

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NAVEEN AERRABOTU, CHARLES PHILIPP BINZEL,
and BHARAT SRINIVASAN

Appeal 2007-3983
Application 10/295,978
Technology Center 2600

Decided: April 22, 2008

Before MAHSHID D. SAADAT, JOHN A. JEFFERY, and MARC S. HOFF, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-5 and 7-20. We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part.

STATEMENT OF THE CASE

Appellants invented a system that enables access to a communications service in the event such access is blocked. Specifically, an identity module controller is provided which grants access to a mobile communications device subscriber identity when identity module is in a blocked mode. Access to user information in such a condition, however, is denied. Such limited access to the subscriber identity enables a service center to unblock access remotely.¹ Claims 1 and 13 are illustrative:

1. An identity module for storing user information in a mobile communication device, the identity module comprising:

an identity module frame;

a secure storage memory coupled to the frame, the secure storage memory including a mobile communication device subscriber identity and the user information; and

an identity module controller coupled to the secure storage memory and the frame, the identity module controller configured to block access to the user information and grant access to the mobile communication device subscriber identity when the identity module is in a blocked mode,

wherein the mobile communication device subscriber identity comprises a primary international mobile subscriber identity.

13. A method of operating an identity module in a mobile communication device comprising:

receiving an access request;

determining a blocked mode of the identity module;

¹ See generally Spec. 3:6-5:16.

granting the access request if the identity module is not in a blocked mode and the request is for a subscriber identity;

denying the access request if the identity module is in a blocked mode and the request is for user information; and

granting the access request if the identity module is in a blocked mode and the request is for the same subscriber identity.

The Examiner relies on the following prior art references to show unpatentability:

Carrara	US 6,360,092 B1	Mar. 19, 2002 (filed Nov. 19, 1999)
Kokubu	EP 0 703 676 A1	Mar. 27, 1996

1. Claims 1-5 and 7-9 stand rejected under 35 U.S.C. § 112, ¶ 1, as failing to comply with the written description requirement.²
2. Claims 1-4 and 7-19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Carrara.
3. Claim 5 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Carrara and Kokubu.
4. Claim 20 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Carrara.

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Briefs and the Answer³ for their respective details. In this

² Although this ground of rejection was not reproduced in the “Grounds of Rejection” section of the Answer (Ans. 4-9), the Examiner nevertheless argues the propriety of the § 112 rejection in the “Response to Argument” section (Ans. 9-10). We therefore presume that the Examiner intended to (1) maintain the § 112 rejection of claims 1-5 and 7-9, and (2) incorporate that rejection on Pages 2 through 4 of the Final Rejection in the Answer.

decision, we have considered only those arguments actually made by Appellants. Arguments which Appellants could have made but did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

OPINION

The § 112 Rejection

We first consider the Examiner’s rejection of claims 1-5 and 7-9 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner takes the position that the limitation of claim 1 calling for a “*primary* international mobile subscriber identity” is not adequately supported in the disclosure as originally filed. According to the Examiner, the modifier “*primary*” at least implicitly suggests the existence of *additional* (i.e., secondary) international mobile subscriber identities. But the originally-filed disclosure, the Examiner contends, supports only “an international mobile subscriber identity” (Final Rej. 2-4; Ans. 9-10).

Appellants respond that while the Specification is directed to a single international mobile subscriber identity, the Specification does not preclude the existence of other international mobile subscriber identities. In any event, Appellants contend, the international mobile subscriber identity is the only one used in the disclosed method and therefore must be the primary international mobile subscriber identity, regardless of the presence of a

³ Throughout this opinion, we refer to (1) the Appeal Brief filed December 6, 2006; (2) the Examiner’s Answer mailed June 6, 2007; and (3) the Reply Brief filed February 12, 2007.

secondary international mobile subscriber identity. Appellants add that since the Specification discloses a subscriber identity module, which is an *essential component* for operating a mobile communication device using a subscriber identity module, the Specification supports a primary subscriber identity module (App. Br. 6-7; Reply Br. 4; emphasis added).

At the outset, we note that Appellants have not identified -- nor can we find -- anywhere in the Specification where the term “primary” actually appears in connection with the disclosed international mobile subscriber identity. Nevertheless, the absence of a recited term in the Specification is not dispositive so long as the disclosure reasonably supports the limitation.

Therefore, the issue before us is, notwithstanding the absence of the term “*primary* international mobile subscriber identity” in the Specification, whether the disclosure nonetheless reasonably supports this recited limitation. For the following reasons, we find that it does.

To satisfy the written description requirement, the disclosure must convey with reasonable clarity to skilled artisans that Appellants were in possession of the claimed invention as of the filing date. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). We agree with Appellants (App. Br. 7) that the term “primary” in connection with an international mobile subscriber identity does not necessarily imply the existence of secondary identities. As Appellants indicate, the term “primary” can mean an essential component or principal object (*id.*). Indeed, one of the Examiner’s own definitions of “primary” evidences this fact.⁴

⁴ See Ans., at 9 (defining “primary,” in pertinent part, as “[s]erving as or being an *essential component*, as of a system; basic”) (emphasis added).

We find that the international mobile subscriber identity disclosed in the Specification is an *essential component* for operating a mobile communication device using a subscriber identity module. As such, the Specification, in our view, conveys with reasonable clarity that the disclosed international mobile subscriber identity is a “primary” international mobile subscriber identity. We therefore will not sustain the Examiner’s rejection of claims 1-5 and 7-9 under 35 U.S.C. § 112, first paragraph.

The Anticipation Rejection

We now consider the Examiner’s anticipation rejection of claims 1-4 and 7-19 over the disclosure to Carrara. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444 (Fed. Cir. 1984); *W.L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554 (Fed. Cir. 1983).

Claims 13-19

The Examiner has indicated how the claimed invention is deemed to be fully met by the disclosure of Carrara (Ans. 4-8). Regarding independent claim 13, Appellants argue that Carrara does not teach or suggest using the *same* international mobile subscriber identity in both the unblocked and blocked modes, as claimed. According to Appellants, Carrara uses one subscriber identity (IMSI1) when unblocked, but a *different* subscriber identity (IMSI2) when blocked (App. Br. 9-10; Reply Br. 8).

The Examiner acknowledges that while Carrara uses two “passcodes” for security reasons, the Examiner nonetheless asserts that “there is no technical barrier/reason that would prevent Carrara from storing and using the same code/IMSI for the two different passcodes (as per the appellant’s design).” As such, the Examiner concludes that Carrara fully reads on the claims (Ans. 11). The Examiner adds that Carrara’s two passcodes *could be* the same number, “although this would negate his ‘strong’ security measures” (Ans. 12; emphasis added).

At the outset, we note that the last clause of independent claim 13 expressly recites that the access request is granted if the identity is in a blocked mode and the request is for the *same* subscriber identity (i.e., the same subscriber identity requested in an unblocked mode recited in the third clause of the claim).

The issue before us, then, is whether Carrara expressly or inherently discloses using the *same* subscriber identity in the blocked and unblocked modes. For the following reasons, we conclude that it does not.

Carrara discloses a system that enables access to a telecommunications service to be unblocked remotely in the event that access to the service is blocked (i.e., after certain blocking events occur, such as repeatedly entering the incorrect personal identification code (PIN)). When blocked, the user’s telephone is restricted to communicating with a service center. In this mode, the service center can then send unblocking commands directly to the user’s phone to allow the user to resume normal (unblocked) operation (Carrara, Abstract; col. 2, ll. 17-36; Figs. 1 and 2).

During normal operation, the user initially powers on the telephone and enters a PIN. If valid, an identification process commences in which the

user's phone sends to the service center an encrypted message SUB1 of data corresponding to the mobile phone subscription. The message SUB1 is produced from subscription data located in the phone's memory, including a mobile telephone subscription identification number IMSI1 and a secret digital encrypting key K1 (Carrara, col. 3, l. 55 - col. 4, l. 32; Fig. 2 (last six lines)).

If the user repeatedly enters an invalid PIN, however, the system then enters a blocked state. In that event, the user's phone sends a supplementary set of data SUB2 to the service center to enable the service center to recognize this blocked state as well as to identify the mobile telephone subscription (Carrara, col. 5, l. 39 - col. 6, l. 2; Fig. 2). Specifically, the supplementary set of data SUB2 includes the *same* mobile telephone subscription number, but *another* identifier number IMSI2 and *another* secret encrypting key K2 with respect to the SUB1 data (i.e., IMSI1 and K1) used in normal operation (Carrara, col. 6, ll. 3-10; emphasis added). Upon receipt of this supplementary data set SUB2, the service center can then send unblocking commands to the user's telephone to enable the user to resume normal operation (Carrara, col. 6, ll. 35-52; Fig. 2).

Based on this functionality, we agree with Appellants that Carrara does not expressly or inherently disclose using the *same* subscriber identity in the blocked and unblocked modes. As noted above, IMSI1 is used in the unblocked mode. But Carrara expressly states that *another* identifier number IMSI2 is used in the blocked mode. There is simply nothing in Carrara to indicate that IMSI1 and IMSI2 are the same. In fact, Carrara's characterizing IMSI2 as *another* identifier number with respect to IMSI1 actually suggests just the opposite.

The Examiner’s contention that Carrara’s two passcodes *could be* the same number is merely speculative, lacks any evidentiary support, and actually runs counter to Carrara’s suggestion noted above of using different numbers. In any event, even if we assume that the same numbers could be used for IMSI1 and IMSI2 in Carrara, mere possibilities are not enough for anticipation. For anticipation, the subscriber identities in Carrara must *necessarily* be the same -- a requirement that the Examiner has simply failed to show.

For the foregoing reasons, we will not sustain the Examiner’s rejection of independent claim 13 or dependent claims 14-19, which are not separately argued, for similar reasons.

Claims 1-9

We will, however, sustain the Examiner’s rejection of representative independent claim 1.⁵ Appellants argue that IMSI1 in Carrara is the “primary” identifier number used in normal operation (i.e., in an unblocked mode), and IMSI2 is not a “primary” identifier number, but rather a “supplementary” identifier number used in the blocked mode. As such, Appellants argue, Carrara does not teach granting access to a *primary* international mobile subscriber identity in a blocked mode as claimed (App. Br. 11; Reply Br. 8).

While we agree with Appellants that Carrara’s IMSI1 corresponds to the recited “primary” international mobile subscriber identity, the scope and

⁵ Appellants argue claims 1-9 together as a group. *See* App. Br. 10-11. Accordingly, we select claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(vii).

breadth of the claim language does not preclude the teachings of Carrara. Significantly, the last clause of independent claim 1 calls for the mobile communication device subscriber identity to *comprise* a primary international mobile subscriber identity. This open-ended language does not preclude the mobile communication device subscriber identity to include additional international mobile subscriber identities including supplemental international mobile subscriber identities such as IMSI2 in Carrara.⁶ That is, since Carrara grants access to a mobile communications device subscriber identity in a blocked mode -- an identity whose breadth does not preclude both IMSI1 and IMSI2 -- the limitation is fully met.

Furthermore, nothing in the claim precludes Carrara's ultimate granting of access to the primary international mobile subscriber identity IMSI1 via the intervening utilization of the supplementary data SUB2 (i.e., IMSI2) in the blocked mode. That is, when the identity module is in a blocked mode, access to IMSI1 is *ultimately* granted via the intervening process in the blocked mode.

For the foregoing reasons, we will sustain the Examiner's rejection of representative independent claim 1 and claims 2-9 which fall with claim 1.

⁶ See, e.g., MPEP § 2111.03, Rev. 6, Sept. 2007 (noting that the transitional term "comprising" is inclusive or open-ended and does not exclude additional, unrecited elements). However, this open-ended language is distinguished from the closed transitional phrase "consisting of" which excludes any element, step, or ingredient not specified in the claim. *Id.*

Claims 10-12

We will also sustain the Examiner’s rejection of representative independent claim 10.⁷ Unlike claim 1, claim 10 does not specify a primary international mobile subscriber identity, but rather recites “international mobile subscriber identity data” without any further distinction as to the *type* of international mobile subscriber identity data. As such, the scope and breadth of this limitation does not preclude the recited “international mobile subscriber identity data” to include both IMSI1 and IMSI2 data components.

Therefore, in an unblocked mode, access in Carrara is granted to the user information and a component of the “international mobile subscriber identity data” (IMSI1). Moreover, in a blocked mode, Carrara (1) denies access to the user information, and (2) grants access to another component of the “international mobile subscriber identity data” (IMSI2).

While IMSI1 and IMSI2 are different data components as noted above, they both nonetheless constitute “international mobile subscriber identity data.” Therefore, we find the functionality of Carrara fully meets representative independent claim 10. The Examiner’s rejection of claim 10 is therefore sustained, as well as claims 11 and 12 which fall with claim 10.

The Obviousness Rejections

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so

⁷ Since Appellants argue claims 10-12 together as a group (App. Br. 11-13), we select claim 10 as representative. *See* 37 C.F.R. § 41.37(c)(1)(vii).

doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

If the Examiner's burden is met, the burden then shifts to the Appellants to overcome the *prima facie* case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Claim 20

Since the Examiner's obviousness rejection of dependent claim 20 is based primarily on the disclosure of Carrara, and the Examiner's reliance on Official Notice does not cure the deficiencies noted above with respect to Carrara, we will not sustain the Examiner's rejection of claim 20 for similar reasons as we indicated previously with respect to independent claim 13.

Claim 5

Regarding the Examiner's rejection of claim 5 over the disclosures of Carrara and Kokubu, we find that the Examiner has established at least a *prima facie* case of obviousness that Appellants have not persuasively rebutted. Specifically, the Examiner has (1) pointed out the teachings of Carrara, (2) noted the perceived differences between Carrara and the claimed invention, and (3) reasonably indicated how and why the reference would have been modified to arrive at the claimed invention (Ans. 8-9). Once the Examiner has satisfied the burden of presenting a *prima facie* case of obviousness, the burden then shifts to Appellants to present evidence and/or arguments that persuasively rebut the Examiner's *prima facie* case. *See In re*

Appeal 2007-3983
Application 10/295,978

Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Appellants did not separately argue the Examiner's obviousness rejections, let alone particularly point out errors in the Examiner's reasoning to persuasively rebut the Examiner's prima facie case of obviousness. Since Appellants have not persuasively rebutted the Examiner's prima facie case of obviousness for claim 5, the obviousness rejection of this claim is therefore sustained.

DECISION

We have not sustained the Examiner's rejection of claims 1-5 and 7-9 under 35 U.S.C. § 112, first paragraph. Neither have we sustained the Examiner's prior art rejections of claims 13-20. We have, however, sustained the Examiner's prior art rejections with respect to claims 1-5 and 7-12. Therefore, the Examiner's decision rejecting claims 1-5 and 7-20 is affirmed-in-part.

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).

Appeal 2007-3983
Application 10/295,978

AFFIRMED-IN-PART

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