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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/803,946	07/20/2015	Sang Soo LEE	2191-52 (2015-OPSE-7320)	2897
66547 7590 09/02/2016 THE FARRELL LAW FIRM, P.C. 290 Broadhollow Road Suite 210E Melville, NY 11747			EXAMINER NGUYEN, SIMON	
			ART UNIT 2649	PAPER NUMBER
			MAIL DATE 09/02/2016	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 14/803,946	Applicant(s) LEE ET AL.	
	Examiner SIMON NGUYEN	Art Unit 2649	AIA (First Inventor to File) Status Yes

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 7/27/16.
☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on ____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.

4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims*

5) ☒ Claim(s) 1-20 is/are pending in the application.
5a) Of the above claim(s) ____ is/are withdrawn from consideration.

6) ☐ Claim(s) ____ is/are allowed.

7) ☒ Claim(s) 1-20 is/are rejected.

8) ☐ Claim(s) ____ is/are objected to.

9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

Application Papers

10) ☐ The specification is objected to by the Examiner.

11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

Certified copies:

a) ☐ All b) ☐ Some** c) ☐ None of the:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. ____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

** See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b)
Paper No(s)/Mail Date ____.

3) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.

4) ☐ Other: ____.

The present application, filed on or after March 16, 2013, is being examined under the first inventor to file provisions of the AIA.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-20 have been considered but are moot because the arguments do not apply to any of the references being used in the current rejection.

Claim Rejections - 35 USC § 103

2. In the event the determination of the status of the application as subject to AIA 35 U.S.C. 102 and 103 (or as subject to pre-AIA 35 U.S.C. 102 and 103) is incorrect, any correction of the statutory basis for the rejection will not be considered a new ground of rejection if the prior art relied upon, and the rationale supporting the rejection, would be the same under either status.

3. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 11, and 16 are rejected under 35 U.S.C. 103 as being unpatentable over Nix (US 2015/0121066 A1).

Regarding claim 1, Nix discloses server 105, comprising: a first interface for transmit a request profile message to an application server (171) as a profile generation server and to receive a plurality of packets associated with a profile/information of a mobile phone 101 from the application server (figs. 1b-1d, 7-9, paragraph 90, 92, 152-165, 188, 189, 289, 298, 319, 367, 369); a processor (105b) for generating a file (such as updating information for the module 110/phone 101) from the plurality of packets (fig. 1c, paragraphs 273-274, 287-289, 298, 300-301); an authentication module for performing authentication with the application server and authenticate (by network firewall 104) an electronic device (101) including an embedded UICC (eUICC)/SIM (101e) (paragraph 217) and a second interface for transmitting the file to the authenticated electronic device (figs. 1b-f, 6a, figs. 7-11, paragraphs 217, 224, 226, 227, 229, 231, 266-269, 274, 279-308, 311-312), wherein Nix further discloses using new private and public keys after the SIM (module) has been installed without swapping out a SIM card (paragraph 15) or update keys for the module 101/device (paragraphs 188, 189, 230, 269, 273, 274), wherein the module 101 as a mobile phone (paragraph 209), wherein the updated keys for the eUICC/SIM of the phone are considered as profiles (paragraph 15, 67, 217), wherein Nix further discloses the public and private keys could be recorded in a file (paragraphs 68, 117, 125, 197, 207, 211) or configuration file (paragraph 211, 213) in different forms which includes images (paragraph 168) or a virtual SIM or a physical SIM card ((paragraphs 217, 219) and wherein the server 105 as a virtualized server, VPN (paragraphs 100, 129, 176). From the teaching of Nix, it is obviously the configuration file for updating the eUICC of the

phone/device 101 comprises an image file/or the virtual SIM which is known those skilled in the art.

Regarding claim 11, this claim is rejected for the same reason as set forth in claim 1 as a method.

Regarding claim 16, Nix discloses a mobile device 101 (figs. 1b, e), comprising: an authentication unit configured to perform an authentication procedure on provisioning profiles to a server (105) and to receive the authentication from the server (fig. 1e-f); a memory for storing data received from the server (fig. 1e); an embedded SIM (110) on which the profiles are installed (fig. 1e); a processor (101b) configured to initiate a process of installing/installation the profile on the eSIM based upon an input key (paragraphs 120, 173, 185, 195, 217, 224, 244, 253, 262, 264, 267, 281), wherein the profile is downloaded/transferred from the server to the embedded UICC of the mobile device/phone in images (paragraph 168) or a virtual SIM (paragraphs 217, 219).

5. Claims 1-20 are rejected under 35 U.S.C. 103 as being unpatentable over Nix (US 2015/0163056 A1) in view of Desai et al. (US 2015/0302398 A1).

Regarding claim 1, Nix discloses server 105 for downloading eUICC profile keys from a subscription manager/server (109) and transferring a selectively downloaded eUICC profile key to an eUICC(108) of a mobile device/phone 101 in virtualization/VPN (image) (fig. 1a, paragraphs 48, 65, 72, 90, 111, 125, 139, 142, 144, 167, 174, 199, 214, 225, 252, 261, 263-264, 273, 278, 281, 283, 284), comprising: a first interface for transmitting a request profile message to the subscription manager 109 as a profile

generation server and receiving a plurality of packets/eUICC profile/data keys and selecting an eUICC profile key associated with a profile/information of the embedded UICC of the mobile device/phone 101 (fig. 1a, paragraph 104); the server 105 (it should be noted that a processor is inherently in the server) for generating an eUICC profile for an embedded UICC (108) of the mobile phone 101 (paragraphs 53-56); an authentication module for performing authentication with the subscription manager and the mobile phone 101 included the embedded UICC (fig. 6, paragraphs 24, 50, 75, 96, 104, 115, 147, 150, 198, 201, 204, 220, 222, 223); a second interface (between the device 101 and the server 105) for transmitting the image file to the authenticated device 101 (fig. 1a,1f, 2a-5, paragraphs 77-79, 99-112, 122-151, 154-198), wherein Nix discloses images, files (paragraph 225) or a virtualize UIC such as data operations to a physical UICC (paragraphs 16, 55), wherein the term “virtualize UICC to the physical UICC is obviously an image file.

Desai, in the same endeavor (abstract, figs. 1, 8-9) discloses a car provisioning (paragraphs 81, 224, 288, 384), comprising: a card image (paragraph 210, 251), files, images (paragraph 219, 222, 375, 400, 403) for provisioning an embedded card of a phone/device (figs. 1, 8-9, paragraphs 181, 209, 213, 221, 232, 224, 357, 384, 523). Therefore, it would have been obviously to one skilled in the art at the time the invention was made to have Nix, modified by Desai in order to improve a method of provisioning SIM/UICC.

Regarding claim 11, this claim is rejected for the same reason as set forth in claim 1 as a method.

Regarding claim 16, Nix discloses a mobile device 101 (figs. 1a-f), comprising: an authentication unit configured to perform an authentication procedure on provisioning profiles to a server (105) and to receive the authentication from the server (fig. 1f, 4-6); a memory for storing data received from the server (fig. 1b-c); an eUICC (108) on which the profiles are installed (fig. 2); a processor (101b) configured to initiate a process of installing/installation the profile on the eSIM based upon an input key (fig. 1a-6, paragraphs 75, 79, 94-99, 102-104, 108, 115-116, 127-135, 150, 159, 193-204), wherein the profile is downloaded/transferred from the server to the embedded UICC of the mobile device/phone in images (paragraph 225) or a virtualized UICC (paragraphs 16, 55).

Regarding claims 2, 12, and 20, Nix further discloses the request message comprises a plurality of profiles (107a-d) (figs. 1a, 1c, and 2a-e).

Regarding claim 3, Nix further discloses a predefined key set (figs. 1a, 1c, and 2a-e).

Regarding claims 4 and 14, Nix further discloses installation (paragraphs 90, 174, 214, 281), activation (paragraphs 19, 57), or remove (paragraph 87).

Regarding claim 5, Nix further discloses downloading the virtual SIM/UICC via a wireless connection network (abstract) which means that Nix discloses an OTA.

Desai further discloses an OTA (paragraphs 77, 80).

Regarding claims 6 and 13, Desai further discloses performing a test on widget (card) (paragraphs 102, 174, 180, 185, 187, 193). It should be noted that using a

message command for the mobile device/phone to test which is known to those skilled in the art.

Regarding claims 7 and 15, Nix further discloses a profile ID/address, MNO information, an ID/address of the profile server, a profile type (figs. 1a-2e, paragraphs 89, 94, 105, 106, 114, 154, 197, 201, 202, 221, 223).

Regarding claim 8, Nix further discloses a dedicated line (paragraph 118, 133, 140).

Regarding claim 8, Desai further discloses a dedicated line (paragraphs 561, 563).

Regarding claim 9, Nix further discloses a wired line/Ethernet (paragraph 86).

Regarding claim 10, Nix further discloses the authentication of the profile server/subscription manager using a predefined key set (figs 1a-2e, 6).

Regarding claim 17, Nix further discloses CPU 101B for receiving authenticating information as the event by a user of the device/phone 101 (fig. 1b-c, paragraphs 55-56, 75, 79, 93-94, 96-99, 102-104, 203, 216, 281).

Regarding claim 18, Nix further discloses the CPU for identifying a profile among the plurality of profiles based upon addresses/identity, respectively (paragraphs 54, 114, 123, 203), which is obviously that Nix discloses identifying a type of an input/installation data.

Regarding claim 19, Nix further discloses input/output interface (paragraph 55, 67, 67, 84, 100, 133, 137, 140, 148, 153, 162, 166), a user authentication,

installation/loading of data (paragraphs 19-22, 128-129, 142, 150, 184, 186, 187, 199-205).

6. Claim 16 is rejected under 35 U.S.C. 103 as being unpatentable over Lee et al. (US 2015/0281198 A1).

Regarding claim 16, Lee discloses a terminal device (200) (abstract, fig. 1), comprising: an authentication unit configured to perform an authentication procedure on provisioning profiles to a server and to receive the authentication from the server (fig. 2, paragraphs 65-67); a memory for storing data received from the server (figs. 3, 7, paragraph 71); an eUICC on which the profiles are installed (fig. 2, paragraph 67-68). However, Lee failed to teach a processor in terminal device. It should be noted that a processor is obviously in a terminal device for processing the authentication in order to install the provisioning of the eUICC which is known to those skilled in the art.

7. Claim 16 is rejected under 35 U.S.C. 103 as being unpatentable over Koshimizu et al. (US 2016/0212617 A1).

Regarding claim 16, Koshimizu discloses a terminal device (200) (abstract, figs. 1), comprising: an authentication unit configured to perform an authentication procedure on provisioning profiles to a server and to receive the authentication from the server (figs. 2-3, paragraphs 83, 85-90, 99); a memory for storing data received from the

server (fig. 21); an eUICC (100) on which the profiles are installed (fig. 2). It should be not that a processor is obviously in the terminal device.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon Nguyen whose telephone number is (571) 272-7894. The examiner can normally be reached on Monday-Friday from 7:00 AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yuwen (Kevin) Pan can be reached on (571) 272-7855. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

August 31, 2016

/SIMON D NGUYEN/

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Primary Examiner, Art Unit 2649

Notice of References Cited	Application/Control No. 14/803,946		Applicant(s)/Patent Under Reexamination LEE ET AL.	
	Examiner SIMON NGUYEN		Art Unit 2649	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	CPC Classification	US Classification
*	A	US-2015/0163056 A1	06-2015	Nix; John A.	H04L9/0869	380/46
*	B	US-2015/0121066 A1	04-2015	Nix; John A.	H04W52/0235	713/155
*	C	US-2015/0302398 A1	10-2015	Desai; Mehul	G06F8/60	705/41
*	D	US-2016/0212617 A1	07-2016	Koshimizu; Takashi	H04L9/0844	1/1
*	E	US-2015/0281198 A1	10-2015	Lee; Hyung Jin	H04W8/18	726/7
*	F	US-2014/0031012 A1	01-2014	PARK; Chul Hyun	H04W12/06	455/411
*	G	US-2013/0339305 A1	12-2013	KIM; Kwan Lae	G06F17/30283	707/652
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FOREIGN PATENT DOCUMENTS

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*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
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