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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/855,712	08/13/2010	Li-Chih Tseng	1291-090.101	1504
106622	7590	12/13/2016	EXAMINER	
Blue Capital Law Firm, P.C. 650 Town Center Drive, Suite 1530 Costa Mesa, CA 92626			CHANG, TOM Y	
			ART UNIT	PAPER NUMBER
			2456	
			NOTIFICATION DATE	DELIVERY MODE
			12/13/2016	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* LI-CHIH TSENG, MENG-HUI OU, and  
YU-HSUAN GUO

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Appeal 2016-002249  
Application 12/855,712<sup>1</sup>  
Technology Center 2400

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Before ST. JOHN COURTENAY III, THU A. DANG, and  
LARRY J. HUME, *Administrative Patent Judges*.

HUME, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the Final Rejection of claims 1, 3–5, 7, 9–11, 19, 21–24, and 26–28.<sup>2</sup> Appellants have previously canceled claims 2, 6, 8, 12–18, 20, and 25. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> According to Appellants, the real party in interest is Innovative Sonic Corp. App. Br. 2.

<sup>2</sup> The Examiner incorrectly includes claims 25 and 29 in the listing of claims pending in the application. Final Act. 1 ("Office Action Summary").

STATEMENT OF THE CASE<sup>3</sup>

*The Invention*

Appellants' claimed invention relates to a method and apparatus for performing buffer status reporting. Title.

*Exemplary Claim*

Claim 1, reproduced below, is representative of the subject matter on appeal (*emphases* added to contested limitations):

1. A method for performing Buffer Status Reporting (BSR) in an user equipment (UE) of a wireless communication system, the method comprising:

*determining if a second BSR is triggered* between cancellation of a first triggered BSR and the transmission of a first Medium Access Control (MAC) Protocol Data Unit (PDU) including a first BSR MAC control element;

*performing a BSR procedure when the second BSR is determined triggered;*

wherein the first triggered BSR is cancelled because the first BSR MAC control element corresponding to the first triggered BSR is included in the first MAC PDU for transmission; and

wherein the BSR procedure comprises generating a second BSR MAC control element corresponding to the second BSR when the UE has a second uplink grant allocated for a new transmission for the current TTI.

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<sup>3</sup> Our decision relies upon Appellants' Appeal Brief ("App. Br.," filed June 24, 2015); Reply Brief ("Reply Br.," filed Dec. 15, 2015); Examiner's Answer ("Ans.," mailed Oct. 15, 2015); Final Office Action ("Final Act.," mailed Nov. 24, 2014); and the original Specification ("Spec.," filed Aug. 13, 2010).

*Prior Art*

The Examiner relies upon the following prior art as evidence in rejecting the claims on appeal:

Chun et al. ("Chun")	US 2009/0219951 A1	Sept. 3, 2009
Ostergaard et al. ("Ostergaard")	US 2010/0284354 A1	Nov. 11, 2010

*Rejections on Appeal*

Claims 1, 3–5, 7, 9–11, 19, 21–24, and 26–28 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Ostergaard and Chun. Ans. 2.<sup>4</sup>

CLAIM GROUPING

Based on Appellants' arguments (App. Br. 5–9), we decide the appeal of the obviousness rejection of claims 1, 3–5, 7, 9–11, 19, 21–24, and 26–28 on the basis of representative independent claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

ISSUE

Appellants argue (App. Br. 5–9; Reply Br. 3–5) the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a) as being obvious over the combination of Ostergaard and Chun is in error. These contentions present us with the following issue:

Did the Examiner err in finding the cited prior art combination teaches or suggests "[a] method for performing Buffer Status Reporting (BSR) in an

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<sup>4</sup> The Examiner incorrectly includes claims 2, 8, 20, 25, and 29 in the explicit statement of the rejection. Final Act. 2; Ans. 2. However, claims 2, 8, 20, and 25 have been canceled, and claim 29 has never been presented in this application.

user equipment (UE) of a wireless communication system," which includes, *inter alia*, the conditional limitations of (1) "determining if a second BSR is triggered," and (2) "performing a BSR procedure when the second BSR is determined triggered," (3) "wherein the BSR procedure comprises generating a second BSR MAC control element corresponding to the second BSR," as recited in claim 1?

#### ANALYSIS

In reaching this decision, we consider all evidence presented and all arguments actually made by Appellants. We do not consider arguments which Appellants could have made but chose not to make in the Briefs so that we deem any such arguments as waived. 37 C.F.R. § 41.37(c)(1)(iv).

We disagree with Appellants' arguments with respect to claim 1, and we incorporate herein and adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken, and (2) the reasons and rebuttals set forth in the Examiner's Answer in response to Appellants' arguments. We incorporate such findings, reasons, and rebuttals herein by reference unless otherwise noted. However, we highlight and address specific findings and arguments regarding claim 1 for emphasis as follows.

Appellants contend:

Ostergaard and Chun do not teach or suggest *when to generate a BSR MAC control element*. Ostergaard discloses that a [Scheduling Request] SR may be erroneously cancelled by modifying the condition to cancel pending SR trigger. However, the detailed handling of triggered [Buffer Status Request] BSR is not specified and the problem described above could occur in Ostergaard.

App. Br. 6.

"In the patentability context, claims are to be given their broadest reasonable interpretations . . . limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citations omitted). Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998); *see also Helmsderfer v. Bobrick Washroom Equip., Inc.*, 527 F.3d 1379, 1381 (Fed. Cir. 2008) ("A patentee may act as its own lexicographer and assign to a term a unique definition that is different from its ordinary and customary meaning; however, a patentee must clearly express that intent in the written description."). Absent an express intent to impart a novel meaning to a claim term, the words take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 (Fed. Cir. 2003) (citation omitted).

We note claim 1 specifically recites conditional limitations "determining *if* a second BSR is triggered . . ." and "*generating a second BSR MAC control element corresponding to the second BSR when the UE has a second uplink grant allocated for a new transmission for the current TTL.*" (Emphasis added).

As a matter of claim construction under the broadest reasonable interpretation, we conclude if a second BSR is not determined to be triggered, or if the UE does not have "a second uplink grant allocated for a new transmission for the current TTI," then the claimed "BSR procedure" is

not required to be performed. Claim 1. *See Ex parte Schulhauser*, Appeal No. 2013-007847, at \*9 (PTAB, April 28, 2016) (precedential) (holding "The Examiner did not need to present evidence of the obviousness of the remaining method steps of claim 1 that are not required to be performed under a broadest reasonable interpretation of the claim (e.g., instances in which the electrocardiac signal data is not within the threshold electrocardiac criteria such that the condition precedent for the determining step and the remaining steps of claim 1 has not been met."); *see also Ex parte Katz*, 2011 WL 514314, at \*4–5 (BPAI Jan. 27, 2011).

In fact, Appellants themselves admit to the possibility of the conditional limitations of claim 1 not being satisfied:

The Examiner seems to have missed the first if-condition, which states "If the Buffer Status reporting procedure determines that at least one BSR has been triggered since the last transmission of a BSR or if this is the first time that at least one BSR is triggered". This first if-condition needs to be fulfilled to generate a BSR MAC control element according to the 3GPP LTE specification.

Reply Br. 4 (emphasis omitted). "However, generating a BSR MAC control element requires taking when the BSR is triggered into account." Reply Br. 5 (emphasis omitted).

We apply the precedential guidance of *Schulhauser* and conclude the Examiner need not present evidence establishing the obviousness of the conditional performance of a BSR procedure step of claim 1, because it is not required to be performed under a broadest reasonable interpretation of the claim (i.e., instances when a second BSR is not "triggered between cancellation of a first triggered BSR and the transmission of a first Medium Access Control (MAC) Protocol Data Unit (PDU) including a first BSR

MAC control element," or "when the UE . . . [does not have] a second uplink grant allocated for a new transmission for the current TTI.").

Therefore, we consider Appellants' argument that the cited references fail to teach or suggest the conditional steps of claim 1 unavailing, because it is not commensurate with the broadest reasonable interpretation of claim 1. *See Schulhauser*, Appeal No. 2013-007847, at \*9. Accordingly, as a matter of claim construction, and on this record, we sustain the Examiner's rejection of claim 1.

Assuming, *arguendo*, our reviewing court were to conclude that the conditional limitations are required to be performed within the scope of method claim 1, , we are not persuaded by Appellants' argument stated above, because Appellants are arguing the references separately.<sup>5</sup> The Examiner cites Chun for the first triggered BSR being cancelled and performing BSR procedures. Final Act. 3.

We agree with the Examiner's finding that "Chun teaches a system for performing BSR procedures . . . [by teaching] the first triggered BSR is cancelled because the first BSR MAC control element corresponding to the first triggered BSR is included in the first MAC PDU for transmission," which teaches or at least suggests "wherein the first triggered BSR is cancelled" portion of the contested limitation of claim 1. *Id.*

We also agree with the Examiner that Chun's UE, if it has UL resources allocated for a new transmission for the TTI, generates a BSR

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<sup>5</sup> Because the Examiner rejects the claims as obvious over the combined teachings of Ostergaard and Chun, the test for obviousness is not what the references show individually but what the combined teachings *would have suggested* to one of ordinary skill in the art. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

MAC control element which teaches or at least suggests "generating a second BSR MAC control element corresponding to the second BSR when the UE has a second uplink grant allocated for a new transmission for the current TTI," as recited in claim 1. Final Act. 3–4.

Accordingly, Appellants have not provided sufficient evidence or argument to persuade us of any reversible error in the Examiner's reading of the contested limitations on the cited prior art. Therefore, we sustain the Examiner's obviousness rejection of independent claim 1 and claims 3–5, 7, 9–11, 19, 21–24, and 26–28 which fall therewith. *See Claim Grouping, supra.*

#### REPLY BRIEF

To the extent Appellants may advance new arguments in the Reply Brief (Reply Br. 3–5) not in response to a shift in the Examiner's position in the Answer, we note arguments raised in a reply brief that were not raised in the appeal brief or are not responsive to arguments raised in the Examiner's Answer will not be considered except for good cause, which Appellants have not shown. *See 37 C.F.R. § 41.41(b)(2).*

#### CONCLUSION

The Examiner did not err with respect to the obviousness rejection of claims 1, 3–5, 7, 9–11, 19, 21–24, and 26–28 under 35 U.S.C. § 103(a) over the cited prior art combination of record, and we sustain the rejection.

Appeal 2016-002249  
Application 12/855,712

DECISION

We affirm the Examiner's decision rejecting claims 1, 3–5, 7, 9–11, 19, 21–24, and 26–28.

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