



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 13/017,455   | 01/31/2011  | Lisa M. Connelly     | 4100-808950-US      | 6675             |
| 114592   | 7590        | 10/31/2016           | EXAMINER            |                  |
| Alcatel-Lucent USA Inc.<br>C/O Davidson Sheehan LLP<br>8834 North Capital of TX Hwy<br>Suite 100<br>Austin, TX 78759 |             |                      | LIU, JUNG-JEN       |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2473                |                  |
|  |             |                      | NOTIFICATION DATE   | DELIVERY MODE    |
|  |             |                      | 10/31/2016          | ELECTRONIC       |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@ds-patent.com  
kasey.larocca@ds-patent.com  
ipsnarocp@nokia.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* LISA M. CONNELLY, JACOB HILLIS, SUBHASHISH GHOSH,  
HAWNLI NIAN, ANNE Y. LEE, and MA-LUNG CHUNG

---

Appeal 2015-004432  
Application 13/017, 455  
Technology Center 2400

---

Before ERIC S. FRAHM, NATHAN A. ENGELS and SCOTT E. BAIN,  
*Administrative Patent Judges.*

BAIN, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants<sup>1</sup> appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–22, which constitute all claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

STATEMENT OF THE CASE

Appellants' invention relates to providing alerts to particular subscribers in a communications systems. Spec. 2. Claims 1, 11, and 19 are independent. Claim 1 is illustrative of the invention and the subject matter of this appeal, and reads as follows (with the disputed limitations in italics):

---

<sup>1</sup> Appellants identify Alcatel Lucent as the real party in interest. App. Br. 3.

1. A method of operating a communication portal, the method comprising:

accessing, at the communication portal, an alert message addressed to a group registered to receive an alert service;

*generating, at the communication portal, user identifiers corresponding to users that are registered to the group, wherein the user identifiers are assigned to the users for use within the communication portal, and wherein the user identifiers are not communicated outside the communication portal to the users or a provider of the alert service; and*

transmitting the alert message from the communication portal to the users indicated by the user identifiers.

App. Br. A-1 (Claims App.).

Claims 1–22 stand rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Siegel et al. (US 2009/0191870 A1; pub. July 30, 2009) (“Siegel”) and Vainik et al. (US 2013/0157609 A1; June 20, 2013) (“Vainik”). Final Act. 6–52.

## ANALYSIS

We have reviewed the Examiner’s rejections in light of the arguments raised in the Briefs, on the record before us. For the reasons set forth below, we do not sustain the Examiner’s rejections.

Appellants argue the Examiner erred in rejecting independent claim 1 because, according to Appellants, the prior art does not teach “wherein the user identifiers are not communicated outside the communication portal to the users or a provider of the alert service,” as recited in claim 1. App. Br. 6–8. Specifically, Appellants argue the Examiner erred in finding the disputed limitation in Siegel. *Id.* Appellants allege the Examiner has provided multiple interpretations of “user identifier” as taught in Siegel, and

under each interpretation, Siegel plainly teaches such “user identifier” being communicated *outside* the communication portal and to users and provider of the alert service, contrary to the claim limitations. *Id.* On the record before us, we are persuaded by Appellants’ argument.

As Appellants allege, App. Br. 6–7, the Examiner finds Appellants’ claimed “user identifier[s]” in Siegel’s teaching of a “Public User Identity (PUID)” or, alternatively, a “Private User Identity (PRUID).” Final Ans. 7, 8 (citing Siegel Figs. 1A-1H, 2A-2B, 3, 16; ¶¶ 89, 100). Siegel, however, teaches the “PUID” being the user’s *public* address of record, Siegel ¶ 9, known to (and thus communicated to) the user, *id.* at ¶¶ 31, 100, and communicated to application servers, *id.* at ¶ 100. *See* App. Br. 6. These communications occur outside what the Examiner finds to be the “communication portal.” *See* Final Act. 6 (“P-CSCF, S-CSCF, or I-CSCF may function as a portal”). Similarly, Siegel teaches the “PRUID” is known to the user and communicated outside the communications portal, including in a header of an IMS register message sent from the user equipment to the home network. Siegel Fig. 7, ¶¶ 110, 113; App. Br. 7.

In response to Appellants’ arguments, the Examiner asserts that Appellants’ own Specification includes embodiments in which the “user identifier” is stored (in databases) outside the communication portal, just as in Siegel. Ans. 55 (citing Appellants’ Fig. 2). The Examiner suggests this disclosure broadens claim 1 such that Siegel teaches the disputed limitation. *Id.* We disagree. The plain language of claim 1 requires “the user identifiers are *not* communicated outside the communication portal to the users or a provider of the alert service.” App. Br. A-1 (emphasis added). Although we give claims their broadest reasonable interpretation consistent

with the specification, we do not read limitations or embodiments from the specification into the claims. *See, e.g., E-Pass Techs., Inc. v. 3Corn Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003). To interpret claim 1 as allowing communication of the user identifier to users outside the portal, as the Examiner suggests, would directly contradict the claim language, and therefore we decline to do so. *Id.*; *see also In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

Because we find, on the record before us, the Examiner erred in finding the foregoing disputed limitation of claim 1 taught in the prior art, we need not reach Appellants' remaining arguments on that claim. Appellants' arguments also persuade us, for the same reasons as discussed above, the Examiner erred in rejecting independent claims 11 and 19, which include limitations commensurate in scope to the disputed limitation of claim 1. *See App. Br. 10, 12.*

Accordingly, we do not sustain the Examiner's rejection of independent claims 1, 11, and 19 under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Siegel and Vainik. For the same reasons, we also do not sustain the same rejection of dependent claims 2–10, 12–18, and 20–22, which depend from claims 1, 11, and 19 and therefore also include the disputed limitation.

#### DECISION

We reverse the Examiner's rejection of claims 1–22.

REVERSED