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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/851,679	08/06/2010	Miguel Griot	093206U2	2214
23696	7590	11/02/2016	EXAMINER	
QUALCOMM INCORPORATED			CHEN, PETER	
5775 MOREHOUSE DR.			ART UNIT	
SAN DIEGO, CA 92121			PAPER NUMBER	
			2462	
			NOTIFICATION DATE	
			DELIVERY MODE	
			11/02/2016	
			ELECTRONIC	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MIGUEL GRIOT and OSOK SONG

Appeal 2015-008181
Application 12/851,679
Technology Center 2400

Before JUSTIN BUSCH, CATHERINE SHIANG, and JOYCE CRAIG,
Administrative Patent Judges.

CRAIG, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants¹ appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–10, 12–16, 18–41, and 55–65.² We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ According to Appellants, the real party in interest is QUALCOMM Incorporated. App. Br. 3.

² Claims 11, 17, and 66–71 are not before us, as they have been objected to as being dependent upon a rejected base claim, but the Examiner indicated they would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Final Act. 10.

INVENTION

Appellants' invention relates to identifying a domain for delivery of message service information. Abstract. Claim 1 is illustrative and reads as follows:

1. A method of communication, comprising:

determining that message service information is to be sent by an access terminal subsequent to the access terminal storing an indication that indicates whether a message service originated by the access terminal is preferred to be invoked over an Internet Protocol domain or that the message service is not to be invoked over the Internet Protocol domain;

identifying a domain for delivering the message service information based on the indication stored at the access terminal, wherein the domain for delivering the message service information is identified when the access terminal originates the message service; and

sending the message service information from the access terminal over the identified domain.

REJECTIONS

Claims 1–5, 9, 13, 15, 19, 21–25, 27–32, 34–39, 41, and 59–61 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Wu (US 2011/0028120 A1; Feb. 3, 2011)³ and Oyama et al. (US 2008/0254791 A1; Oct. 16, 2008) (“Oyama”).

³ In the Answer, the Examiner noted that “previous Pub No. of Wu reference in the Office Action of November 25, 2014 and Appellant’s Appeal Brief were typed wrong, but contents and paragraph numbers cited were from the correct Pub Number.” Ans. 13. The Examiner inadvertently used the Publication No. of Hallenstal et al., another prior art reference used in the Final Action. Because Appellants’ arguments reflect the teachings of the

Claims 6–8, 10, 12, 14, 16, 18, 20, 26, 33, 40, 55–58, and 62–65 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Wu, Oyama, and Hallenstal et al. (US 2010/0254313 A1; Oct. 7, 2010) (“Hallenstal”).

ANALYSIS

We have considered Appellants’ arguments, but do not find them persuasive of error. We agree with and adopt as our own the Examiner’s findings of facts and conclusions as set forth in the Answer and in the Action from which this appeal was taken. We provide the following explanation for emphasis.

In rejecting claim 1, the Examiner found Wu teaches or suggests all of the recited limitations, except “determining that message service information is to be sent by an access terminal subsequent to the access terminal storing an indication,” for which the Examiner relied on Oyama. Final Act. 2–3 (citing Wu Fig. 3, ¶ 40; Oyama Fig. 6, ¶¶ 7, 35).

Appellants contend the cited portions of Wu and Oyama fail to teach the “determining” step of claim 1. App. Br. 8–9. Appellants argue “*Wu* does not disclose the UE stores the indication, much less storing the indication prior to determining any message service information is to be sent.” *Id.* at 9. Appellants further argue that Oyama does not teach that the UE stores any indication of a preferred domain and is silent with respect to the UE storing any indication. *Id.* at 11. Appellants also argue that simply registering with a domain, as Oyama teaches, does not teach the user storing

intended Wu reference, we find the Examiner’s error harmless. The correct Publication No. is shown here.

an indication of a preferred domain for invoking the message service, as claim 1 requires. *Id.* at 12.

Appellants' arguments are not persuasive because they attack the prior art references individually, even though the Examiner relies on the combination of Wu and Oyama as teaching or suggesting the disputed features. Final Act. 2–3; Ans. 12. *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)) (“The test for obviousness is what the combined teachings of the references would have suggested to those having ordinary skill in the art.”). The Examiner found Wu teaches that user equipment (UE) may originate the service in either an IMS domain or a CS domain, and that the indication of the domain is from a stored data/profile at the UE. Final Act. 3 (citing Wu Fig. 3, ¶ 40); Ans. 12 (citing Wu Fig 3, ¶ 40, ll. 1–2, 7–9). The Examiner further found Oyama teaches determining that message service information is to be sent occurs subsequent to storing service domain information. Ans. 12 (citing Oyama Figs. 4, 6, ¶ 35).

Appellants argue Wu does not disclose that the UE stores the indication.⁴ App. Br. 9. Appellants, however do not persuasively explain why the Examiner erred in finding that an artisan of ordinary skill would appreciate that, in order for Wu to originate the service in a particular domain, the indication of the domain would be stored at the UE. Appellants

⁴ Appellants further argue for the first time in the Reply Brief, without a showing of good cause, that “*Wu* expressly discloses that ‘the UE does not determine the service domain at the beginning when originating the service’.” Reply Br. 4 (citing Wu ¶ 54). Appellants did not raise paragraph 54 of Wu in the Appeal Brief. Thus, Appellants waived that argument. *See* 37 C.F.R. § 41.41(b)(2) (2012).

argue that Oyama does not teach that the UE stores any information (App. Br. 10; Reply Br. 6), but Appellants present no persuasive explanation or evidence to rebut the Examiner’s findings. Rule 41.37 “require[s] 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.” *In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011).

Moreover, an obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim” because the analysis “can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Here, based on the portions of Wu cited by the Examiner, we agree with the Examiner that an artisan of ordinary skill would appreciate that, when the domain to which a UE is to connect is variable, an indication of which domain to connect to would be stored at the UE. *See* Final Act 3; Ans. 11–12. We agree that the limitation “the access terminal storing an indication that indicates whether a message service originated by the access terminal is preferred to be invoked over an Internet Protocol domain or that the message service is not to be invoked over the Internet Protocol domain,” recited in claim 1, is broad enough to encompass storing a pre-configured indication of the domain. *See* Final Act. 3; Ans. 12. Such interpretation is consistent with the disclosure in Appellants’ Specification of preconfiguring the access terminal with an indication “when the access terminal is initially programmed, when the access terminal is initially deployed, or at some other time,” including when the device is manufactured. Spec. ¶¶ 40–42.

Appellants next contend the cited portions of Wu and Oyama fail to disclose the “identifying” step of claim 1. App. Br. 12. Appellants argue Wu teaches that the UE originates the service and determines the domain for performing the service only after receiving the indication from the network regarding whether the network supports the domain. *Id.* at 13.

Appellants’ arguments are unpersuasive. The Examiner found Wu’s teaching that “the UE may originate the service and . . . [t]he first service domain may be referred as to an IP multimedia subsystem (IMS) domain or a circuit switched (CS) domain” would have taught or suggested “that the domain is identified when the access terminal originates the message service” and that “the IMS or CS domain is stored in the terminal.” Final Act. 3 (citing Wu Fig. 3, ¶ 40). Appellants present no persuasive explanation or evidence to rebut the Examiner’s findings. Moreover, in the Answer, the Examiner found that Wu in combination with Oyama also teaches this limitation. Ans. 12 (citing Oyama Figs. 4, 6 ¶ 35). In response, Appellants argue only that Oyama is silent regarding the access terminal identifying a domain for delivering message service information when the message service is originated. Appellants’ arguments do not address the combination proposed by the Examiner, but instead attack the references individually. *Mouttet*, 686 F.3d at 1332.

Appellants further contend that the Examiner erred in combining the teachings of Wu and Oyama because Wu, in paragraph 40, teaches away from determining which message service domain to invoke when the service is originated. App. Br. 13; Reply Br. 2. Appellants point to the statement “the UE may determine the service domain after acquiring network

capability rather than determine the service domain when originating the service.” *Id.*

We are not persuaded the Examiner erred. A teaching away requires a reference to actually criticize, discredit, or otherwise discourage the claimed solution. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). We find that paragraph 40 of Wu does not actually criticize, discredit, or otherwise discourage the UE from originating the service with a preferred domain. Moreover, we find that the Examiner provides persuasive articulated reasoning with rational underpinning for an artisan of ordinary skill to have modified the system of Wu with the teachings of Oyama. Final Act. 3 (citing Oyama ¶ 35).

For these reasons, we are not persuaded that the Examiner erred in combining Wu and Oyama or in finding that the combination of Wu and Oyama teaches or suggests the limitations of claim 1.

Accordingly, we sustain the Examiner’s 35 U.S.C. § 103(a) rejection of independent claim 1, as well as the 35 U.S.C. § 103(a) rejection of independent claims 21, 28, and 35, which Appellants argue are patentable for similar reasons. App. Br. 14. We also sustain the 35 U.S.C. § 103(a) rejection of dependent claims 2–5, 9, 13, 15, 19, 22–25, 27, 29–32, 34, 36–39, 41, and 59–61, for which Appellants make no additional arguments. *Id.* We also sustain the 35 U.S.C. § 103(a) rejection of dependent claims 6–8, 10, 12, 14, 16, 18, 20, 26, 33, 40, 55–58, and 62–65, for which Appellants’ argue only that Hallenstal fails to overcome the deficiencies of Wu and Oyama. *Id.* at 14–15.

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DECISION

We affirm the decision of the Examiner rejecting claims 1–10, 12–16, 18–41, and 55–65.

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).

AFFIRMED