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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte HUA CHAO, ZHONGJI HU, HE WANG, and PHILIPPE GODIN

Appeal 2019-000414
Application 14/009,859
Technology Center 2400

Before JOHN A. JEFFERY, JAMES W. DEJMEK,
and STEPHEN E. BELISLE, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's decision to reject claims 1, 2, 5–10, 13–19, 22–24, and 27–29. We have jurisdiction under 35 U.S.C. § 6(b). We REVERSE.

STATEMENT OF THE CASE

Appellant's invention performs Multimedia Broadcast Multicast Service (MBMS) communications by (1) acquiring location area information of an MBMS service distribution, and (2) notifying user equipment (UE) of that information. *See generally* Abstract. Claim 1 is illustrative:

¹ We use the word "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42 (2017). Appellant identifies the real party in interest as Alcatel Lucent of Paris, France. Appeal Br. 3.

1. A method for performing Multimedia Broadcast Multicast Service (MBMS) communications, comprising:

acquiring location area information for an MBMS service at a network entity in a network side of a cellular system, wherein the location area information includes a service area identifier for the MBMS service; and

notifying a User Equipment (UE) of the location area information for the MBMS service, wherein the notifying includes providing the location area information from the network entity to the UE via a base station, wherein the service area identifier for the MBMS service corresponds to a coverage area for the MBMS service within the cellular system.

THE REJECTIONS²

The Examiner rejected claims 1, 2, 9, and 10 under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Hsu (US 2011/0305183 A1; published Dec. 15, 2011; filed June 14, 2011; provisional application No. 61/354,791 filed June 15, 2010 and provisional application No. 61/357,706 filed

² Although the Examiner omits claims 28 and 30 from the claims indicated as pending in paragraph 5 of the PTOL-326 form on page 1 of the Final Office Action, these claims are nonetheless pending. Although claims 28 and 30 were also omitted from the claims indicated as rejected in paragraph 7 of that PTOL-326 form, the Examiner nonetheless rejected claim 28, but did not reject claim 30. And despite the Examiner indicating that claim 29 is rejected, the Examiner did not specify the particular ground of that rejection. *See* Final Act. 7–12. Moreover, despite indicating that claim 23 is rejected as obvious over Hsu, Kuo, and TS 125.346 (Final Act. 7), the Examiner does not include this claim in the associated discussion. *See* Final Act. 7–12. *Accord* Appeal Br. 3 (presuming that claims 23, 29, and 30 are directed to allowable subject matter because the Examiner’s Final Office Action does not present any grounds of rejection for these claims). Despite these omissions and inconsistencies, we nonetheless present the Examiner’s rejections as they appear in the Examiner’s Final Office Action—the grounds of which were confirmed by the Examiner on page 3 of the Examiner’s Answer.

June 23, 2010) and *ETSI TS 125 346 v. 10.0.0, Universal Mobile Telecommunications System (UTMS); Introduction of the Multimedia Broadcast/Multicast Service (MBMS) in the Radio Access Network (RAN); Stage 2 (3GPP TS 25.346 version 10.0.0 Release 10)* (“TS 125.346”). Final Act. 4–7.³

The Examiner rejected claims 5–8, 13–16, 18, 22, 23, 24,⁴ 27, and 28 under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Hsu, Kuo (US 2010/0315987 A1; published Dec. 16, 2010), and TS 125.346. Final Act. 7–12.

The Examiner rejected claims 17 and 19 under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Hsu, TS 125.346, and Frost (US 2009/0180417 A1; published July 16, 2009). Final Act. 12.

THE OBVIOUSNESS REJECTION OVER HSU AND TS 125.346

Regarding independent claim 1, the Examiner finds that Hsu discloses a method for performing MBMS communications including (1) acquiring location area information for an MBMS service at a network entity in a network side of a cellular system, and (2) notifying a UE of the location area information for the MBMS service by providing that information from the

³ Throughout this opinion, we refer to (1) the Final Rejection mailed January 26, 2018 (“Final Act.”); (2) the Appeal Brief filed July 12, 2018 (“Appeal Br.”); (3) the Examiner’s Answer mailed August 23, 2018 (supplemented August 31, 2018) (“Ans.”); and (4) the Reply Brief filed October 19, 2018 (“Reply Br.”).

⁴ Although the Examiner omits claim 24 from the statement of the rejection, the Examiner nonetheless includes this claim in the corresponding discussion. *Compare* Final Act. 7 *with* Final Act. 11. We, therefore, include claim 24 here for clarity.

network entity to the UE via a base station. Final Act. 4–5. Although the Examiner acknowledges that Hsu’s location area information lacks a service area identifier for the MBMS service that corresponds to the service’s coverage area within the cellular system, the Examiner cites TS 125.346 for teaching this feature in concluding that the claim would have been obvious. Final Act. 5–6.

Appellant argues that not only are Hsu’s cited portions disqualified as prior art, the cited prior art does not teach or suggest the recited acquiring and notifying steps in any event. Appeal Br. 6–14; Reply Br. 2–16.

ISSUE

Under pre-AIA 35 U.S.C. § 103(a), has the Examiner erred in rejecting claim 1 by finding that Hsu and TS 125.346 collectively would have taught or suggested the claimed invention? This issue turns on whether Hsu qualifies as prior art to the present application.

ANALYSIS

We begin by noting that the present application was filed October 4, 2013 and is a national stage application filed under 35 U.S.C. § 371 of Patent Cooperation Treaty (PCT) International Application PCT/IB2012/000881 filed March 28, 2012.⁵ The present application also

⁵ Given this PCT application filing date, this application is not subject to the provisions of the America Invents Act (AIA). *See* Manual of Patent Examining Procedure (MPEP) § 2159.01 (9th ed. Rev. 08.2017, Jan. 2018). *Accord* Final Act. 2 (examining the present application under pre-AIA statutory provisions).

claims foreign priority to Chinese Application 201110085858.9 filed April 4, 2011. *See* Bibliographic Data Sheet.

The Hsu reference is a U.S. application that published on December 15, 2011 and was filed on June 14, 2011, both of which are *after* the present application's earliest priority date (April 4, 2011).⁶ Hsu, however, is based on (1) U.S. Provisional Application 61/354,791, filed June 15, 2010 ("791 provisional"), and (2) U.S. Provisional Application 61/357,706, filed June 23, 2010 ("706 provisional"), both of which were filed *before* the present application's earliest priority date.

The critical question, then, is whether the relied-upon subject matter in Hsu is entitled to the date of either of its provisional applications, for if it is not, then Hsu does not qualify as prior art because its utility application filing date (June 14, 2011) is after that of the present application's earliest priority date (April 4, 2011).

Thus, it is crucial for the Examiner to show that at least one of Hsu's provisional applications adequately provides (1) support for the subject matter of *Hsu's claimed invention* in Hsu's published utility application under 35 U.S.C. § 112, first paragraph, *and* (2) similar § 112, first paragraph support for the particular subject matter from Hsu relied on in the rejection. Only then would Hsu be entitled to the filing date of at least one of its provisional applications. *See Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1380 (Fed. Cir. 2015) ("A reference patent is only

⁶ There is no dispute that the application's earliest priority date of April 4, 2011 is the application's effective filing date under 35 U.S.C. §§ 100 and 365. *See* C.F.R. § 1.109(a)(2); *see also* MPEP § 2152.01. Nor is this priority claim's perfection under 37 C.F.R. § 1.55(g) disputed. *See* MPEP §§ 213.04, 706.02(b)(2).

entitled to claim the benefit of the filing date of its provisional application if the disclosure of the provisional application provides support for the *claims* in the reference patent in compliance with § 112, ¶ 1.”) (emphasis added) (citing *In re Wertheim*, 646 F.2d 527, 537 (CCPA 1981)); *see also Dynamic Drinkware* at 1382 (“A provisional application’s effectiveness as prior art depends on its written description support for the *claims* of the issued patent of which it was a provisional.”) (emphasis added). *Accord Amgen v. Sanofi*, 872 F.3d 1367, 1380 (Fed. Cir. 2017); MPEP § 2136.03(III); Robert W. Bahr, Memorandum to Patent Examining Corps, *Critical reference date under pre-AIA 35 U.S.C. § 102(e) of a U.S. patent or U.S. published application claiming the benefit of a prior U.S. provisional application during examination of an application*, USPTO, Apr. 5, 2018 (“Bahr Memo.”) (citing *Amgen*).⁷

In short, showing that at least one of Hsu’s provisional applications provides adequate § 112, first paragraph support for *both* (1) Hsu’s claimed invention, *and* (2) the specific subject matter from Hsu’s published application relied on in the rejection is crucial for that relied-upon subject matter to qualify as prior art to the present application particularly where, as here, Appellant contends that at least some of that relied-upon subject matter does not qualify as prior art. *See* Appeal Br. 6–8; Reply Br. 2–6 (arguing that Hsu’s paragraph 47 and Figure 8 do not qualify as prior art).

⁷ This memorandum is available from the USPTO’s web site at https://www.uspto.gov/sites/default/files/documents/dynamic_memo_05apr2018.pdf.

That did not happen here. First, even if we were to accept the Examiner's findings that the bulleted lists on what resembles presentation slides on pages 5 and 10 of Hsu's '706 provisional application somehow support the relied-upon subject matter in Hsu's paragraph 47 and Figure 8 under § 112, first paragraph (*see* Ans. 3–4), the Examiner still does not show that this provisional application *also* provides adequate § 112, first paragraph support for *Hsu's claimed invention*—a crucial deficiency on this record. *See Amgen*, 872 F.3d at 1380; *see also Dynamic Drinkware*, 800 F.3d at 1382; Bahr Memo. Given this deficiency, the Examiner has not shown that the relied-upon subject matter in Hsu qualifies as prior art to the present application. Therefore, the Examiner's rejection based on this subject matter is erroneous for that reason alone.

But even if the Examiner had shown that the '706 provisional application adequately supports Hsu's claimed invention—a crucial finding that was not made on this record—we still find the bulleted lists on pages 5 and 10 of Hsu's '706 provisional application on which the Examiner relies (Ans. 3–4) fall short of providing the requisite § 112, first paragraph support for the relied-upon subject matter in Hsu's paragraph 47 and Figure 8 as Appellant indicates on pages 2 to 6 of the Reply Brief.⁸ The Examiner's rejection is therefore problematic for this additional reason.

⁸ Although Appellant's characterization of the third solution to Problem 1 pertaining to the S1 enhancement on page 5 of the '706 provisional application as involving *both* source *and* target eNBs (Reply Br. 4) is overstated given this solution's reference to only a source eNB, we nonetheless find this solution (and other solutions on page 5) falls short of showing the requisite § 112, first paragraph support for the particular subject matter in Hsu's paragraph 47 and Figure 8 relied upon by the Examiner. We reach this conclusion despite Appellant's additional erroneous references to

Accordingly, we are persuaded that the Examiner erred in rejecting (1) independent claim 1; (2) independent claim 9 that is similarly rejected based partly on Hsu's paragraph 47 and Figure 8 that does not qualify as prior art (*see* Final Act. 6–7); and (3) dependent claims 2 and 10 for similar reasons. Because this issue is dispositive regarding our reversing the Examiner's rejection of these claims, we need not address Appellant's other associated arguments.

THE OTHER OBVIOUSNESS REJECTIONS

Because the Examiner's obviousness rejections of claims 5–8, 13–19, 22, 23, 24, 27, and 28 rely on subject matter from Hsu that does not qualify as prior art to the present application (*see* Final Act. 7–12), the Examiner's obviousness rejections of these claims are likewise erroneous.

Hsu's Figure 4 in connection with the second and third solutions on page 5 of the '706 provisional (*see* Reply Br. 4), for Hsu's Figure 3—not Figure 4—shows source and target eNBs. Nevertheless, we deem these errors and inconsistencies harmless on this record given the '706 provisional application's shortcomings in providing the requisite § 112, first paragraph support for the above-noted relied-upon subject matter in Hsu.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
1, 2, 9, 10	§ 103	Hsu, TS 125.346		1, 2, 9, 10
5–8, 13–16, 18, 22, 23, 24, 27, 28	§ 103	Hsu, Kuo, TS 125.346		5–8, 13–16, 18, 22, 23, 24, 27, 28
17, 19	§ 103	Hsu, TS 125.346, Frost		17, 19
Overall Outcome				1, 2, 5–10, 13–19, 22– 24, 27–29 ⁹

REVERSED

⁹ As noted previously, despite indicating that claim 29 is rejected on page 1 of the Final Office Action, the Examiner did not specify the particular ground of that rejection. *See* Final Act. 7–12. We nevertheless include that claim here for clarity and completeness.