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Huawei Technologies Co., Ltd. c/o Conley Rose, P.C. 5601 Granite Parkway, Suite 500 Plano, TX 75024			CHERY, DADY	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte WENFU WU and SHANSHAN WANG

Appeal 2018-002908¹
Application 14/104,753
Technology Center 2400

Before MAHSHID D. SAADAT, ERIC S. FRAHM, and JOHN A. EVANS,
Administrative Patent Judges.

EVANS, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellant² seeks our review under 35 U.S.C. § 134(a) of the Examiner’s Final Rejection of all pending claims, i.e., Claims 1–37. Appeal Br. 3. We have jurisdiction under 35 U.S.C. § 6(b).

¹ An oral hearing was held December 6, 2019. A transcript will be made of Record in due course.

² We use the word “Appellant” to refer to “Applicants” as defined in 37 C.F.R. § 1.42(a). The Appeal Brief identifies Huawei Technologies Co., Ltd., as the real party in interest. Appeal Br. 3.

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We REVERSE.³

STATEMENT OF THE CASE

The claims relate to a method, device and system for creating resources during a user equipment (UE) hand-over from a non-3rd Generation Partnership Project (non-3GPP) system to a 3GPP system. *See* Abstract.

INVENTION

Claims 1, 5, 14, and 24 are independent. An understanding of the invention can be derived from a reading of illustrative Claim 1, which is reproduced below with some formatting added:

1. A method for creating resources during a handover from a non-3rd Generation Partnership Project (non-3GPP) access system to a 3GPP access system, the method comprising:

receiving, by a serving gateway (Serving GW), a first resource request message from a mobility management network device, the first resource request message including handover indication information;

sending, by the Serving GW, a second resource request message including the handover indication information to a packet data network gateway (PDN GW);

³ Rather than reiterate the arguments of Appellant and the Examiner, we refer to the Appeal Brief (filed July 10, 2017, “Appeal Br.”), the Reply Brief (filed January 16, 2018, “Reply Br.”), the Examiner’s Answer (mailed November 14, 2017, “Ans.”), the Final Action (mailed June 17, 2016, “Final Act.”), and the Specification (filed December 12, 2013, “Spec.”) for their respective details.

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receiving, by the PDN GW, the second resource request message including the handover indication information; and
obtaining, by the PDN GW, a policy and charging control (PCC) rules, after the PDN GW receives the second resource request message.

Rejections

Claims 1–37 stand rejected under pre-AIA 35 U.S.C. 102(b) as anticipated by “3GPP TS 23.402 V1.0.0 (2007-05)” (“3GPP”). Final Act. 2–6.

ANALYSIS

We have reviewed the rejections of Claims 1–37 in light of Appellant’s arguments that the Examiner erred. We consider Appellant’s arguments as they are presented in the Appeal Brief, pages 7–23.

CLAIMS 1–37: ANTICIPATION BY 3GPP.

Because we find a single issue is dispositive of all rejections, we decide the appeal on the basis of illustrative Claim 1, and refer to the rejected claims collectively herein as “the claims.” *See* 37 C.F.R. § 41.37(c)(1)(iv); *In re King*, 801 F.2d 1324, 1325 (Fed. Cir. 1986).

Multiple Embodiments.

Appellant contends, in making the anticipation rejection, the Examiner cites three separate and unrelated parts of the 3GPP standard.

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Appeal Br. 11. Appellant argues the first reference is to Fig. 5.4.2.6-1, entitled “Initial E-UTRAN Attach via IETF based S5 or S8,” the second reference is to Fig. C.3.1-1, entitled “Untrusted Non-3GPP IP Access with DSMIPv6 over S2c to 3GPP Access Handover in the Non-Roaming Scenario,” and the third reference is to Fig. C.3-1, entitled “3GPP Access (UTRAN) to Trusted Non-3GPP IP Access with PMIPv6 Handover for the Non-Roaming Scenario.” *Id.* Appellant argues it is improper to make a case of anticipation through the synthesis of multiple, distinct embodiments. Appeal Br. 8 (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”)).

The Examiner maps the claim recitations to the disclosure of three, separate figures of the 3GPP reference, i.e., Figure 5.4.2.6-1, Figure C.1.1-1, and Figure C.3.1-1. *See* Ans. 3–4. The Examiner finds the three cited figures “all disclose similar features as claimed by the instant applicant. Therefore, they can be used in a single embodiment.” *Id.* 5.

We disagree with the Examiner because we find the three figures relate to three, separate embodiments disclosed by the 3GPP reference.

Section 5.4.2.6 is entitled “Initial E-UTRAN Attach via IETF based S5 or S8b” and discloses “[t]his section is related to the case when the UE powers-on in the LTE network via IETF based S5 or S8b interface. 3GPP, 26. Figure 5.4.2.6-1 (cited by the Examiner) is entitled “Initial E-UTRAN Attach via IETF based S5 or S8b.” 3GPP, 28.

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Whereas § 5.4.2.1 relates to UE power-on in the LTE network via IETF based S5 or S8b interface, § C.2 relates to “Handovers involving S2b interface.” 3GPP, 39. Specifically, § C.2.1 relates to “Untrusted Non-3GPP IP Access with PMIPv6 to E-UTRAN Handover in the Non-Roaming Scenario.” 3GPP, 39. Figure C.1.1-1 (cited by the Examiner) relates to “Handover from Trusted Non-3GPP IP Access to E-UTRAN with PMIPv6 on S2a and S5.” 3GPP, 35.

Moreover, whereas § C.2.1 relates to handovers using PMIPv6 on S2a and S5 interfaces, § C.3 relates to “Handovers Involving S2c Interface. 3GPP, 42. Specifically, § C.3.1 relates to “Untrusted Non-3GPP IP Access with DSMIPv6 over S2c to 3GPP Access Handover in the Non-Roaming Scenario. 3GPP, 43. Moreover, Figure C.3.1-1, cited by the Examiner relates to “Untrusted Non-3GPP S2c (DSMIPv6) to 3GPP Handover. 3GPP, 42.

Thus, we find, the Examiner has synthesized a *prima facie* case from multiple, separate embodiments. The Board reverses an anticipation rejection where the Examiner relies on multiple distinct embodiments within the single reference. *See Ex parte Cucerzan*, Appeal 2009-008190; Appl. 11/094,078 (PBAI May 2, 2011). “Thus, it is not enough [in an anticipation rejection] that the prior art reference discloses part of the claimed invention, which an ordinary artisan might supplement to make the whole, or that it includes multiple, distinct teachings that the artisan might somehow combine to achieve the claimed invention. *Net MoneyIn, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008).”

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In view of the foregoing, we decline to sustain the rejection of Claims 1–37 under 35 U.S.C. § 102.

CONCLUSION

The rejections of Claims 1–37 under 35 U.S.C. § 102 is REVERSED.

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–37	102	3GPP		1–37

REVERSED