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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAGANNATH GHOSHAL, ROBERT L. SPANEL,
BRET D. SUMNER, and ROBERT E. URBANEK

Appeal 2018-009131
Application 15/063,383
Technology Center 2600

Before JENNIFER S. BISK, LARRY J. HUME, and
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

DIRBA, *Administrative Patent Judge*.

DECISION ON APPEAL¹

Appellant² seeks our review under 35 U.S.C. § 134(a) of the Examiner's rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

¹ This Decision uses the following abbreviations: “Spec.” for the original specification, filed March 7, 2016, which claims the benefit of an earlier filed U.S. patent application; “Final Act.” for the Final Office Action, mailed January 18, 2018; “Appeal Br.” for Appellant’s Appeal Brief, filed June 14, 2018; “Ans.” for Examiner’s Answer, mailed July 10, 2018; and “Reply Br.” for Appellant’s Reply Brief, filed August 31, 2018.

² 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 Sprint Communications Company L.P. Appeal Br. 3.

BACKGROUND

Appellant's disclosed embodiments and claimed invention relate to a dynamic subscriber identity module (SIM) that selects a carrier applet based on the mobile network identified by the SIM. Spec. ¶¶ 5–8.

Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method of dynamically changing a mobile communication device by communicative coupling with a dynamic subscriber identity module (SIM), the method comprising:

identifying, via a communication transceiver of the mobile communication device that is executing at least one processor, a mobile communication network;

polling, by the mobile communication device from the dynamic SIM executing at least one processor, an identification of an active carrier applet on the dynamic SIM, wherein the dynamic SIM is removably engaged with the mobile communication device and comprises *a non-transitory memory that is segmented into a plurality of separate memory partitions, wherein at least some of the plurality of separate memory partitions comprise a different carrier applet, and wherein the active carrier applet is one of a plurality of carrier applets stored in one of the plurality of separate memory partitions on the dynamic SIM*; and

in response to the polling, directing, via execution of a steering applet of the dynamic SIM, the dynamic SIM to switch the active carrier applet to another carrier applet of the plurality of carrier applets based on the identification of the mobile communication network, *wherein each carrier applet of the plurality of carrier applets is maintained in parallel storage in different memory partitions on the dynamic SIM while the active carrier applet is switched.*

Appeal Br. 24 (Claims App.) (emphasis added).

THE REJECTIONS

R1. Claims 1–8 stand rejected under 35 U.S.C. § 103 as obvious over Brown (US 2005/0164737 A1, published July 28, 2005), Cormier (US 2015/0312873 A1, published October 29, 2015), and Tagg (US 2017/0150435 A1, published May 25, 2017). Final Act. 2–7.

R2. Claims 9–20 stand rejected under 35 U.S.C. § 103 as obvious over Brown, Cormier, Tagg, and Lhamon (US 2015/0271662 A1, published September 24, 2015). Final Act. 7–23.

ANALYSIS

We review the appealed rejections for error based upon the issues identified by Appellant and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential). To the extent Appellant has not advanced separate, substantive arguments for particular claims, or other issues, such arguments are waived. 37 C.F.R. § 41.37(c)(1)(iv).

We have considered all of Appellant’s arguments and any evidence presented. We highlight and address specific findings and arguments for emphasis in our analysis below.

Obviousness Rejection R1 of Claims 1–8

Claim 1 recites a dynamic subscriber identity module (SIM) that “comprises a non-transitory memory that is segmented into a plurality of separate memory partitions.” Appeal Br. 24 (Claims App.). The claim provides that “each carrier applet of [a] plurality of carrier applets is

maintained in parallel storage in different [ones of the] memory partitions.”³ *Id.* The claim also recites “directing, via execution of a steering applet . . . , the dynamic SIM to switch the active carrier applet⁴ to another carrier applet of the plurality of carrier applets.” *Id.* (footnote added).

The Examiner rejected claim 1 as obvious over Brown, Cormier, and Tagg. Final Act. 2–4. Specifically, the Examiner found Brown stores, in separate memory portions, different sets of subscription parameters (each set including an IMSI, an ICCID, and other parameters), and the Examiner found this teaches a plurality of “carrier applets” in different “memory partitions.” *Id.* at 3 (citing Brown, Fig. 1, ¶¶ 14, 19, 20, 36); *see also id.* at 23 (explaining that because multiple service providers can use the same SIM, Brown’s subscription parameters are stored in separate partitions). Further, the Examiner found Brown switches the active set of the subscription parameters, and Cormier describes “a Roaming Applet (522) [that] steers the dynamic SIM to a first carrier applet (USIM1) or a second carrier applet (USIM2).” *Id.* at 3–4 (citing Brown ¶¶ 30, 33; Cormier, Fig. 5)).

Appellant contends the Examiner’s rejection is in error because the references fail to teach or suggest “memory partitions” that store a plurality of “applets,” as required by claim 1. Appeal Br. 15–18. In addition,

³ The reference to “memory partitions” in this phrase refers to the previously recited “plurality of memory partitions.” *See* Appeal Br. 24 (Claims App.) (claim 1). Accordingly, we have added the phrase “ones of the” before “memory partitions” for clarity.

⁴ The claim also specifies that “the active carrier applet is one of [the] plurality of carrier applets stored in one of the plurality of separate memory partitions.” Appeal Br. 24 (Claims App.).

Appellant contends that the Examiner failed to establish a prima facie case of obviousness. *Id.* at 18–20. For the reasons provided below, Appellant’s arguments do not persuade us of Examiner error.

Prima Facie Case

Appellant contends the Examiner failed to establish a prima facie case because the Final Office Action explains the rejection using terminology that differs from the language recited in the claim. Appeal Br. 18–20. For example, Appellant notes that the Final Office Action refers to memory “portions” when explaining how the reference teaches the claimed memory “partitions” and adds a phrase not present in the claim language (i.e., “plurality of carrier sub-partitions”). *Id.* at 18–19. According to Appellant, this “muddle[s] the explicit language of Appellant’s claim.” *Id.* at 20. We disagree.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992); *see also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). An Examiner’s rejection establishes a prima facie case when it provides notice of the reasons for the rejection, and the rejection is deficient when it of “is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.” *In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011).

The Examiner provided sufficient notice of the reasons for the rejection by identifying the relevant portions of the cited references and by explaining how the references disclose the claim limitations. *See* Final Act. 2–4. Although the Final Office Action explains the rejection using

different terminology, the relevant claim language is also clearly identified in the rejection. *See id.* Moreover, the differences between the claim language and the terminology used in the explanation (individually and collectively) neither “muddle” the claim language nor create undue confusion. Accordingly, the rejection is sufficient to make a prima facie case, and we are not persuaded by Appellant’s argument to the contrary.

Carrier Applets Limitation

Appellant contends the Examiner’s rejection is in error because the references fail to teach or suggest a plurality of “carrier applets,” as required by claim 1. Appeal Br. 17–18. Appellant contends, “[A]pplets comprise instructions or logic executable by a processor.” *Id.* at 17 (citing Spec. ¶ 34). According to Appellant, Brown’s IMSI and ICCID fail to teach an applet because these are “numbers” or “static data” rather than executable instructions or logic. *Id.* Appellant argues, “While Cormier may discuss a UICC storing multiple identities (USIMs), Cormier does not disclose that the UICC comprises a plurality of separate memory partitions . . . much less that at least some of the plurality of separate memory partitions comprise a different applet.” *Id.* at 17–18.

Appellant’s arguments do not persuade us of error. In particular, the Examiner found that Cormier’s USIM1 and USIM2 disclose the claimed carrier applets (*see* Final Act. 4; Ans. 4–5), and we perceive no error in this finding. Appellant does not expressly argue that Cormier’s USIMs fail to teach the claimed carrier applets. Rather, Appellant characterizes the USIMs as “identities” and states that an identity is not the same thing as an applet. *See* Appeal Br. 17–18 (asserting that Cormier stores identities);

Reply Br. 7 (arguing that the Examiner “unreasonably equates carrier applets with identities”). However, Cormier explains that a USIM is an “application” that is “used for subscriber identity verification” to allow access to a cellular provider’s network. Cormier ¶ 3; *see also e.g., id.* ¶¶ 4, 17, 20, 101, 103, Fig. 5 (showing commands sent to and from USIM1 and/or USIM2). Indeed, Cormier’s Figure 5 shows commands sent to and from USIM1 and/or USIM2, which demonstrates that USIM1 and USIM2 must include executable instructions or logic. Cormier, Fig. 5 (*cited by* Final Act. 4). Appellant does not address this teaching of Cormier, and Appellant fails to explain why Cormier’s USIMs do not teach the claimed carrier applets. Accordingly, we are not persuaded by Appellant’s argument that the references fail to teach or suggest this limitation.⁵

Memory Partitions Limitation

Appellant contends the Examiner’s rejection is in error because the references fail to teach or suggest “memory partitions” that store the carrier applets, as required by claim 1. Appeal Br. 16–18. Appellant submits that the term “memory partition” is “well understood in the information technology arts.” *Id.* at 16. Specifically, Appellant states, “Separate memory partitions are understood to be separated either by hardware (e.g., separate integrated circuits or physically separated blocks of memory) or by software, as by operating system restrictions.” *Id.* (citing Spec. ¶ 34). According to Appellant, Brown “does not discuss memory partitions” (*id.*),

⁵ Because we determine that the Examiner correctly found that Cormier teaches the claimed carrier applets, we need not evaluate the Examiner’s finding that this claim limitation is also taught by Brown.

and “Cormier does not disclose that the UICC comprises a plurality of separate memory partitions” (*id.* at 17).

Appellant’s arguments do not persuade us of error. The Examiner pointed to Brown for the claimed “memory partitions,” explaining that Brown describes separate sets of parameters that are stored, in parallel, in different portions of memory. Final Act. 3–4 (citing Brown, Fig. 1, ¶¶ 14, 19, 20, 36). The Examiner further found Brown teaches that the same SIM is used by multiple service providers, which further supports the Examiner’s finding. *Id.* at 23. Appellant does not specifically respond to these findings (*see* Appeal Br. 16–18), and consequently, does not show error in them.

Moreover, even if we were to find that Brown merely teaches simultaneous storage of parameters in the SIM’s memory (*see* Brown ¶ 20, Fig. 1), Appellant fails to explain why it would not have been obvious to segregate Brown’s memory into partitions, each configured to store a different set of parameters. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) (“If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.”). Brown explains that each set of parameters corresponds to a different user identification, and only one set is selected and activated at a time. Brown ¶¶ 13, 14, 19, 20, 30, 32, 33. A person of ordinary skill in the art would be familiar with memory partitioning, would understand that it can be used to separate different sets of information (such as Brown’s identities), and would know how to segregate a memory into partitions. *See* Appeal Br. 16 (acknowledging that a “memory partition” is “well understood in the information technology arts”); *see generally* Spec. (omitting detailed explanation of memory partitions or how they are created or implemented). Appellant does not contend that use

of partitions in this context would be beyond the level of skill of one of ordinary skill in the art, and Appellant does not submit that segregating Brown's memory into partitions would yield undesirable, unpredictable, or unexpected results. Indeed, Appellant's arguments focus only on the *explicit* disclosure of Brown, rather than addressing what is—or is not—*suggested* by this reference. *See* Appeal Br. 16 (“[A]n electronic word search of Brown for ‘memory partition’ produced no results.”). Accordingly, Appellant has not shown that Brown fails to suggest the claimed partitions.

Therefore, based upon the findings above, on this record, we are not persuaded of error in the Examiner's reliance on the cited prior art combination to teach or suggest the disputed limitations of claim 1, nor do we find error in the Examiner's resulting legal conclusion of obviousness. Accordingly, we sustain the Examiner's obviousness rejection of independent claim 1. Claims 2–8 each depend from claim 1, and Appellant does not separately argue the patentability of these claims. Appeal Br. 20. Accordingly, we also sustain the Examiner's obviousness rejection of dependent claims 2–8.

Obviousness Rejection R2 of Claims 9–20

The Examiner rejects claims 9–20 over a combination of Brown, Cormier, Tagg, and Lhamon. Final Act. 7–23. For independent claims 9 and 17, Appellant relies on the arguments made with respect to independent claim 1, and Appellant does not separately argue the patentability of the dependent claims. Appeal Br. 20–22. These arguments are not persuasive for the reasons discussed above. Consequently, we find Appellant's arguments do not show error in the Examiner's factual findings and the

Appeal 2018-009131
Application 15/063,383

conclusion of obviousness of independent claims 9 and 17, or their respective dependent claims (i.e., claims 10–16 and 18–20).

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
1–8	103	Brown, Cormier, Tagg	1–8	
9–20	103	Brown, Cormier, Tagg, Lhamon	9–20	
Overall Outcome			1–20	

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)(iv). *See* 37 C.F.R. § 41.50(f).

AFFIRMED