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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TOMAS NYLANDER, MATS BUCHMAYER, and JARI VIKBERG

Appeal 2015-004677
Application 12/991,502[1]
Technology Center 2400

Before LARRY J. HUME, SCOTT B. HOWARD, and MATTHEW J. McNEILL, *Administrative Patent Judges*.

HUME, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the Final Rejection of claims 1–8 and 14–17. Appellants have withdrawn claims 9–13 from consideration. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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[1] According to Appellants, the real party in interest is Telefonaktiebolaget LM Ericsson (publ). App. Br. 2.

STATEMENT OF THE CASE[2]

The Invention

Appellants' disclosed and claimed "invention relates to a method and arrangement in a telecommunication system, in particular to paging optimization in an evolved UTRAN (E-UTRAN) applying so called Home eNodeBs . . . [and m]ore particularly, the present invention relates to methods and arrangements in a gateway node and a core network node for paging a communication device." Spec. 1, ll. 5–9 ("Technical Field").

Exemplary Claims

Claims 1 and 2, reproduced below, are representative of the subject matter on appeal (*emphases* added to contested limitations):

> 1. A method in a gateway node *for forwarding a page message* to a communication device, wherein the gateway node serves a plurality of radio base stations, wherein a radio communication system comprises the gateway node, the communication device and said plurality of radio base stations, the method comprising:
>
> *receiving the page message and a list of Closed Subscriber Group (CSG) Identities, in conjunction therewith, wherein each of the CSG Identities is indicative of which radio base stations among said plurality of radio base stations the communication device is allowed to access*;

[2] Our decision relies upon Appellants' Appeal Brief ("App. Br.," filed Feb. 19, 2014); Examiner's Answer ("Ans.," mailed June 6, 2014); Final Office Action ("Final Act.," mailed Aug. 21, 2013); and the original Specification ("Spec.," filed Nov. 8, 2010). We note Appellants did not file a Reply Brief in response to the factual findings and legal conclusions in the Examiner's Answer.

selecting, based on the list of CSG Identities received in conjunction with the received page message, a subset of radio base stations among said plurality of radio base stations; and

forwarding the page message to each radio base station in the selected subset of radio base stations, whereby the communication device is paged only via radio base stations that the communication device is allowed to access.

2. The method according to Claim 1, *further configuring the gateway node, before receiving the page message, to select the subset of radio base stations based on the list of CSG Identities that will be received* in conjunction with the page message.

Prior Art

The Examiner relies upon the following prior art as evidence in rejecting the claims on appeal:

Gupta et al. ("Gupta") US 2009/0094680 A1 Apr. 9, 2009

Rejections on Appeal

R1. Claim 2 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Ans. 3.

R2. Claims 1–8 and 14–17 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Gupta. Ans. 4.

ISSUES AND ANALYSIS

In reaching this decision, we consider all evidence presented and all arguments actually made by Appellants. We do not consider arguments that Appellants could have made but chose not to make in the Briefs, and we deem any such arguments waived. 37 C.F.R. § 41.37(c)(1)(iv).

We agree with particular arguments advanced by Appellants with respect to the indefiniteness Rejection R1 of claim 2 and anticipation Rejection R2 of claim 1 for the specific reasons discussed below. We highlight and address specific findings, arguments, and conclusions regarding claims 1 and 2 for emphasis as follows.

1. § 112, ¶ 2 Rejection R1 of Claim 2

Issue 1

Appellants argue (App. Br. 10) the Examiner's rejection of claim 2 under 35 U.S.C. § 112, second paragraph, as being indefinite is in error. These contentions present us with the following issue:

Did the Examiner err in concluding "[i]t is confusing how '*to select the subset of radio base stations based on the list of CSG Identities that will be received in conjunction with the page message*' '*before receiving the page message*', wherein the page message comprises the list of CSG [Closed Subscriber Group]," in connection with the definiteness of dependent claim 2 under § 112? Ans. 3–4.

Analysis

Appellants contend:

> Claim 2 is about configuring the gateway node to be able to perform a selection step once the CSG identities are received with the page message. The gateway node would need to be so configured so that once the page message and CSG identities are received, it can perform other steps. *This claim appears clear on its face*, and Applicants respectfully request reconsideration and allowance of the claim.

App. Br. 10 (emphasis added).

While Appellants' argument appears to be conclusory, relating to preparatory configuration actions to be taken by the gateway node in advance of receiving the page message and the *actual* CSG Identities list, we do not agree with the Examiner's conclusion that the current recitation of claim 2 is confusing, and reasonably interpreted as being inconsistent with the recitations of claim 1.

"[I]f a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim . . . indefinite." *Ex parte Miyazaki,* 89 USPQ2d 1207, 1211 (BPAI 2008) (precedential). *See* also *In re Packard*, 751 F.3d 1307, 1324 (Fed. Cir. 2014), (J. Plager concurring) ("In my view (and that of the *per curiam court*), it is within the authority of the USPTO to so interpret the applicable standard").

We disagree with the Examiner's conclusion of indefiniteness because claim 1, from which claim 2 depends, recites "receiving the page message and a list of Closed Subscriber Group (CSG) Identities, *in conjunction therewith*" (emphasis added), which can reasonably be interpreted as the list of CSG Identities being received *at the same time* as the page message. Dependent claim 2 recites, "configuring the gateway node, *before receiving the page message*, to select the subset of radio base stations *based on the list of CSG Identities that will be received* . . . ."

Thus, claim 2 does not require, and explicitly disclaims, the page message needing to be received in order to configure the gateway node. We read this limitation as merely requiring preparatory action to configure the

gateway node to account for the fact that CSG Identities *will be* received in the future.[3]

Therefore, on this record, we are persuaded of at least one error in the Examiner's resulting legal conclusion of indefiniteness of dependent claim 2.

2. § 102(e) Rejection R2 of Claims 1–8 and 14–17

Issue 2

Appellants argue (App. Br. 10–12) the Examiner's rejection of claim 1 under 35 U.S.C. § 102(e) as being anticipated by Gupta is in error. These contentions present us with the following issue:

Did the Examiner err in finding the cited prior art discloses a "method in a gateway node for forwarding a page message to a communication device" that includes, *inter alia*, the steps of "receiving the page message and a list of Closed Subscriber Group (CSG) Identities, in conjunction therewith, wherein each of the CSG Identities is indicative of which radio base stations among said plurality of radio base stations the communication device is allowed to access," and "forwarding the page message to each radio base station in the selected subset of radio base stations, whereby the communication device is paged only via radio base stations that the communication device is allowed to access," as recited in claim 1?

Analysis

Appellants contend, "*Gupta* has not been shown to disclose a network node that forwards any message *to a selected subset of radio base stations*.

[3] Although not before us on Appeal, we leave it to the Examiner to determine whether claim 2 meets the enablement requirement of 35 U.S.C. § 112, first paragraph.

Instead, in *Gupta*, the communication device (or access terminal — a mobile phone) requests access to an access point that it may or may not have access to . . . . The access point must then determine whether to grant access based on the access list . . . [but] in the present claims, no determination is made because only radio base stations that have been selected will page the communications device." App. Br. 11 (citing Gupta ¶¶ 53-54). In particular, Appellants contend Gupta does not disclose "receiving" or "forwarding" a *page message*, as claimed. *Id.*

Anticipation of a claim under 35 U.S.C. § 102 occurs when each claimed element and the claimed arrangement or combination of those elements is disclosed, inherently or expressly, by a single prior art reference. *Therasense, Inc.* v. *Becton, Dickinson & Co.,* 593 F.3d 1325, 1332 (Fed. Cir. 2010). A reference inherently discloses an element of a claim "if that missing characteristic is *necessarily* present, or inherent, in the single anticipating reference." *Schering Corp. v. Geneva Pharms.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003) (citation omitted) (emphasis added). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Therasense*, 593 F.3d at 1332 (citing *Cont'l Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264,1269 (Fed. Cir. 1991)).

We agree with Appellants' arguments, and disagree with the Examiner's findings regarding the disclosure of Gupta. We disagree with the Examiner because, while Gupta generally discloses access control, there is no explicit disclosure of a *page message*, nor is there any evidence of record that would support a finding that such a page message is *inherently* disclosed by the disclosure of Gupta.

Therefore, based upon the findings above, on this record, we are persuaded of at least one error in the Examiner's reliance on the cited prior art to disclose the disputed "page message" limitations of claim 1, such that we cannot sustain the Examiner's anticipation rejection of independent claim 1, or independent claim 8 which recites the contested limitations in commensurate form. For the same reasons, we cannot sustain the anticipation rejection of dependent claims 2–8 and 14–17 which variously depend from claims 1 and 8.

CONCLUSIONS

(1) The Examiner erred with respect to indefiniteness Rejection R1 of claim 2 under 35 U.S.C. § 112, second paragraph, and we do not sustain the rejection.

(2) The Examiner erred with respect to anticipation Rejection R2 of claims 1–8 and 14–17 under 35 U.S.C. § 102(e) over the cited prior art of record, and we do not sustain the rejection.

DECISION

We reverse the Examiner's decision rejecting claims 1–8 and 14–17.

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).

REVERSED