

Federal Circuit Patent Bulletin: *IPCom GmbH & Co. v. HTC Corp.*

July 11, 2017

"[T]he PTO may not disregard the structure disclosed in the specification corresponding to [means-plus-function claim] language when rendering a patentability determination."

On July 7, 2017, in *IPCom GmbH & Co. v. HTC Corp.*, the U.S. Court of Appeals for the Federal Circuit (Prost, Cleverger, Chen*) affirmed-in-part, vacated-in-part and remanded the U.S. Patent and Trademark Office Patent Trial and Appeal Board inter partes reexamination decision that certain claims of U.S. Patent No. 6,879,830, which related to a method and system for handing over a mobile phone call from one base station to another base station, were invalid for obvious under 35 U.S.C. § 103. The Federal Circuit stated:

[T]he issue of identifying in the '830 patent the algorithm for performing the "arrangement for reactivating the link" function was front and center during the reexamination. The Board rejected IPCom's proposed three-step algorithm of: (1) "receiving a rejection from the second (i.e., target) base station"; (2) "sending a message to the first (i.e., old) base station to maintain the link with the first base station"; and (3) "re-establishing the link with the first base station by receiving a message from that first base station." Rather than inquiring further into what algorithm (if any) the specification actually discloses, however, the Board only questioned whether each individual step of IPCom's proposed algorithm was separately necessary. For step one, the Board found that the specification described an example of an "algorithm structure" that "does not involve receiving a rejection from the second base station" because "in some cases . . . no other base station is receiving." For step two, the Board cited the specification's discussion of a timer mechanism that purportedly obviated the need for a message to be sent to the

Authors

Lawrence M. Sung
Partner
202.719.4181
lsung@wiley.law

Neal Seth
Partner
202.719.4179
nseth@wiley.law

Practice Areas

Intellectual Property
Patent

first base station to reactivate the link with the first base station. For step three, the Board pointed to the specification's explanation that the mobile station "re-registers at its old [base station] and keeps its previous settings," purportedly without requiring a receipt of an acknowledgement message from the first base station. The Board then concluded its analysis by stating that it "need not consider whether or not the combination of Anderson and McDonald discloses or suggests these method steps."

The Board's analysis was erroneous because it never specified what it believed was the actual algorithm disclosed in the '830 patent for performing the "arrangement for reactivating the link" function. It was not enough for the Board to reject the individual steps of IPCom's proposed three-step algorithm. "[T]he PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination." [T]he Board here impermissibly treated the means-plus-function limitation in its patentability analysis as if it were a purely functional limitation. We vacate the Board's claim construction of the "arrangement for reactivating the link" limitation, and we remand for the Board to identify the corresponding algorithm (if any) in the specification in the first instance Because it never identified any algorithm for the "arrangement for reactivating the link" limitation, the Board also erred by failing to evaluate whether the prior art disclosed that algorithm (or its equivalents). We therefore vacate and remand the Board's finding of obviousness of claims 1, 18, 30, and 34, and their corresponding dependent claims.

We also address here the Board's findings on the other claim limitations—the "forced handover request message," "handover query," and "rejection message"—which are each recited in claims 18, 30, and 34. We then discuss the Board's rejections of claims 5–17 based on the "informing the mobile station" limitation, and the Board's rejections of claims 23 and 25 based on the limitation reciting different generations of radio communication standards, before addressing the motivation to combine McDonald, Anderson, GSM, and PACS to arrive at the claimed inventions. . . .

We agree that substantial evidence supports the Board's finding that the combination of Anderson and McDonald teaches the recited "informing the mobile station" limitation because Anderson teaches a successful handover, and McDonald describes cases in which handover is unsuccessful by using a busy OSW signal. Under the broadest reasonable construction, a combined system that can indicate either a successful handover using the features of Anderson or that no handover is possible using the features of McDonald is sufficient to meet the requirements of the claims, which only recite that the network informs the mobile base station whether a handover is possible. We affirm the Board's findings that combining Anderson and McDonald discloses the informing the mobile station limitation. . . .

Substantial evidence supports the Board's motivation to combine findings. Both Anderson and McDonald teach solutions for solving the problem of an unsuccessful handover in a cellular telephone network, and each teach a means for returning to a first base station after a failed handover attempt to a second base station. . . . A person of ordinary skill in the art would have been motivated to combine these teachings to solve the common problem of unsuccessful handovers. Combining McDonald with Anderson's "make before break" embodiment also teaches the "informing the mobile station" limitation In light of their interrelated teachings, combining these four known systems for handover and handoff for cellular telephone systems would have resulted in no more than the predictable result for a system for handing over mobile stations

between base stations, consistent with the GSM and PACS industry standards. For these reasons, we affirm the Board's factual findings that the prior art discloses all the limitations of the challenged claims on appeal, except for the "arrangement for reactivating the link" means-plus-function limitation. We also affirm the Board's finding of a motivation to combine McDonald, Anderson, GSM, and PACS to arrive at the combinations recited in the challenged claims except for the "arrangement for reactivating the link" limitation. We vacate and remand the Board's findings on the "arrangement for reactivating the link" limitation.