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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL T. WILHOITE and THOMAS A. CARTER

Appeal 2019-000301
Application 13/709,732 ¹
Technology Center 2400

Before BRYAN F. MOORE, NORMAN H. BEAMER, and
MATTHEW J. McNEILL, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION ON APPEAL²

Appellant seeks our review under U.S.C. § 134(a) of the Examiner’s rejection of claims 2, 3, 8, and 11–15. We have jurisdiction under 25 U.S.C. § 6(b). We REVERSE.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as Bridgeport Networks, Inc. App. Br. 1.

² Throughout this Decision we have considered the Specification filed December 10, 2012 (“Spec.”), the Non-Final Rejection mailed August 3, 2017 (“Non-Final Act.”), the Appeal Brief filed April 3, 2018 (“Appeal Br.”), the Examiner’s Answer mailed August 7, 2018 (“Ans.”), and the Reply Brief filed October 9, 2018 (“Reply Br.”).

BACKGROUND

Appellant's invention relates to telephone systems and more particularly to a system and method for delivering a circuit-based wireless telephone call to a packet-based telephone call including a television cable system-based telephone call. Spec. ¶ 2.

Claim 2, reproduced below with indentation added, is illustrative of the claimed subject matter:

2. A call handover method comprising:

while a call is in progress between a mobile device and a second device via a first component of a public mobile telephone network over a circuit based leg of the public mobile telephone network between the mobile device and the first component, receiving a user initiated action at a packet telephone connected to a local area data network to initiate a handover of the call from the mobile device to the packet telephone;

responsive to the action, forming a communication path from the first component of the public mobile telephone network to the packet telephone, the communication path passing over a packet data based leg and terminating at the packet telephone, wherein at least part of the packet data based leg is established over the local area data network;

completing the handover of the call from the mobile device to the packet telephone including re-routing the call from the circuit based leg to pass over the packet based leg.

Appeal Br. 27 (Claims Appendix).

THE REJECTIONS

1. Claims 2–4 and 8–15 stand rejected under 35 U.S.C. § 112(a) for failing to comply with the written description requirement. Non-Final Act. 3–7.

2. Claims 2, 3, 8, and 11–15 were rejected under 35 U.S.C. § 103(a) as obvious over US 6,674,746 B1, issued Jan. 4, 2004 (“Lamarque”), in view of US 2005/0170825 A1, issued Aug. 4, 2005 (“Dowling”). Non-Final Act. 7–10. This rejection was withdrawn by the Examiner. Ans. 6.
3. Claims 4 and 10 were rejected under 35 U.S.C. § 103(a) as obvious over Lamarque, in view of Dowling, in further view of admitted prior art. Non-Final Act. 10–11. This rejection was withdrawn by the Examiner. Ans. 6.
4. Claim 9 were rejected under 35 U.S.C. § 103(a) as obvious over Lamarque, in view of Dowling, in further view of 6,459,783 B1, issued Oct. 1, 2002, (“March”). Non-Final Act. 11–12. This rejection was withdrawn by the Examiner. Ans. 6.

ANALYSIS

We have considered all of Appellant’s arguments and any evidence presented. We highlight and address specific findings and arguments for emphasis in our analysis below.

THE § 112 REJECTION

The Examiner rejects claims 2–4, 8–15 under § 112(a) for failing to comply with the written description requirement. Non-Final Act. 3–4. In particular, the Examiner considers as new matter the claim limitations “while a call is in progress between a mobile device and a second device via a first component of a public mobile telephone network over a circuit based leg of the public mobile telephone network between the mobile device and the first component” and “receiving a user initiated action at a packet telephone connected to a local area data network to initiate a handover of the

call from the mobile device to the packet telephone” as recited in claim 2 and similar recitations in claim 9. *Id.* at 4, 6; Ans. 7. According to the Examiner, Appellant relies on paragraphs 54 and 55 of the Specification for “while a call is in progress”, but the Specification at 54 and 55 shows only initiating calls. Ans. 4. The Examiner also asserts that Appellant relies on Figure 7 and its associated discussion to show “receiving a user initiated action” to handover of a call, but Figure 7 only shows a mobile device initiating handover of a call.

Appellant argues that “a description of the features of claims 2 and 9 that the Examiner contends are missing from the written description can clearly be found in paragraphs [085]-[088] (related to FIG. 7) of the written description.” Appeal Br. 12. Appellant also argues “[t]he Examiner has not set forth any reasoning as to why a person of ordinary skill in the art who has read paragraphs [085]-[088] (related to FIG. 7), in addition to paragraphs [054]-[055] would not have recognized, in the Appellant’s disclosure, an exemplary description of the invention defined by the claims.” Appeal Br. 12. (Emphasis omitted).

As to the limitation to “while a call is in progress,” we agree with Appellant that a person of ordinary skill in the art would understand from the Specification that the description of paragraphs 54 and 55 can be read in conjunction with the description of Figure 7. For example, the Specification states in paragraph 54 that “calls to and from the subscriber are transferred to a local packet-based (IP) telephone when the subscriber approaches the access point or initiates an action at the packet telephone.” Spec ¶ 54. Similarly, the Specification states in paragraph 88 that “in the *in-session* call

hand-off at registration process is as the mobile enters the cell site coverage area for private domain.” Spec. ¶ 87 (emphasis added). Although the Examiner states that paragraphs 54 and 55 are limited to initiating a new call, the fact that paragraphs 54 and 55 do not expressly state they are limited to new calls and the parallel language between paragraphs 54 and 87 suggests that they are discussing the same registration process which paragraph 87 explicitly states can be during “in session” calls. We find that a person of ordinary skill in the art would understand from this description that the system can while a call is in progress between a mobile device and a second device via a first component of a public mobile telephone network over a circuit based leg of the public mobile telephone network between the mobile device and the first component.

We agree with Appellant that a person of ordinary skill in the art would understand from the Specification that the description of paragraphs 54 and 55 can be read in conjunction with the description of Figure 7. For example, the Specification states in paragraph 55 that “subscriber registers with his SCP either by merely approaching the access point with his subscriber unit turned on or by taking an action at the desktop system or other packet telephone..” Spec ¶ 55. Similarly, the Specification states in paragraph 88 that “in the in-session call hand-off at registration process is as the mobile enters the cell site coverage area for private domain.” Spec. ¶ 87. Although the Examiner states that Figure 7 is limited to mobile device initiating handoff of a call, the parallel language between paragraphs 55 and 87 suggests that they are discussing the same registration process which paragraph 55 explicitly states can be initiated by a user. We find that a person of ordinary skill in the art would understand from this description

that the system can receive a user initiated action at a packet telephone connected to a local area data network to initiate a handover of the call from the mobile device to the packet telephone.

We, therefore, do not sustain the Examiner's rejection of claims 2-4, 8-15 under 35 U.S.C. § 112(a).

CONCLUSION

We conclude the Examiner erred in rejecting claims 2-4, 8-15 under 35 U.S.C. § 112.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	References/Basis	Affirmed	Reversed
2-4, 8-15	112(a)	Lack of written description support		2-4, 8-15

Because we reverse the existing ground of rejection with respect to each claim on appeal, we reverse the Examiner's rejection of claims 2-4, 8-15.

REVERSED