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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MIRA VRBASKI, LUI CHU YEUNG,
HAMDY FARID, and ALLEN ROBINSON

Appeal 2015-004699
Application 13/343,357
Technology Center 2400

Before ST. JOHN COURTENAY III, TERRENCE W. McMILLIN, and
NORMAN H. BEAMER, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's Non-Final Rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

Invention

The disclosed and claimed invention on appeal relates “generally to telecommunications networks.” (Spec. ¶ 1.) More particularly, the invention relates “to a method performed by a policy and charging rules node (PCRN) of generating a notification message.” (Abstract.)

Representative Claim 1

1. A method performed by a policy and charging rules node (PCRN) of generating a notification message, the method comprising:

[L1] *defining a notification server profile including an address of a notification server;*

defining a notification template including a message body and a variable;

defining an action rule including a condition, a first action implementing a policy decision, and a second action for sending a notification message;

evaluating the condition of the action rule using a rules engine based on context information related to the state of a mobile network;

[L2] *determining, by the rules engine, a result set including a value of an attribute determined by the first action;*

placing the value of the attribute in the variable to form a notification message; and

[L3] *sending the notification message to the address of the notification server.*

(Emphasis and bracketed lettering added to highlight contested limitations (L1, L2, and L3).)

Rejection

Claims 1–20 are rejected under 35 U.S.C. § 103(a) over the combined teachings and suggestions of Li et al. (US 2013/0031231 A1; Jan. 31, 2013) and Batz et al. (US 2006/0047814 A1; Mar. 2, 2006).

Grouping of Claims

Based on Appellants’ arguments, we decide the appeal of all rejected claims on the basis of representative independent claim 1, except for dependent claims 2 and 15, which are argued separately, and addressed *infra*. See 37 C.F.R. § 41.37(c)(1)(iv).

ANALYSIS

We have considered all of Appellants’ arguments and any evidence presented. For the reasons discussed below, and regarding contested limitations L1, L2, and L3 of representative claim 1, we disagree with Appellants’ arguments. However, for essentially the same reasons argued by Appellants, we reverse the Examiner’s rejection of dependent claims 2 and 15. We highlight and address specific findings and arguments for emphasis in our analysis below.

Rejection of Independent Claim 1 under 35 U.S.C. § 103(a)

Issue: Under 35 U.S.C. § 103(a), did the Examiner err in finding the cited combination of Li and Batz would have taught or suggested contested limitations L1, L2, and L3, within the meaning of claim 1?¹

¹ We give the contested claim limitations the broadest reasonable interpretation consistent with the Specification. See *In re Morris*, 127 F.3d

To the extent that Appellants may substantively contest limitations L1, L2, and L3, we are not persuaded by Appellants' arguments, because they are not responsive to the Examiner's specific findings.² In reviewing the administrative record, we find the Examiner's legal conclusion of obviousness is supported by a preponderance of the evidence, for the following reasons:

Limitation L1

Regarding contested limitation L1 (“*defining a notification server profile including an address of a notification server*”), Appellants contend: “While Li may disclose ‘notification server 5,’ Li is silent regarding the claimed definition of a notification server profile.” (App. Br. 7.)

However, Appellants have not identified any definition of a “notification server profile” in the Specification that would preclude the Examiner's reading.³ (*See* Ans. 3–4). Turning to the Specification for

1048, 1054 (Fed. Cir. 1997). *See, e.g.*, Spec. ¶ 84 (“the foregoing disclosure, description, and figures are for illustrative purposes only and do not in any way limit the invention, which is defined only by the claims.”).

² *See In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”). *Accord Ex parte Belinne*, No. 2009-004693, 2009 WL 2477843, at *4 (BPAI Aug. 10, 2009) (Informative) (“Appellants’ argument . . . repeatedly restates elements of the claim language[] and simply argues that the elements are missing from the reference.”)

³ Any special meaning assigned to a term “must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.” *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998); *see*

context, we merely find non-limiting descriptions of exemplary *notification server profiles* (e.g., see ¶¶ 6–7).⁴ In construing the contested definition as recited in the claim (“*defining a notification server profile including an address of a notification server;*”), we conclude “*defining a notification server profile*” merely requires “*including an address of a notification server;*” under a broad but reasonable interpretation of claim 1.⁵

The Examiner cites to *Li*, *inter alia*, paragraphs 138 and 147, as evidence in support of the rejection. Both cited paragraphs (*id.*) expressly describe: “[w]herein the account information notification control information [i.e., a ‘profile’] includes *a network address of a web notification server;*” which we find would have taught or suggested contested limitation L1. (Emphasis added).

also Helmsderfer v. Bobrick Washroom Equip., Inc., 527 F.3d 1379, 1381 (Fed. Cir. 2008) (“A patentee may act as its own lexicographer and assign to a term a unique definition that is different from its ordinary and customary meaning; however, a patentee must clearly express that intent in the written description.”).

⁴ See *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1346-47 (Fed. Cir. 2015) (“This court has repeatedly ‘cautioned against limiting the claimed invention to preferred embodiments or specific examples in the specification.’”) (quoting *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1328 (Fed. Cir. 2002)).

⁵ Because “applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee.” *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (citation omitted).

Limitation L2

Regarding contested limitation L2 (“*determining, by the rules engine, a result set including a value of an attribute determined by the first action;*”), Appellants merely contend:

On page 3, the Office Action cites more paragraph numbers from Li but fails to provide any explanation or articulated reasoning. Appellant[s] respectfully submit[] that Li is silent regarding the claimed determination of a result set.

(App. Br. 7.)

As evidence supporting the rejection, the Examiner cites to Li at paragraphs 82, 90, and 106 (Non-Final Act. 3), and further explains the basis for the rejection in the “Response to Argument” section of the Answer. The Examiner finds, *inter alia*, that Li’s online charging system

determines that the predetermined condition is satisfied from the message. Specifically, the message includes the amount of data (attribute) consumed by Mr. Zhang reaches or exceeds the first predetermined threshold (attribute) of 4.5 GB for the past first duration this month (attribute), e.g., 20 days (result set) (paragraphs [0011, 0065-66, 0100-101, 0110-111]).”

(Ans. 4–5.)

Appellants do not further substantively respond to the Examiner’s findings in the Reply Brief, other than to present an untimely argument that the additional step of “defining an action rule . . . implementing a policy decision” is “subject matter that the Examiner fails to address in the context of the claimed result set.” (Reply Br. 2.)⁶ However, Appellants have not addressed the Examiner’s specific findings regarding Li’s paragraphs 6, 7,

⁶ See 37 C.F.R. § 41.41(b)(2).

60, 65–68, and 101–106, as teaching or suggesting the newly argued step of “defining an action rule . . . implementing a policy decision” (Claim 1.)

Limitation L3

Regarding contested limitation L3 (“*sending the notification message to the address of the notification server*”), Appellants urge:

On page 3, the Office Action cites paragraph numbers from Li but fails to provide any explanation or articulated reasoning. Appellant[s] respectfully submit[] that the Examiner cited the same paragraph numbers for “defining a notification server profile including an address of a notification server.”

(App. Br. 8).

Although the Examiner does rely on the same paragraph numbers (as argued by Appellants (*id.*)), we find at least paragraph 113 of Li would have taught or suggested contested limitation L3, as claimed:

B) The Final-Indicate-Unit, which includes a Final-Unit action as a redirection action and a Redirection URL address, *where the Redirection URL address is the network address of the notification server 5.*

(Li ¶ 113, emphasis added).

Given this evidence (*id.*), we find Li at least suggests sending a message “where the Redirection URL address is the network address of the notification server 5.” In the Non-Final Action (page 3), the Examiner relies on Li’s paragraphs 50–53, 82–83, 101, 106, and 121, as teaching or suggesting *forming the notification message*, as claimed. Our reviewing court guides that “[c]ombining two embodiments disclosed adjacent to each other in a prior art patent does not require a leap of inventiveness.” *Boston Scientific Scimed, Inc. v. Cordis Corp.*, 554 F.3d 982, 991 (Fed. Cir. 2009).

For these reasons, and on this record, we find a preponderance of the evidence supports the Examiner’s underlying factual findings and ultimate legal conclusion of obviousness regarding the contested limitations of independent claim 1. Because Appellants have not persuaded us the Examiner erred, we sustain the § 103 rejection of representative claim 1 over the combination of Li and Batz. Grouped claims 1, 3–14, and 16–20 fall with claim 1.⁷ *See* Grouping of Claims, *supra*.

Dependent Claims 2 and 15

Regarding claims 2 and 15, Appellants contend:

On page 4, the Examiner cites various paragraph numbers from Li without explanation. Li is actually silent regarding the claimed “**Simple Object Access Protocol (SOAP) based web-service server**.” Thus, Appellant[s] respectfully submit[] that the Examiner has not presented a prima facie case of obviousness.

(App. Br. 9).

The Examiner disagrees, and discusses Li in the context of paragraphs 2, 52–56, and 79–83, and finds: “Therefore, Li discloses ‘wherein the notification server is a Simple Object Access Protocol (SOAP) based web-service server’.” (Ans. 6–7.)

⁷ Although Appellants argue that “[s]imilar subject matter [to claim 1] appears in claims 8 and 14” (App. Br. 7), we do not agree that independent claim 8 is of similar scope to independent claims 1 and 14. Nevertheless, Appellants do not advance separate, *substantive* arguments under 37 C.F.R. § 41.37(c)(1)(iv), regarding claim 8. Arguments not made are considered waived. (*Id.*)

Although the Simple Object Access Protocol (SOAP) is a notoriously well-known protocol, we agree with Appellants that Li is silent regarding the “Simple Object Access Protocol (SOAP) based web-service server” recited in claims 2 and 15. A text search of the secondary Batz reference reveals that Batz is also silent regarding the SOAP protocol, and thus cannot remedy the deficiency of Li.

In patent examination, it is the Examiner’s burden to demonstrate a prima facie case of obviousness that must satisfy the notice requirement of 35 U.S.C. § 132. *See Kennametal, Inc. v. Ingersoll Cutting Tool Co.*, 780 F.3d 1376, 1384 (Fed. Cir. 2015) (noting that the Patent Office “bears the initial burden of showing a prima facie case of obviousness”). The Federal Circuit guides “the prima facie case is merely a procedural device that enables an appropriate shift of the burden of production.” *Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007).

[A]ll that is required of the office to meet its prima facie burden of production is to set forth the statutory basis of the rejection and the reference or references relied upon in a sufficiently articulate and informative manner as to meet the notice requirement of [35 U.S.C.] § 132. As the statute itself instructs, the examiner must “notify the applicant,” “stating the reasons for such rejection,” “together with such information and references as may be useful in judging the propriety of continuing prosecution of his application.”

In re Jung, 637 F.3d 1356, 1363 (Fed. Cir. 2011).

This burden is met by “adequately explain[ing] the shortcomings [the Office] perceives so that the applicant is properly notified and able to respond.” *Hyatt*, 492 F.3d at 1370. It is only “when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection” that the prima facie burden has not been

met and the rejection violates the minimal requirements of 35 U.S.C. § 132. *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990).

Here, the Examiner fails to provide sufficient *specific* evidence of record to support the Examiner's finding that the cited references teach or suggest the contested "Simple Object Access Protocol (SOAP) based web-service server." (Claims 2, 15.) (Ans. 6–7.) Because we find the rejection of claims 2 and 15 fails to satisfy the minimal notice requirement of 35 U.S.C. § 132, we agree with Appellants the prima facie burden has not been met for these dependent claims.

Therefore, we are constrained by the *absence of any evidence in the record* which teaches or suggests a "Simple Object Access Protocol (SOAP) based web-service server," as contested by Appellants regarding claims 2 and 15. Accordingly, we reverse the Examiner's rejection of dependent claims 2 and 15.

Reply Brief

To the extent Appellants advance new arguments in the Reply Brief not in response to a shift in the Examiner's position in the Answer, we note arguments raised in a Reply Brief that were not raised in the Appeal Brief or are not responsive to arguments raised in the Examiner's Answer will not be considered except for good cause. *See* 37 C.F.R. § 41.41(b)(2).

Conclusion

For at least the aforementioned reasons, and on this record, we find a preponderance of the evidence supports the Examiner's underlying factual findings and ultimate legal conclusion of obviousness regarding the contested limitations of representative independent 1. However, we reverse

the rejection of dependent claims 2 and 15, for essentially the same reason argued by Appellants, as discussed above. (App. Br. 9.)⁸

⁸ In the event of further prosecution, we leave it to the Examiner to consider whether at least method claim 1 (broadly covering financial “policy and charging rules”) should also be rejected under 35 U.S.C. § 101. We note abstract ideas have been identified by the courts by way of example, as including *fundamental economic practices*, certain methods of organizing human activities, an idea of itself, and mathematical relationships and/or formulas. See *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355–56 (2014). Here, we leave it to the Examiner to consider whether a person would also be capable of performing the claimed steps or functions as mental steps, or with the aid of pen and paper. See *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1375 (Fed. Cir. 2011) (“That purely mental processes can be unpatentable, even when performed by a computer, was precisely the holding of the Supreme Court in *Gottschalk v. Benson*.”). That is, “a method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101.” (*Id.* at 1373.); see also *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (“For instance, *fundamental economic and conventional business practices* are often found to be abstract ideas, even if performed on a computer.”) (Emphasis added). We urge the Examiner to “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289, 1298, 1297)). The Supreme Court guides: “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” (*Id.* at 2358.) Although the Board is authorized to reject claims under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so. See Manual of Patent Examining Procedure (MPEP) § 1213.02.

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DECISION

We reverse the Examiner's rejection of claims 2 and 15, under 35 U.S.C. § 103(a).

We affirm the Examiner's rejection of claims 1, 3–14, and 16–20, under 35 U.S.C. § 103(a).

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 41.50(f).

AFFIRMED-IN-PART