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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* CHRISTIAN CORRELL

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Appeal 2017-002245<sup>1</sup>  
Application 13/979,676  
Technology Center 2400

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Before BRADLEY W. BAUMEISTER, JOSEPH P. LENTIVECH, and  
DAVID J. CUTITTA II, *Administrative Patent Judges*.

LENTIVECH, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>2</sup> appeals from the Examiner's decision to reject claims 1–20, the only claims pending in the application on appeal. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We reverse and enter a new ground of rejection within the provisions of 37 C.F.R. § 41.50(b).

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<sup>1</sup> An oral hearing was held on October 9, 2018.

<sup>2</sup> According to Appellant, the real party in interest is Unify GmbH & Co. KG. App. Br. 1.

STATEMENT OF THE CASE

*Appellant's Invention*

Appellant's invention generally relates to creating multiple addresses for a network element in a communication network. Spec. 1. Claim 1, which is illustrative of the claimed invention, reads as follows:

1. A method for creating multiple addresses for a network element in a communication network, comprising:

a) creating virtual identifiers for each of the addresses to be created from an existing identifier for the network element and at least one configured piece of additional information stored on the network element, each of the virtual identifiers created by a virtual identifier creation process comprising:

forming an initial identifier based on the existing identifier and subsequently replacing a middle segment of the initial identifier with a value derived from the formed initial identifier to form the virtual identifier;

b) creating the addresses based on the created virtual identifiers;

c) testing at least one of the created virtual identifiers and the created addresses for collisions; and

d) discarding at least one of any of the created virtual identifiers determined from the testing to be a colliding virtual identifier and the created addresses created from those colliding virtual identifiers; and

e) retaining at least one address that is determined from the testing not to be a colliding address or that is created from a virtual identifier that is determined from the testing to not be a colliding virtual identifier.

*Rejections*

Claims 1, 2, 4–9, 11–17, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Vesterinen et al.

(US 7,974,311 B2; issued July 5, 2011) (“Vesterinen”) and Narten et al., *Privacy Extensions for Stateless Address Autoconfiguration in IPv6*, Network Working Group, IETF RFC 4941 (2007) (“Narten”). Final Act. 3–12.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Vesterinen, Narten, and Thomson et al., *IPv6 Stateless Address Autoconfiguration*, Network Working Group, IETF RFC 4862 (2007) (“Thomson”). Final Act. 13.

Claims 10, 18, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Vesterinen, Narten, and Lappin, Jr. (US 7,047,453 B2; issued May 16, 2006) (“Lappin”). Final Act. 13–16.

#### ANALYSIS

Appellant contends Vesterinen does not teach or suggest “each of the virtual identifiers created by a virtual identifier creation process comprising: forming an initial identifier based on the existing identifier and subsequently replacing a middle segment of the initial identifier with a value derived from the formed initial identifier to form the virtual identifier,” as recited in claim 1. App. Br. 9. Appellant argues Vesterinen’s teaching of adding the fixed value, FFFE, to a middle segment of a MAC address does not teach or suggest “replacing any middle segment.” App. Br. 9. Appellant further argues Vesterinen teaches that the FFFE value “is a value that is added to a pre-existing MAC address,” “is a ‘fixed value’ that is added to the 48 bit MAC address,” and “is not a value derived from a formed initial identifier,”

as required by claim 1. App. Br. 9, 10 (citing Vesterinen 8:50–53).

Appellant argues:

No replacing of any middle segment occurs in Versterinen. The plain meaning of “replace” is understood to be “to put something new in the place of” (Merriam-Webster definition of “replace” *available at* <http://www.merriam-webster.com/dictionary/replace>) or “to put someone or something in the place of another” (The Free Dictionary by Farlex, *available at* <http://www.thefreedictionary.com/replace>). No replacing of any middle segment of any address occurs in Versterinen. For instance, the second half of the MAC address is still present as shown in Figure 5. It has not been removed and had something else put in its place.

App. Br. 10–11.

Appellant argues Narten “also fails to teach or suggest a virtual identifier creation process in which an initial identifier is formed *and a middle segment of that identifier is then replaced with a value derived from the formed initial identifier.*” App. Br. 9. According to Appellant, Narten “is directed to a state address auto configuration in which an address is formed by combining a network prefix with an interface identifier.” *Id.* (citing Narten, Abstract). Appellant argues Narten fails to teach or suggest “formation of an initial identifier based on an existing identifier for a network element that then has its middle segment replaced with a value derived by that initial identifier” and that Narten “is silent with respect to such a feature.” *Id.*

Appellant further argues:

[T]he process disclosed by Section 3.2.1 of [Narten] that is relied upon by the Examiner fails to teach or suggest any generation of a value that is to be added into a middle segment of a formed initial identifier. To the contrary, the process of Section 3.2.1 is to form an entirely new identifier from appending

a stored historical value with a previously used identifier as an input value into a calculation algorithm to form an entirely new identifier. No replacement of any middle portion of any identifier occurs in Section 3.2.1.

Further, no use of any left or right most section of a MD5 value as a history value is used as any middle segment for inserting into anything. This left or right value is an initial value to which a previously used identifier is appended to generate a value for inputting to an algorithm to form an entirely new identifier. There is no use of any middle segment of anything nor any replacement of any middle segment of any previously formed identifier in [Narten] or initially formed identifier in [Narten].

App. Br. 12.

Appellant argues Narten's "history value having the appended identifier value is not an initial interface identifier value that is formed" but, instead, "is a step in forming an input value for a calculation methodology for forming an entirely new identifier value." App. Br. 13.

Appellant's arguments are persuasive. The Examiner finds Vesterinen teaches "forming an initial identifier (a MAC address) based on [a] serial number of the module such as [a] Cabinet ID (existing identifier)." Ans. 3. The Examiner finds Vesterinen teaches "based on the EUI-64 identifier format in Fig. 5c, the MAC address (initial identifier) is taken as the basis and a value (FFFE) is added in the middle." Ans. 3 (citing Vesterinen 8:41–54). The Examiner finds "Narten teaches using a portion (leftmost, rightmost), i.e., using a first half and not using the second half or using a second half and not using the first half, which the Examiner considers as equivalent of using a (middle) portion and not using other portions." Ans. 4. However, the Examiner's findings are insufficient to show how "using a (middle) portion and not using other portions," as taught

by Narten, either alone or in combination with the teachings of Vesterinen, teaches or suggests *replacing* a middle segment of an initial identifier (e.g., Vesterinen’s “FF:FE”) with a derived value, as required by claim 1.

Accordingly, we do not sustain the Examiner’s rejection of claim 1; and claims 2–20, which depend from claim 1.

We do not reach Appellant’s further allegations of error because we find the issue discussed above to be dispositive as to the rejection of all the pending claims.

#### NEW GROUND OF REJECTION WITHIN 37 C.F.R. § 41.50(b)

##### *Principles of Law*

Claims 1–20 are newly rejected under 35 U.S.C. § 101 because the claimed subject matter is judicially-accepted from patent eligibility under § 101.

Under 35 U.S.C. § 101, a patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” The Supreme Court has “long held that this provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)). The Supreme Court in *Alice* reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 82–84 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at 2355.

The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” such as an abstract idea. *Id.* The inquiry often is whether the claims are directed to “a specific means or method” for improving technology or whether they are simply directed to an abstract end-result. *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016). If the claims are not directed to a patent-ineligible concept, the inquiry ends.

Otherwise, the inquiry proceeds to the second step, where the elements of the claims are considered “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*, 566 U.S. at 78–79). We, therefore, look to whether the claims focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016).

#### *Analysis*

Turning to the first step of the analysis, we find Appellant’s independent claim 1 is directed to a patent-ineligible abstract concept of “creating multiple addresses for a network element.” All the steps recited in Appellant’s claim 1, including, for example: (i) “creating virtual identifiers for each of the addresses to be created from an existing identifier for the network element and at least one configured piece of additional information stored on the network element”; (ii) “forming an initial identifier based on the existing identifier”; (iii) “replacing a middle segment of the initial identifier with a value derived from the formed initial identifier to form the

virtual identifier”; (iv) “creating the addresses”; (v) “testing at least one of the created virtual identifiers and the created addresses for collisions” (vi) “discarding at least one of any of the created virtual identifiers determined from the testing to be a colliding virtual identifier and the created addresses created from those colliding virtual identifiers”; and (vii) “retaining at least one address that is determined from the testing not to be a colliding address or that is created from a virtual identifier that is determined from the testing to not be a colliding virtual identifier” are abstract processes of collecting, storing, and analyzing information of a specific content.

Information, as such, is intangible. *See Microsoft Corp. v. AT & T Corp.*, 550 U.S. 437, 451 n.12 (2007). Information collection and analysis, including when limited to particular content, is within the realm of abstract ideas. *See, e.g., Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1349 (Fed. Cir. 2015); *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014); and *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011).

Our conclusion that the claims are directed to an abstract idea is buttressed by the fact that we see no reason why the method, as claimed, could not be performed by a person using pen and paper. *See CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372–73 (Fed. Cir. 2011) (“[A] method that can be performed by human thought alone is merely an abstract idea” and holding that a claim whose “steps can be performed in the human mind, or by a human using a pen and paper” is directed to an “unpatentable mental process[ ]”).

Turning to the second step of the analysis, we find nothing in Appellant’s claims 1, 9, and 15 that adds anything “significantly more” to transform the abstract concept of collecting, storing, and analyzing information into a patent-eligible application. *Alice*, 134 S. Ct. at 2357. The claims fail to recite (1) any structure for performing the claimed process, or (2) any limitation tying the recited steps to the network elements for which the addresses are created. As such, none of the recited limitations, whether individually or in an ordered combination, shows any inventive concept.

For similar reasons, we further find that the dependent claims, 2–20, do not add anything materially more patent-eligible than the abstract concepts recited in the independent claim.

Because Appellant’s claims 1–20 are directed to a patent-ineligible abstract concept, and because they do not recite something “significantly more” under the second prong of the *Alice* analysis, we reject these claims under 35 U.S.C. § 101.

## DECISION

We reverse the Examiner’s rejections of claims 1–20 under 35 U.S.C. § 103(a).

We newly reject claims 1–20 under 35 U.S.C. § 101.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground

of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

REVERSED; 37 C.F.R. § 41.50(b)