UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Ex parte JAN OTTO BLOM

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Appeal 2016-000418
Application 13/278,978[1]
Technology Center 2400

_____

Before MARC S. HOFF, LARRY J. HUME, and JOHN D. HAMANN,
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
Examiner's Final Rejection of claims 1–20 and 49, which constitute all the
claims pending in this application. Appellant has canceled claims 21–48.
We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

_____

[1] According to Appellant, the real party in interest is Nokia Corp. App.
Br. 1.

STATEMENT OF THE CASE[2]

The Invention

Appellant's disclosed and claimed inventions relate to "a method, apparatus, and computer program for providing data sharing schemes to provision device services." Spec. ¶ 22.

Exemplary Claims

Claims 1 and 49, reproduced below, are representative of the subject matter on appeal (*emphases* added to contested limitations):

> 1. A method comprising facilitating a processing of and/or processing (1) data and/or (2) information and/or (3) at least one signal, the (1) data and/or (2) information and/or (3) at least one signal based, at least in part, on the following:
>
> at least one determination, by at least one processor, of at least one data sharing scheme for activation at one or more devices;
>
> *a processing of context data and metadata associated with one or more applications, one or more services, or a combination thereof, to determine whether the one or more applications, one or more services, or a combination thereof, are at least substantially compliant with the at least one data sharing scheme*; and
>
> a presentation of the one or more applications, the one or more services, or a combination thereof.

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49. A method of claim 1, wherein the (1) data and/or (2) information and/or (3) at least one signal are further based, at least in part, on the following:

a processing of the context data and the metadata associated with the one or more applications, one or more services, or a combination thereof, *to recommend another data sharing scheme, wherein the another data sharing scheme is more open than the at least one data sharing scheme.*

Prior Art

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

Salmenkaita et al. ("Salmenkaita")	US 2002/0188589 A1	Dec. 12, 2002
Paretti et al. ("Paretti")	US 2010/0076777 A1	Mar. 25, 2010
Tobe et al. ("Tobe")	US 2010/0107216 A1	Apr. 29, 2010
Hu et al. ("Hu")	US 2010/0235877 A1	Sept. 16, 2010
Wilson	US 2011/0030067 A1	Feb. 3, 2011
Jagannathan et al. ("Jagannathan")	US 2013/0014040 A1	Jan. 10, 2013

Rejections on Appeal

R1. Claims 1–10 stand rejected under 35 U.S.C. § 101 as being drawn to non-statutory subject matter. Final Act. 4.

R2. Claims 1, 6, 7, 10, 11, 16, 17, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Wilson and Salmenkaita. Final Act. 5.

R3. Claims 2, 3, 5, 9, 12, 13, 15, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Wilson, Salmenkaita, and Paretti. Final Act. 7.

R4.   Claims 4 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Wilson, Salmenkaita, Paretti, and Jagannathan. Final Act. 10.

R5.   Claims 8 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Wilson, Salmenkaita, and Tobe. Final Act. 11.

R6.   Claim 49 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Wilson, Salmenkaita, and Hu. Final Act. 12.[3]

CLAIM GROUPING

Although Appellant sets forth a proposed claim grouping for the claims on appeal (App. Br. 4), based on Appellant's *arguments* (App. Br. 4–18), we decide the appeal of obviousness Rejection R2 of claims 1, 6, 7, 10, 11, 16, 17, and 20 on the basis of representative claim 1. We address separately argued Rejection R1 of claims 1–10, and Rejection R6 of claim 49, *infra*.

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[3] In the event of further prosecution, we leave it to the Examiner to determine whether the recitation in claim 49 of "the another data sharing scheme is *more open* than . . . " meets the definiteness requirements of 35 U.S.C. § 112, second paragraph. When a claim term "depend[s] solely on the unrestrained, subjective opinion of a particular individual purportedly practicing the invention" (e.g., "more open"), without sufficient guidance in the specification to provide objective direction to one of skill in the art, the term is indefinite. *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1350 (Fed. Cir. 2005). 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.

Remaining claims 2–5, 8, 9, 12–15, 18, and 19 in rejections R2 through R5, not separately or substantively argued, stand or fall with the respective independent claim from which they depend.[4]

ISSUES AND ANALYSIS

In reaching this decision, we consider all evidence presented and all arguments actually made by Appellant. We do not consider arguments that Appellant 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 disagree with Appellant's arguments with respect to claims 1–20 and 49, and we incorporate herein and adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken, and (2) the reasons and rebuttals set forth in the Examiner's Answer in response to Appellant's arguments. We incorporate such findings, reasons, and rebuttals herein by reference unless otherwise noted. However, we

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[4] "Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately." 37 C.F.R. § 41.37(c)(1)(iv). For example, Appellant contends, with respect to Rejection R3 of claims 2, 3, 5, 9, 12, 13, 15, and 19, and of the same form as presented with respect to Rejections R4 and R5 of claims 4, 8, 14, and 18, "[a]ccordingly, since the Examiner has erred in failing to present a prima facie case of obviousness with regard to the subject matter of independent claims 1 and 11. Therefore, independent claims 1 and 11; and dependent claims 2, 3, 5, 9, 12, 13, 15, and 19 that depend from and incorporate the subject matter of the independent claims, and the rejection of these claims under 35 U.S.C. 103(a) is neither legally nor factually viable . . . ." App. Br. 12, 14. We find this form of argument is not a substantive, separate argument, but instead only relies upon arguments presented with respect to the independent claims from which they depend.

highlight and address specific findings and arguments regarding claims 1 and 49 for emphasis as follows.

1.   § 101 Rejection R1 of Claims 1–10

Issue 1

Appellant argues (App. Br. 4–5; Reply Br. 2–3) the Examiner's rejection of claim 1 under 35 U.S.C. § 101 as being drawn to non-statutory subject matter is in error. These contentions present us with the following issue:

Did the Examiner err in relying upon the holding in *Bilski*[5] and concluding claim 1 and claims 2–10 depending therefrom are "not statutory as the method is not tied to a particular machine or apparatus nor do they transform a particular article into a different state or thing . . . [and because] the steps of 'determination', 'processing' and 'present[ing]' can be performed by a person?" Final Act. 4–5.

Analysis

Appellant contends:

> Even assuming, arguendo, that "processor" is not limited specifically in the claim language, independent claim 1 recites, "[a] method comprising facilitating a processing of and/or processing, by a processor . . ." and, as conceded in the Advisory Action, page 2, the examples presented within the instant Specification of paragraphs [0061] and [0073], and FIGs. 5, 6, and 7 clearly illustrate processors in combination with computer hardware elements, and never in relation to a human. In fact, no recitation within the Specification relates to human processing over computer processing.

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[5] *Bilski v. Kappos*, 130 S. Ct. 3218, 3225 (2010).

> Considering the foregoing, the interpretation in the Office Action, of ". . . a processor . . ." as encompassing a human being is NOT reasonable. The interpretation is NOT consistent with Applicant's specification. It is simply NOT tenable in that the claims are to be given a reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art.
>
> For at least the foregoing reasoning, recitation of "by a processor" in independent claim 1 sufficiently ties the claim to statutory subject matter under 35 U.S.C § 101.

App. Br. 5.

We first note, "[w]hether a patent claim is drawn to patent-eligible subject matter is an issue of law that is reviewed *de novo.*" *SiRF Tech., Inc. v. Int'l Trade Comm'n,* 601 F.3d 1319, 1331 (Fed. Cir. 2010).

Abstract ideas have been identified by the courts by way of example, including fundamental economic practices, certain methods of organizing human activities, an idea 'of itself,' and mathematical relationships/formulas. *Alice Corp. Pty. Ltd. v. CLS Bank Int'l,* 134 S. Ct. 2347, 2355–56 (2014). Although claim 1 nominally recites "a method comprising facilitating a processing of and/or processing (1) data and/or (2) information and/or (3) at least one signal based, at least in part on . . . at least one determination, by at least one processor," a question arises as to whether a person would also be capable of performing the acts of the claimed method 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.*"). Our reviewing court further guides that "a method that can be performed by human thought

7

alone is merely an abstract idea and is not patent-eligible under § 101."
Bancorp Servs., L.L.C. v. Sun Life Assur. Co. of Canada, 687 F.3d 1266,
1373 (Fed. Cir. 2012).

Method claim 1 on appeal is optionally directed to: (a) "facilitating a
processing," *and/or* (b) "processing" either/or: "(1) data *and/or* (2)
information *and/or* (3) at least one signal," to determine a data sharing
scheme and "substantial[ ] complian[ce]" of applications and/or services
with the data sharing scheme for one or more devices, and which appears to
be directed to data intended for human perception.[6] App. Br. 20 (emphasis
added).

Under the two-part test described by the Supreme Court in *Alice*,
"[w]e [must first] determine whether the claims at issue are directed to a
patent-ineligible concept," such as an abstract idea. *Alice*, 134 S. Ct.
at 2355. Regarding claim 1, "a method that can be performed by human
thought alone is merely an abstract idea and is not patent-eligible under
§ 101." *CyberSource*, 654 F.3d at 1373.

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[6] Note the final limitation of claim 1: "a presentation of the one or more
applications, the one or more services, or a combination thereof."). *See* Fig.
3A, step 305, i.e., "Present to a user the compliant applications/services." In
the event of further prosecution, including any review for allowance, we
leave it to the Examiner to determine whether the recited "presentation of the
one or more applications" is directed to non-functional descriptive material.
See MPEP § 2111.05, 9th ed., Mar. 2014 ("[W]here the claim as a whole is
directed conveying a message or meaning to a human reader independent of
the intended computer system, and/or the computer-readable medium merely
serves as a support for information or data, no functional relationship
exists.").

As a matter of claim construction, and in light of the holdings in *Alice*[7] and *CyberSource* cited, *supra*, we find the optional nature of the recitations of claim 1, e.g., "facilitating a processing" "and/or processing" along with only the nominal recitation of a processor, the claim does not preclude the method from being carried out by human thought alone (e.g., "facilitating"), notwithstanding the nominal recitation of "at least one processor."

Therefore, based upon the factual findings and legal precedent cited above, and on this record, we are not persuaded of error in the Examiner's conclusion that claims 1–10 are directed to non-statutory subject matter such that we sustain the Examiner's Rejection R1 of claims 1–10.[8]

2. § 103 Rejection R2 of Claims 1, 6, 7, 10, 11, 16, 17, and 20

Issue 2

Appellant argues (App. Br. 6–10; Reply Br. 3–6) the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a) as being obvious over the combination of Wilson and Salmenkaita is in error. These contentions present us with the following issue:

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[7] We point out the Examiner's statement, "[t]he examiner notes that at the time of the Office action the provisions of Alice Corp. was not considered with respect to claims 1–20 and 49." Ans. 3.

[8] We note the Examiner omitted dependent claim 49 from the explicit statement of the rejection of § 101 Rejection R1. Final Act. 4. Although claim 49, depending from claim 1, appears to also be eligible for rejection under § 101 for the same reasons as claim 1, in the event of further prosecution, we leave it to the Examiner to determine whether this claim was inadvertently omitted from Rejection R1.

9

Did the Examiner err in finding the cited prior art combination teaches or suggests a method that includes, *inter alia*, the limitation of "a processing of context data and metadata associated with one or more applications, one or more services, or a combination thereof, to determine whether the one or more applications, one or more services, or a combination thereof, are at least substantially compliant with the at least one data sharing scheme," as recited in claim 1?

Analysis

"Appellant respectfully disagrees with the Examiner's continued assertions that Wilson in view of Salmenkaita makes obvious the features of at least independent claims 1 . . . and 11. . . . Appellant will focus their arguments on independent claim 1. . . ." App. Br. 6–7.

Further, after extensive quotation of the portions of Salmenkaita relied upon by the Examiner for teaching or suggesting the contested limitation (i.e., ¶¶ 105, 109, 112, and 114), Appellant contends:

> As best understood, it is clear *Salmenkaita* does not teach that the application's context information (the alleged 'context data') is processed to determine whether the requesting program (the alleged 'one or more applications') is compliant with the user's privacy profile (the alleged data sharing scheme).
>
> At best, *Salmenkaita* teaches that a program's level of permission to access user's context information is determined during a program registration step. . . .

App. Br. 9 (citing Salmenkaita ¶ 105).

Appellant further alleges, "*Salmenkaita* also does not provide for the use metadata as well as context data to determine compliance, even though it is shown above, that context data is not even used for compliance

determination" (App. Br. 10), "[t]hus *Salmenkaita* fails to disclose the claimed feature, at least because Salmenkaita does not teach that the user's current context information (the alleged 'context data') is itself utilized in any way to determine whether the registered programs (the alleged 'one or more applications') comply with the user's privacy profile (the alleged 'data sharing scheme')." *Id.*

In response to Appellant's contentions, the Examiner finds "Salmenkaita teaches sensor data such as position, temperature, audio etc. to be processed and then fed to various application programs" (Ans. 4, citing Salmenkaita ¶¶ 108 and 112), and "Salmenkaita also teaches registering application programs such that they can access the sensor data." *Id.* The Examiner further explains his findings:

> [T]he examiner is interpreting the user's security data associated with the application programs as taught by Salmenkaita as the context data and metadata. It is clear that Salmenkaita teaches the user's security data associated with the application is processed to determine whether or not the application can access the sensor data. In other words, it is determined whether or not the application is compliant with a data sharing scheme based on the user's security data in order to receive sensor data." Therefore, Salmenkaita teaches [the disputed limitation of claim 1]."

Id.

We agree with the Examiner's finding that Salmenkaita teaches or at least suggests both context data and metadata, as well as compliance with a data sharing scheme, specifically as recited in claim 1. Final Act. 6; Ans. 4. We agree with the Examiner because Salmenkaita teaches determining whether or not the application is compliant with a data sharing scheme based

11

on the user's security data, which is interpreted as both context data and metadata, so that sensor data may be received in accordance with the data sharing scheme, i.e., a privacy profile.

Therefore, based upon the findings above, on this record, we are not persuaded of error in the Examiner's reliance on the combined teachings and suggestions of the cited prior art combination to teach or suggest the disputed limitation of claim 1, nor do we find error in the Examiner's resulting legal conclusion of obviousness. Therefore, we sustain the Examiner's obviousness rejection of independent claim 1, and grouped claims 6, 7, 10, 11, 16, 17, and 20 which fall therewith. *See* Claim Grouping, *supra*.

3.   § 103 Rejection R6 of Claim 49

Issue 3

Appellant argues (App. Br. 15–18; Reply Br. 6–7) the Examiner's rejection of claim 6 under 35 U.S.C. § 103(a) as being obvious over the combination of Wilson, Salmenkaita, and Hu is in error. These contentions present us with the following issue:

Did the Examiner err in finding the cited prior art combination teaches or suggests a method that includes, *inter alia*, the limitation of "a processing of the context data and the metadata associated with the one or more applications, one or more services, or a combination thereof, to recommend another data sharing scheme, wherein the another data sharing scheme is more open than the at least one data sharing scheme," as recited in claim 49?

Analysis

> *Hu* merely teaches privacy policies may be evaluated to find a
> better privacy policy recommendation. *Hu*, at best, describes
> the updating/modification or suggestion of a second privacy
> policy based on an evaluation of whether a change would
> increase information provided. However, none of those
> modifications explicitly include an evaluation based on "the
> context data and the metadata associated, with the one or more
> applications, one or more services, or a combination thereof" as
> claimed. In contrast to claim 49 . . . which requires "**a
> processing of the context data and the metadata associated
> with the one or more applications, one or more services, or
> a combination thereof**, to recommend another data sharing
> scheme," *Hu* does not provide any details as to how such an
> evaluation is made.

App. Br. 17.

> Appellant further contends,

> *Hu* acts on a [deep packet inspection (DPI)] not on the user
> device, thus *Hu* never contemplates context data of any sort
> since the context does not matter to the DPI engine since *Hu*
> isn't determining compliance with a scheme, rather Hu is
> determining if the correlated "scheme" can comply with greater
> information provisioning to the user.

App. Br. 17–18. "[E]ven if the Examiner is correct that Hu teaches the

above-recited feature, which Appellant does not concede, Hu cannot

correctly be combined with *Salmenkaita*." App. Br. 18. Additionally,

"*Salmenkaita* does not teach the 'processing of the context data and the

metadata' as claimed nor does *Hu* teach the above-recited feature.

Therefore, *Hu* does not remedy the deficiencies of *Wilson* in view of

Salmenkaita and *Wilson* in view of *Salmenkaita* and *Hu* does not teach the

features of claim 49 . . . ." *Id.*

We note, because the Examiner rejects the claims as obvious over the combined teachings of Wilson, Salmenkaita, and Hu, the test for obviousness is not what the references show individually but what the combined teachings *would have suggested* to one of ordinary skill in the art. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Contrary to Appellant's contentions with respect to claim 49, we agree with the Examiner's findings that Wilson and Salmenkaita teaches or suggests the disputed limitations of claim 1, as discussed with respect to claim 1, *Issue 1, supra*. We also agree with the Examiner's finding that "Hu teaches evaluating a privacy rule(s) to determine whether modification of the privacy rule(s) can enable additional information to be shared and providing the suggested privacy rule modification to the user ([0092]). In other words, processing data to determine and recommend to a user a more open data sharing scheme." Ans. 8.

In response to the Examiner's findings, Appellant asserts, "even if the Examiner is correct that Salmenkaita discloses the 'context data and metadata', which Appellant does not concede, the Examiner fails to further provide reasoning as to how the combination with *Hu* would be done." Reply Br. 6. We disagree with Appellant's contentions.

We disagree with Appellant because the Examiner finds

> it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the teachings of Hu into Wilson in view of Salmenkaita, because by recommending a more open privacy policy enables additional information to be provided to the user based on analysis of additional context and metadata associated with the user.

Final Act. 13.

14

Additionally,

> Hu's known technique of recommending a more open privacy
> rule(s), sharing scheme, would have been recognized by one of
> ordinary skill in the art as applicable to the process of
> Salmenkaita and the results would have been predictable and
> resulted in the applications receiving the requested sensor data
> based on the more open sharing scheme which results in
> improved recommendations provided by the applications to the
> user based on the received sensor data.

Ans. 8.

Therefore, based upon the findings above, on this record, we are not
persuaded of error in the Examiner's reliance on the combined teachings and
suggestions of the cited prior art combination to teach or suggest the
disputed limitation of claim 49, nor do we find error in the Examiner's
resulting legal conclusion of obviousness. Therefore, we sustain the
Examiner's obviousness rejection of dependent claim 49.

4.   <u>Rejections R3–R5 of Claims 2–5, 8, 9, 12–15, 18, and 19</u>

In view of the lack of any substantive or separate arguments directed
to obviousness Rejections R2 through R5 of claims 2–5, 8, 9, 12–15, 18, and
19 under § 103 (*see* App. Br. 11–15), we sustain the Examiner's rejection of
these claims. Arguments not made are waived.

<p style="text-align:center">REPLY BRIEF</p>

To the extent Appellant may advance new arguments in the Reply
Brief (Reply Br. 1–8) 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)), which Appellant has not shown.

CONCLUSIONS

(1) The Examiner did not err with respect to non-statutory subject matter Rejection R1 of claims 1–10 under 35 U.S.C. § 101, and we sustain the rejection.

(2) The Examiner did not err with respect to obviousness Rejections R2 through R6 of claims 1–20 and 49 under 35 U.S.C. § 103(a) over the cited prior art combinations of record, and we sustain the rejections.

DECISION

We affirm the Examiner's decision rejecting claims 1–20 and 49.

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