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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte UWE BAEDER and HOLGER JAUCH

Appeal 2018-005120
Application 14/796,038
Technology Center 2600

Before JOHN A. JEFFERY, ST. JOHN COURTENAY III, and
MATTHEW J. McNEILL, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Under 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's
decision to reject claims 1–14. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37
C.F.R. § 1.42. Appellant identifies the real party in interest as Rohde &
Schwarz GmbH & Co. Appeal Br. 3.

STATEMENT OF THE CASE

Appellant's invention tests mobile communications devices by (1) transmitting a Universal Integrated Circuit Card (UICC) testing profile to the device that activates the profile; (2) setting the device's configuration to a testing mode according to information in the profile; and (3) testing the device while in the testing mode. *See* Abstract. Claim 1 is illustrative:

1. A testing method for testing a mobile communication device, the method comprising:

transmitting, by a testing front end module, a testing profile of a Universal Integrated Circuit Card (UICC) that emulates subscriber-specific information to a mobile communication device, wherein the UICC is external to the mobile communication device and arranged in the testing front end module;

activating the testing profile on the mobile communication device; setting, by a testing controller, the configuration of the mobile communication device to a testing mode according to the information of the activated testing profile of the UICC; and

performing operational tests on the mobile communication device using a testing front end module of a testing system while the configuration of the mobile communication device is set to the testing mode.

THE REJECTIONS

The Examiner rejected claims 1, 2, 4, 7, 8, and 10–14 under 35 U.S.C. § 103 as unpatentable over Doshi (US 2013/0078996 A1; published Mar. 28, 2013), Merrien (US 2013/0283047 A1; published Oct. 24, 2013), Reed (US 2013/0273853 A1; published Oct. 17, 2013), and Buchsbaum (US 2015/0333397 A1; published Nov. 19, 2015). Ans. 2–13.²

² Throughout this opinion, we refer to (1) the Appeal Brief filed December 6, 2017 (supplemented January 9, 2018) (“Appeal Br.”); (2) the Examiner’s

The Examiner rejected claims 3, 5, 6, and 9 under 35 U.S.C. § 103 as unpatentable over Doshi, Merrien, Reed, Buchsbaum, and Haggerty (US 2012/0331292 A1; published Dec. 27, 2012). Ans. 14–15.

**THE OBVIOUSNESS REJECTION OVER DOSHI, MERRIEN, REED,
AND BUCHSBAUM**

Regarding independent claim 1, the Examiner finds that Doshi discloses, among other things, a method for testing a mobile communication device where a “testing front end module,” namely a system simulator, transmits a UICC testing profile to the mobile device that activates the profile. Ans. 3–4. Although the Examiner finds that Doshi’s UICC card (1) does not emulate subscriber-specific information; (2) is not external to the mobile device; and (3) is not arranged in the testing front end module, the Examiner cites Merrien, Reed, and Buchsbaum for teaching these respective features. Ans. 4–8. The Examiner also finds that Doshi’s mobile device operational tests are not performed while the device’s is set to the testing mode, but the Examiner nonetheless takes Official Notice that this feature is well known in the art to use the appropriate device operational mode. Ans. 4. Based on these collective teachings, the Examiner concludes that the claim would have been obvious. *See* Ans. 3–8.

Appellant argues the Examiner’s reliance on Buchsbaum is misplaced because not only is the reference non-analogous art, but Buchsbaum does not disclose a UICC, let alone a UICC in a testing front end module as claimed. Appeal Br. 11–13; Reply Br. 6. Appellant adds that ordinarily

Answer mailed April 5, 2018 (“Ans.”); and (3) the Reply Brief filed April 12, 2018 (“Reply Br.”).

skilled artisans would not have been motivated to modify Doshi based on Buchsbaum to rearrange parts as the Examiner proposes because, among other things, the Examiner's parts rearrangement rationale lacks articulated reasoning with rational underpinning, and such a rearrangement would not likely result in the claimed invention. Appeal Br. 14–16; Reply Br. 7.

ISSUES

I. Under § 103, has the Examiner erred in rejecting claim 1 by finding that Doshi, Merrien, Reed, and Buchsbaum collectively would have taught or suggested arranging a UICC in a testing front end module?

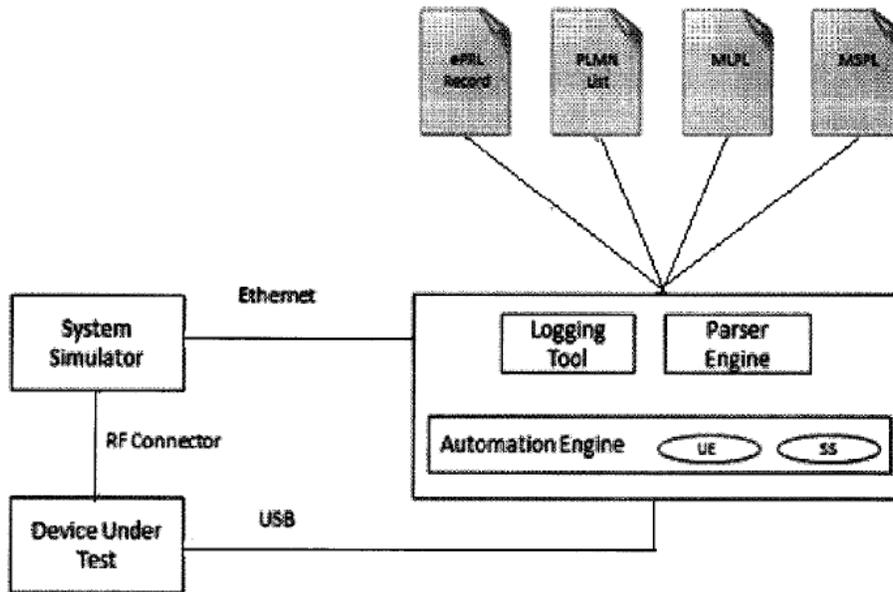
II. Is the Examiner's proposed combination of the cited references supported by articulated reasoning with some rational underpinning to justify the Examiner's obviousness conclusion? This issue turns on whether Buchsbaum is analogous art.

ANALYSIS

We begin by noting that the Examiner's findings regarding Doshi, Merrien, and Reed are undisputed, including the Examiner's equating Doshi's system simulator in Figure 1 to the recited "testing front end module." *See* Ans. 3. Rather, as noted above, this dispute turns on the Examiner's reliance on Buchsbaum to cure Doshi's acknowledged deficiency, namely arranging a UICC *in* a testing front end module, and the proposed rationale to do so.

Our emphasis on the word "in" above underscores the claim's requirement that the UICC is *in* the testing front end module. As the Examiner acknowledges, Doshi does not say whether the UICC is in the

system simulator, namely the “testing front end module” under the Examiner’s mapping, nor does Doshi specify exactly where the UICC is located. *See* Doshi ¶¶ 2, 9–16, 20–35. Doshi does, however, explain that a parser engine parses various entries from a UICC. *See* Doshi ¶¶ 24–25. As shown in Doshi’s Figure 1 below, the parser engine is located in an unlabeled device that includes an automation engine and logging tool, where this device is connected to the system simulator and device under test via Ethernet and USB connections, respectively.



Doshi’s Figure 1 showing device with parser engine connected to system simulator and device under test via Ethernet and USB connections

Although Doshi does not specify the UICC’s exact location, the fact that its four entries shown in the shaded boxes in Figure 1 above are parsed by the parser engine at least suggests that the UICC may be in the unlabeled

device that includes this engine, particularly given the entries' four corresponding lines that each converge on that device.

Therefore, assuming, without deciding, that Doshi's UICC is in the unlabeled device with the parser engine ("the parser engine device"), the question is whether it would have been obvious to arrange the UICC in the system simulator instead of the parser engine device as the Examiner proposes in light of Buchsbaum. On this record, we answer "yes" to this question.

As shown in Buchsbaum's Figure 1, mobile telephone 100 includes a module 109 that can be a Subscriber Identity Module (SIM) card, which the Examiner equates to a UICC (Ans. 7), *on* which various components, including secure element (SE) 105, front-end 104, and further components 106, can be arranged. *See* Buchsbaum ¶¶ 19–20, 27. Our emphasis on the word "on" underscores that Buchsbaum's UICC-based SIM card is not arranged *in* the front-end 104 or other such components; rather, these components are arranged *on* this UICC. The Examiner's finding, then, that Buchsbaum teaches arranging the UICC *in the front end* (Ans. 6–7, 16) is somewhat puzzling at first blush given the front-end 104's arrangement *on* Buchsbaum's UICC-based module 109 in Figure 1.

Nevertheless, we see no reason why Doshi's UICC could not be arranged in the system simulator, or "testing front end module," as the Examiner proposes, particularly given Buchsbaum's teaching of arranging the UICC *within* mobile telephone 101 in Figure 1, and the fact that Doshi's system simulator is connected directly to the parser engine device via an Ethernet connection as shown in Figure 1. To the extent that Appellant contends that arranging Doshi's UICC in the system simulator instead of the

parser engine device would somehow render the parser engine incapable of parsing the UICC's entries via the Ethernet connection or otherwise render Doshi unsuitable for its intended purpose, there is no persuasive evidence on this record to substantiate such a contention. On this record, we find the Examiner's proposed enhancement that effectively rearranges the UICC from the parser engine device to the system simulator uses prior art elements predictably according to their established functions—an obvious improvement. *See KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417 (2007). To the extent that Appellant contends that the Examiner's proposed enhancement to Doshi would be uniquely challenging or otherwise beyond the skill level of ordinarily skilled artisans, there is no persuasive evidence on this record to substantiate such a contention. *See id.*; *see also Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007).

Appellant's arguments regarding the alleged inadequacy of the Examiner's parts rearrangement rationale (Appeal Br. 14–16; Reply Br. 7) are unavailing. To be sure, nearly any device or system modification rearranges parts and, such a rationale, standing alone, can be problematic in some circumstances as Appellant indicates. Appeal Br. 15. But where, as here, the Examiner merely proposes to arrange the UICC in Doshi's system simulator instead of the parser engine device, such a parts rearrangement would have been merely an obvious variation, particularly given the simulator's direct Ethernet connection to the parser engine device as shown in Figure 1. In short, this enhancement uses prior art elements predictably according to their established functions—an obvious improvement. *See KSR*, 550 U.S. at 417.

We also find Buchsbaum is analogous art despite Appellant's arguments to the contrary. *See* Appeal Br. 11–13; Reply Br. 15–16. Prior art is analogous if it is (1) from the same field of endeavor regardless of the problem addressed, or (2) reasonably pertinent to the particular problem with which the inventor is involved. *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). Here, because Buchsbaum pertains to a mobile telephone and associated communication functionality, it is at least reasonably pertinent to Appellant's problem, namely testing a mobile communication device, which can include mobile telephones. *See* Spec. ¶ 23. That Buchsbaum's paragraph 36 notes that the *manufacturer* of the module or communication device does not need any test systems *for contactless communication* does not change our conclusion. Leaving aside the fact that such unnecessary test systems are not only limited to manufacturers, but also contactless communication as emphasized above, Buchsbaum's paragraph 30 nonetheless teaches that module manufacturers typically require contactless test systems to verify the module. In any event, the Examiner cites Buchsbaum for a very limited purpose, namely to show that arranging a UICC in a front end would have been obvious, and that ordinarily skilled artisans would have applied such a teaching to a *testing* front end module, such as that disclosed in Doshi. *See* Ans. 6–8. Therefore, Appellant's arguments regarding Buchsbaum's paragraph 36 are unavailing, for Buchsbaum's teachings regarding mobile communications devices are at least reasonably pertinent to Appellant's invention that likewise involves mobile communications devices. Accordingly, we find Buchsbaum is analogous art.

On this record, then, we find that the Examiner's proposed combination of the cited references is supported by articulated reasoning with some rational underpinning to justify the Examiner's obviousness conclusion.

Lastly, although Appellant argues for the first time on pages 3 to 6 of the Reply Brief that the Examiner's Official Notice is improper, these arguments were not raised in the Appeal Brief and are, therefore, waived as untimely. *See* 37 C.F.R. § 41.41(b)(2). Nor has good cause been shown to raise these new arguments in the first instance in the Reply Brief.

Therefore, we are not persuaded that the Examiner erred in rejecting claim 1, and claims 2, 4, 7, 8, and 10–14 not argued separately with particularity.

THE OTHER OBVIOUSNESS REJECTIONS

We also sustain the Examiner's obviousness rejections of claims 3, 5, 6, and 9. Ans. 14–15. Because these rejections are not argued separately with particularity, we are not persuaded of error in these rejections for the reasons previously discussed.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 2, 4, 7, 8, 10–14	103	Doshi, Merrien, Reed, Buchsbaum	1, 2, 4, 7, 8, 10–14	
3, 5, 6, 9		Doshi, Merrien, Reed, Buchsbaum, Haggerty	3, 5, 6, 9	
Overall Outcome			1–14	

TIME PERIOD FOR RESPONSE

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).

AFFIRMED