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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/579,085	10/24/2012	Hiroyuki Ishii	17470/262001	2528
22511	7590	10/14/2020	EXAMINER	
Osha Bergman Watanabe & Burton LLP TWO HOUSTON CENTER 909 FANNIN, SUITE 3500 HOUSTON, TX 77010			ROSE, DERRICK V	
			ART UNIT	PAPER NUMBER
			2462	
			NOTIFICATION DATE	DELIVERY MODE
			10/14/2020	ELECTRONIC

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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* HIROYUKI ISHII and MIKIO IWAMURA

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Appeal 2020-003151  
Application 13/579,085  
Technology Center 2400

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Before JOHNNY A. KUMAR, CATHERINE SHIANG, and  
BETH Z. SHAW, *Administrative Patent Judges*.

KUMAR, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner's decision to reject claims 46, 47, 50, 52, 54, 56, 57, 61, 63, 64, 66, and 67. *See* Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> We use the term "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as NTT DOCOMO, Inc. Appeal Br. 4.

*Exemplary Claim*

Exemplary claim 46 under appeal reads as follows:

46. A mobile station configured to communicate with a radio base station of a serving cell, the mobile station comprising:  
a processor, in conjunction with a receiver, configured to:  
    measure radio quality of the serving cell for at least one carrier,  
    measure radio quality of at least one neighboring cell for the at least one carrier, and  
    determine if a predetermined event is triggered based on first measurement results, the first measurement results comprising at least one of the measured radio quality of the serving cell and the measured radio quality of the at least one neighboring cell; and  
a transmitter configured to transmit to the radio base station, if the predetermined event is triggered, a measurement report including the first measurement results that triggered the predetermined event and second measurement results comprising radio quality and a physical cell ID of the at least one neighboring cell for a carrier other than the at least one carrier for which the predetermined event is triggered.

REFERENCES

The prior art relied upon by the Examiner is:

<b>Name</b>	<b>Reference</b>	<b>Date</b>
Kuroda	US 2008/0285477 A1	Nov. 20, 2008
Kazmi	US 2010/0041384 A1	Feb. 18, 2010
Sagfors	US 2011/0170418 A1	July 14, 2011
Jung	US 2012/0076041 A1	Mar. 29, 2012

*Rejections on Appeal*

Claims 46, 47, 50, 52, 54, 56, 57, 61, 63, 64, 66, and 67 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Sagfors in view of Kazmi and further in view of Jung. Final Act. 4.

Claims 54, and 61 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Sagfors in view of Kazmi in view of Jung and further in view of Kuroda. Final Act. 6.

*Appellant's Contentions*

1. Appellant contends the Examiner erred in rejecting independent claims 46, 47, 56, 57, 63, 64, 66, and 67 because “Sagfors fails to suggest at least measuring ‘radio quality of at least one neighboring cell *for the at least one carrier.* ’” as required by the independent claims. Appeal Br. 15 (hereinafter disputed limitation).

Appellant also contends “[o]ne of ordinary skill in the art would have no motivation to modify the cited prior art in the manner suggested in the Examiner’s Answer.” Reply Br. 2. In particular, Appellant further contend:

it is clear that Sagfors considers the measurement configuration described in par. [0043] problematic and to be avoided under **CA [carrier aggregation]**. Accordingly, even assuming *arguendo* the cited prior art can be modified based on par. [0043] of Sagfor[s], one of ordinary skill in the art would not have the motivation to make the modification given that Sagfor[s] expressly **teaches away** from the modification.

*Id.* at 3. (hereinafter teaching away contention) emphasis added.

2. Appellant also contends the Examiner erred in rejecting independent claims 46, 47, 56, 57, 63, 64, 66, and 67 because “The Examiner’s Answer is based on an unreasonable interpretation of claim limitations” Reply Br. 4. In particular, Appellant further contends “Contrary to the Examiner’s statement that the two terms [physical layer identity and physical cell ID] ‘aren't inherently different,’ Appellant has submitted the declaration as evidence to demonstrate that the two terms are

inherently different.” *Id.* at 4, 5. (hereinafter inventor declaration contention).

3. Appellant contends the Examiner erred in failing “to properly designate a new ground of rejection” in the Answer. Reply Br. 6. In particular, Appellant submits that the Examiner’s Answer is defective and should not be given consideration:

the Examiner has introduced two new references, namely, U.S. Patent Application Publication No. 2012/0094673 (“Sebire”) and U.S. Patent Application Publication No. 2009/0061878 (“Fischer”), in support of the mapping between the claimed “physical cell ID” and the “physical layer identity” allegedly disclosed in Kazmi. *See* Examiner’s Answer, pp. 8-9. While the introduction of new references necessitates a new ground of rejection, the Examiner has failed to make proper designation thereof in the Examiner’s Answer.  
*Id.* (hereinafter new ground contention).

#### ANALYSIS

We have only considered those arguments that Appellant actually raised in the Briefs. Arguments Appellant could have made, but chose not to make, in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

We have reviewed the Examiner’s rejections in light of Appellant’s arguments that the Examiner has erred. We adopt as our own the findings and reasons set forth in the Examiner’s Answer (*see* Ans. 7–9). We highlight and address specific findings and arguments for emphasis as follows.

As to Appellant’s contention 1, initially we note that Appellant’s arguments are not commensurate with the scope of the claim because the claim does not recite “carrier aggregation.”

The Examiner determines that in Paragraph 20, Sagfors teaches the disputed limitation (Final Act. 4, citing Fig. 3, ¶ 20), which is not rebutted by Appellant. Regarding Appellant’s contention about ¶ 43 of Sagfors, Examiner’s reliance upon ¶ 43 of Sagfors is *cumulative* to that of ¶ 20—not teaching away. “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *Ricoh Co. v. Quanta Computer Inc.*, 550 F.3d 1325, 1332 (Fed. Cir. 2008) (citations and internal quotation marks omitted). Teaching an alternative or equivalent method, however, does not teach away from the use of a claimed method. *See In re Dunn*, 349 F.2d 433, 438 (CCPA 1965). A reference does not teach away if it merely expresses a general preference for an alternative invention from amongst options available to the ordinarily skilled artisan, and the reference does not discredit or discourage investigation into the invention claimed. *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

Based on the record before us, we find no error in the Examiner’s rejection of representative claims 46, 47, 56, 57, 63, 64, 66, and 67, for the reasons indicated by the Examiner, as our interpretation of the disclosure of Sagfors coincides with that of the Examiner.

As to Appellant’s contention 2, on pages 8 and 9 of the Answer, the Examiner provides a well-reasoned explanation, which demonstrates that the claimed “physical cell ID” encompasses Kazmi’s “physical layer identity” (citing Kazmi, ¶ 42). We concur with the Examiner’s fact finding as it is supported by Kazmi’s disclosure.

In particular, the Examiner determines, and we agree:

The Specification of this application doesn't mention a physical layer identity so there is no distinction between the two (they aren't inherently different). Also it is evident that Physical cell ID is simply an identifier of the cell in the broadest reasonable interpretation (See Specifications ¶0116, ¶0118, and ¶0126). Despite the declaration under 37 CFR §1.132 filed July 16, 2018, a physical cell ID is equivalent to a physical layer identity due to the fact that both are used to distinguish a cell. Also it should be noted that the claims have not specifically precluded a physical layer identity as described in Kasmi.

In addition the declaration is insufficient to overcome the rejection under 35 USC §103(a) based upon the Kazmi reference because a measurement is identifying new /unknown cells that have physical layer identifiers and measurements are sent in measurement reports. The factual findings in TS 36.211 is not enough to overturn sending the physical layer identifier for new /unknown cells because in Kazmi the new /unknown cells are identified and measured and reported based on the physical layer identifier (Kazmi ¶0037 and ¶0042).

Ans. 8.

Further, we are unpersuaded by the inventor declaration, especially because the Federal Circuit has declared “[t]he testimony of an inventor and his attorney concerning claim construction is thus entitled to little or no consideration. The testimony of an inventor often is a self-serving, after-the-fact attempt to state what should have been part of his or her patent application.” *Bell & Howell Document Mgmt. Prods. v. Altek Sys.*, 132 F.3d 701, 706 (Fed.Cir.1997).

As to Appellant’s contention 3, we note that the Examiner relied upon the Sebire and Fischer references to construe the term physical cell ID and show that it is the same as physical layer identifier. Ans. 8, 9. This is proper because the references have been provided for the missing limitation only to

show that the “terms ‘physical cell ID’ and a ‘physical layer identifier’ are accepted in the art as interchangeable.” *Id.* at 9.

Further, Appellant’s new ground contention is a petitionable<sup>2</sup>—not appealable—matter and is, therefore, not before us. *See* MPEP § 1002.02(c) (Petitions and Requests Decided by the Technology Center Directors) (“Petitions . . . to request review of the primary examiner’s failure to designate a rejection in the examiner’s answer as a new ground of rejection”); *see also* MPEP § 1201 (“The Board will not ordinarily hear a question that should be decided by the Director on petition . . .”).

Accordingly, Appellant has not provided sufficient evidence or argument to persuade us of any reversible error in the Examiner’s reading of the contested limitations on the cited prior art, or in the proper combinability of the prior art references as suggested by the Examiner. Therefore, we sustain the Examiner’s obviousness rejection of independent claims 46, 47, 56, 57, 63, 64, 66, and 67; and the dependent claims not argued separately.

Consequently, we conclude there is no reversible error in the Examiner’s rejections of claims 46–47, 50, 52, 54, 56–57, 61, 63, 64, 66, and 67.

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<sup>2</sup> See MPEP §1207.03:

If appellant believes that an examiner’s answer contains a new ground of rejection not identified as such, appellant may file a petition under 37 CFR 1.181(a) within two months from the mailing of the examiner’s answer requesting that a ground of rejection set forth in the answer be designated as a new ground of rejection.

MPEP §1207.03, IV (Eighth Edition, August 2001, Revised August 2012).



DECISION SUMMARY

<b>Claim(s) Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
46, 47, 50, 52, 54, 56, 57, 61–67	103(a)	Sagfors, Kazmi, Jung	46, 47, 50, 52, 54, 56, 57, 61, 63, 64, 66, 67	
54, 61	103(a)	Sagfors, Kazmi, Jung, Kuroda	54, 61	
<b>Overall Outcome</b>			46, 47, 50, 52, 54, 56, 57, 61, 63, 64, 66, 67	

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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED