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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte EUGENE NOLAN

Appeal 2019-003318
Application 14/153,571
Technology Center 2400

Before ST. JOHN COURTENAY III, LARRY J. HUME, AND
PHILLIP A. BENNETT, *Administrative Patent Judges*.

HUME, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision rejecting claims 1–5, 8–19, 22–26, which are all claims pending in the application. Appellant has canceled claims 6, 7, 20 and 21. *See* Appeal Br. 9–12 (Claims App.). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the term “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Comcast Cable Communications, LLC. Appeal Br. 1.

STATEMENT OF THE CASE²

The claims are directed to dynamic connection management. *See* Spec. ¶ 2. In particular, Appellant’s “systems and methods for dynamic registration and connection management disclosed herein allow a device such as a user device to establish a connection with a computing device only when a communication session is requested.” Spec. ¶ 6.

Exemplary Claim

Claim 1, reproduced below, is representative of the subject matter on Appeal (labelling, and *emphases* added to contested prior-art limitations):

1. A method comprising:

establishing, by a user device, a persistent connection with a service subscribed to a presence service;

[L1] *receiving, at the user device, a notification of a request for a communication session with a computing device via the service*, wherein the request is published by the presence service to the service in response to receiving the request for the communication session;

determining a location of the user device;

[L2] *registering, by the user device, in response to the notification and based on the location of the user device, with a communication processing system to receive the request for the communication session*; and

engaging, by the user device, in the communication session with the computing device via the communication processing system.

² Our decision relies upon Appellant’s Appeal Brief (“Appeal Br.,” filed Oct. 24, 2018); Appellant’s Reply Brief (“Reply Br.,” filed Mar. 25, 2019); Examiner’s Answer (“Ans.,” mailed Jan. 25, 2019); Final Office Action (“Final Act.,” mailed May 4, 2018); and the original Specification (“Spec.,” filed Jan. 13, 2014).

REFERENCES

The prior art relied upon by the Examiner as evidence is:

Name	Reference	Date
Kennedy et al. (“Kennedy”)	US 2004/0252683 A1	Dec. 16, 2004
Rogers et al. (“Rogers”)	US 8,312,092 B2	Nov. 13, 2012

REJECTION

Claims 1–5, 8–19, 22–26 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Kennedy and Rogers. Final Act. 2.

CLAIM GROUPING

Based on Appellant’s arguments (Appeal Br. 4–7) and our discretion under 37 C.F.R. § 41.37(c)(1)(iv), we decide the appeal of the obviousness rejection of independent claims 1, 10, and 16 on the basis of representative claim 1. Remaining dependent claims 2–5, 8, 9, 11–15, 17–19, and 22–26, not argued separately, stand or fall with the respective independent claim from which they depend.³

³ “Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.” 37 C.F.R. § 41.37(c)(1)(iv). In addition, when Appellant does not separately argue the patentability of dependent claims, the claims stand or fall with the claims from which they depend. *In re King*, 801 F.2d 1324, 1325 (Fed. Cir. 1986).

ISSUES AND ANALYSIS

In reaching this decision, we consider all evidence presented and all arguments actually made by Appellant. 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 disagree with Appellant's arguments with respect to claims 1–5, 8–19, 22–26 and, unless otherwise noted, we incorporate by reference herein and adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken, and (2) the reasons and rebuttals set forth in the Examiner's Answer in response to Appellant's arguments. We highlight and address specific findings and arguments regarding claim 1 for emphasis as follows.

1. § 103 Rejection of Claims 1–5, 8–19, 22–26

Issue 1

Appellant argues (Appeal Br. 6–14; Reply Br. 2) the Examiner's rejection of claim 1 under 35 U.S.C. § 103 as being obvious over the combination of Kennedy and Rogers is in error. These contentions present us with the following issues:

(a) Did the Examiner err in finding the cited prior art combination teaches or suggests limitation L1, i.e., “receiving a *notification* of a request” as recited in claim 1 (emphasis added)?

(b) Did the Examiner err in finding the cited prior art combination teaches or suggests limitation L2, i.e., “registering, by the user device, in response to the notification and based on the location of the user device, *with a communication processing system to receive the request for the communication session*” as recited in claim 1 (emphasis added)?

Principles of Law

During prosecution, claims must be given their broadest reasonable interpretation when reading claim language in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Under this standard, we interpret claim terms using “the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.” *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

“[O]ne cannot show non-obviousness by attacking references individually where . . . the rejections are based on combinations of references.” *In re Keller*, 642 F.2d 413, 426 (CCPA 1981). “The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference. . . . Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art.” *Id.* at 425.

In *KSR*, the Court stated “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103

likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. . . . [A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Id. at 417.

Further, the relevant inquiry is whether the Examiner has set forth “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited with approval in *KSR*, 550 U.S. at 418).

Analysis

(a) Limitation L1 (“receiving a notification”) is Taught or Suggested

The Examiner relies upon the combination of Kennedy and Rogers as teaching or suggesting the contested limitation L1. Final Act. 3–5 (citations omitted).

Appellant contends:

Although *Kennedy* discloses sending and receiving a “request,” *Kennedy* is silent as to receiving a “**notification** of a request.” One skilled in the art would appreciate the difference between receiving a “request” and receiving a “notification of a request” as claimed.

Appeal Br. 5.

We are not persuaded by Appellant’s argument quoted above, because we find Kennedy’s INVITE/SDP request, sent from a client 1202 to the application server 1201, teaches or at least suggests the disputed

“notification of a request.” Kennedy ¶ 70; Final Act. 4, Ans. 3–4; *see generally* Kennedy ¶ 62 *et seq.* Appellant’s Specification provides a non-limiting list of embodiments as examples of a “notification.” Spec. ¶ 41. Given this list, we agree with the Examiner’s conclusion that the broadest reasonable interpretation of “notification of a request” encompasses Kennedy’s INVITE/SDP request. Ans. 3–5.

(b) Limitation L2 (“registering . . .”) is Taught or Suggested

Appellant contends the disputed limitation “registering, by the user device, in response to the notification, with a *communication processing system* to receive the request for the communication session, wherein registering with the communication processing system comprises determining a location of the user device” is not taught by Kennedy. Appeal Br. 6. Appellant further argues “Even if, for the sake of argument, this ‘SIP application server’ discloses the claimed ‘communication processing system,’ it does not appear that the ‘SIP client B’ is ‘registered’ with the ‘SIP application server’ in response to a ‘notification’ as claimed.” Appeal Br. 7.

We are not persuaded by Appellant’s argument because Kennedy’s SIP application server 1301, in determining the location of the user device 1304 and forwarding the SIP Invite request to user device 1304, and registering with application server 1301, teaches or at least suggests the disputed limitation L2. Kennedy ¶ 70, Ans. 6–7.

Appellant further argues:

Furthermore, Applicant notes that, in rejecting this element, the Office Action maps the “SIP application server” to the claimed “communication processing system.” However, as set forth

above, the Office Action has previously mapped the “SIP application server” to the claimed “service [subscribed to a presence service],” further ignoring the relationships between the claim elements.

App. Br. 7.

We are not persuaded by Appellant’s argument because Appellant’s contention is not commensurate with the Examiner’s rejection that relies upon Rogers, not Kennedy, as teaching or suggesting “*service subscribed to a presence service.*” Final Act. 3 (citing Rogers Col. 7, ll. 13–21, 35–49).

Thus, we are not persuaded by Appellant’s arguments, and we agree with the Examiner’s finding that the combination of Rogers and Kennedy teaches or suggests disputed limitations L1 and L2 in claim 1.

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. Therefore, we sustain the Examiner’s obviousness rejection of independent claim 1 and grouped claims 2–5, 8–19, 22–26, which fall therewith. *See* Claim Grouping, *supra*.

REPLY BRIEF

To the extent Appellant *may* advance new arguments in the Reply Brief (Reply Br. 2) not in response to a shift in the Examiner’s position in the Answer, arguments raised in a Reply Brief that were not raised in the Appeal Brief or are not responsive to arguments raised in the Examiner’s Answer will not be considered except for good cause (*see* 37 C.F.R. § 41.41(b)(2)), which Appellant has not shown.

CONCLUSION

The Examiner did not err with respect to the obviousness rejection of claims 1–5, 8–19, 22–26 under 35 U.S.C. § 103 over the cited prior art combination of record, and we sustain the rejection.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Basis / References	Affirmed	Reversed
1–5, 8–19, 22–26	103	Obviousness Kennedy, Rogers	1–5, 8–19, 22–26	

FINALITY AND 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* 37C.F.R. § 41.50(f).

AFFIRMED