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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SUGURU TOYOKAWA and MASAFUMI ARAMOTO

Appeal 2019-006694
Application 14/630,355
Technology Center 3900

Before JOHN A. JEFFERY, RAE LYNN P. GUEST, and ERIC B. CHEN,
Administrative Patent Judges.

CHEN, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 9–14. Original claims 1–8 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

The instant application is a continuation of US RE45,465, based on Application No. 13/933,081, filed July 1, 2013, issued on April 14, 2015, which is a reissue of Application No. 12/512,525, filed on July 30, 2009, now US 8,325,677, issued on December 4, 2012, which is a continuation of Application No. 12/440,181, filed on Mar. 5, 2009, now abandoned, which is the national phase of PCT/JP2007/067016, filed on August 31, 2007.

CLAIMED SUBJECT MATTER

The claims are directed to a communication control method used in a relaying intermediate node at a movement source of a mobile node when a handover is performed. (Abstract.)

Claim 9, reproduced below, are illustrative of the claimed subject matter, with disputed limitations in italics:

9. A communication control method used in a relaying intermediate node at a movement source of a mobile node in a case that a handover is performed, the communication control method comprising:

forwarding a user data to a relaying intermediate node at a movement destination of the mobile node, the user data having been received from an anchor node, the user data being addressed to the mobile node, and the user data being stored in

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 Sharp Kabushiki Kaisha. (Appeal Br. 1.)

a buffer of the relaying intermediate node at the movement source of the mobile node;

continuing the forwarding of the user data as long as the buffer has not been emptied; and

sending a transfer cancel notification to the relaying intermediate node at the movement destination of the mobile node.

REFERENCES

Name	Reference	Date
Toyokawa et al.	US RE45,465	April 14, 2015
Toyokawa et al.	US 2009/0290529 A1	Nov. 26, 2009
O'Neill et al.	US 2003/0224758 A1	Dec. 4, 2003

REJECTIONS

Claims 9–14 stand rejection under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9–12 of commonly owned Toyokawa (US RE45,465).²

Claims 9–14 stand rejected under 35 U.S.C. § 102(a)(1) as being anticipated by Toyokawa (US 2009/0290529 A1).³

Claims 9–14 stand rejected under 35 U.S.C. § 102(a)(1) as being anticipated by O'Neill.

² Appellant has submitted a Terminal Disclaimer on May 3, 2018. (Appeal Br. 6.) According, the rejection is moot.

³ Appellant has not presented any substantial arguments with respect to the rejection of claims 9–14 under 35 U.S.C. § 102(a)(1) as being anticipated by Toyokawa. Instead, Appellant argues that Toyokawa does not qualify as prior art. (Appeal Br. 15.) Thus, any such arguments are deemed to be waived.

OPINION

*Toyokawa (US 2009/0290529 A1) as § 102(a)(1) Prior Art—Bauman
Continuation Application*

Initially, we note that Appellant has challenged the Examiner’s initial classification of the instant application as a *Bauman* type continuing application, rather than a continuation reissue application, in the form of a Petition to the Director under 37 C.F.R. § 1.182 three times. The first two Petitions, filed April 19, 2017, and July 21, 2017, were dismissed on May 22, 2017, and November 20, 2017, respectively. The most recent petition, filed January 19, 2018 after the Appeal Brief was filed, was denied on December 19, 2018. The rationale for not granting the conversion request has been consistent. In particular, the December 19, 2018 Petition Decision stated that “[r]equiring indicia of a reissue **upon filing** is necessary [pursuant to MPEP § 1451] to ensure that the application is evaluated for compliance with the appropriate law and regulations, assigned to an appropriate examiner, and subjected to the appropriate procedures for a reissue (as opposed to a regular) application” (Petition Dec. 6) and Appellant provided “no indicia of a reissue were present upon filing of this application on February 24, 2015, and the application thus did not comply with the regulations applicable to reissue applications” (*id.* at 7).

Appellant’s Appeal Brief presents further arguments with respect to the conversion of the application to continuation reissue application, as follows:

In the present case, Appellant desires a reissue application with its earlier effective filing date and is perfectly willing to accept reissue restrictions. Indeed, Applicant has made every effort possible to accept such reissue application restrictions as detailed above. But such efforts have been thwarted by the

Decisions on Petition and despite Applicants repeated filings all of which indicate an intention and willingness to accept reissue restrictions . . . It is only Applicant's representatives inadvertent error upon filing, corrected with later filings, that is being used by the USPTO to confine this application to a "Bauman" Continuation thus effectively denying Applicants ability to seek protection under the patent laws for the full measure of protection there afforded.

(Appeal Br. 12–13.) However, certain procedural decisions made during the examination proceeding (e.g., compliance with the six reissue indicia pursuant to MPEP § 1451) are not appealable, and thus, this issue is not before us and we express no opinion as to its propriety. *See In re Hengehold*, 440 F.2d 1395, 1403 (CCPA 1971) (“There are a host of various kinds of decisions an examiner makes in the examination proceeding—mostly matters of a discretionary, procedural or nonsubstantive nature—which have not been and are not now appealable to the board or to this court when they are not directly connected with the merits of issues involving rejections of claims, but traditionally have been settled by petition to the Commissioner.”)

Moreover, MPEP § 1451 lists six such indicia that a continuing reissue application is filed, namely (1) a 37 C.F.R. § 1.175 oath/declaration, which is not merely a copy of the parent's reissue oath/declaration; (2) a specification and/or claims in proper double column reissue format per 37 C.F.R. § 1.173; (3) amendments in proper format per 37 C.F.R. § 1.173, i.e., amending the claims vis-à-vis the claims of the patent seeking to be reissued; (4) a 37 C.F.R. § 3.73 statement of assignee ownership and consent; (5) a correct transmittal letter identifying the application as a reissue filing under 35 U.S.C. § 251; and (6) an identification of the application as being (a) a reissue continuation of the parent reissue

application; (b)(i) a continuation of the parent reissue application, *and* (ii) an application to reissue the patent; or (c) equivalent language. Notably, indicia (6) most clearly distinguishes these identifications from merely stating that the application is a continuation of the parent reissue application, and gives nine examples of acceptable identifications of reissue continuing applications as opposed to “*Bauman-type*” continuation applications. What all of these indicia have in common is the identification of an attempt to file a reissue application under 35 U.S.C. § 251 as opposed to a utility application under 35 U.S.C. § 1.111(a), merely claiming a priority benefit to a reissue application. Although the MPEP does not specify how many of the six enumerated indicia must be present to identify a reissue continuation application, the MPEP nonetheless states explicitly that when there are *no such indicia* on filing, a continuing application of a reissue application will be considered a “*Bauman-type*” continuing application. MPEP § 1451; *see also Reissue Filing Guide for Applications Filed on/after September 16, 2012*.⁴ We note that Appellant has not identified any error in the Petition Decisions’ findings that none of the indicia that Appellant was filing a continuing reissue application enumerated in MPEP § 1451 were present at the time of filing.⁵

⁴www.uspto.gov/sites/default/files/forms/uspto_reissue_ads_guide_Sept2014.pdf

⁵ Appellant’s argument that the claim of priority to a great grandparent application “may only be valid in a reissue application” is not persuasive because identification of the chain of priority designation would also be required to properly file a non-reissue, *Bauman-type* continuation application claiming priority to a reissue application. Accordingly, reciting the applications that led to the reissue application being relied upon, without

Because we decline to disturb the procedural posture set forth in the Petition Decisions in this case, we also affirm the anticipation rejection based on the Examiner’s finding that Toyokawa (US 2009/0290529 A1) is prior art.

§ 102 Rejection—O’Neill

We are persuaded by Appellant’s arguments (Reply Br. 4–5) that O’Neill does not describe the limitation “sending a transfer cancel notification to the relaying intermediate node at the movement destination of the mobile node,” as recited in independent claim 9.

The Examiner found that the absence of tunnel 710, as illustrated in Figure 8 of O’Neill, in comparison to Figure 7 of O’Neill, corresponds to the limitation “sending a transfer cancel notification to the relaying intermediate node at the movement destination of the mobile node.” (Final Act. 10–11; *see also* Ans. 20–21.) In particular, the Examiner found that “[t]his [cancelled tunnel 710] would occur as a result of messaging between home node 632 and *the relaying intermediate node 605*,” with a citation to paragraph 27 of O’Neill. (Final Act. 10–11(emphasis added).) We do not agree with the Examiner’s findings.

O’Neill relates to “enabling the use of multiple uplinks and a downlink corresponding to a mobile node at the same time.” (¶ 2.) Figures 7–9 of O’Neill illustrates “signaling and operations associated with the establishment of forward and reverse tunnels” (¶¶ 36–38), which includes mobility agent node 632, access nodes 605, 605', 605", and end

more, is not one of the indicia for demonstrating an intent to file a reissue application enumerated in MPEP § 1451.

node 604 (¶ 53). In particular, Figure 7 of O'Neill illustrates both outgoing tunnel 710 and incoming tunnel 711 from mobility agent node 632 to access node 605. However, Figure 8 of O'Neill illustrate only tunnel 711 from mobility agent node 632 to access node 605. In Figure 8, access node 605 represents the relaying intermediate node at the movement *source* of the mobile node, not "the relaying intermediate node at the movement *destination* of the mobile node" (i.e., node 605') to which the claims recite the "transfer cancel notification" is sent.

Moreover, O'Neill explains that "[t]unnels between an HA [Home Agent, i.e. home node] and a CoA [Care-of-Address] corresponding to a mobile node [can be bidirectional], incoming only, outgoing only or canceled" and "[t]he modification of the tunnel type indicator flag can be in response to a registration message used to trigger modification of the tunnel information, said registration message including tunnel end node addresses corresponding to the ends of the tunnel which is to have its registration information modified." (¶ 27.)

Although the Examiner cited to: (i) the differences between Figures 7 and 8 of O'Neill, including the absence of tunnel 710, and; (ii) the explanation in O'Neill that tunnels between mobility agent node 632 and end node 604 can be "canceled," the Examiner has provided insufficient evidence to support a finding that O'Neill teaches the limitation "sending a transfer cancel notification to the relaying intermediate node at the movement destination of the mobile node." In particular, paragraph 27 of O'Neill is silent respect to any "notification" resulting in the cancellation of tunnel 710, much less any "notification" sent to access node 605' in Figure 8 or node 605" in Figure 9 (i.e., the relaying intermediate nodes at the

movement *destination* of the mobile node in each figure, respectively), resulting in the cancellation of forwarding tunnel 710, as required by claim 9. Thus, on this record, the Examiner has not demonstrated that O'Neill teaches the limitation "sending a transfer cancel notification to the relaying intermediate node at the movement destination of the mobile node." While such limitation of "sending a transfer cancel notification to the relaying intermediate node at the movement destination of the mobile node" may be obvious over O'Neill under 35 U.S.C. § 103, the issue of obviousness is not before us.

Accordingly, we are persuaded by Appellant's arguments as follows:

despite [O'Neill's] alleged indication that "tunnels may be cancelled" and the disappearance of tunnels between Fig. 7 and Fig. 8, O'Neill does not indicate how such cancelation is achieved. Certainly, O'Neill does not "identically" disclose, "arranged as in the claims", a transfer cancel notification to the relaying intermediate node at the movement destination of the mobile node. The Examiner's speculation regarding "messaging between home node 632 and the relaying intermediate node 605" even if shown, would be different from what is claimed.

(Reply Br. 4–5 (footnote omitted).)

Thus, we do not sustain the rejection of independent claim 9 under 35 U.S.C. § 102(a)(1). Claims 10 and 11 depend from claim 9. We do not sustain the rejection of claims 10 and 11 under 35 U.S.C. § 102(a)(1) for the same reasons discussed with respect to claim 9.

Independent 12 recites limitations similar to those discussed with respect to claim 9. We do not sustain the rejection of claim 12, as well as dependent claims 13 and 14, for the same reasons discussed with respect to claim 12.

CONCLUSION

The Examiner's decision rejecting claims 9–14 under 35 U.S.C. § 102(a)(1) is affirmed.

DECISION

In summary:

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
9–14	102(a)(1)	Toyokawa	9–14	
9–14	102(a)(1)	O'Neill		9–14
Overall Outcome			9–14	

TIME PERIOD FOR RESPONSE

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