM Ericsson (publ) as the real party in interest. (*See* App. Br. 2.)

THE REFERENCES AND THE REJECTION

Claims 16–18, 20–23, and 25–27 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Kim et al. (US 2011/0092217 A1; published Apr. 21, 2011) and Guo et al. (US 2010/0238863 A1; published Sept. 23, 2010). (*See* Final Act. 3–15.)

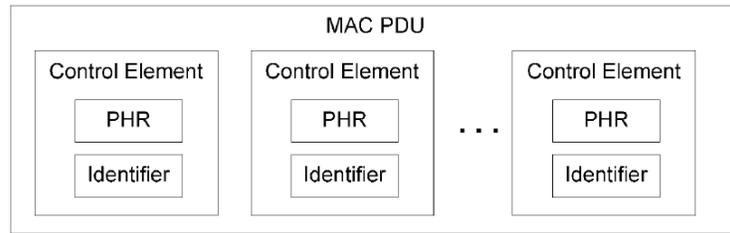
ANALYSIS

The Examiner relies primarily on Kim, but finds that “Kim is silent about the control element with the plurality of the carriers, control element with a respective identifier for each of the carriers, and control element comprises a respective power headroom report for each of the carriers.” (Final Act. 6.) The Examiner further finds, however, that such an arrangement was known from Guo, which discloses the following:

[T]he PHR values of the configured uplink carriers can be together transmitted in a pre-defined uplink carrier, or can be individually transmitted in its corresponding uplink carrier. For the case that the PHR values are all transmitted in the pre-defined uplink carrier, the UE may generate a plurality of PHR Control Elements carried by a same MAC PDU according to the PHR values of each configured uplink carrier. Each PHR Control Element may have an identification field, for identifying which uplink carrier the carried PHR value is corresponding to. The identification field can be included either in the PHR Control Element, or in a MAC sub-header corresponding to the PHR Control Element.

(Guo ¶ 36; *see* Final Act. 6.)

Appellants argue the Examiner’s findings are “erroneous because ¶ [0036] clearly teaches that only one PHR is included per CE.” (App. Br. 5–6, emphasis omitted.) In support of their argument, Appellants offer the figure below, said to “depict what is taught by ¶ [0036] of Guo”:



Appellants' Illustration of ¶ 36 of Guo

(App. Br. 6.)

The Examiner responds by equating the drawing in Appellants' brief with Figure 6 of Appellants' application, concluding that, from a comparison of the respective figures, "it can be easily seen that a control element comprises a respective PHR and identifier for each of its associated carriers." (Ans. 12.)

We agree with Appellants. The Examiner's analysis is flawed because, as Appellants point out (*see* Reply Br. 3), Figure 6 of the application represents a single MAC control element,² including a plurality of carriers, whereas the figure from the brief represents Guo's MAC PDU, which includes a plurality of MAC control elements, each including a single carrier identifier. Although paragraph 36 of Guo does teach identifiers and PHRs for a plurality of carriers in a MAC PDU, it does not teach identifiers and PHRs for a plurality of carriers in a MAC control element.

For these reasons, we do not sustain the rejection of claim 16, or the rejections of claims 17–18, 20–23, and 25–27, each of which requires a control element with a headroom report and identifier for a plurality of carriers.

² *See* Spec. 10:35–11:2 ("In some embodiments, in order to reduce overhead it may be more efficient though to generate only one MAC CE with multiple PH and CCI fields as shown in Fig. 6.").

NEW GROUND OF REJECTION
UNDER 37 C.F.R. § 41.50(B)

Claims 16–18, 20–23, and 25–27 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kim and Guo.

We adopt the Examiner’s findings and explanations regarding the teachings of Kim and Guo and their combination (*see* Final Act. 3–15), except for the Examiner’s reliance on paragraph 36 of Guo.

Regarding the requirement of the claims that a control element include an identifier and power headroom report for each of a plurality of carriers, we find that, although such an arrangement is not disclosed in paragraph 36 of Guo, it is taught or suggested in paragraph 37, which states that “the PHR values of the configured uplink carriers can be all carried by one PHR Control Element” and that “the PHR Control Element may have an identification field, for identifying which uplink carrier the carried PHR value is corresponding to.” (Guo ¶ 37.)

Appellants’ argument that “[t]here is no disclosure in ¶ [0037], or any other portion of Guo that a single MAC CE includes a respective identifier for each of a plurality of carriers” (App. Br. 8) is unpersuasive because we do not read the disclosure so narrowly, concluding one of skill in the art would understand that, in teaching multiple PHR values in one control element and identification fields for PHR values that may be in control elements, it contemplates an identification field in the control element for each of the multiple PHR values in that control element. Moreover, even if that were not the case (or if these concepts were aspects of different

embodiments³), we find that it would have been obvious to include the multiple identification fields in the control element with the multiple PHR values because the skilled artisan would have been “able to fit the[se] teachings . . . together like pieces of a puzzle” and the combination does no more “than yield a predictable result.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416, 420 (2007).

NEW GROUND

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).

37 C.F.R. § 41.50(b) provides that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review” and that Appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) reopen prosecution by submitting an appropriate amendment of the claims so rejected, or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner; or

³ We do not agree with Appellants’ “different embodiments” arguments, as paragraph 37 of Guo describes both features as options “in other embodiments,” which would include an embodiment with both features, and the provisional lists them as possible features for “Option 1” of “Invention 2.” (See ’863 Provisional at 3.)

Appeal 2016-000997
Application 13/514,063

(2) request that the proceeding be reheard under § 41.52 by the Board upon the same Record.

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

REVERSED
37 C.F.R. § 41.50(b)