

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KEVIN B. EASTERBROOK, ROBERT A. KNEE,  
JOEL G. HASSELL and MICHAEL D. ELLIS

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Appeal No. 2003-1598  
Application 09/213,851

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ON BRIEF

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Before KRASS, JERRY SMITH and DIXON, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-104, which constitute all the claims in the application.

Appeal No. 2003-1598  
Application 09/213,851

The disclosed invention pertains to an e-mail notification and messaging system. A local client device receives both the e-mail notifications and the e-mail messages. A particular feature of the invention is that e-mail messages are retrieved over a different communications link than the e-mail notifications, and the e-mail notifications are received over a low bandwidth communications link.

Representative claim 1 is reproduced as follows:

1. An e-mail notification and messaging system for providing e-mail messages and e-mail notifications from an e-mail service system to local client devices of a plurality of users, the system comprising:

an e-mail service system configured to receive e-mail messages for a plurality of users and configured to provide e-mail notifications and e-mail messages to the local client devices of the plurality of users;

a given local client device from among the local client devices that is configured to receive e-mail notifications from the e-mail service system and that is configured to retrieve e-mail messages from the e-mail service system;

a first communications link over which the local client device retrieves e-mail messages from the e-mail service system;  
and

a second communications link separate from the first communications link over which the e-mail service system provides e-mail notifications to the local client device, wherein the second communications link is a low bandwidth communications link.

Appeal No. 2003-1598  
Application 09/213,851

The examiner relies on the following reference:

Dillon	6,067,561	May 23, 2000 (filed Feb. 7, 1997)
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Claims 1-104 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Dillon.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of anticipation relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the disclosure of Dillon does not fully meet the invention as set forth in claims 1-104. Accordingly, we reverse.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of

Appeal No. 2003-1598  
Application 09/213,851

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, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to independent claims 1 and 55, the examiner has indicated how he finds the claimed invention to be fully met by the disclosure of Dillon. Of particular note in the rejection is the examiner's position that the e-mail notification communications link in Shtivelman, although nominally disclosed as a high bandwidth link, could be considered a low bandwidth link because there could be higher bandwidth links such as fiber optics. The examiner also asserts that Shtivelman teaches that e-mail notifications can be sent over a low bandwidth link as taught in the prior art or over a high bandwidth link as in Shtivelman's invention [answer, pages 3-7].

With respect to independent claims 1 and 55, which stand or fall together [brief, page 7], appellants argue that Dillon only discloses using a high speed link for e-mail notifications. Appellants assert that the portions of Dillon relied on by the

Appeal No. 2003-1598  
Application 09/213,851

examiner fail to support the examiner's position that Dillon teaches low speed links for e-mail notifications in the manner recited in appellants' claims. Appellants note that the prior art pagers described in Dillon, which use low speed links for e-mail notification, are not disclosed as being used with Dillon's two-link system. Appellants argue that the examiner has selected elements from a prior art device and combined them with elements from Dillon's disclosed invention in order to meet the claimed invention [brief, pages 7-16].

The examiner responds that Dillon clearly teaches a low speed link for e-mail notifications in column 3, lines 1-11 and column 2, lines 19-22. The examiner asserts that the prior art device disclosed in Dillon is appellants' claimed invention [answer, pages 11-13].

Appellants respond that the e-mail notifications in Dillon use a high speed link. Appellants also respond that the prior art pager described in Dillon does not meet the claimed invention because the pager is separate from the user's e-mail message device [reply brief, pages 4-6].

We do not sustain the examiner's rejection of independent claims 1 and 55 for essentially the reasons argued by appellants in the briefs. As noted by appellants, neither the prior art

pager nor Dillon's invention meets the claimed invention by itself. The prior art pager does not meet the claimed invention because the pager is not a client device that is configured to receive e-mail notifications and e-mail messages as claimed. The pager only receives e-mail notifications. Dillon's invention does not meet the claimed invention because e-mail notifications are sent over a high speed link. The examiner's attempt to identify the high speed link of Dillon as a low speed link because it may not be the highest speed link available is totally without merit. Dillon calls the link a high speed link and that is what is disclosed and suggested to the artisan. Since neither the prior art pager nor Dillon's invention meets the claimed invention for reasons just noted, the examiner has attempted to combine the low speed communications link of the prior art pager with the two-link device of Dillon's invention. These are separate devices, however, and there is no indication that elements from these two separate devices can be combined in a single embodiment as proposed by the examiner.

It would have been helpful if the examiner had considered the possibility that his position might have been incorrect, and based on that possibility, had provided us with a factual record on whether the claimed invention would have been obvious over the

Appeal No. 2003-1598  
Application 09/213,851

teachings of Dillon. Since we have no findings on the question of obviousness before us, we decline to consider that issue on this record. We leave it to the examiner to consider whether an appropriate rejection under 35 U.S.C. § 103 can be supported by the prior art of record or by any additional prior art.

In summary, we have not sustained the examiner's rejection of independent claims 1 and 55. Therefore, we also do not sustain the examiner's rejection of any of the dependent claims. Accordingly, the decision of the examiner rejecting claims 1-104 is reversed.

REVERSED

ERROL A. KRASS	)	
Administrative Patent Judge	)	
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	)	
JERRY SMITH	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
JOSEPH L. DIXON	)	
Administrative Patent Judge	)	

Appeal No. 2003-1598  
Application 09/213,851

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