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148528	7590	09/30/2020	EXAMINER	
2SPL Patent Attorneys Landaubogen 3 Munich, 81373 GERMANY			DANIEL JR, WILLIE J	
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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* MATTHIAS KINDLER and  
HARIBALARAMAN RAMASUBRAMANIAN

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Appeal 2019-004241  
Application 14/762,476  
Technology Center 2400

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Before ROBERT E. NAPPI, NORMAN H. BEAMER, SCOTT E. BAIN,  
*Administrative Patent Judges.*

BAIN, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a) from the Examiner’s decision to reject claims 1–11, 14, 15, 18, 20, 21, and 25. Claims 12, 13, 16, 17, 19, and 22–24 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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<sup>1</sup> 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 Lantiq Deutschland GmbH. Appeal Br. 1.

## BACKGROUND

### *The Claimed Invention*

The invention relates to “systems using two different links to a provider network,” and specifically, “to an extender usable to provide an additional link to a provider network.” Spec. 1. Claims 1, 21, and 25 are independent. Claim 1 is illustrative of the invention and the subject matter in dispute, and is reproduced below:

1. A mobile extender apparatus configured to couple to a base unit, *wherein the base unit is configured to communicate directly via a first uplink to a communications network using a first protocol*, the apparatus comprising:

a first transceiver that receives a first mobile signal from the communications network and transmits a second mobile signal to the communications network via a second, different uplink to the communications network *using a second protocol that is different than the first protocol*,

wherein the mobile extender apparatus forms, with the base unit, a *dual uplink to the communications network, wherein each uplink employs a different protocol*,

a translator that translates the first mobile signal from the second protocol into third protocol that is different from the second protocol,

a second transceiver that modulates and transmits the translated first mobile signal to the base unit according to the third protocol,

wherein the mobile extender apparatus is physically separate from the base unit.

Appeal Br. 11 (Claims App.) (emphases added).

### *References*

The references relied upon by the Examiner are:

<b>Name</b>	<b>Reference</b>	<b>Date</b>
Akatsu et al. ("Akatsu")	US 6,505,255 B1	Jan. 7, 2003
Rakib et al. ("Rakib")	US 2004/0172658 A1	Sept. 2, 2004
Zas Couce et al. ("Zas Couce")	EP 2365663 A1	Sept. 14, 2011

*The Rejections on Appeal*

Claims 1–11, 14, 15, 20, 21, and 25 stand rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Rakib and Akatsu. Final Act. 2–7.

Claims 18 stand rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Rakib, Akatsu, and Zas Couce. Final Act. 7–8.

**DISCUSSION**

We have reviewed the Examiner’s rejections in light of Appellant’s arguments presented in this appeal. On the record before us, we cannot sustain the Examiner’s rejections.

Appellant argues that the Examiner erred in failing to accord any patentable weight to the “base unit” as recited in the preamble of claim 1, and erred in finding the prior art teaches or suggests a “mobile extender” and further limitations to the “base unit” recited in the claim. Appeal Br. 6; Reply Br. 2. Appellant also argues that the Examiner’s mapping of the claim elements is “not clear” and that the cited references do not teach or suggest using the “separate” uplinks as recited in claim 1. Appeal Br. 6–7. For the following reasons, Appellant’s arguments persuade us of error.

We begin with the preamble of claim 1. The preamble recites a “mobile extender apparatus” configured to couple to a base unit, “wherein

the base unit is configured to communicate directly via a first uplink to a communications network using a first protocol.” Appeal Br. 11 (Claims App.). The Examiner determines that this clause in the preamble merely recites “purpose” or “intended use” of a base unit, and the body of the claim does not depend on the preamble for completeness. Ans. 11–12.

Both the language of the preamble and the remainder of claim 1, however, contradict the Examiner’s determination regarding the preamble. The body of claim 1 recites a “second protocol that is different than the first protocol [communicated by the base unit]” and that “the mobile extender apparatus forms, *with the base unit*, a *dual uplink* to the communications network, wherein each uplink employs a *different protocol*.” Appeal Br. 11 (emphases added). Accordingly, the preamble’s requirement that the base unit is “configured to” communicate using a *first protocol* is directly and critically related to elements within the body of the claim. Moreover, the body of the claim further limits the base unit by reciting “a second transceiver that modulates and transmits the translated first mobile signal to *the base unit* according to the *third protocol*, wherein the mobile extender apparatus is physically separate from *the base unit*.” Appeal Br. 11 (emphases added).

The language of the preamble itself also contradicts the Examiner’s interpretation. Claim 1 is an apparatus claim, and the “base unit” is one of the physical elements within the apparatus. “Configuring” the base unit in a particular, claimed manner imparts required characteristics of the apparatus, not merely intended uses. The preamble does not recite a “base unit to” communicate or a “base unit which may communicate,” but rather, a “base unit . . . *configured to* communicate” (i) “directly via a first uplink to a

communications network” and (ii) “using a first protocol.” Appeal Br. 11 (emphasis added). The word “configured,” in this instance, requires that the base unit has the recited characteristics.

The absence of patentable weight given to the preamble is fatal to the Examiner’s rejection of claim 1 on this record, but even if we had agreed with the Examiner’s position regarding the preamble, we are persuaded of error for a second, independent reason.

Specifically, in rejecting the claim in the Final Action, the Examiner cites extensively to Rakib (both the text and figures in the disclosure) but, as Appellant argues, the Examiner does not sufficiently explain how the “gateway” and other elements in Rakib teach or suggest the “mobile extender apparatus” and “base unit” (terms not appearing in Rakib) in claim 1. Appeal Br. 6. On this record, we cannot discern from the Examiner’s broad citations (Final Act. 2–4) what specific elements from the prior art the Examiner is mapping to corresponding elements in claim 1. *See* Appeal Br. 6–7. In response to this argument in Appellant’s opening brief, the Examiner, in essence, merely copies into the Answer the same citations used in the Final Action. Ans. 11–12. Accordingly, we determine the Examiner has not established a prima facie case of unpatentability, on this record. *See, e.g., Hyatt v. Dudas*, 492 F.3d 1365, 1370 (Fed. Cir. 2007) (holding that the Office carries the initial burden of establishing a prima facie case of unpatentability “by adequately explain[ing] the shortcomings it perceives so that the applicant is properly notified and able to respond”).

Accordingly, we are persuaded the Examiner erred in rejecting claim 1. For the same reasons, we are persuaded of error regarding the same rejection of independent claims 21 and 25, argued as a group with claim 1,

as well as the remaining claims (all of which depend from claims 1, 21, or 25). We, therefore, do not sustain the obviousness rejections of claims 1–11, 14, 15, 18, 20, 21, and 25.

### CONCLUSION

We reverse the Examiner’s decision rejecting claims 1–11, 14, 15, 18, 20, 21, and 25.

### DECISION SUMMARY

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1–11, 14, 15, 20, 21, 25	103(a)	Rakib, Akatsu		1–11, 14, 15, 20, 21, 25
18	103(a)	Rakib, Akatsu, Zas Couce		18
<b>Overall Outcome</b>				1–11, 14, 15, 18, 20, 21, 25

REVERSED