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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte NITZAN NISSIM, BRIAN L. PULITO, and ASAF ZINGER

Appeal 2017-007499
Application 14/563,183¹
Technology Center 2400

Before MARC S. HOFF, JAMES R. HUGHES, and SCOTT B. HOWARD,
Administrative Patent Judges.

HOWARD, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Final Rejection of claims 26–43,² which constitute all of the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

¹ Appellant, is the Applicant, International Business Machines Corporation, which, according to the Appeal Brief, is the real party in interest. App. Br. 1.

² Although the first page of the Final Action indicates that claims 29, 35, and 41 are objected to and not rejected, the body of the Final Action rejects those claims for not complying with 35 U.S.C. § 101. *Compare* Final Act. 1, *with id.* at 2–4.

THE INVENTION

The disclosed and claimed invention is directed to “computer networks supporting SIP.” Spec. ¶ 2.

Claim 26, reproduced below, is illustrative of the claimed subject matter:

26. A method for processing mid-dialog SIP messages, comprising:
- receiving, from a SIP user agent client, a mid-dialog SIP message;
 - creating, based upon the mid-dialog SIP message, a new SIP session, and
 - associating the new SIP session with the mid-dialog SIP message.

REFERENCES

The prior art relied upon by the Examiner as evidence in rejecting the claims on appeal is:

Bakshi	US 2009/0022145 A1	Jan. 22, 2009
Qiu	US 2011/0149951 A1	June 23, 2011
Backman	US 2012/0260312 A1	Oct. 11, 2012
Haserodt	US 2014/0047122 A1	Feb. 13, 2014
Nissim (hereinafter “Nissim '553)	US 8,930,553 B2	Jan. 6, 2015
Nissim (hereinafter “Nissim '415)	US 8,935,415 B2	Jan. 13, 2015

REJECTIONS

Claims 26–43 stand rejected under 35 U.S.C. § 101 as directed to patent-ineligible subject matter.³ Final Act. 2–4.

Claims 38–43 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Final Act. 4.

Claim 32 stands rejected under pre-AIA 35 U.S.C. § 112 second paragraph as being indefinite. Final Act. 5.

Claims 26, 27, 32, 33, 38, and 39 stand rejected on the grounds of nonstatutory double patenting as being unpatentable over claims 1 and 2 of Nissim '415 in view of Haserodt, Bakshi, and Qiu. Final Act. 6–11.

Claims 26, 27, 32, 33, 38, and 39 stand rejected on the grounds of nonstatutory double patenting as being unpatentable over claims 1 and 2 of Nissim '553 in view of Haserodt, Bakshi, and Qiu. Final Act. 11–15.

Claims 26–28, 30, 32–34, 36, 38–40, and 42 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Haserodt in view of Bakshi and Qiu. Final Act. 16–26.

Claims 31, 37, and 43 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Haserodt in view of Bakshi, Qiu, and Backman. Final Act. 27–29.

³ Although the rejection states the claims are rejected as directed to non-statutory subject matter, the body of the rejection addresses whether or not the claims are patent-ineligible as directed to a judicial exception. *Compare* Final Act. 2, *with id.* at 2–4.

ANALYSIS

We have reviewed the Examiner’s rejection in light of Appellant’s arguments that the Examiner erred. In reaching this decision, we have considered all evidence presented and all arguments made by Appellant.⁴

Claims 26–37 (Section 101)

Patent-eligible subject matter is defined in § 101 of the Patent Act, which recites:

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.

There are, however, three judicially created exceptions to the broad categories of patent-eligible subject matter in § 101: laws of nature, natural phenomena, and abstract ideas. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014); *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 70–71 (2012). Although an abstract idea, itself, is patent-ineligible, an application of the abstract idea may be patent-eligible. *Alice*, 134 S. Ct. at 2355. Thus, we must consider “the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 566 U.S. at 79, 78). The claim must

⁴ Rather than reiterate the entirety of the arguments of Appellant and the positions of the Examiner, we refer to the Appeal Brief (filed Nov. 15, 2016); the Reply Brief (filed Apr. 14, 2017); the Final Office Action (mailed June 15, 2016); and the Examiner’s Answer (mailed Feb. 21, 2017) for the respective details.

contain elements or a combination of elements that are “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [abstract idea] itself.” *Id.* (quoting *Mayo*, 566 U.S. at 72–73).

The Supreme Court set forth a two-part “framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Id.* at 2355.

First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts. [*Mayo*, 566 U.S. at 77]. If so, we then ask, “[w]hat else is there in the claims before us?” *Id.*, at [78]. To answer that question, we consider the elements of each claim both individually and “as an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application. *Id.*, at [79, 78]. We have described step two of this analysis as a search for an “‘inventive concept’”—*i.e.*, an element or combination of elements that is “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.” *Id.*, at [72–73].

Id.

“The ‘abstract idea’ step of the inquiry calls upon us to look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs of Tex. v. DirectTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) (quoting *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016)); *see also Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016). There is no definitive rule to determine what constitutes an “abstract idea.” Rather, the Federal Circuit has explained that “both [it] and the Supreme Court have found it sufficient to compare claims at issue to

those claims already found to be directed to an abstract idea in previous cases.” *Enfish*, 822 F.3d at 1334; *see also Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (explaining that, in determining whether claims are patent eligible under § 101, “the decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided”).

The Examiner concludes the claims are “directed to the abstract idea of receiving a message, determining whether the message is associated with an existing session, and, in event message is unassociated, associating the message with a new session.” Final Act. 3. The Examiner further concludes that “[t]his concept is analogous to following abstract idea listed in July 2015 Update: Interim Eligibility Guidance Identifying Abstract Ideas: 1) comparing new and stored information and using rules to identify options.” *Id.*; *see also* Ans. 3 (“The claimed invention is also analogous to *SmartGene*’s ‘comparing new and stored information and using rules to identify options.’”). The Examiner further concludes the claimed invention is also “analogous to following abstract idea listed in December 2016 Quick Reference Sheet: *Classen*’s ‘collecting and comparing known information.’” Ans. 3.

Appellant argues the Examiner erred in concluding the claim is directed to an abstract idea. App. Br. 9–16; Reply Br. 2–3. Specifically, Appellant argues the pending claims are different from those in *SmartGene* and *Classen*. App. Br. 13–14. According to Appellant, *SmartGene* turned on the claim at issue encompassing a mental process. App. Br. 13 (citing *SmartGene, Inc. v. Advanced Biological Labs., SA*, 555 F. App’x 950, 955

(Fed. Cir. 2014)). Appellant argues that “[u]nlike SmartGene in which every step could be performed by a doctor ‘in their heads,’ the claimed invention cannot be performed by the human mind.” *Id.* at 14.

Appellant also argues the claimed invention does not resemble the claims in *Classen*, which “are directed to the abstract principle that variation in immunization schedules may have consequences for certain diseases.” Reply Br. 3 (quoting *Classen Immunotherapies Inc. v. Biogen IDEC*, 659 F.3d 1057, 1067 (Fed. Cir. 2011)).

Based on the current record, we are persuaded by Appellant’s arguments that the Examiner erred. The Examiner has not shown sufficiently that the claims at issue are analogous to those found to be patent-ineligible in *SmartGene* and *Classen*.⁵ Accordingly, we reverse the Examiner’s rejection that claims 26–37 are directed to patent-ineligible subject matter.

Claims 38–43 (Section 101)

The Examiner rejected claims 38–43 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Final Act. 4; Ans. 4.⁶ Specifically, the Examiner concludes that “computer readable storage medium” as recited in claim 38, is broad enough to encompass both non-transitory media and transitory media. Final Act. 4; Ans. 4.

⁵ Because we agree with Appellant that the Examiner has not shown sufficiently that the claims are directed to an abstract idea, we did not have to address the second step of the *Alice/Mayo* framework.

⁶ The Examiner also rejected the claims as directed to patent-ineligible subject matter based on a judicial exception. *See* Final Act. 2–4. Because, as discussed below, the claims are broad enough to encompass non-statutory subject-matter, we do not address that alternate grounds of rejection.

Appellant argues the Examiner erred. App. Br. 18–28; Reply Br. 4. More particularly, Appellant argues, based on the Specification, that “the Examiner’s claim construction that the claimed ‘storage mediums’ encompasses a propagating signals is inconsistent with Appellants’ specification.” Reply Br. 4; *see also* App. Br. 21–22 (citing Spec. ¶¶ 16–17). Appellant also relies on various patent applications it contends have nearly identical language within their respective specifications and have recently had section 101 rejections withdrawn. App. Br. 22–26.

If the broadest reasonable interpretation of a claim covers non-patentable subject matter such as a transitory signal, the claim is unpatentable under 35 U.S.C. § 101. *See In re Nuijten*, 500 F.3d 1346, 1356–57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter). Unless limited to non-transitory embodiments, the broadest reasonable interpretation of the phrase “computer readable storage medium” includes both transitory and non-transitory embodiments and would be unpatentable under section 101. *Ex parte Mewherter*, 107 USPQ2d 1857, 1862 (PTAB 2013) (precedential).

When determining whether a “computer readable storage medium” limitation covers non-patentable subject matter, the following factors must be considered:

- (1) Extrinsic evidence relevant to the meaning as would be understood by one skilled in the art at the time of the effective filing date of the patent application. . . .
- (2) Whether there is express intent in applicant’s specification to limit the term, i.e., applicant’s specification is not silent as to the meaning of such terms.
- (3) Whether the claim *expressly* limits the medium to “non-transitory” embodiments.

(4) Whether the claim *implicitly* limits the medium to “non-transitory” embodiments. The most common form of this is the use of “means plus function” elements in the claim (i.e., a true Beauregard type claim). Such means plus function elements are limited by statute to the corresponding structure in the specification and equivalents thereof. Such a structure requirement limits the claim to non-transitory embodiments.

Mewherter, 107 USPQ2d at 1860 n.5.

Similar to the facts of *Mewherter*, Appellant’s Specification does not limit “computer readable storage medium” such that it excludes transitory propagating signals. *See* Spec. ¶¶ 16–17. Although the Specification states that a computer readable *signal* medium may be a signal and that a computer readable *signal* medium is not a computer readable storage medium, the Specification does not define readable *storage* medium such that it cannot be a signal per se. *See Id.* Moreover, because the Specification uses the permissive “may” and not a more mandatory phrase, such as “shall,” the Specification is not sufficient to show that the applicant acted as a lexicographer and limited the scope of the claim. *See In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (holding that an applicant must provide a definition of the term in the specification with “reasonable clarity, deliberateness, and precision” in order to act as a lexicographer). Accordingly, Appellant has not persuaded us the Examiner erred.

We are also unpersuaded by Appellant’s reliance on various decisions made by Examiners in other, unrelated applications. Those decisions are not binding on us and we are bound to apply this Board’s precedential decision of *Mewherter*.

Accordingly, we sustain the Examiner's rejection of claims 38–43 as being directed to non-statutory subject matter.⁷

Claim 32 (Section 112 Rejection)

The Examiner rejects claim 32 as indefinite. Final Act. 5; Ans. 5. More specifically, the Examiner concludes that “‘and/or’ is ambiguous phrasing that precludes definitive interpretation of what is claimed.” Final Act. 5. According to the Examiner,

The construction “and/or” introduces ambiguity regarding whether all elements or one element of a group of elements must be present to satisfy a condition. The “or” conjunction alone provides for a condition being satisfied if, for a group of elements, one element, more than one element but less than all of the elements of a group, or all the elements of a group are present.

Ans. 5.

Appellant argues the term “and/or” is not ambiguous and informs those of ordinary skill in the art the scope of the invention with reasonable certainty. App. Br. 28–30; Reply Br. 5. Appellant further argues that the Board has previously held “and/or” has a definitive meaning and “covers embodiments having element A alone, element B alone, or elements A and

⁷ We note that both the Examiner and the USPTO has suggested amending claims such as these so that the claims only read on non-transitory statutory embodiments. *See* Final Act 4 (“Examiner suggests that ‘computer readable storage medium’ be amended to recite ‘non-transitory computer readable storage medium.’”); David J. Kappos, *Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. & Trademark Office 212 (Feb. 23, 2010).

B taken together.” App. Br. 29 (quoting *In re Gross*, Appeal No. 2011-004811, 2013 WL 6907805 (PTAB Dec. 31, 2013)).

“[W]e apply the approach for assessing indefiniteness approved by the Federal Circuit in *Packard*, i.e., ‘[a] claim is indefinite when it contains words or phrases whose meaning is unclear.’” *Ex parte McAward*, No. 2015-006416, 2017 WL 3669566, at *5 (PTAB Aug. 25, 2017) (precedential) (quoting *In re Packard*, 751 F.3d 1307, 1310, 1314 (Fed. Cir. 2014)). “Put differently, ‘claims are required to be cast in clear—as opposed to ambiguous, vague, indefinite—terms.’” *Id.* (quoting *Packard*, 751 F.3d at 1313); *see also* MPEP § 2173.02(I). “At the same time, this requirement is not a demand for unreasonable precision.” *Packard*, 751 F.3d at 1313.

Applying the standard set forth in *Packard*, we agree with Appellant that the claim is sufficiently clear. That is, as we held in *Gross*, the claim covers a system that either initiates, performs, or both initiates and performs the claimed steps.

According, we reverse the Examiner’s rejection of claim 32 as indefinite.

Claims 26, 27, 32, 33, 38, and 39 (Double Patenting)

Appellant has not identified any errors in the Examiner’s findings regarding the two double patenting rejections. “If an appellant fails to present arguments on a particular issue — or, more broadly, on a particular rejection — the Board will not, as a general matter, unilaterally review those uncontested aspects of the rejection.” *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential).

Accordingly, we affirm the Examiner’s rejections of claims 26, 27, 32, 33, 38, and 39 on the grounds of obviousness-type double patenting.

Claims 26, 32, and 48 (Section 103)

As detailed in the Final Action and the Answer, the Examiner relies on a combination of the teachings of Haserodt, Bakshi, and Qiu to teach the “creating, based upon the mid-dialog SIP message, a new SIP session” step recited in claim 26. Final Act. 16–18; Ans. 5–6.

Appellant argues the Examiner erred for three reasons. App. Br. 31–36; Reply Br. 5–7. First, Appellant argues “Haserodt is directed to reconstructing an existing session – not creating a new session.” App. Br. 31; *see also id.* at 31–32; Reply Br. 5–6 (“Haserodt does not create a session (new or old) ‘based upon the mid-dialog SIP message.’ Instead, Haserodt teaches creating a new message.”). Second, Appellant argues because “the Examiner now admits that Haserodt fails to teach the ‘new SIP session’ . . . the alleged fact that Qiu teaches a ‘new SIP session’ does not cure the deficiency of Haserodt.” App. Br. 34; *see also id.* at 35 (“The alleged fact that Qiu teaches ‘creating . . . a new SIP session’ does not cure the deficiencies of Haserodt since Qiu also fails to tie the creation of the new SIP session with the receipt of the mid-dialog SIP message.”); *see also* Reply Br. 6–7. Third, Appellant argues “that the Examiner’s response, while establishing that Qiu teaches creating a new SIP session, does not cure the aforementioned deficiencies in the Examiner’s combination of references.” App. Br. 36.

Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art

disclosures. *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). The test for obviousness is not whether the claimed invention is expressly suggested in any one or all of the references, but whether the claimed subject matter would have been obvious to those of ordinary skill in the art in light of the *combined teachings* of those references. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). Because each of Appellant's arguments are premised on addressing the references individually and not the combination of teachings as relied upon by the Examiner, we are not persuaded that the Examiner erred. Instead, we find the Examiner's findings regarding the references is supported by the record and that the Examiner's finding provides a "rational underpinning to support the legal conclusion of obviousness." *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), *cited with approval in KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Accordingly, we agree with and adopt the Examiner's findings and ultimate conclusion on obviousness.

Therefore, we sustain the Examiner's rejection of claim 26 as obvious, along with the rejection of claims 32, and 38, which are argued on the same grounds.

Claims 27, 33, and 39 (Section 103)

Appellant argues the Examiner erred in finding Haserodt teaches the additional limitation recited in claim 27. App. Br. 36; Reply Br. 8. Specifically, Appellant states as follows:

Regarding these limitations, on page 18 of the Third Office Action, the Examiner made the following Graham findings of fact regarding the scope and content of Haserodt:

Haserodt, [0047], lines 5-10: a message processor encapsulates the second SIP message into another SIP message. The message is associated with a session different from the first SIP session.

Notably, neither the Examiner's analysis nor the Examiner's cited passage makes any mention of the claimed "unsuccessfully associating the mid-dialog SIP message with a pre-existing SIP session" (emphasis added).

App. Br. 36.

The Examiner finds that Haserodt teaches the additional limitation recited in claim 27:

The method of claim 26, wherein the creating and the associating are responsive to unsuccessfully associating the mid-dialog SIP message with a pre-existing SIP session (Haserodt, [0047], lines 5-10: a message processor encapsulates the second SIP message into another SIP message. The message is associated with a session different from the first SIP session).

Final Act. 18 (emphasis added); *see also* Ans. 6–7. The Examiner further finds that to the extent the different SIP session in Haserodt is not new, "Qiu is relied upon for its disclosure of creation of a new SIP session for a SIP message for which call state information is unavailable (par. 0020)." Ans. 7.

We are not persuaded by Appellant's argument that the Examiner erred. First, the quotation of the Examiner's findings in the Appeal Brief was incomplete. Specifically, the material emphasized above—which uses the language Appellant states is missing—was omitted from Appellant's reproduction. Thus, the Examiner's findings includes the language recited in claim 27 and explained how it was taught and Haserodt.

Second, there is no requirement in an obviousness analysis for the prior art to “contain a description of the subject matter of the appealed claim in *ipsissimis verbis*.” *In re May*, 574 F.2d 1082, 1090 (CCPA 1978). Thus, it is irrelevant that the section of the reference relied on by the Examiner does not use the same words of the claims. Instead, we agree with and adopt the Examiner’s findings.

Accordingly, we sustain the Examiner’s rejection of claim 27 as obvious, along with the rejections of claims 33 and 39, which are argued on the same ground.

Claims 28, 30, 34, 36, 40, and 42 (Section 103)

Appellant argues the Examiner erred in rejecting claim 28 because the section of Haserodt relied on by the Examiner does not make “any mention of the claimed ‘receiving, from the application, an **acknowledgement that the application will accept the mid-dialog SIP message**’ (emphasis added). Consequently, the Examiner has not established that Haserodt teaches all of the limitations for which Haserodt is being relied upon to teach.” App. Br. 37; *see also* Reply Br. 9.

However, as discussed above, there is no requirement in an obviousness analysis for the prior art to “contain a description of the subject matter of the appealed claim in *ipsissimis verbis*.” *May*, 574 F.2d at 1090. Therefore, we are not persuaded by Appellant’s argument that the Examiner erred. Instead, we agree with and adopt the Examiner’s findings.

Accordingly, we sustain the Examiner’s rejection of claim 28 as obvious, along with the rejections of claims 34, and 40, which are argued on

the same grounds, and dependent claims 30, 36, and 42, which are not argued separately.

Claims 31, 37, and 43 (Section 103)

With respect to dependent claims 31, 37, and 43, Appellant merely contends that because the additional reference used in the rejections of these claims (Backman) does not cure the shortcomings of the other references applied against claim 28, 34, and 40, the proposed combination of references would not yield the claimed invention. App. Br. 37–38. Because we determine that the rejections of claims 28, 34, and 40 are not erroneous for the reasons discussed above, we sustain the rejections of these claims.

DECISION

For the above reasons, we reverse the Examiner’s decisions rejecting claims 26–37 under 35 U.S.C. § 101.

For the above reasons, we affirm the Examiner’s decisions rejecting claims 38–43 under 35 U.S.C. § 101.

For the above reasons, we reverse the Examiner’s decision rejecting claim 32 under 35 U.S.C. § 112, second paragraph.

For the above reasons, we affirm the Examiner’s rejection of claims 26, 27, 32, 33, 38, and 39 on the grounds of double patenting.

For the above reasons, we affirm the Examiner’s decisions rejecting claims 26–28, 30–34, 36–40, 42, and 43 under 35 U.S.C. § 103(a).

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). *See* 37 C.F.R. § 41.50(f).

Appeal 2017-007499
Application 14/563,183

AFFIRMED-IN-PART