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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PAUL ANDREW ERB and
PETER MATTHEW HILLIER

Appeal 2017-003038
Application 13/373,610¹
Technology Center 2400

Before JASON V. MORGAN, BRUCE R. WINSOR, and
JON M. JURGOVAN, *Administrative Patent Judges*.

WINSOR, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the final rejection of claims 23, 24, 29, and 30. We have jurisdiction under 35 U.S.C. § 6(b). Claims 1–22 are cancelled. App. Br. 5. Claims 25–28 are finally rejected, but the rejection is not appealed. *See* App. Br. 9.

We affirm-in-part and institute a new ground of rejection within the provisions of 37 C.F.R. § 41.50(b) (2015).

¹ The real party in interest identified by Appellants is Mitel Networks Corporation. App. Br. 3.

STATEMENT OF THE CASE

The Invention

Appellants' disclosed invention "generally relates to communications, and more particularly, to converting messages between different formats without user intervention." Spec. ¶ 1. Claims 23 and 29, which are illustrative, read as follows:

Claim 23: A method comprising:

 during a call between a communication module and a first device the communication module receiving communications from the first device in an audio call format;

 the communication module identifying that said call has been terminated;

 the communication module converting said communications received in said audio call format into a text format;

 the communication module providing said communications converted into said text format to a second device;

 the communication module receiving communications from said second device in said text format;

 the communication module converting said communications received from said second device into said audio call format; and

 the communication module providing said communications converted into said audio call format to said first device;

 wherein the step of providing said communications converted into said audio call format to said first device comprises the communication module initiating a call back to said first device.

Claim 29: A computer program comprising machine readable instructions that when executed by computing apparatus controls it to perform the method of claim 23.

The Rejections and References

Claims 25–28 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. *See* Final Act. 2.

Claims 23–30² stand rejected under 35 U.S.C. § 103(a)³ as being unpatentable over Dutta et al. (US 6,453,294 B1; Sept 17, 2002; “Dutta”) and Rowe (US 2003/0028601 A1; Feb. 6, 2003)⁴. *See* Final Act. 3–7.

The Record

Rather than repeat the arguments here, we refer to the Briefs (“App. Br.” filed May 2, 2016; “Reply Br.” filed Dec. 9, 2016) and the Specification (“Spec.” filed Nov. 21, 2011, amended Feb. 10, 2014) for the positions of Appellants and the Final Office Action (“Final Act.” mailed Nov. 4, 2015) and Answer (“Ans.” mailed Nov. 17, 2016) for the reasoning, findings, and conclusions of the Examiner. Only those arguments actually made by Appellants have been considered in this decision. Arguments that

² In an apparent typographical error, the summary of the ground of rejection only lists claim 23. Final Act. 3.

³ The prior art rejection is under the provisions of 35 U.S.C. in effect prior to the effective date of the Leahy-Smith America Invents Act of 2011 (“pre-AIA”). *Id.*

⁴ The Examiner identifies Rowe as US 2007/0230674 A1 (*see* Final Act. 3), however the ’674 document names Altberg et al., not Rowe, as inventors. The passages cited by the Examiner, when considered in the context of the Final Office Action, appear to refer to Rowe ’601, and not Altberg ’674 (*see* Final Act. 4). We treat this apparent inconsistency as a clerical or typographical error, which does not appear to have confused Appellants (*see, e.g.*, App. Br. 10–11; Reply Br. 2–3).

Appellants did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

CLAIMS 25–28

Appellants state that “[c]laims 25–28 are cancelled in a concurrently filed amendment in order to reduce the issues on appeal.” App. Br. 9; *accord id.* at 5. However, we find no such amendment and no entry of such an amendment in the record. *See id.* at 6. In the Answer, the Examiner maintains every ground of rejection stated in the Final Office Action. Ans. 2. However, Appellants submit no arguments in support of the patentability of claims 25–28 (*see* 37 C.F.R. § 41.37(c)(1)(iv)) and have unequivocally indicated their intent to limit the appeal to the rejection of claims 23, 24, 29, and 30 (*see id.* at 9, 11). Accordingly, to the extent claims 25–28 are currently pending, we summarily sustain the rejections of claims 25–28 under 35 U.S.C. §§ 101 and 103(a).

ISSUE

The dispositive issue presented by Appellants’ arguments is whether the Examiner errs in finding the combination of Dutta and Rowe teaches or suggests

[a] communication module identifying that [a] call [between a first and a second device] has been terminated; . . . the communication module converting [text format] communications received from [a] second device into [an] audio call format; and the communication module providing said communications converted into said audio call format to [a] first device; wherein the step of providing said communications converted into said audio call format to said first device

comprises the communication module initiating a call back to said first device

(emphases added), as recited in claim 23.

ANALYSIS

As an initial matter we note that “[u]nless the steps of a method actually recite an order, the steps are not ordinarily construed to require one. However, such a result can ensue when the method steps implicitly require that they be performed in the order written.” *Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323, 1342–43 (Fed. Cir. 2001) (citations omitted). Here, although no order of steps is explicitly recited, as a matter of logic, the step of identifying that the call has been terminated must occur before the step of delivering the audio format communication to the second device; otherwise, the limitation of delivering the communication by initiating a *call back* to the first device would be meaningless. *See also* Spec. ¶ 36 (as amended) (“[T]he originator 102 can communicate what is needed and terminate the call. The receiver 104 can get the email and compose a reply. The originator 102 can then be ‘called back’ and the receiver’s email can be translated to voice to the originator 102.”).

The Examiner relies on Dutta to teach communication between devices in which audio from a first device to a communications module is converted to text and delivered to a second device and text from the second device to the communications module is converted to audio and delivered to the first device. Final Act. 3–4 (citing Dutta, col. 3, ll. 36–57, col. 5, ll. 55–67, col. 6, ll. 1–26, Figs. 2a, 3, 4). The Examiner relies on Rowe to teach terminating a call and initiating a call back. Final Act. 4 (citing Rowe ¶¶ 11, 13, 42, 45, 65).

Appellants contend “[t]he passages cited in Rowe [i.e., paragraphs 11 and 13] refer to a terminating switch 140 that can receive and deliver calls, but there is no disclosure of identifying that a call has been terminated.” App. Br. 10. The term “terminate[]” is used in the claim and Specification (*see, e.g.*, Spec. ¶ 36) to mean “to come to an end in time,” MERRIAM-WEBSTER’S COLLEGIATE DICTIONARY 1216 (10th ed. 1999) (*vi*, def. 3), whereas in Rowe’s paragraphs 11 and 13 “terminating switch” is used to refer to a switch at “the switching center . . . of the person you’re calling,” Harry Newton and Steve Schoen, NEWTON’S TELECOM DICTIONARY 1183 (27th ed. 2013) (definition of “terminating office”). Even accepting, *arguendo*, that the Examiner may have conflated these meanings, we nonetheless agree with the Examiner that the “ordinary artisan would agree that a terminating switch regardless of its location on the telephonic network which usually lies at the central offices of local exchange carriers are certainly capable of terminating the call and initiating call back to a first device or any other device.” Ans. 4.

However, mere “capability” is not enough. The claim recites a specific sequence of steps. In particular, the claim recites that after a call is terminated, a voice format message converted from a text message created at the second device is delivered by call back to the first device. Appellants contend as follows:

Paragraph [65 of Rowe] says “the user may be presented with a list of call back numbers that may be previously stored in the user’s personal database in memory 180. INP⁵] 150 may send the plurality of callback numbers to user device 110” This passage clearly discloses presenting a list of numbers that the

⁵ Intelligent Network Processor. Rowe ¶ 11.

user can call but there is no suggestion whatsoever of the communication module initiating a call back to said first device. Claim 23 clearly recites that the communication module initiates a call back to said first device, rather than what is described in Rowe, which is presenting a user with callback numbers so that the user can manually make the call.

App. Br. 11. We agree with Appellants. Although the cited passages of Rowe (*see* Rowe ¶ 65) disclose the presentation of call back numbers, these numbers are sent during a paging process (*id.* (“The paging unit 160 pages the party based on the paging number and forwards the return telephone number or the call back number to the party’s pager.”)) and not following identifying a call has been terminated. Furthermore, Rowe teaches that the *user* initiates any call back (*id.* (“The user may select the desired call back number from the list and the selection call back number is returned to INP 150 over the data portion of the communication channel.”)) rather than teaching or suggesting that the INP (i.e., the recited “communication module”) initiates a call back. The other passages of Rowe relied upon by the Examiner (*see* Rowe ¶¶ 42, 45) teach the insertion of a text alert and text message into an ongoing call by the INP, and do not teach or suggest a call back initiated by the INP.

Appellants have demonstrated error in the articulated rejection of claim 23 under 35 U.S.C. § 103(a). Accordingly, constrained by this record, we do not sustain the rejection of claim 23 and claims 24, 29, and 30, which directly or indirectly incorporate the limitations of claim 23.

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

“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement

thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. Claims 29 and 30 are rejected on a new ground of rejection under 35 U.S.C. § 101 as being directed to software *per se*, which is not within any of the statutory classes of patent-eligible subject matter.

Claim 29 is directed to “[a]computer program comprising machine readable instructions that when executed by [a] computing apparatus controls it to perform [a] method.” Although claim 29 references the method, i.e., process, of claim 23, it is directed to a computer program for performing the method and not the method itself. Therefore, claim 29 is not directed to a process. Claim 29 recites that the computer program comprises instructions that, when executed by a computing apparatus, i.e., a machine, controls the apparatus, but does not positively recite the apparatus or that the instructions are actually embodied in a computer. Therefore, claim 29 is not directed to a machine. Claim 29 does not recite any tangible, non-transitory or transitory, embodiment of the computer program or instructions, and would encompass such a program and instructions in the mind of a programmer. Therefore, claim 29 is not directed to an article of manufacture or composition of matter. Rather claim 29 is directed to a “computer program comprising machine readable instructions,” i.e., software *per se*, and is, accordingly, not patent-eligible. Claim 30 has a substantially similar recitation and is patent-ineligible for the same reasons as claim 29.⁶

⁶ We note that it is unclear whether claims 29 and 30 are independent claims or dependent claims. Although they incorporate the subject matter of other claims by reference, the preambles of claims 29 and 30 do not clearly relate to the preambles of claims 23 and 24 and appear to be broader than claims 23 and 24, respectively. For instance, one would not need to actually

DECISION

The decision of the Examiner to reject claims 25–28 is summarily affirmed.

The decision of the Examiner to reject claims 23, 24, 29, and 30 is reversed.

We enter a new ground of rejection for claims 29 and 30 under 35 U.S.C. § 101.

Regarding the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides “Appellant may file a single request for rehearing within two months of the date of the original decision of the Board.”

In addition to affirming the Examiner’s rejection(s) of one or more claims, 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 that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

perform the method of claim 23 to infringe claim 29. On the other hand, Appellants have characterized claims 29 and 30 as dependent claims. *See* App. Br. 11; *see also* Fee Worksheet (May 26, 2015) (characterizing only two out of eight claims as independent). In the event of further prosecution of claims 29 and 30, the Examiner may wish to consider whether claims 29 and 30 are independent or dependent and, if dependent, whether they comply with the requirements of 35 U.S.C. § 112(d) (“[A] claim in dependent form shall . . . specify a *further limitation* of the subject matter claimed.” (Emphasis added.)).

(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. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record.

Should Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Patent Trial and Appeal Board for final action on the affirmed rejection, including any timely request for rehearing thereof.

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). *See* 37 C.F.R. §§ 41.50(f), 41.52(b).

AFFIRMED-IN-PART
37 C.F.R. § 41.50(b)