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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LOUIS HOLDER

Appeal 2019-002340
Application 14/322,229¹
Patent 8,213,594 B2
Technology Center 3900

Before ALLEN R. MacDONALD, RAE LYNN P. GUEST, and
CYNTHIA L. MURPHY, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL²

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from a Final Rejection of claims 1–21, 24, 26, 28–38, 40–44, 46–52, 54, 56–64, 66–70, 72–78, 80, 81, 83–87, 90–95, 97, 99–105, 107, 109, 144–146, 148–152, and 159–164.

¹ Filed July 2, 2014, seeking to reissue U.S. Patent 8,213,594 B2, issued July 3, 2012, based on Application 13/157,504, filed June 10, 2011; which is a continuation of Application 12/692,808, filed January 25, 2010, now abandoned; which is a continuation of Application 12/153,504, filed May 20, 2008, now U.S. Patent 7,680,262 B2, issued September 2, 2008; which is a division of Application 10/774,689, filed February 10, 2004, now U.S. Patent 7,386,111 B2, issued June 10, 2008.

² The real party in interest is Vonage America, Inc. App. Br. 3.

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Appellant has cancelled claims 22, 23, 25, 27, 39, 45, 53, 55, 65, 71, 79, 82, 88, 89, 96, 98, 106, 108, 110–143, 147, and 153–158. App. Br. 77–89.

We have jurisdiction under 35 U.S.C. § 6(b).³

Summary of the Decision

Based on affirmed rejections and newly entered grounds of rejection, claims 1–21, 24, 26, 28–38, 40–44, 46–52, 54, 56–64, 66–70, 72–78, 80, 81, 83–87, 90–95, 97, 99–105, 107, 109, 144–146, 148–152, and 159–164 (*all pending claims*) are not patentable.

Summary – Affirmed & Newly Rejected

The Examiner’s rejection of claims 21, 24, 26, 28–38, 40, 41, 43, 46–52, 54, 56–64, 66, 67, 69, 72–77, 80, 83–87, 90–92, 94, 97, 99–102, 104, 107, 109, 144–146, 148, 149, 151, and 159–164 under 35 U.S.C. § 251 as being an improper recapture is **affirmed**.

The Examiner’s rejection (based on the term “equivalent”) of claims 1–20, 38, 44, 64, 70, 81, 95, 105, 152, and 159–164 under 35 U.S.C. § 112(a) as lacking a proper written description is **affirmed**.

The Examiner’s rejection (based on the term “equivalent”) of claims 1–8, 11–20, 44, 64, 70, 81, 95, 105, 152, and 159–164 under 35 U.S.C. § 112(b) as being indefinite is **affirmed**.

The Examiner’s *Eighth*, *Ninth*, and *Tenth* (8th–10th)⁴ rejections under 35 U.S.C. § 103(a) of claims 21, 24, 26, 28–37, 40–43, 46–50, 74–78, 80, and 83–86 as being unpatentable are **affirmed**.

³ All MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) citations herein are to MPEP 9th Edition, Rev. 08.2017 (Jan. 2018).

⁴ As the fourteen § 103(a) rejections are numbered in sub-section H. of this Decision’s *Rejections* section *infra*.

The Examiner's rejection of claim 9 under 35 U.S.C. § 112(b) as being indefinite is *pro forma* **affirmed**.

We **newly reject** claims 7, 8, 10–21, 24, 26, 28–38, 40–44, 46–52, 54, 56–64, 66–70, 72–78, 80, 81, 83–87, 90–95, 97, 99–105, 107, 109, 144–146, 148–152, and 159–164 under 35 U.S.C. § 251 as being based on a defective reissue declaration.

We **newly reject** reissue claims 51, 52, 54, 56–63, 66–69, 72, and 73 under 35 U.S.C. § 112(a) as failing to comply with the written description requirement.

We **newly reject** claims 9, 38, 51, 52, 54, 56–63, 66–69, 72, and 73 under 35 U.S.C. § 112(b) as being indefinite.

Summary – Reversed

The Examiner's rejection of claims 1–20, 51, 52, 54, 56–64, 66–70, 72–78, 80, 81, 83–86 and 159–164 under 35 U.S.C. § 251 as being based on new matter is **reversed**.

The Examiner's rejection (based on the phrase “at least one”) of claims 10–20, 51, 52, 54, 56–64, 66–70, 72–78, 80, 81 and 83–86 under 35 U.S.C. § 112(a) as lacking a written description is **reversed**.

The Examiner's rejection (based on the “Intermediate Point Phrases”) of claims 1–21, 24, 26, 28–38, 40–44, 46–52, 54, 56–64, 66–70, 72–78, 80, 81, 83–87, 90–95, 97, 99–105, 107, 109, 144–146, 148–152, and 159–164 (*all pending claims*) under 35 U.S.C. § 112(b) as being indefinite is **reversed**.

The Examiner's rejection of claims 62 and 64 under 35 U.S.C. § 112(d) as being of improper dependent form is **reversed**.

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The Examiner's rejection of claims 1–21, 24, 26, 28–38, 40–44, 46–52, 54, 56–64, 66–70, 72–78, 80, 81, 83–87, 90–95, 97, 99–105, 107, 109, 144–146, 148–152, and 159–164 (*all pending claims*) under 35 U.S.C. § 101, as being directed to patent-ineligible subject matter is **reversed**.

The Examiner's rejection of claims 87, 91, 92, 94, 97, 100–102, 104, 107, 144–146, 148, 149, and 151 under 35 U.S.C. § 102(b) as being anticipated is **reversed**.

The Examiner's *Eighth* rejection under 35 U.S.C. § 103(a) of claims 90, 99, and 109 as being unpatentable is **reversed**.

The Examiner's *First* through *Seventh* (1st–7th) and *Eleventh* through *Fourteenth* (11th–14th) rejections under 35 U.S.C. § 103(a) of claims 1–20, 21, 24, 26, 28–37, 40–43, 46–52, 54, 56–63, 66–69, 72–78, 80, 83–86, 90, 93, 97, 99–104, 107, 109, 150, and 159–164 as being unpatentable are **reversed**.

Appellant's Invention

This invention relates to “to a method and apparatus for minimizing the cost of making a long distance phone call.” Spec. col. 1, ll. 19–21.

[In one Embodiment a] method comprises receiving a virtual number from at least one point on an originating network at a first intermediate point on a computer network. Then, based on the virtual number, a second intermediate point on the computer network is determined. The first and second intermediate points are preferably capable of communicating over the computer network.

Spec. col. 2, ll. 28–34.

Illustrative Claims

Illustrative claims 1, 9, 21, 41, 42, and 44 under appeal read as follows (emphasis and bracketed material added; reissue underlining omitted):

1. [Patent claim – not amended] A method of establishing a communications link, comprising:

[A.] receiving a virtual telephone number at a first intermediate point from an originating point, the first intermediate point being operatively connected to a data network; and

[B.] transmitting a call setup request over the data network that includes a second intermediate point, ***wherein the call setup request includes the virtual telephone number or its equivalent***, and wherein information in the call setup request allows the second intermediate point to establish a communications link to a destination point that corresponds to the virtual telephone number.

9. [Patent claim – not amended] A system for establishing a communications link, comprising:

[A.] means for receiving a virtual telephone number at a first intermediate point from an originating point, the first intermediate point being operatively connected to a data network; and

[B.] means for transmitting a call setup request over the data network from the first intermediate point to a second intermediate point, ***wherein the call setup request includes the virtual telephone number or its equivalent***, and wherein information in the call setup request allows the second intermediate point to establish a communications link to a destination point that corresponds to the virtual telephone number.

21. [Reissue claim] A system for facilitating at least a portion of a communication link between an originating point and a destination point, comprising:

[A.] a first intermediate point configured to receive a virtual number from the originating point, wherein the virtual number corresponds to a physical number of the destination point; and

[B.] a first routing table that comprises a part of the first intermediate point and that correlates virtual numbers to second intermediate points capable of communicating with the destination points that correspond to those virtual numbers,

[C.] wherein the first intermediate point is configured to use the virtual number and information in the first routing table to identify a second intermediate point corresponding to the destination point.

41.^[5] [Reissue claim] The system as claimed in claim 40, wherein the first intermediate point facilitates the telephony communication, at least in part, by sending a communication setup request over a data network to the second intermediate point.

42. [Reissue claim] The system as claimed in claim 41, wherein the communication setup request comprises the virtual telephone number.

44. [Reissue claim] The system as claimed in claim 41, wherein the communication setup request comprises an equivalent to the virtual telephone number.

⁵ Claim 41 depends from claim 40, which depends from claim 33, which depends from claim 21.

*References*⁶

Dulman	US 5,915,008	June 22, 1999
Thornton et al.	US 6,363,065 B1	Mar. 26, 2002
Dolan et al.	US 6,477,246 B1	Nov. 5, 2002
Schuster et al.	US 6,681,252 B1	Jan. 20, 2004
Sugla	US 2001/0036258 A1	Nov. 1, 2001
DiCamillo et al.	US 2002/0061100 A1	May 23, 2002
Dolan et al. ⁷	US 2003/0142807 A1	July 31, 2003
Bedingfield et al.	US 2004/0110465 A1	June 10, 2004

Rejections

A. § 251 – New Matter

The Examiner entered a rejection under 35 U.S.C. § 251 based on new matter. The Examiner reasoned:

Claims 1-20, 51, 52, 54, 56-64, 66-70, 72-78, 80, 81, 83-86 and 159-164 are rejected under 35 U.S.C. [§] 251 as being ***based upon new matter*** added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

See rejections of claims 1-20, 51, 52, 54, 56-64, 66-70, 72-78, 80, 81, 83-86 and 159-164 in §[IX].A below. [(Final Act. 53-56.)]

Final Act. 32 (emphasis added).

We select claims 1 and 74 as representative. Separate patentability is not argued for remaining claims 2–20, 51, 52, 54, 56–64, 66–70, 72, 73,

⁶ All citations herein to this reference are by reference to the first named inventor only.

⁷ The Examiner's rejections which rely on Dolan '807 uniformly cite to columns in the earlier dated Dolan '246. As Dolan '807 is a continuation of Dolan '246 and their specifications are identical, we deem this cross-citation to be harmless error.

75–78, 80, 81, 83–86, and 159–164. App. Br. 26. Except for our ultimate decision, we do not discuss this § 251 rejection of these remaining claims further herein.

B. § 251 – Recapture

The Examiner also rejected claims 21, 24, 26, 28–38, 40, 41, 43, 46–52, 54, 56–64, 66, 67, 69, 72–77, 80, 83–87, 90–92, 94, 97, 99–102, 104, 107, 109, 144–146, 148, 149, 151, and 159–164 under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based (Final Act. 32–45) because in these claims “the surrendered subject matter has been entirely eliminated” (Final Act. 44).

We select claim 21 as representative. Separate patentability is not argued for remaining claims 24, 26, 28–38, 40, 41, 43, 46–52, 54, 56–64, 66, 67, 69, 72–77, 80, 83–87, 90–92, 94, 97, 99–102, 104, 107, 109, 144–146, 148, 149, 151, and 159–164. App. Br. 26–30. Except for our ultimate decision, we do not discuss this § 251 rejection of these remaining claims further herein.

C. § 112(a)⁸

The Examiner rejected claims⁹ 1–20, 38, 44, 51, 52, 54, 56–64, 66–70, 72–78, 80, 81, 83–86, 95, 105, 152, and 159–164 under 35 U.S.C. § 112(a)

⁸ For simplicity, we label rejections under 35 U.S.C. §§ 112, 1st paragraph, 2nd paragraph, and 4th paragraph, respectively as rejections under § 112(a), § 112(b), and § 112(d).

⁹ Although not listed in the heading at page 53 of the Final Office Action, claims 38, 44, 95, 105, 152 are rejected at page 55 of the Final Office Action.

as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor or a joint inventor . . . , at the time the application was filed, had possession of the claimed invention.

Final Act. 53–56.

First, the Examiner determined that the recitation of “‘wherein the call setup request includes the virtual number or its equivalents’ [sic] in claims 1, 9 and 10 (emphasis added) [and their dependent claims] is insufficiently described in the original specification.” Final Act. 54. “Claims 2-8, 11-20 and 160-164 are similarly rejected based on their dependency from independent claims 1, 9, 10 and 159.” Final Act. 55. We select claim 1 as representative. This rejection overlooks similar “equivalent” limitations in claim 51 (and thus claim 51’s dependent claims 52, 54, 56–63, 66–69, 72, and 73). We include these overlooked claims in our analysis *supra*.

Second, the Examiner determined that the same analysis is applicable to “dependent claims 38, 44, 64, 70, 81, 95, 105, 152 and 163, [which] recite the limitation ‘wherein the communication information/setup request comprises/includes an equivalent to the virtual number.’ (emphasis added).” Final Act. 55. Thus, the rejection of these claims turns on our decision as to claim 1.

Third, as to claims 10, 51, and 74 (and their dependent claims), the Examiner determined there was lack of possession because “the recitation to ‘a first intermediate point comprising at least one processor that receives/is configured to receive . . .’ (emphasis added) is new matter.”¹⁰ Final Act. 56. “Claims 11-20, 52, 54, 56-64, 66-70, 72-78, 80, 81 and 83-86 are similarly rejected based on their dependency from independent claims 10, 51 and 74.” *Id.* We select claim 74 as representative.

We have selected claims 1 and 74 as representative. Separate patentability is not argued for remaining claims 2–20, 38, 44, 51, 52, 54, 56–64, 66–70, 72, 73, 75–78, 80, 81, 83–86, 95, 105, 152, and 159–164. App. Br. 45–47. Except for our ultimate decision, we do not discuss the § 112(a) rejection of these remaining claims further herein.

D. § 112(b)

The Examiner rejected claims 1–21, 24, 26, 28–38, 40–44, 46–52, 54, 56–64, 66–70, 72–78, 80, 81, 83–87, 90–95, 97, 99–105, 107, 109, 144–146, 148–152, and 159–164 (*all pending claims*) under 35 U.S.C. § 112(b) “as being indefinite.” Final Act. 57–60. An alternative § 112(b) rejection of claim 145 (Final Act. 60–61) has been withdrawn. Ans. 9.

First, as to claims 1–8, 11–20, 44, 64, 70, 81, 95, 105, 152, and 159–164, the Examiner determined that as to the recitation of “the limitation ‘the virtual number and its equivalent’. (’594 patent claims 1, 9, 10 and [reissue claim] 159; emphasis added)” (Final Act. 57), “it is unclear and indefinite to what exactly an ‘equivalent’ to a ‘virtual number’ is.” Final

¹⁰ The phrase “comprising at least one processor” was added to patent claim 10 by amendment during reissue prosecution. Amdt. 5 (dated Sept. 28, 2016).

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Act. 58. Dependent claims 2–8, 11–20, 44, 64, 70, 81, 95, 105, 152, and 160–164, are “similarly rejected.” Final Act. 58. We select claim 1 as representative. Separate patentability is not argued for the remaining claims 2–8, 11–20, 44, 64, 70, 81, 95, 105, 152, and 160–164. App. Br. 47. Except for our ultimate decision, we do not discuss this § 112(b) rejection of the remaining claims further herein. This rejection overlooks similar “equivalent” limitations in claims 9, 38, and 51 (and thus claim 51’s dependent claims 52, 54, 56–63, 66–69, 72, and 73). We include these overlooked claims in our analysis *supra*.

Second, as to claim 9 written in means-plus-function format, the Examiner determined that both the claimed “means for receiving” and “means for transmitting” are construed as the same server or router structure (*see* Final Act. 12–18). The Examiner further determined

it is unclear and indefinite to how there can be two different router structures at the first intermediate point, with each designated as being solely a receiver and/or transmitter when the [’]594 patent only sufficiently discloses a single router at the first intermediate point receiving data from the originating point and transmitting data over the data network to a second intermediate point.

Final Act. 59. Appellant does not present appeal arguments directed to this rejection. Therefore, we sustain this rejection *pro forma*.

Third, as to all pending claims, the Examiner determined the Intermediate Point Phrases (i.e., “first intermediate point,” “second intermediate point,” and “intermediate points”) are indefinite because—to one of ordinary skill in this art—the metes and bounds of these phrases cannot be reasonably determined. Final Act. 59. We select claim 1 as representative. Separate patentability is not argued for the remaining

pending claims. App. Br. 47. Except for our ultimate decision, we do not discuss this § 112(b) rejection of the remaining claims further herein.

E. § 112(d)

The Examiner rejected claims 62 and 64 under 35 U.S.C. § 112(d) “as being of improper dependent form for failing to further limit the subject matter of the claim upon which it depends.” Final Act. 62.

We select claim 62 as representative. Appellant does not separately argue claims 62 and 64. *See* 37 C.F.R. § 41.37(c)(1)(iv) (“Under each heading identifying the ground of rejection being contested, any claim(s) argued separately or as a subgroup shall be argued under a separate subheading that identifies the claim(s) by number.”). Except for our ultimate decision, we do not discuss the § 112(d) rejection of claim 64 further herein.

F. § 101

The Examiner rejected claims 1–21, 24, 26, 28–38, 40–44, 46–52, 54, 56–64, 66–70, 72–78, 80, 81, 83–87, 90–95, 97, 99–105, 107, 109, 144–146, 148–152, and 159–164 (*all pending claims*) under 35 U.S.C. § 101 because the claimed invention is “directed to a judicial exception . . . without significantly more.” Final Act. 45–53.

Our decision as to claim 1 is determinative as to all the claims rejected under § 101. Therefore, even though claims 1, 9, 21, 51, 74, 87, 97, and 144, are argued separately (App. Br. 32–45), we select claim 1 as representative. Except for our ultimate decision, we do not discuss the § 101 rejection of the remaining claims further herein.

G. § 102(b)

The Examiner rejected claims 87, 91, 92, 94, 97, 100–102, 104, 107, 144–146, 148, 149, and 151 under pre-AIA 35 U.S.C. § 102(b) as being anticipated by DiCamillo. Final Act. 71–83.

Our decision as to claim 87 is determinative as to the § 102(b) rejection on appeal. Therefore, we select claim 87 as representative. Except for our ultimate decision, we do not discuss the § 102(b) rejection of claims 91, 92, 94, 97, 100–102, 104, 107, 144–146, 148, 149, and 151 further herein.

H. § 103(a)

1. *First § 103(a) Rejection*

The Examiner rejected claims 1–16, 93, 103, 150, 159–161, 163, and 164 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over the combination of DiCamillo and Dolan '807. Final Act. 84–105.

Our decision as to claim 1 is determinative as to the *First* § 103(a) rejection on appeal. Therefore, we select claim 1 as representative. Except for our ultimate decision, we do not discuss the *First* § 103(a) rejection of claims 2–16, 93, 103, 150, 159–161, 163, and 164 further herein.

2. *Second § 103(a) Rejection*

The Examiner rejected claims 17–20 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over the combination of DiCamillo, Dolan '807, and Schuster. Final Act. 105–109.

Our decision as to claim 1 in the *First* § 103(a) rejection on appeal is determinative as to the *Second* § 103(a) rejection on appeal. Therefore, except for our ultimate decision, we do not discuss the *Second* § 103(a) rejection of claims 17–20 further herein.

3. *Third § 103(a) Rejection*

The Examiner rejected claims 21, 24, 26, 28–30, 32–35, 37, 40, 41, 43, 46–50, 74–77, 80, 83–86, 90, 99, and 109 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over the combination of DiCamillo and Sugla. Final Act. 109–129.

Our decision as to claim 21 is determinative as to the *Third § 103(a)* rejection on appeal. Therefore, we select claim 21 as representative. Except for our ultimate decision, we do not discuss the *Third § 103(a)* rejection of claims 24, 26, 28–30, 32–35, 37, 40, 41, 43, 46–50, 74–77, 80, 83–86, 90, 99, and 109 further herein.

4. *Fourth § 103(a) Rejection*

The Examiner rejected claim 31 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over the combination of DiCamillo, Sugla, and Bedingfield. Final Act. 129–130.

Our decision as to claim 21 in the *Third § 103(a)* rejection on appeal is determinative as to the *Fourth § 103(a)* rejection on appeal. Therefore, except for our ultimate decision, we do not discuss the *Fourth § 103(a)* rejection of claim 31 further herein.

5. *Fifth § 103(a) Rejection*

The Examiner rejected claims 36, 42, and 78 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over the combination of DiCamillo, Sugla, and Dolan '807. Final Act. 130–131.

Our decision as to claim 21 in the *Third § 103(a)* rejection on appeal is determinative as to the *Fifth § 103(a)* rejection on appeal. Therefore, except for our ultimate decision, we do not discuss the *Fifth § 103(a)* rejection of claims 36, 42, and 78 further herein.

6. Sixth § 103(a) Rejection

The Examiner rejected claims 51, 52, 54, 56–58, 60–63, 66–69, 72, 73, and 162 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over the combination of DiCamillo, Dolan '807, and Sugla. Final Act. 132–148.

Our decision as to claim 51 is determinative as to the *Sixth* § 103(a) rejection on appeal. Therefore, we select claim 51 as representative. Except for our ultimate decision, we do not discuss the *Sixth* § 103(a) rejection of claims 52, 54, 56–58, 60–63, 66–69, 72, 73, and 162 further herein.

7. Seventh § 103(a) Rejection

The Examiner rejected claim 59 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over the combination of DiCamillo, Dolan '807, Sugla, and Bedingfield. Final Act. 148–150.

Our decision as to claim 51 in the *Sixth* § 103(a) rejection on appeal is determinative as to the *Seventh* § 103(a) rejection on appeal. Therefore, except for our ultimate decision, we do not discuss the *Seventh* § 103(a) rejection of claim 59 further herein.

8. Eighth § 103(a) Rejection

The Examiner rejected claims 21, 24, 26, 28–30, 32–35, 37, 40, 41, 43, 46–50, 74–77, 80, 83–86, 90, 99, and 109 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over the combination of DiCamillo and Thornton. Final Act. 150–170.

As to the *Eighth* § 103(a) rejection of claims 21, 24, 26, 28–30, 32–35, 37, 40, 41, 43, 46–50, 74–77, 80, and 83–86, we select claim 21 as representative. Appellant does not argue separate patentability for claims 24, 26, 28–30, 32–35, 37, 40, 41, 43, 46–50, 74–77, 80, and 83–86. To the extent that Appellant discusses claim 74 (App. Br. 66–67), Appellant merely

repeats for claim 74 arguments directed to claim 21. Such a repeated argument is not an argument for “separate patentability.” Except for our ultimate decision, we do not discuss the *Eighth* § 103(a) rejection of claims 24, 26, 28–30, 32–35, 37, 40, 41, 43, 46–50, 74–77, 80, and 83–86, further herein.

As to the *Eighth* § 103(a) rejection of claims 90, 99, and 109, our decision as to claim 87 in the § 102(b) rejection on appeal is determinative. Therefore, except for our ultimate decision, we do not discuss the *Eighth* § 103(a) rejection of claim claims 90, 99, and 109 further herein.

9. *Ninth* § 103(a) Rejection

The Examiner rejected claim 31 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over the combination of DiCamillo, Thornton, and Bedingfield. Final Act. 170–171.

Appellant argues claim 31 by reference to the arguments directed to the *Eighth* § 103(a) rejection of claim 21. Appellant does not present separate arguments for claim 31. Thus, the rejection of this claim turn on our decision as to claim 21. Except for our ultimate decision, we do not address the *Ninth* § 103(a) rejection of claim 31 further herein.

10. *Tenth* § 103(a) Rejection

The Examiner rejected claims 36, 42, and 78 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over the combination of DiCamillo, Thornton, and Dolan ’807. Final Act. 171–172.

Appellant argues claims 36, 42, and 78 by reference to the arguments directed to the *Eighth* § 103(a) rejection of claim 21. Appellant does not present separate arguments for claims 36, 42, and 78. Thus, the rejection of these claims turn on our decision as to claim 21. Except for our ultimate

decision, we do not address the *Tenth* § 103(a) rejection of claims 36, 42, and 78 further herein.

11. *Eleventh § 103(a) Rejection*

The Examiner rejected claims 51, 52, 54, 56–58, 60–63, 66–69, 72, 73, and 162 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over the combination of DiCamillo, Dolan '807, and Thornton. Final Act. 172–189.

Our decision as to claim 51 is determinative as to the *Eleventh* § 103(a) rejection on appeal. Therefore, we select claim 51 as representative. Except for our ultimate decision, we do not discuss the *Eleventh* § 103(a) rejection of claims 52, 54, 56–58, 60–63, 66–69, 72, 73, and 162 further herein.

12. *Twelfth § 103(a) Rejection*

The Examiner rejected claim 59 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over the combination of DiCamillo, Dolan '807, Thornton, and Bedingfield. Final Act. 190–191.

Our decision as to claim 51 in the *Eleventh* § 103(a) rejection on appeal is determinative as to the *Twelfth* § 103(a) rejection on appeal. Therefore, except for our ultimate decision, we do not discuss the *Twelfth* § 103(a) rejection of claim 59 further herein.

13. *Thirteenth § 103(a) Rejection*

The Examiner rejected claims 97, 99–102, 104, 107, and 109 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over the combination of Thornton and DiCamillo. Final Act. 191–204.

Our decision as to claim 97 is determinative as to the *Thirteenth* § 103(a) rejection on appeal. Therefore, we select claim 97 as

representative. Except for our ultimate decision, we do not discuss the *Thirteenth* § 103(a) rejection of claims 99–102, 104, 107, and 109 further herein.

14. *Fourteenth § 103(a) Rejection*

The Examiner rejected claim 103 under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over the combination of Thornton, DiCamillo, and Dolan '807. Final Act. 205–206.

Our decision as to claim 97 in the *Thirteenth* § 103(a) rejection on appeal is determinative as to the *Fourteenth* § 103(a) rejection on appeal. Therefore, except for our ultimate decision, we do not discuss the *Fourteenth* § 103(a) rejection of claim 103 further herein.

Issues on Appeal

A.

Did the Examiner err in rejecting claims 1 and 74 under 35 U.S.C. § 251 by determining the claims are “based upon new matter added to the patent” (Final Act. 32)?

B.

Did the Examiner err in rejecting claim 21 under 35 U.S.C. § 251 by determining the claim is an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based (Final Act. 43–45)?

C.
C.1.

Did the Examiner err in rejecting claim 1 under 35 U.S.C. § 112(a) “as failing to comply with the written description requirement” (Final Act. 53–56) because there is “insufficient original disclosure to what the equivalent of a virtual number is” (Final Act. 55)?

C.2.

Did the Examiner err in rejecting claim 74 under 35 U.S.C. § 112(a) “as failing to comply with the written description requirement” (Final Act. 53–56) because “there is insufficient indication in the specification that Applicant had possession of a system for facilitating a communication link that includes a first intermediate point comprising *at least* one processor (*i.e.*, more than one)” (Final Act. 55 (emphasis added))?

D.
D.1.

Did the Examiner err in rejecting claim 1 under 35 U.S.C. § 112(b) as being indefinite because the phrase “[or] its equivalent” is unclear (Final Act. 57–58)?

D.2.

Did the Examiner err in rejecting claim 1 under 35 U.S.C. § 112(b) as being indefinite because the “Intermediate Point Phrases” are unclear (Final Act. 59–60)?

E.

Did the Examiner err in rejecting claim 62 under 35 U.S.C. § 112(d) “as being of improper dependent form” because it fails to further limit the subject matter of the claim upon which it depends (Final Act. 62)?

F.

Did the Examiner err in rejecting claim 1 under 35 U.S.C. § 101 “directed to a judicial exception . . . without significantly more.” (Final Act. 45–53)?

G.

Did the Examiner err in rejecting claim 87 under 35 U.S.C. § 102(b) by determining DiCamillo discloses information associating the virtual number with a second intermediate point ***based on a proximity*** of the second intermediate point to the destination point (Final Act. 72)?

H.

H.1.

Did the Examiner err in rejecting claim 1 in the *First* rejection under 35 U.S.C. § 103(a) by determining Dolan discloses information in a ***setup request provided to a second intermediate point including a virtual number*** or its equivalent (Final Act. 85–86)?

H.2.

Did the Examiner err in rejecting claim 21 in the *Third* rejection under 35 U.S.C. § 103(a) by determining Sugla discloses a first ***routing table that comprises a part of the first intermediate point*** (Final Act. 111)?

H.3.

Did the Examiner err in rejecting claim 51 in the *Sixth* rejection under 35 U.S.C. § 103(a) by determining Dolan discloses a ***setup request provided to a first intermediate point (from a second intermediate point) including a virtual number*** or its equivalent (Final Act. 134)?

H.4.

Did the Examiner err in rejecting claim 21 in the *Eighth* rejection under 35 U.S.C. § 103(a) by determining Thornton discloses a first ***routing table that comprises a part of the first intermediate point*** (Final Act. 152)?

H.5.

Did the Examiner err in rejecting claim 51 in the *Eleventh* rejection under 35 U.S.C. § 103(a) by determining Dolan discloses a ***setup request provided to a first intermediate point (from a second intermediate point) including a virtual number*** or its equivalent (Final Act. 175)?

H.6.

Did the Examiner err in rejecting claim 97 in the *Thirteenth* rejection under 35 U.S.C. § 103(a) by determining alternatively (a) Thornton inherently discloses information associating the virtual number with a second intermediate point ***based on a proximity*** of the second intermediate point to the destination point (Final Act. 193–194), and (b) DiCamillo discloses information associating the virtual number with a second intermediate point ***based on a proximity*** of the second intermediate point to the destination point (Final Act. 194)?

ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellant’s Appeal Brief and Reply Brief arguments that the Examiner has erred.

A. *Section 251 – New Matter*

A.1. *The Examiner’s Rejection*

The Examiner rejected claims 1 and 74 under 35 U.S.C. § 251 “as being ***based upon new matter added to the patent*** for which reissue is

sought.” Final Act. 32 (emphasis added). Section 251(a) states “[n]o new matter shall be introduced into the application for reissue.” As the sole support for this rejection the Examiner references the rejections under 35 U.S.C. § 112(a) of claims 1 and 74 stating “[s]ee rejections of claims . . . [1 and 74] in § [I]X.A below.”] *Id.*

In § IX.A. of the Final Office Action, the Examiner rejected claims 1 and 74 under 35 U.S.C. § 112(a)

as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor or a joint inventor . . . , at the time the application was filed, had possession of the claimed invention.

Final Act. 53–54. First, as to the virtual number, the Examiner finds the recitation of “or its equivalent” in claim 1 is insufficiently described in the original Specification. Final Act. 54. Second, the Examiner finds the recitation of “comprising at least one processor” in claim 74 is new matter. Final Act. 56.

A.2. Appellant’s Contention

Appellant references (App. Br. 26) his § 112(a) arguments (App. Br. 47) in contending that the Examiner erred in rejecting claims 1 and 74 under 35 U.S.C. § 251.

A.3. This Panel’s Determination

Our review determines that there is insufficient supporting analysis for the Examiner’s § 251 rejection based on new matter under § 112(a). First, the § 112(a) rejection of claim 1 is not premised on new matter. Therefore, regardless of our determination as to the § 112(a) written

description rejection of claim 1, the Examiner's claim 1, § 112(a) analysis provides no support for the corresponding § 251 new matter rejection.

Second, the Examiner rejected claim 74 "as failing to comply with the written description requirement" (i.e., lacking possession) because of the presence of new matter in the form of the claim limitation "comprising at least one processor." However, as discussed *infra*, as to the § 112(a) rejection of claim 74, we disagree with the Examiner's reasoning as to new matter.

Therefore, we reverse the Examiner's § 251 new matter rejections of claims 1 and 74.

B. *Section 251 – Recapture*

B.1. *Recapture Principles*

B.1.a. *The Statute*

The reissue statute expressly permits a patentee to correct an "error," thus permitting patentee to obtain reissue claims broader than the originally issued patent claims at any time within two (2) years from the date the original patent issues. More particularly, 35 U.S.C. § 251(a), (d), provide in pertinent part:

Whenever any patent is, through error, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. . . .

....

. . . . No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

B.1.b. *Recapture is not an error within the meaning of 35 U.S.C. § 251*

What has become known as the “recapture rule,” prevents a patentee from regaining through a reissue patent subject matter that the patentee surrendered in an effort to obtain allowance of claims in the patent sought to be reissued. *In re Clement*, 131 F.3d 1464, 1468 (Fed. Cir. 1997).

If a patentee attempts to “recapture” what the patentee previously surrendered in order to obtain allowance of original patent claims, that “‘deliberate withdrawal or amendment . . . cannot be said to involve the inadvertence or mistake contemplated by 35 U.S.C. § 251, and is not an error of the kind which will justify the granting of a reissue patent which includes the [subject] matter withdrawn.’” *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 995 (Fed. Cir. 1993) (quoting from *Haliczer v. U.S.*, 356 F.2d 541, 545 (Ct. Cl. 1966)).¹¹ *See also Hester Indus., Inc. v. Stein, Inc.*, 142 F.3d 1472, 1480 (Fed. Cir. 1998).

B.1.c. *The Recapture Rule*

Application of the recapture rule is a three step process. The **first step** is to “determine whether and in what ‘aspect’ the reissue claims are broader than the patent claims.” “[A] reissue claim that deletes a limitation or element from the patent claims is broader” with respect to the modified limitation. **Next**, the court must “determine whether the broader aspects of the reissue claims relate to surrendered subject matter.” “To determine

¹¹ *Haliczer* is binding precedent. *See South Corp. v. U.S.*, 690 F.2d 1368 (Fed. Cir. 1982) (en banc) (decisions of the former U.S. Court of Customs and Patent Appeals and former U.S. Court of Claims decisions are binding precedent).

whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.” . . .

. . . . In . . . [the] *final step*, the court must “determine whether the surrendered subject matter has crept into the reissue claim.” In discussing this third step, it is important to distinguish among the original claims (i.e., the claims before the surrender), the patented claims (i.e., the claims allowed after surrender), and the reissue claims. Violation of the rule against recapture may be avoided under this final step of the analysis if the reissue claims “materially narrow” the claims relative to the original claims such that full or substantial recapture of the subject matter surrendered during prosecution is avoided.

To avoid violation of the rule against recapture in this way, the narrowing must relate to the subject matter surrendered during the original prosecution (i.e., the applicant cannot recapture the full scope of what was surrendered).

In re Mostafazadeh, 643 F.3d 1353, 1358–59 (Fed. Cir. 2011) (citations omitted) (emphasis added).

B.1.d. *Objective Observer*

It is clear that in determining whether “surrender” of subject matter has occurred, the proper inquiry is whether *an objective observer viewing the prosecution history* would conclude that the purpose of the patentee’s amendment or argument was to overcome prior art and secure the patent. . . . Thus, if the objective public observer can discern a surrender of subject matter during the prosecution of an original patent in order to overcome prior art and obtain the patent, then the recapture rule should prevent the reissuing of that patent to claim the surrendered subject matter.

Kim v. ConAgra Foods, Inc., 465 F.3d 1312, 1323 (Fed. Cir. 2006) (citations and footnote omitted) (emphasis added).

B.2. *The Examiner's Rejection*

The Examiner rejected claim 21 because the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. § 251.

A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claimed subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. [§] 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Final Act. 32–33. The Examiner particularly points out:

Claim 21 is broadened at least by deleting/omitting the patent claim language requiring:

...
a first intermediate point . . . that **transmits a call setup request to a second intermediate point, wherein the call setup request includes the virtual telephone number or its equivalent.**

Final Act. 34–35. The Examiner further particularly points out:

Applicant filed a response on 26 April 2012 (“April 2012 App Response”) arguing that the prior art of record did not teach “a method which includes a first intermediate point sending a call setup request to a second intermediate point, where *the call setup request includes the virtual telephone number* dialed by a calling party.” (See April 2012 App Response at 8-9). . . .

. . . . [T]he Examiner concludes that the claimed . . . [limitation] is *surrendered subject matter* and some of the broadening of the reissue claims, as noted above, is clearly in the area of the surrendered subject matter (*i.e.*, Claim 21 First Intermediate Point Omission[]).

Final Act. 44 (emphasis added). The Examiner lastly points out:

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With respect to . . . Claim 21 . . . , it is noted that the surrendered subject matter has been entirely eliminated from the . . . [claim]. If surrendered subject matter has been entirely eliminated from a claim present in the reissue application, then a recapture rejection under 35[U.S.C. §]251 is proper and must be made for that claim. . . .

Thus, the Examiner concludes that improper recapture of broadened claimed subject matter surrendered in the application is clearly present.

Final Act. 44–45 (emphasis added).

B.3. *Appellant's Contention*

Appellant first points to case law relating to surrender during an extended patent family's prosecution.¹²

When a patent is under reissue, and the patent issued from an application that is one of multiple applications in a chain of continuation applications, it is necessary to consider the actions that occurred during all of the applications in that chain when applying the recapture rule. In other words, the “original application” being considered for purposes of the recapture rule includes the patent family's entire prosecution history. *MBO Laboratories, Inc. v. Becton, Dickinson & Co.*, 602 F.3d 1306, 94 USPQ2d 1598 (Fed. Cir. 2010).

In *MBO*, the Federal Circuit found the recapture rule contemplates “surrenders made while prosecuting the original application or any precedent divisional, continuation, or continuation-in-part applications.” 602 F.3d at 1316.

App. Br. 28 (emphases omitted).

Appellant then acknowledges he “has not located a decision that directly applies this [related case] analysis to find the *non-applicability* of the recapture rule.” *Id.* However, Appellant argues “logic and fairness

¹² “The . . . [13/157,504] Application that led to the patent under reissue was the fourth application in a chain of applications that ultimately led to the issuance of three patents.” App. Br. 28. *See n.1 supra.*

dictate” that such should be the case. *Id.* Appellant then postulates (*id.* at 29–30):

Because MBO Laboratories teaches us that the “original application” being considered for purposes of the recapture rule includes all precedent applications in the patent family’s prosecution history, the situation is basically analogous to one in which all the claims of the three patents in this family were obtained in a single application. If that had occurred, it would be clear that Appellant did not need to add the . . . [call setup request includes the virtual telephone number] to all claims in the application to obtain allowance of the application. Under those circumstances, the recapture rule would not prevent Appellant from obtaining claims in a reissue application that lack the . . . [call setup request includes the virtual telephone number].

In view of all of the foregoing, and in particular, in light of the fact that Appellant did not surrender the subject matter of the . . . [call setup request includes the virtual telephone number] by adding those features to all claims of the “original application,” Appellant respectfully submits that the recapture rule should not apply to prevent Appellant from obtaining claims in this reissue application which lack the . . . [call setup request includes the virtual telephone number].

B.4. Panel’s Recapture Determination

B.4.a. Adoption of Examiner’s Recapture Analysis

First, the Examiner determines whether and in what “aspect” the reissue claims are broader than the patent claims. The Examiner determines that claim 21 is broadened by deleting/omitting the patent claim language requiring a first intermediate point that transmits a call setup request to a second intermediate point, wherein ***the call setup request includes the virtual telephone number*** or its equivalent. *See* Final Act. 34–35. We agree and Appellant does not dispute that this limitation is not present in reissue claim 21.

Second, the Examiner determines whether the broader aspects of the reissue claims relate to surrendered subject matter. The Examiner determines Appellant’s argument “that the prior art of record did not teach ‘a method which includes a first intermediate point sending a call setup request to a second intermediate point, where *the call setup request includes the virtual telephone number* dialed by a calling party’” was a surrender of the argued subject matter, and that the broader aspects of claim 21 relate to this surrendered subject matter. *See* Final Act. 44 (emphasis added). We agree.

Third, the Examiner determines whether the surrendered subject matter has crept into the reissue claim (i.e., whether Appellant is recapturing the full scope of what was surrendered). The Examiner determines that the surrendered subject matter has been entirely eliminated from claim 21. *See* Final Act. 44–45. We agree.

The Examiner concludes that improper recapture of broadened claimed subject matter surrendered in the application is clearly present. *See* Final Act. 45. We agree.

We adopt the Examiner’s three-step recapture analysis as our own.

B.4.b. Disagreement with Appellant’s Recapture Argument

We disagree with Appellant’s recapture argument. Essentially, Appellant is arguing that an objective observer cannot rely on a later surrender if broader claims issued in an earlier related patent. Stated differently, Appellant is effectively arguing that this later surrender is the error to be corrected by the Reissue Application. *See* Appellant’s Reissue Declaration at page 4 (Additional Sheet). We have reviewed the case law and we find no case holding that broader claims issued in a related earlier

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issued patent can serve to negate a later surrender in a subsequent patent prosecution. Rather, in *MBO* the court stated:

In holding that MBO violated the rule against recapture, we seek to clarify that a patentee may violate the rule against recapture by claiming subject matter in a reissue patent that the patentee surrendered while prosecuting a related patent application.

MBO Labs., 602 F.3d at 1316.

Appellant's theory also overlooks that the order of the events in the related prosecutions is significant. Each surrender is separate and distinct as the prosecution record develops over time. The later surrender in the subsequent patent application prosecution is to overcome a later claim rejection in place at the time of the surrender. The earlier broader issued claim is not before the Office at the same time as, and was not rejected under the same rejection that prompted, the later surrender. Although in the same prosecution history and, thus, related, these events are in separate prosecutions and, here, the later surrender is a distinct event in response to a specific rejection at the time of the surrender.

When multiple patents derive from the same initial application, the prosecution history regarding a claim limitation in any patent that has issued applies with equal force ***to subsequently issued patents*** that contain the same claim limitation.

Elkay Mfg. Co. v. Ebco Mfg. Co., 192 F.3d 973, 980 (Fed. Cir. 1999) (emphasis added). For example, a later issued broader claim may serve to ameliorate (or even negate) an earlier surrender in the same continuous prosecution history because it is understood that the same prior art and/or reasoning that prompted the surrender has been considered in subsequent prosecution. However, we see no basis for Appellant's theory that this

principle also works in the opposite direction, so that an earlier broader claim would always negate a later surrender in a subsequent prosecution within the same continuous prosecution history. Particularly where additional relevant prior art and/or reasoning in a rejection prompted a later surrender and that prior art and/or reasoning was not presented earlier

Other than Appellant’s non-surrender theory, with which we disagree, we do not find where Appellant, otherwise, disputes the Examiner’s reissue recapture analysis. Final Act. 32–45. Therefore, we affirm the Examiner’s § 251 reissue recapture rejection of claim 21.

*B.5. New Ground of Rejection –
Those Reissue Claims Not Subject to Recapture Rejection*

The Examiner determined that dependent claims 42, 44, 68, 70, 78, 81, 93, 95, 103, 105, 150, and 152 “recite the required surrendered subject matter.” Final Act. 45 n.11. The Examiner further determined these claims “are not subject to the 35 U.S.C. [§] 251 recapture rejection.” *Id.*

However, the Examiner and Appellant overlook that the sole specific error set forth in Appellant’s Reissue Declaration (page 4 (Additional Sheet))¹³ is an *improper* error related to the reissue recapture as discussed *supra*. Without at least one *proper* error upon which a reissue can be based,

¹³ Appellant sets forth the following sole error upon which the reissue is based:

“Claims 10-20 all require that a first intermediate point transmit a call setup request to a second intermediate point, wherein the call setup request includes a virtual telephone number or its equivalent. New claims 21-35 do not require this feature, and thus are broader in that respect.”

the Reissue Declaration is defective; and all Appellant's reissue claims must be rejected as being based upon that defective reissue declaration.

We enter a defective reissue declaration rejection as a new ground of rejection against claims 7, 8, and 10–20 (as directly amended or amended by dependency), and reissue claims 21, 24, 26, 28–38, 40–44, 46–52, 54, 56–64, 66–70, 72–78, 80, 81, 83–87, 90–95, 97, 99–105, 107, 109, 144–146, 148–152, and 159–164 (all pending reissue claims). *See Clement*, 131 F.3d at 1472 (“[O]riginal claims 1–18 continue to exist with their normal presumption of validity, unaffected by the examiner’s rejection based on the allegedly defective declaration.”); *see also* MPEP §1414.

C. Section 112(a) Written Description (Possession)

The Federal Circuit explained that “[t]he test for the sufficiency of the written description ‘is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.’” *Vasudevan Software, Inc. v. MicroStrategy, Inc.*, 782 F.3d 671, 682 (Fed. Cir. 2015) (quoting *Ariad Pharm., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc)).

C.1. Virtual Telephone Number or Its Equivalent

C.1.a. Examiner’s Rejection & Appellant’s Argument

The Examiner rejects claim 1 under 35 U.S.C. § 112(a) as failing to comply with the written description requirement because there is

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insufficient original disclosure as to what is the equivalent of a virtual number. Final Act. 55.

Appellant asserts the following in contending that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 112(a).

In this instance, a person of ordinary skill in the voice over IP telephony arts, at the time of the invention, would have understood what constitutes an equivalent to a virtual telephone number. Examples include an IP address that corresponds to a virtual telephone number, as well as a tel Uniform Resource Identifier – also called a “tel URI” which corresponds to a virtual telephone number. A tel URI is described in RFC 3966, which was published by the Network Working Group at Columbia University in December 2004.

App. Br. 45.

C.1.b. *Panel’s “Or Its Equivalent” § 112(a) Determination*

Appellant’s Specification states:

Each virtual phone number serves as a[n] alias for, and directs calls to, a destination physical number. ***The virtual phone number does not exist on any physical device on the originating or destination network.***

Spec. col. 5, ll. 14–17 (emphasis added).

We are unpersuaded by Appellant’s “tel URI” argument. First, Appellant sets forth no explanation as to why the “tel URI” would be viewed as an equivalent to a virtual number. To the contrary, our review of RFC 3966 (referenced by Appellant) determines that the “tel URI” is not the equivalent of a virtual number. “The tel URI for Telephone Numbers” (RFC 3966) states:

This document defines the URI scheme “tel”, which describes resources identified by telephone numbers. A telephone

number is a string of decimal digits that *uniquely indicates the network termination point*.

RFC 3966 Introduction (emphasis added). RFC 3966 goes on to state:

The “tel” URI has the following syntax:

telephone-uri = “tel:” telephone-subscriber
telephone-subscriber = global-number / local-number

...

uric = reserved / unreserved / pct-encoded

RFC 3966 Section 3 (URI Syntax).

We find no mention in RFC 3966 of virtual numbers either explicitly by name or by description of a “number that does not exist on any physical device on the originating or destination network.” Rather, we determine that an artisan would understand the “global-number / local-number” of the tel syntax to be a physical number.

Second, in Appellant’s disclosure as filed, we find no mention of the “tel URI” now referenced, and no mention of any other specific equivalent of the virtual number. At best, the Specification indicates (*supra*) that the virtual phone number serves as an alias for a destination physical number. While it might be argued that the physical number is a disclosed equivalent of the virtual number, such is precluded by the requirement that the virtual number does not exist on any physical device on the originating or destination network.

We agree with the Examiner that Appellant’s disclosure does not reasonably convey to those skilled in the art that Appellant had possession of any “equivalent” as of the filing date. Therefore, we affirm the Examiner’s § 112(a) rejection of claim 1.

C.1.c. *New Ground of Rejection under § 112(a)*

As we note *supra*, the Examiner’s § 112(a) rejection overlooks similar “equivalent” limitations in claim 51 (and thus claim 51’s dependent claims 52, 54, 56–63, 66–69, 72, and 73). We newly reject these claims for the same reasoning set forth by the Examiner for claim 1.

C.2. *At Least One Processor* (i.e., more than one)

C.2.a. *Examiner’s Rejection & Appellant’s Argument*

The Examiner rejects claim 74 under 35 U.S.C. § 112(a) as failing to comply with the written description requirement because there is insufficient indication in the Specification that Appellant had possession of a system for facilitating a communication link that includes a first intermediate point comprising *at least* one processor (i.e., more than one).
Final Act. 55.

Appellant asserts the following arguments in contending that the Examiner erred in rejecting claim 74 under 35 U.S.C. § 112(a).

First, a claim that recites “at least one processor” does not require two processors. Instead, the language means exactly what it says - at least one. This language has always been interpreted to read on a device which has one processor *or multiple processors*. Thus, even the broadest reasonable interpretation of the claim language cannot require the device to have multiple processors.

Second, the application discloses that an intermediate point could be a server or a router. Indeed, the specification at column 4, lines 47-49, states that the router which acts as an intermediate point “may comprise any computing device *known to those skilled in the art.*”

Those of ordinary skill in the voice over IP telephony art know that a router or server that acts as an intermediate point routinely includes multiple processors which perform various different functions. Thus, the fact that the application discloses

that a server or router could act as an intermediate point necessarily means that the specification discloses that a device acting as an intermediate point could include multiple processors. But the fact that the application goes further to indicate that a router acting as an intermediate point could comprise any computing device known to those skilled in the art should remove any doubt about this point, as *those skilled in the art were surely aware* of computing device that included multiple processors.

App. Br. 46 (emphasis added).

C.2.b. *Panel's "At Least One" § 112(a) Determination*

As to Appellant's first argument, we are not persuaded. Appellant acknowledges that the claim language encompasses "multiple processors." Therefore, the Examiner correctly looks to see if the application reasonably conveys to those skilled in the art that the inventor had possession of the full scope of the claimed invention, which encompasses multiple processors, as of the filing date.

As to Appellant's second argument, contrary to Appellant's premise, the test is not whether those skilled in the art were aware of computing device that included multiple processors. Rather, the test is whether those skilled in the art would understand Appellant to have possession of an invention that includes multiple processors. Appellant points to the clause "may comprise any computing device known to those skilled in the art" (Spec. col. 4, ll. 47–49) as sufficient to show possession by Appellant.

We agree with Appellant that "multiple processors" are known to those skilled in the art. However, we disagree that this alone is sufficient to show possession by Appellant. Alone, the clause *supra* is, at best, a boilerplate statement providing no specific disclosure about what knowledge

is possessed by Appellant. However, this clause in combination with other specific disclosures by Appellant indicates to us that Appellant intends those other disclosures to be to the fullest reasonable extent of knowledge in the art. We find much more helpful Appellant's explicit statement that:

In one embodiment, the point on the originating network and the point on the destination network are preferably telephones and the first and second intermediate points may be servers.

Spec. col. 3, ll. 3–6. We determine that those skilled in the art would understand this “may be servers” statement to reasonably describe not only the situation with a single server at each of the first and second intermediate points, but also other situations with one *or more* “servers” at each of the first and second intermediate points. We further determine that the argued clause *supra* and the “may be servers” statement together are sufficient to show possession of the now claimed “one or more processors.”

We conclude there is insufficient articulated reasoning to support the Examiner's conclusion that claim 74 fails to comply with the written description requirement.

D. Section 112(b) Indefinite

D.1. Virtual Telephone Number or Its Equivalent

D.1.a. Examiner's Rejection & Appellant's Argument

The Examiner rejects claim 1 under 35 U.S.C. § 112(b) as being indefinite because the phrase “[or] its equivalent” is unclear. Final Act. 57–58.

Appellant asserts the following in contending that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 112(b).

As explained above . . . [in the § 112(a) “tel URI” argument], one of ordinary skill in the art would have known what constitutes an equivalent to a virtual number. Because this term was understood by one of ordinary skill in the art, Appellant respectfully submits that claims are not rendered indefinite simply because they recite this feature.

App. Br. 47.

D.1.b. Panel's “Or Its Equivalent” § 112(b) Determination

As we explain *supra*, we are unpersuaded by Appellant’s “tel URI” argument. Contrary to Appellant’s contention, we do not agree that “or its equivalent” was understood by one of ordinary skill in the art.

We agree with the Examiner that “it is unclear and indefinite [as] to what exactly an ‘equivalent’ to a ‘virtual number’ is.” Final Act. 58. Therefore, we affirm this § 112(b) rejection of claim 1.

D.1.c. New Ground of Rejection under § 112(b)

As we note *supra*, the Examiner’s § 112(b) rejection overlooks similar “equivalent” limitations in claims 9, 38, and 51 (and thus claim 51’s dependent claims 52, 54, 56–63, 66–69, 72, and 73). We newly reject these claims for the same reasoning set forth by the Examiner for claim 1.

D.2. *Intermediate Point Phrases*

D.2.a. *Examiner's Rejection & Appellant's Argument*

The Examiner rejects claim 1 under 35 U.S.C. § 112(b) as being indefinite because the “Intermediate Point Phrases are indefinite because—to one of ordinary skill in this art—the metes and bounds of the phrases cannot be reasonably determined.” Final Act. 59.

Appellant asserts the following arguments in contending that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 112(b).

The specification makes it very clear that an intermediate point could be a server or a router that is connected to both a telephony system and a data network. In fact, the specification at column 2, lines 47-52, and again at column 3, lines 5-6, specifically states that the intermediate points can be servers. The specification then goes on to provide a detailed description of the functions that would be performed by a server or a router acting as an intermediate point between column 4, line 37 and column 5, line 57.

Because the specification indicates that an intermediate point can be a server or a router, and because the specification provides a detailed description of the functions that would be performed by a server or router acting as an intermediate point, Appellant respectfully submits that ***the meaning of the term “intermediate point” would be clear to one of ordinary skill in the art.***

App. Br. 47 (emphasis added).

D.2.b. *Panel's “Intermediate Point” § 112(b) Determination*

As to Appellant's conclusion, we agree. We determine that the meaning of the term “intermediate point” would be clear to one of ordinary skill in the art. However, we base our determination on more than Appellant's argument. We determine that those skilled in the art would understand the meaning of “point” (i.e., a router) with the word

“intermediate” merely describing location. The word “point” in the network art is a term of art indicating a particular structural element in the network.

We cite the following exemplary uses of the term.

1. Walpole et al. (US 2003/0236904 A1; published December 25, 2003).

This is what multicast tries to achieve, sending only one instance of a stream down any branch, and *at branch points (routers or forwarding nodes* in an overlay network) the stream is replicated such that one instance goes out on each outgoing link.

Para. 13 (emphasis added).

2. Basso et al. (US 2003/0210688 A1; published November 13, 2003).

A packet switching network has *switching points or nodes* (commonly referred to as *routers* or switches) for transmissions of data among senders and receivers connected to the network.

Para. 2 (emphasis added).

3. Dawson et al. (US 2003/0115319 A1; published June 19, 2003).

In a packet-switching network, a hop is the trip a data packet takes from one *router* or *intermediate network node point* to another network node point in the network.

Para. 35 (emphasis added).

4. Sundaresan et al. (US 6,957,358 B1; issued October 18, 2005; filed January 28, 2002).

Nodes represent switching points, such as switches or *routers*, within a network.

Col. 1, ll. 15–17 (emphasis added).

5. Kodialam et al. (US 6,538,991 B1; issued March 25, 2003).

An *ingress point is a router of node* N1 that transfers packets to the backbone network 100 from a source (packet network 102), and an *egress point is a router of node* N4 that transfers packets from the backbone network 100 to a destination (packet network 104).

Col. 1, ll. 37–41 (emphases in original omitted, panel emphases added).

Contrary to the Examiner’s determination that the metes and bounds of the “intermediate point” phrases cannot be reasonably determined, we determine that “point” is a term of art well understood by artisans. Therefore, we conclude there is insufficient articulated reasoning to support the Examiner’s conclusion that the “intermediate point” phrases of claim 1 are indefinite.

E. Section 112(d) Improper Dependent Form

The Examiner rejects claim 62 under 35 U.S.C. § 112(d) as being of improper dependent form for failing to further limit the subject matter of the claim upon which it depends, or for failing to include all the limitations of the claim upon which it depends. Final Act. 62.

Appellant raises the following argument in contending that the Examiner erred in rejecting claim 62 under 35 U.S.C. § 112(d).

Claim 62 depends from claims 51 and 61. The relevant portion of claim 51 recites that . . . a first intermediate point is configured to receive communication information from a second intermediate point, wherein the communication information includes a virtual number received from the originating point, or its equivalent This means that the communication information could include the virtual number, or its equivalent.

Claim 62 further specifies that the communication information comprises the virtual number. Thus claim 62 further

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limits what was recited in claim 51, by requiring that the communication information comprises the virtual number. Note, claim 62 would not read on a system where the communication information is only an equivalent to the virtual number. But claim 51 would read on that system. This demonstrates that claim 62 has a different scope than claim 51, and one which is more narrow than claim 51.

App. Br. 48.

We agree. Therefore, we conclude that there is insufficient explanation to support the Examiner's conclusion that claim 62 is of improper dependent form.

F. *Section 101*

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g., Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208, 216 (2014) (quotation marks and citation omitted).

F.1. *USPTO Section 101 Guidance*

The United States Patent and Trademark Office (USPTO) recently published revised guidance on the application of § 101. USPTO's Memorandum, *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (Jan. 7, 2019) (“Memorandum”). Under that guidance, we first look to whether the claim recites:

(1) (*see* Memorandum Step 2A – Prong One) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical

concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes); and

(2) (*see* Memorandum Step 2A – Prong Two) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)).

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look to whether the claim:

(3) adds a specific limitation beyond the judicial exception that are not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)); or

(4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

See Memorandum Step 2B.

F.2. Examiner’s § 101 Rejection

In rejecting claim 1, the Examiner determines:

The Examiner finds that the claims of the ’229 Reissue Proceedings are ***directed to the concept of a system and method of establishing an out-of-region connection to a local in-region user***. This concept is not meaningfully different than those concepts found by the courts to be abstract ideas, such as ‘streaming regional broadcast signals to cellular telephones located outside the region served by the regional broadcaster’ as in *Affinity Labs of Texas, LLC v. DirectTV, LLC*, . . . [838 F.3d 1253] (Fed. Cir. 2016) (“*Affinity*”). *Affinity* specifically states “[the patent] does not provide an inventive solution to a problem in implementing the idea of remote delivery of regional broadcasting; it simply recites that the abstract idea of remote delivery will be implemented using the conventional components and functions generic to cellular telephones.” (*Affinity*[, 838 F.3d

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at 1263]). The instant claims are likewise similar to those in *Affinity* in that the system establishes an out-of-region communications link between an in-location originating location and an out-of-region destination location.

Final Act. 48 (emphasis added).

F.3. Panel's § 101 Analysis

We disagree with the Examiner's reasoning. The Examiner's reasoning relies on the Federal Circuit's *Affinity* decision where the magistrate judge determined:

The purpose of the '379 patent . . . "is the dissemination of regionally broadcasted content to users outside the region." That purpose . . . is a "***fundamental economic and conventional business practice***" that is both "well-known and historically long-standing"; [and] the claims [are] directed to an abstract idea.

Affinity, 838 F.3d at 1256 (emphasis added). The Federal Circuit stated:

The concept of providing out-of-region access to regional broadcast content is an abstract idea, as that term is used in the section 101 context. It is a broad and familiar concept concerning information distribution that is untethered to any specific or concrete way of implementing it.

Affinity, 838 F.3d at 1258.

There is nothing in claim 1 that is directed to *how* to implement out-of-region broadcasting on a cellular telephone. Rather, the claim is drawn to the idea itself.

Id.

Unlike the fundamental economic and conventional business practice in *Affinity*, Appellant's claim 1 is directed to *how* to implement a communications link in a specific way, that is, by the use of a call setup request including a virtual telephone number to establish the communications link. That is, by:

receiving *a virtual telephone number* at a first intermediate point from an originating point, the first intermediate point being operatively connected to a data network; and

transmitting a call setup request over the data network that includes a second intermediate point, wherein *the call setup request includes the virtual telephone number* or its equivalent, and wherein *information in the call setup request allows* the second intermediate point to *establish a communications link* to a destination point that corresponds to the virtual telephone number.

See claim 1 (emphasis added). Thus we determine that contrary to the Examiner's conclusion, claim 1 is not directed to an identified method of organizing human activity, e.g., a fundamental economic practice.

Also, we compare the claimed invention to the claims in *Electric Power Grp., LLC. v. Alstom SA.*, 830 F.3d 1350 (Fed. Cir. 2016) and *FairWarning IP, LLC. v. Iatric Systems, Inc.*, 839 F.3d 1089 (Fed. Cir. 2016). In *Electric Power*, the Federal Circuit recognized that “analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category.” *Electric Power*, 830 F.3d at 1354. For example, claim 12 in *Electric Power* involved analyzing events based on measurements. See *id.* at 1351–52. In *FairWarning*, the claims were “directed to collecting and analyzing information to detect misuse and notifying a user when misuse is detected.” *FairWarning*, 839 F.3d at 1094. That is the type of activity that can be, and often is, performed in the human mind. See *Electric Power*, 830 F.3d at 1354; *FairWarning*, 839 F.3d at 1093.

In contrast, we conclude the claimed use of a call setup request including a virtual telephone number to establish the communications link (a) is a particular technological implementation, and (b) cannot practically be performed by a human being, either mentally or with pen and paper. Further, our review of claim 1 does not find a mathematical concept is recited.

In light of the above analysis, and because use of a call setup request including a virtual telephone number to establish the communications link, is not a mathematical concept, an identified method of organizing human activity, or a mental process, we conclude the claimed invention is not directed to an abstract idea. *See* Memorandum at 52; *see also id.* at 53 (“Claims that do not recite matter that falls within these enumerated groupings of abstract ideas should not be treated as reciting abstract ideas, except” in rare circumstances.).

Accordingly, we reverse the Examiner’s § 101 rejection of claim 1.

G. *Section 102(b)*¹⁴

G.1. *Appellant’s Contention*

Appellant raises the following argument in contending that the Examiner erred in rejecting claim 87 under 35 U.S.C. § 103(a).

DiCamillo fails to provide any disclosure about how the information in the database 24 is arranged or configured. Certainly, DiCamillo fails to disclose that the database 24 includes information associating a virtual number with a second

¹⁴ The contentions we discuss are determinative as to this § 102 rejection and the claims 90, 93, 99, 103, 109, and 150 portions of the first and third § 103(a) rejection discussed *infra* which portions dependent on this § 102 rejection. Therefore, Appellant’s other contentions as to these § 102 and dependent portions of the § 103(a) rejections are not discussed herein.

intermediate point based on a proximity of the second intermediate point to the destination point that corresponds to the virtual number, as recited in claim 87.

App. Br. 49.

G.2. Panel Determinations

As to Appellant's above contention, we agree. First, we disagree with the Examiner's determination that claim 87 "does invoke 35 U.S.C. §112, 6th paragraph." Final Act. 71 (referencing Final Act. 27–29). Contrary to the Examiner's determination, we determine that "a first intermediate point" is a term of art indicating a particular structure as discusses *supra* at section D.2.b. Ultimately this error is harmless as the Examiner treats the "a first intermediate point" as a "server or router," which correspond to the structures referred to by this term of art.

Second, our review of the Examiner's articulated reasoning for this seven-line claim determines that the rejection is unnecessarily complex with a multi-layered articulation (rejection points to Examiner fact finding which in turn points to numerous sections of the reference) that ultimately leaves this panel guessing as to which particular items in the reference the Examiner believes align with particular limitations (e.g., the "proximity" limitation) in the claim.

Third, in an attempt to bring clarity to the Examiner's rejection, we review the cited reference to see if we are able to discern that the claimed limitations are readily apparent within the cited portions of the reference. While we are able to discern some claim limitations in the cited reference, we are unable to discern all required limitations (e.g., the argued "proximity" limitation).

We conclude, consistent with Appellant's arguments, there is insufficient articulated reasoning to support the Examiner's findings. Therefore, we reverse the Examiner's § 102(b) rejection of claim 87.

H. *Section 103(a)*¹⁵

H.1. *First § 103(a) rejection*

H.1.a. *Appellant's Contention*

Appellant raises the following argument in contending that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a).

[T]he Final Office Action asserts that the Dolan reference discloses sending a call setup request that includes a virtual telephone number. Appellant respectfully disagrees.

App. Br. 51.

Dolan . . . teaches that a call setup request should include the telephone number that is actually assigned to the telephone device to which the call is directed.

App. Br. 53–54.

H.1.b. *Panel Determinations*

As to Appellant's above contention, we agree. Our review of Dolan agrees with Appellant's argument. Dolan does not teach sending a call setup request that includes a virtual telephone number as required by claim 1.

We conclude, consistent with Appellant's arguments, there is insufficient articulated reasoning to support the Examiner's findings. Therefore, we conclude that there is insufficient articulated reasoning to support the Examiner's final conclusion that claim 1 would have been

¹⁵ The contentions we discuss are determinative as to these § 103 rejections on appeal. Therefore, Appellant's other § 103 contentions as to these rejections are not discussed herein.

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obvious to one of ordinary skill in the art at the time of Appellant's invention.

Therefore, we reverse the Examiner's § 103(a) rejection of claim 1.

H.2. Third § 103(a) rejection

H.2.a. Appellant's Contention

Appellant raises the following argument in contending that the Examiner erred in rejecting claim 21 under 35 U.S.C. § 103(a).

Appellant notes that the element of the service provider that the Final Office Action asserts corresponds to the claimed routing table, which is the database 203, is also shown as a separate element. The disclosure of Sugla makes it clear that this database 203 is an element that is separate from the first processing switch 202 and the second processing switch 204. Thus, Sugla fails to disclose or suggest a routing database which is a part of an intermediate point, as recited in claim . . . [21].

App. Br. 59.

H.2.b. Panel Determinations

As to Appellant's above contention, we agree. Our review of Sugla agrees with Appellant's argument. Dolan does not teach a first routing table that comprises a part of the first intermediate point as required by claim 21.

We conclude, consistent with Appellant's arguments, there is insufficient articulated reasoning to support the Examiner's findings. Therefore, we conclude that there is insufficient articulated reasoning to support the Examiner's final conclusion that claim 21 would have been obvious to one of ordinary skill in the art at the time of Appellant's invention.

Therefore, we reverse the Examiner's § 103(a) rejection of claim 21.

H.3. *Sixth § 103(a) rejection*

H.3.a. *Appellant's Contention*

Appellant raises the following argument in contending that the Examiner erred in rejecting claim 51 under 35 U.S.C. § 103(a).

Dolan . . . fail[s] to disclose or suggest systems where a first intermediate point is configured to receive communication information from a second intermediate point, and where the communication information includes a virtual number received from the originating point, or its equivalent.

App. Br. 63.

H.3.b. *Panel Determinations*

As to Appellant's above contention, we agree. Our review of Dolan agrees with Appellant's argument. Again, Dolan does not teach sending a call setup request that includes a virtual telephone number as required by claim 51.

We conclude, consistent with Appellant's arguments, there is insufficient articulated reasoning to support the Examiner's findings. Therefore, we conclude that there is also insufficient articulated reasoning to support the Examiner's final conclusion that claim 51 would have been obvious to one of ordinary skill in the art at the time of Appellant's invention.

Therefore, we reverse the Examiner's § 103(a) rejection of claim 51.

H.4. *Eighth § 103(a) rejection*

H.4.a. *Appellant's Contentions*

Appellant raises the following arguments in contending that the Examiner erred in rejecting claim 21 under 35 U.S.C. § 103(a).

H.4.a.i. *First Contention*

With reference to Figure 5 of Thornton, the Office Action appears to assert that the database 508 in Thornton corresponds to the routing table recited in claim 21. Appellant respectfully disagrees.

The database 508 in Thornton correlates actual physical telephone numbers that are assigned to IP-based telephony devices to information that could be used to route an incoming telephone call to the IP-based telephony devices. For example, the database 508 in Thornton could cross-reference a physical (not virtual) telephone number assigned to an IP telephony device to the IP address currently assigned to the IP telephony device. Thus, the database 508 in Thornton does not correlate virtual numbers to the identity of destination points.

In contrast, claim 21 recites a first routing table that correlates virtual numbers to second intermediate points capable of communicating with the destination points that correspond to those virtual numbers. Thus, the database 508 in Thornton contains very different information than the first routing table recited in claim 21.

App. Br. 66.

H.4.a.ii. *Second Contention*

Appellant further notes that because DiCamillo utilizes prior art call setup procedures, any routing table in DiCamillo that is used to identify second intermediate points will cross-reference the identity of those second intermediate points to the actual physical numbers (not the virtual numbers) of destination points that are reachable by those second intermediate points.

App. Br. 66.

H.4.b. *Panel Determinations*

As to Appellant’s above contentions, we disagree. Our review of DiCamillo and Thornton agrees with the Examiner’s analysis.

H.4.b.i. *First Determination – Thornton*

As to Appellant’s *first* contention, we disagree. The Examiner does not cite Thornton for the argued “database . . . [to] correlate *virtual numbers* to the identity of destination points.” App. Br. 66 (emphasis in original omitted, panel emphasis added). Rather, the Examiner cites DiCamillo to show a database to correlate *virtual numbers* to the identity of destination points. Final Act. 151. Thornton is cited to show that a “routing table [database] being a part of the first intermediate point is known in the art.” Final Act. 152.

Thus, Appellant does not address the actual reasoning of the Examiner’s rejection. Instead, Appellant attacks the Thornton reference singly for lacking a teaching that the Examiner relied on a combination of references to show. It is well-established that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). References must be read, not in isolation, but for what they fairly teach in combination with the prior art as a whole. *Merck*, 800 F.2d at 1097.

H.4.b.ii. *Second Determination – DiCamillo*

As to Appellant’s *second* contention, we disagree. We agree with the Examiner’s reasoning that DiCamillo discloses a database to correlate virtual numbers to the identity of destination points.

[T]he Examiner finds that DiCamillo et al. discloses a caller utilizing a telephone 12 to dial a VTN [Virtual Telephone Number] which in return is provided to [point of presence] POP 18. (EFF 1). The Examiner finds that POP 18 comprises combination gateway 22 and router 32. (EFF 3). The Examiner finds that the VTN corresponds to the host telephone 42 number. (EFF 2). The Examiner finds that database 24 contains all information of any VTN. (EFF 8). The Examiner finds that the gateway 22 of POP 18 sends a query to the database 24 using the VTN as an input. (EFF 6). The Examiner finds that DiCamillo et al. discloses the system determining, based on the dialed VTN, the “correct destination gateway 28” of destination POP 29 that corresponds to the host telephone 42. (*Id.*)

Final Act. 151 (emphases omitted).

H.4.b.iii. *Conclusion*

We disagree with the Examiner’s determination that claim 21 “does invoke 35 U.S.C. §112, 6th paragraph.” Final Act. 110 (referencing Final Act. 18–21). Contrary to the Examiner’s determination, we determine that “a first intermediate point” is a term of art indicating a particular structure as discusses *supra* at section D.2.b. Ultimately this error is harmless as the Examiner treats the “a first intermediate point” as a “server or router” which correspond to the structures referred to by this term of art.

We, otherwise, agree with and adopt as our own the Examiner’s reasoning as to the *Eighth* § 103(a) rejection of claim 21. Therefore, we affirm the Examiner’s § 103(a) rejection of claim 21.

H.5. *Eleventh § 103(a) rejection*

Appellant repeats (App. Br. 69) the *Sixth* § 103(a) argument reproduced *supra* in section H.3.a., and again contends that the Examiner erred in rejecting claim 51 under 35 U.S.C. § 103(a).

As to Appellant's above contention, again we agree as set forth in section H.3.b.

Therefore, we reverse the Examiner's § 103(a) rejection of claim 51.

H.6. *Thirteenth § 103(a) rejection*

H.6.a. *Appellant's Contention*

Appellant raises the following argument in contending that the Examiner erred in rejecting claim 97 under 35 U.S.C. § 103(a).

[N]either Thornton nor DiCamillo disclose or suggest a system that includes a routing database that comprises information that associates second intermediate points with destination points that correspond to virtual numbers based on a proximity of the second intermediate points to the destination points, as recited in claim 97.

App. Br. 71.

H.6.b. *Panel Determinations*

As to Appellant's above contention, we agree. Our review of Thornton and DiCamillo agrees with Appellant's argument. Thornton and DiCamillo do not teach the "proximity" limitation as required by claim 97.

We conclude, consistent with Appellant's arguments, there is insufficient articulated reasoning to support the Examiner's findings. Therefore, we conclude that there is insufficient articulated reasoning to support the Examiner's final conclusion that claim 97 would have been

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obvious to one of ordinary skill in the art at the time of Appellant's invention.

Therefore, we reverse the Examiner's § 103(a) rejection of claim 97.

CONCLUSIONS

Based on affirmed rejections and new entered grounds of rejection, claims 1–21, 24, 26, 28–38, 40–44, 46–52, 54, 56–64, 66–70, 72–78, 80, 81, 83–87, 90–95, 97, 99–105, 107, 109, 144–146, 148–152, and 159–164 (*all pending claims*) are not patentable.

DECISION

We **newly reject** claims 7, 8, 10–21, 24, 26, 28–38, 40–44, 46–52, 54, 56–64, 66–70, 72–78, 80, 81, 83–87, 90–95, 97, 99–105, 107, 109, 144–146, 148–152, and 159–164 under 35 U.S.C. § 251 as being based on a defective reissue declaration.

We **newly reject** reissue claims 51, 52, 54, 56–63, 66–69, 72, and 73 under 35 U.S.C. § 112(a) as failing to comply with the written description requirement.

We **newly reject** claims 9, 38, 51, 52, 54, 56–63, 66–69, 72, and 73 under 35 U.S.C. § 112(b) as being indefinite.

The Examiner's rejection of claims 21, 24, 26, 28–38, 40, 41, 43, 46–52, 54, 56–64, 66, 67, 69, 72–77, 80, 83–87, 90–92, 94, 97, 99–102, 104, 107, 109, 144–146, 148, 149, 151 and 159–164 under 35 U.S.C. § 251 as being an improper recapture is **affirmed**.

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The Examiner's rejection (based on the term "equivalent") of claims 1–20, 38, 44, 64, 70, 81, 95, 105, 152 and 159–164 under 35 U.S.C. § 112(a) as lacking a proper written description is **affirmed**.

The Examiner's rejection (based on the term "equivalent") of claims 1–8, 11–20, 44, 64, 70, 81, 95, 105, 152, and 159–164 under 35 U.S.C. § 112(b) as being indefinite is **affirmed**.

The Examiner's *Eighth*, *Ninth*, and *Tenth* (8th–10th) rejections under 35 U.S.C. § 103(a) of claims 21, 24, 26, 28–37, 40–43, 46–50, 74–78, 80, and 83–86 as being unpatentable are **affirmed**.

The Examiner's rejection of claim 9 under 35 U.S.C. § 112(b) as being indefinite is *pro forma* **affirmed**.

The Examiner's rejection of claims 1–20, 51, 52, 54, 56–64, 66–70, 72–78, 80, 81, 83–86 and 159–164 under 35 U.S.C. § 251 as being based on new matter is **reversed**.

The Examiner's rejection (based on the phrase "at least one") of claims 10–20, 51, 52, 54, 56–64, 66–70, 72–78, 80, 81 and 83–86 under 35 U.S.C. § 112(a) as lacking a written description is **reversed**.

The Examiner's rejection (based on the "Intermediate Point Phrases") of claims 1–21, 24, 26, 28–38, 40–44, 46–52, 54, 56–64, 66–70, 72–78, 80, 81, 83–87, 90–95, 97, 99–105, 107, 109, 144–146, 148–152, and 159–164 (*all pending claims*) under 35 U.S.C. § 112(b) as being indefinite is **reversed**.

The Examiner's rejection of claims 62 and 64 under 35 U.S.C. § 112(d) as being of improper dependent form is **reversed**.

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The Examiner's rejection of claims 1–21, 24, 26, 28–38, 40–44, 46–52, 54, 56–64, 66–70, 72–78, 80, 81, 83–87, 90–95, 97, 99–105, 107, 109, 144–146, 148–152, and 159–164 (*all pending claims*) under 35 U.S.C. § 101, as being directed to patent-ineligible subject matter is **reversed**.

The Examiner's rejection of claims 87, 91, 92, 94, 97, 100–102, 104, 107, 144–146, 148, 149, and 151 under 35 U.S.C. § 102(b) as being anticipated is **reversed**.

The Examiner's *Eighth* rejection under 35 U.S.C. § 103(a) of claims 90, 99, and 109 as being unpatentable is **reversed**.

The Examiner's *First* through *Seventh* (1st–7th) and *Eleventh* through *Fourteenth* (11th–14th) rejections under 35 U.S.C. § 103(a) of claims 1–20, 21, 24, 26, 28–37, 40–43, 46–52, 54, 56–63, 66–69, 72–78, 80, 83–86, 90, 93, 97, 99–104, 107, 109, 150, and 159–164 as being unpatentable are **reversed**.

NEW GROUNDS OF REJECTION

37 C.F.R. § 41.50(b)

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b), which provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

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(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under §41.52 by the Board upon the same Record.

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-IN-PART; 37 C.F.R. § 41.50(b)