

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the **PATENT APPLICATION** of:

InterDigital Patent Holdings, Inc.

Application No.: 15/413,072

Confirmation No.: 3243

Filed: January 23, 2017

For: METHODS TO ENABLE WLAN
PROXIMITY SERVICE

Group: 2466

Examiner: DECKER, CASSANDRA L

Our File:

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Date: June 12, 2020

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Communication is being filed in response to the Final Office Action dated March 12, 2020 (hereinafter "Office Action"). A Pre-Appeal Brief Review is hereby requested in the above application for the following reasons:

Claim 1 has Proper Antecedent Basis

Claim 1, 2, and 8-10 are rejected under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventors regard as the invention.

The Office Action on page 3 recites that claim 1 “appears to have antecedent basis in the claim[.]” however proceeds to reject the claim and its dependents. No other basis under section 112 is given for the Applicant to respond to.

Respectfully, for at least the reason that claim 1 does have appropriate antecedent basis for each and every element, thus it appropriately points out and distinctly claims the subject matter, the Applicant respectfully requests the rejection over claim 1 and its dependents be withdrawn.

Final Office Action Does Not Give a Reason to Combine the Cited

References

Claims 1, 2, 10-12, 14, 15, 17, and 19 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Johnsson et al. (US 2014/0036793) (hereinafter “Johnsson”) in view of Mgrdechian et al. (US 2011/0276412) (hereinafter “Mgrdechian”), Fodor et al. (US 2014/0122607) (hereinafter “Fodor”), and Yu et al. (US 2011/0098043) (hereinafter “Yu”).

One of skill in the art would not combine Johnsson and Mgrdechian. Johnsson is directed to device-to-device discovery and communication. Mgrdechian is directed to dating and entertainment websites. One of skill in the art would not modify Johnsson to employ an identifier, for example, a username used in the dating website of Mgrdechian. This is true, because the identifier used in the UE discovery request of Johnsson, sent by a UE to the EPC, identifies a user equipment (UE) which is understood by other UEs and the EPC.

In contrast, a username of the dating website of Mgrdechian, would not be understood to be the EPC of Johnsson. Furthermore, the dating website username

does not directly identify a UE operable in a wireless network such as Johnsson. Instead, the username of Mgrdechian identifies a particular user of the web based entertainment system. The username does not identify user equipment such that the EPC of Johnsson would be able to identify a UE from it. This is because the username correlates to a user of a website. For example, the FOA cites paragraph 28 of Mgrdechian, however this paragraph refers to the use of identification to download images correlated with a different user's account. The identification is not directly correlated to a UE or even device-device communication.

Yu and Fodor do not solve the deficiencies of Johnson and Mgrdechian.

Respectfully, for at least the reason given above, the Applicant respectfully submits that Johnsson, Mgrdechian, Fodor, and Yu, alone or in combination fail to teach all the elements of claim 1. Claims 11 and 16 recite similar elements to claim 1 and are also not taught by the cited references of record for the same reasons given above.

Despite and in addition to the arguments above, the rejection of claim 1 is improper in that the reasons given on Pages 3 and 4 of the FOA why the combination of elements from Johnsson, Mgrdechian, Fodor, and Yu would be made by one skilled in the art rely on the benefit of hindsight. As stated in the Applicant's Reply filed January 31, 2020, Mgrdechian, Fodor, and Yu "are silent as to a ProSe function receiving 'a request from the first WLAN ProSe capable WTRU, for EPC support to establish a WLAN ProSe connection to the second WLAN ProSe capable WTRU...' as is required by amended claim 1. By providing a ProSe function in the EPC to support the establishment of a WLAN ProSe connection, the EPC may

maintain control of charging policies for offline (outside of EPC) communications.

This functionality is not taught, or suggested, by the cited five-way combination of references detailed above.” (See 1/31/2020 Reply, page 7) The FOA declined to address this argument, instead concluding it was moot in light of Johnsson and asserted new grounds of rejection. However, this fails to provide rationale for why the cited references now render ProSe functionality in the EPC obvious.

Particularly in light of the above argument regarding Mgrdechian.

As MPEP § 2143 states “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reasons why the claimed invention would have been obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” Moreover, the Supreme Court in KSR stated, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. ... [I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed invention does.” KSR Int’l Co. v. Teleflex Inc., 550 U. S. 398, 418 (2007).

Conclusion

In view of the foregoing remarks, Applicant respectfully requests a
Pre-Appeal Brief Review and a notice to that effect is respectfully requested.

Respectfully submitted,

InterDigital Patent Holdings, Inc.

By /Wesley T. McMichael/
Wesley T. McMichael
Registration No. 56,982

Volpe and Koenig, P.C.
30 South 17th Street, 18th Fl.
Philadelphia, PA 19103-4009
Telephone: (215) 568-6400
Facsimile: (215) 568-6499
WTM/srp