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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* JOSEF LAUMEN, JOERG REINECKE, FRANK SCHANGE,  
and GUNNAR SCHMIDT

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Appeal 2017-005633  
Application 14/247,654<sup>1</sup>  
Technology Center 2400

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Before JAMESON LEE, KEVIN F. TURNER, and STEPHEN C. SIU,  
*Administrative Patent Judges.*

TURNER, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a Final Office Action dated June 20, 2016 (“Final Act.”), rejecting claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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<sup>1</sup> According to Appellants, the real party in interest is IPCOM GmbH & CO, the assignee of this application. Appeal Brief (hereinafter “App. Br.”), 3.

### THE CLAIMED SUBJECT MATTER

The claims are directed to a method and a transmitter for sending predetermined messages of the first message service, using messages of the second message service. Specification ¶¶ 21–24. Claims 1 and 11 are independent. Claim 1, reproduced below, is illustrative of the claimed subject matter, with emphases added:

1. A method for transmitting multimedia messages of a multimedia message service using short messages of a short message service in a telecommunications network, the method comprising:

*embedding a multimedia message of a multimedia message service within a data portion of a short message of a short message service, the data portion following a header portion of the short message;*

including in said short message a first identifier indicating that said multimedia message is present in said data portion;

including in the data portion of the short message a second identifier indicating a type of said multimedia message; and

transmitting the short message to a receiver.

### REJECTIONS

Claims 1–7, 9–17, 19, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Winbladh (US 6,205,330 B1, issued Mar. 20, 2011), Belpaire (EP 0777394 A1, pub. June 4, 1997), and Global System for Mobile Communications 03.40 version 7.1.0 (pub. 1998) (hereinafter “GSM 03.40 V7.1”); and

Claims 8 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Winbladh, Belpaire, GSM 03.40 V7.1, and 3rd Generation Partnership Project Technical Specification 23.140 version 1.0.0 (pub. 1999) (hereinafter “3G TS 23.140”).

## ANALYSIS

### The § 103(a) rejections

Appellants argue claims 1–20 together as a group. *See generally* App. Br. We select claim 1 as representative. Thus, claims 2–20 will stand or fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner finds that Winbladh discloses all the elements of claim 1, except for (1) sending an multimedia message service (“MMS”) message of a multimedia message service, and (2) wherein the identifier is distinct from the message of the first message service. Final Act. 4–6; Answer (hereinafter “Ans.”), 5–7. The Examiner finds that the combination of Belpaire and GSM 03.40 V7.1 discloses sending emails<sup>2</sup> using the short message service (“SMS”) protocol, which includes identifiers indicating the type of message that is being transmitted, i.e., sending an email via SMS. Final Act. 6; Ans. 5, 7. The Examiner argues that given the teachings of Belpaire and GSM 03.40 V7.1, one of ordinary skill in the art would have found it obvious to send an MMS message, wherein the identifier is distinct from the message of the first message service. Final Act. 7.

Appellants argue that the Examiner’s obviousness rejection is improper because Winbladh fails to teach or suggest “embedding a

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<sup>2</sup> The Examiner interprets emails as messages sent using a multimedia message service because emails can contain multimedia data. Final Act. 6.

multimedia message of a multimedia message service within a data portion of a short message of a short message service” (hereinafter “embedding limitation”), per claim 1. App. Br. 8–11; Reply Brief (hereinafter “Reply Br.”), 6–7. In particular, Appellants argue that Winbladh cannot teach embedding a MMS message within the data portion of a SMS message because Winbladh teaches that the SMS contains an agent that initiates the email transfer from a host, i.e., contains instructions that instruct a mobile phone to grab an email from a remote server. App. Br. 8–11; Reply Br. 6. We agree with Appellants. More specifically, we agree that Winbladh fails to disclose the embedding limitation, and the additional references of Belpaire and GSM 03.40 V7.1 fail to correct this deficiency.

In particular, the Examiner does not offer sufficient evidence to show Winbladh discloses that the MMS message’s *content* is embedded within the SMS message’s data portion to meet the embedding limitation. Final Act. 4; Ans. 5–6. Rather, Winbladh discloses that the SMS message contains *instructions* for transferring an email, stored on a remote server, to a mobile device. Winbladh Abstract. As explained in Winbladh, an arriving email is stored on a remote server. *Id.* at 4:38–40. Thereafter, the arriving email creates an SMS message, which is sent to a mobile device. *Id.* at 7:5–9. The SMS message contains code that the mobile device’s software reads to access the email together with specific commands, i.e., “get now,” “get later,” or “delete mail.” *Id.* at 7:9–57. *See also* Figure 1 (illustrating a flowchart for routing of the email from the internet to a mobile phone or computer via SMS).

We note that the Examiner does not look to or apply the secondary references in an effort to cure Winbladh’s lack of disclosure. In view of the

above, we are persuaded that the Examiner erred in rejecting claim 1. We note that all the rejections rely, at least in part, on the combination of Winbladh, Belpaire, and GSM 03.40 V7.1, and the Examiner does not find that the additional reference 3G TS 23.140, asserted in the rejection of claims 8 and 18, corrects the deficiencies identified above regarding the combination of Winbladh, Belpaire, and GSM 03.40 V7.1. Final Act. 4–9; Ans. 5–7. For the above reasons, we do not sustain the rejection of claim 1 under 35 U.S.C. § 103(a), as well as the rejections of claims 2–20.

DECISION

The Examiner’s rejection of claims 1–20 is reversed.

REVERSED