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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte AMER A. HASSAN, THOMAS W. KUEHNEL,
and DEYUN WU¹

Appeal 2017-003712
Application 11/899,350
Technology Center 2400

Before ALLEN R. MacDONALD, MICHAEL M. BARRY, and
PHILLIP A. BENNETT, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ According to Appellants, the real party in interest is Microsoft Technology Licensing, LLC. *See* Appeal Br. 2

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a rejection of claims 1–6, 24–33, and 35–37. Claims 7–23 and 34 have been cancelled. App. Br. 20–23. We have jurisdiction under 35 U.S.C. § 6(b).²

Representative Claim

Representative claims 1 and 3 under appeal read as follows (emphasis, formatting, and brackets added):

1. ***A method for accessing***, by a wireless client computing device configured to communicate via a wireless access point that is separate from the client computing device, ***a spectrum***, where the wireless client computing device includes at least one processor and memory, the method comprising:

[A.] receiving, by the wireless client computing device in response to ***auctioning of the spectrum*** by a spectrum provider that is separate from the wireless client computing device and the wireless access point, an ***offer to access*** the spectrum,

[i.] where the auctioning comprises sending the offer,

[ii.] where the offered access is subject to one or more constraints,

[iii.] where the auctioning is initiated by the spectrum provider as opposed to the wireless client computing device; and

² “The Patent Trial and Appeal Board shall—(1) on written appeal of an applicant, review adverse decisions of examiners upon applications for patents pursuant to section 134(a) . . .” 35 U.S.C. § 6(b)(1).

[B.] responding, by the wireless client computing device, to the offer,

[i.] where the responding comprises the wireless client computing device performing one of

[a.] ***accepting*** the offer,

[b.] ***rejecting*** the offer, and

[c.] ***countering*** the offer.

3. The method of claim 1, where the one or more constraints comprise at least an amount of acceptable spectrum ***interference***.

Rejections

The Examiner rejected claims 1, 2, 4, 5, 25, 26, 28, 30, 32, 33, and 35 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Calisti et al. (US 2009/0191858 A1; published July 30, 2009) and Buddhikot et al. (US 2006/0083205 A1; published April 20, 2006).³

The Examiner rejected claims 3, 27, and 34 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Calisti, Buddhikot '205, and Buddhikot et al. (US 2008/0108365 A1; published May 8, 2008).⁴

The Examiner rejected claims 6, 31, and 37 under 35 U.S.C. § 103(a) as being unpatentable over Calisti, Buddhikot '205, and Gazdzinski et al. (US 2005/0100076 A1; published May 12, 2005).⁵

³ Separate patentability is not argued for claims 2, 4, 5, 25, 26, 28, 30, 32, 33, and 35. Except for our ultimate decision, these claims are not discussed further herein.

⁴ Separate patentability is not argued for claims 27 and 34. Except for our ultimate decision, these claims are not discussed further herein.

⁵ Separate patentability is not argued for claims 6, 24, 29, 31, 36, and 37. Rather, these claims are argued by reference to the arguments for claims 1,

The Examiner rejected claims 24, 29, and 36 under 35 U.S.C. § 103(a) as being unpatentable over Calisti, Buddhikot '205, and Asher et al. (US 2005/0222914 A1; published Oct. 6, 2005).

Issues on Appeal

Did the Examiner err in rejecting claim 1 as being obvious?

Did the Examiner err in rejecting claim 3 as being obvious?

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants' arguments (Appeal Brief and Reply Brief) that the Examiner has erred.⁶

25, and 32. App. Br. 17–18. Thus, the rejections of these claims turn on our decision as to claim 1. Except for our ultimate decision, these claims are not discussed further herein.

⁶ Appellants present a number of general arguments (App. Br. 5–10) labelled as “Response to Examiner’s Comments” (App. Br. 5). These general arguments are not specifically directed to any particular claim rejection. In an ex parte appeal, this Board does not review Examiner comments, but rather the adverse decision of the Examiner (35 U.S.C. § 6(b)(1)). Therefore, we treat these general arguments only to the extent they are applicable to the rejection of claim 1.

To the extent that these general arguments attempt to incorporate by reference (App. Br. 5, 7, 9) the prior reply filed August 23, 2015 by the Appellants, these arguments do not comply with the 37 C.F.R. § 41.37 (c)(1)(iv) ([T]he brief *shall* contain “[t]he arguments of appellant with respect to each ground of rejection, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the Record relied on.”). We review based solely on the arguments presented in the Briefs.

Appellants contend the Examiner erred in rejecting claim 1 because:

[T]he Examiner responded to Applicants' argument that Calisti is not directed to spectrum auctioning . . . by claiming that the argument is not persuasive and then by pointing out that Buddhikot teaches spectrum auctioning (FOA, pg. 12, lines 9-13). *Appellants agree* that Buddhikot discusses *aspects of spectrum auctioning* but also maintain that Calisti is not directed to spectrum auctioning at all.

App. Br. 5 (emphasis added).

We disagree. Although Appellants provide numerous additional pages of argument to support why Calisti is not directed to spectrum auctioning, we fail to see the relevance of this line of argument (or Examiner's response thereto) as the Appellants explicitly agreed (*see* above) that Buddhikot '205 discloses aspects of spectrum auctioning. That the Examiner may have erred as to Calisti, by mistakenly finding it also discloses *spectrum* auctioning, is not sufficient alone to show the rejection is in error given the Examiner's finding (Final Act 12) that Buddhikot '205 teaches spectrum auctioning.

Appellants also contend the Examiner erred in rejecting claim 1 because:

Buddhikot actually teaches a Spectrum Information and Management ("SPIM") Server 310 that allocates and leases spectrum to a Radio Access Network ("RAN") Manager 315 (¶¶ [0037]-[0038]), neither of which is a client device such as mobile device 340.

App. Br. 8.

We disagree. Appellants attack Buddhikot '205 singly for lacking a teaching (a client device) that the Examiner relied on a combination of references to show. Particularly, the Examiner points to Calisti for this limitation. Final Act. 3. It is well established that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Appellants argue a finding the Examiner never made. This form of argument is unavailing to show Examiner error.

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Appellants further contend the Examiner erred in rejecting claim 1 because:

Buddhikot's FIG. 8 does not teach what the Examiner alleges. Instead, "FIG. 8 depicts a high level skeleton diagram of an embodiment of a Spectrum Lease (SPEL) Protocol" (¶ [0063]). But this SPEL protocol is not used by Buddhikot's client device 340 or the like.

App. Br. 10.

We disagree. Again, Appellants attack Buddhikot '205 for lacking a teaching (protocol used by Buddhikot's client device) that the Examiner did not rely on the reference to show. As to claim 1, the Examiner only finds that Buddhikot '205's auctioning comprises sending an offer broadcast in response to auctioneer initiated auctioning of the spectrum. Final Act. 4. This argument does not identify an error in the actual basis of the rejection of claim 1.

Appellants contend the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a) because:

[N]o combination of the [items (i)–(x)] listed by Calisti teach or suggest an offer in response to auctioning **spectrum**, as encompassed by claim 1.

App. Br. 12 (emphasis added).

We disagree. As we discuss above, Appellants agreed Buddhikot '205 discloses aspects of spectrum auctioning. Each reference cited by the Examiner must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole. *See Merck*, 800 F.2d at 1097.

Appellants also contend the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a) because:

[Buddhikot '205] fails to teach *an offer in response to a **spectrum provider auctioning spectrum***, as encompassed by claim 1.

App. Br. 12 (emphasis added).

We disagree. Again, Appellants attack Buddhikot '205 singly for lacking a teaching (an offer in response to a spectrum provider auctioning spectrum) that the Examiner relied on a combination of references to show. Particularly, the Examiner relies on Calisti for an offer in response to a provider auction (Final Act. 3–4) and Buddhikot '205 for spectrum auctioning (as discussed above).

Appellants contend that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a) because:

Appellants point out that the “rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art” (*KSR v. Teleflex*, 550 U.S. at 12, 82 USPQ2d at 1395; underlining added). “If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art” (MPEP §2143; underlining added). Accordingly, ***because the Examiner’s proposed combination would require changes to the functionality of Calisti, the Examiner’s rationale cannot properly be used to support a conclusion of obviousness.***

App. Br. 13 (emphasis added). Additionally Appellants argue “the *KSR* Court held that a permissible combination must be made “with no change in their respective functions.” Reply Br. 9.

We disagree. First, no such “no change” quotation appears in *KSR*. The Court’s closest statement is the quotation:

For over a half century, the Court has held that a “patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men.” *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 71 S.Ct. 127, 95 L.Ed. 162 (1950).

KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 415–16 (2007) (ellipsis in original). Second, this quotation is not a mandate that shows the only way to demonstrate a claim is obvious. Rather it is exemplary as the Court

follows it with further examples. Third, Appellants overlook the Court's explicit statement:

The principles underlying these cases are instructive when the question is whether a patent claiming the combination of elements of prior art is obvious. When a work is available in one field of endeavor, design incentives and other market forces can prompt *variations* of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable *variation*, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

KSR, 550 U.S. at 417 (emphasis added). Contrary to the premise of Appellants' argument that no change is permitted, the *KSR* Court explicitly contemplates otherwise (i.e., "variations").

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Appellants also contend that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a) because:

Appellant submits that such a change in function [of Calisti] would yield unpredictable results—that is, it is unknown what would occur if Calisti's *connection characteristics negotiations* were modified with Buddhikot's *spectrum auctioning*.

Reply Br. 9.

We disagree. Although Appellants assert a change in function of Calisti would yield unpredictable results, we do not find where Appellants have provide support for this assertion. Rather, we find Appellants' assertion to be conclusory. Such unsupported attorney argument, is entitled to little probative value. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984).

Appellants contend that the Examiner erred in rejecting claim 3 under 35 U.S.C. § 103(a):

First, the client-originated spectrum requests of Buddhikot365 fail to teach a client receiving an offer to access spectrum, as encompassed by claim 1.

App. Br. 16 (emphases omitted).

Second, Buddhikot365 teaches a client initiating a request for spectrum by sending a spectrum request to a base station, as detailed above. But this is essentially opposite of an auctioneer-initiated auctioning of spectrum in which a spectrum provider sends an [sic] spectrum offer to a client, as encompassed by claim 1.

Thus, as understood by those skilled in the art, Buddhikot365 fails to teach a client receiving a spectrum offer in response to auctioneer-initiated auctioning of spectrum, as encompassed by claim 1.

App. Br. 16 (emphases omitted).

We disagree. Appellants attack Buddhikot '365 singly for lacking a teaching (limitations “as encompassed by claim 1”) that the Examiner relied on a combination of other references to show. Particularly, the Examiner points to Calisti and Buddhikot '205 for these claim 1 limitations. Final Act. 3–4. Again, Appellants argue findings the Examiner never made.

CONCLUSIONS

(1) The Examiner has not erred in rejecting claims 1–6, 24–33, and 35–37 as being unpatentable under 35 U.S.C. § 103(a).

(2) Claims 1–6, 24–33, and 35–37 are not patentable.

DECISION

The Examiner's rejections of claims 1–6, 24–33, and 35–37 are affirmed.⁷

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

⁷ As the Examiner has shown that all the claims are unpatentable, we do not also reject Appellants' claims 1–6, 24–33, and 35–37 under 35 U.S.C. § 101 as not being directed to patent eligible subject matter. However, should there be further prosecution of these claims; the Examiner's attention is directed to our following concern.

Appellants' claims appear to focus on the abstract idea of auctioning spectrum. We find relevant the Court's decision in *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014) and any subsequent agency guidance. The Supreme Court in *Alice* set forth a two-part test to determine compliance of a claim with § 101. The Court held that a mere instruction to implement an abstract idea on a computer cannot impart patent eligibility. 134 S. Ct. at 2357–59.