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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL J. COOK and IVAN ONG

Appeal 2016-001971
Application 13/351,585
Technology Center 2600

Before JAMES R. HUGHES, LINZY T. McCARTNEY, and
JOHN D. HAMANN, *Administrative Patent Judges*.

McCARTNEY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a rejection of claims 1–4, 6, and 8–17. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

STATEMENT OF THE CASE

The present patent application concerns “providing a WiFi network and managing the same.” Spec. ¶ 1. Claim 1 illustrates the claimed subject matter:

1. A method, comprising:
 - receiving location information of a first transceiver from the first transceiver;
 - in response to a determination that a first coverage area of the first transceiver overlaps with a second coverage area of a second transceiver, determining whether the first transceiver is available to move based at least on whether the first transceiver is providing service to any device.

REJECTIONS

Claim 8 stands rejected under 35 U.S.C. § 112(a) as failing to comply with the written description requirement.

Claims 1 and 8–17 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Kalhan (US 2010/0216461 A1; Aug. 26, 2010) and Kong (US 2011/0009098 A1; Jan. 13, 2011).

Claims 2, 3, and 6 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Kalhan, Kong, and Tang (US 2005/0076137 A1; Apr. 7, 2005).

Claim 4 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Kalhan, Kong, Tang, and Wu et al. (US 2013/0064089 A1; Mar. 14, 2013).

ANALYSIS

§ 112 Rejection

The Examiner found Appellants' written description does not provide adequate support for the following limitation recited in claim 8:

wherein the determining whether the first transceiver is available to move based on at least whether the first transceiver is providing service to any device comprises determining whether the first transceiver is available to move based on at least whether the first transceiver is providing network access to any device.

See Final Act. 4; Ans. 5. In particular, the Examiner found the written description does not describe “determining whether the first transceiver is available to move based on at least whether the first transceiver is providing network access to any device.” Ans. 5

Appellants argue at least paragraphs 2, 22, 28, and 67 of the written description provide adequate support for the disputed limitation. *See* App. Br. 3–4; Reply Br. 2–9. According to Appellants, paragraph 67 teaches determining whether to move a transceiver based on whether the transceiver is providing a service, and the remaining paragraphs make clear that “providing a service” includes “providing network access.” *See* App. Br. 3–4.

We find Appellants' arguments persuasive. To satisfy the written description requirement, “the disclosure of the application relied upon [must] reasonably convey[] to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010). Appellants' written description meets this standard with respect to the

limitation at issue. For example, paragraph 67 of the written description discloses that

[i]n step 603, it is determined whether the transmitting transceiver 207 is available to move. When a transceiver 207 is not providing service to any user or client devices 208, it may be desirable to move the transmitting transceiver 207 to another area where it may provide service to client devices 208.

Spec. ¶ 67. We agree with Appellants that this disclosure teaches considering whether a transceiver is “providing a service” when determining whether the transceiver is free to move. *See* App. Br. 3–4. And as argued by Appellants, paragraphs 2, 22, and 28 of the written description teach that a transceiver “providing a service” in this context includes the transceiver providing network access. Paragraph 2 indicates that Appellants’ invention satisfies “a need for providing network access so that electronic devices . . . can be fully appreciated.” Spec. ¶ 2. And paragraphs 22 and 28 teach that Appellants’ invention satisfies this need in part by employing transceivers, where “[e]ach of the transceivers may serve as a wireless access point, and therefore, may provide a coverage area.” *Id.* ¶ 22; *see also id.* ¶ 28 (“The transceivers 207 may also contain wireless circuitry, and therefore, may serve as wireless access points.”). These disclosures are in keeping with the stated purpose of the invention, namely “providing a Wifi network and managing the same.” *Id.* ¶ 1. Accordingly, Appellants’ written description would have conveyed to one of ordinary skill in the art at the time the application was filed that Appellants had possession of the claimed subject matter.

For the above reasons, we agree with Appellants that the written description provides adequate support for the limitation at issue. Therefore, we do not sustain the Examiner’s rejection of claim 8 under 35 U.S.C.

§ 112.

§ 103 Rejections

Claim 1 recites in relevant part “in response to a determination that a first coverage area of the first transceiver overlaps with a second coverage area of a second transceiver, determining whether the first transceiver is available to move based at least on whether the first transceiver is providing service to any device.” App. Br. 10. The Examiner found Kalhan’s method of handing mobile devices from one mobile transceiver (i.e., a base station or an access point) to another teaches determining whether transceiver coverage areas overlap. *See* Final Act. 5–6; Ans. 6–7. However, the Examiner found Kalhan’s method does not teach “in response to [a] transceiver coverage area overlapping, determining whether the first transceiver is available to move based at least on whether the first transceiver is providing service to any device.” Final Act. 5–6. The Examiner found Kong’s method of using a mobile terminal (e.g., a mobile phone) to hail an available vehicle (e.g., a taxi) remedies this deficiency and concluded a combination of Kalhan’s and Kong’s teachings rendered claim 1 obvious. *See* Final Act. 5–6; Ans. 6–7.

Appellants contend one of ordinary skill in the art would not have combined Kalhan’s handover method with Kalhan’s taxi-hailing method because Kalhan’s transceivers are immobile and “Kalhan’s transceivers are nothing like a taxi.” App. Br. 4 (reference numbers omitted). Appellants also argue “[t]here is no rational underpinning to support combining the systems of Kalhan and Kong . . . to arrive at the claimed combination of features.” *Id.* at 5 (emphasis omitted).

We agree with Appellants. First, a reference “qualif[ies] as prior art for an obviousness determination only when analogous to the claimed invention.” *See In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). For a reference to be analogous to a claimed invention, the reference must either be “from the same field of endeavor, regardless of the problem addressed” or “reasonably pertinent to the particular problem with which the inventor is involved.” *Id.* Kong does not satisfy either of these tests. Kong’s invention “relates to a method for allowing a user of a mobile terminal to call for a vacant or empty vehicle (e.g., a taxi).” Kong ¶ 3. By contrast, Appellants’ field of endeavor and the particular problem faced by Appellants concern “providing a WiFi network and managing the same.” Spec. ¶ 1. Kong’s taxi-hailing method is unrelated to this endeavor and particular problem. Accordingly, Kong does not qualify as prior art for purposes of the obviousness analysis.

Second, the Examiner’s rejection rests in part on the Examiner’s finding that Kalhan’s transceivers are mobile. For example, in the Final Rejection, the Examiner found Kalhan teaches or suggests part of the disputed limitation because Kalhan’s “transceiver is in motion (i.e. available to move).” Final Act. 5. The Examiner bolstered this finding in the Answer, stating “[o]ne of ordinary skill in the art would appreciate and understand that a wireless access point or a transceiver in a mesh communication system is often portable.” Ans. 6–7. But the Examiner has not provided adequate evidence or reasoning to support these findings. The cited portions of Kalhan disclose that a *wireless communication device* (e.g., a cell phone) is in motion, not that Kalhan’s transceivers are mobile. *See, e.g.*, Kalhan ¶ 15; Final Act. 5 (citing Kalhan ¶ 15). And the Examiner has provided no

support for the assertion that one of ordinary skill in the art would understand that transceivers are mobile. *See* Ans. 6–7.

Third, the Examiner has not provided sufficient rationale for combining Kalhan’s and Kong’s teachings in the claimed manner. The Examiner found one of ordinary skill in the art would have been motivated “to incorporate Kong’s teachings [i.e., taxi hailing] . . . [into] Kalhan’s method to provide services to the mobile terminal by identifying [a] vehicle terminal available to travel or move from one location to another within a predetermined distance (i.e. coverage range).” Final Act. 6 (citing Kong ¶¶ 14–15). But as argued by Appellants, it makes little sense to incorporate taxi-hailing services into a handover method for wireless devices. *See* App. Br. 5; Reply Br. 4. Accordingly, this rationale is insufficient to support the Examiner’s combination of the cited art.

For the above reasons, we do not sustain the Examiner’s rejection of claim 1 under 35 U.S.C. § 103. Because claims 2–4, 6, and 8–17 depend from claim 1, we also do not sustain the Examiner’s rejections of these claims under 35 U.S.C. § 103.

DECISION

We reverse the Examiner’s rejections of claim 8 under 35 U.S.C. § 112 and claims 1–4, 6, and 8–17 under 35 U.S.C. § 103.

REVERSED