

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

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte EDWARD E. KELLEY

Appeal No. 2006-0489
Application No. 09/433,504

ON REQUEST FOR REHEARING

Before HAIRSTON, KRASS, and BARRY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

I. BACKGROUND

A patent examiner rejected claims 1-10 and 12-20. The appellant appealed therefrom under 35 U.S.C. § 134(a). We affirmed. Pursuant to 37 C.F.R. § 41.52(a)(1), the appellant now asks us to reconsider our affirmance. We grant his request.

II. OPINION

"Rather than reiterate the positions of the examiner or the appellant *in toto*, we focus on the point of contention therebetween." *Ex parte Kaysen*, No. 2003-0553, 2004 WL 1697755, at *2 (B.P.A.I. 2004). The examiner finds, "Since the communications terminal of Moon is for sending and receiving e-mail, and e-mail does not change in transit, and so identifiers must be present upon creation in order to result

in classification. . . ." (Examiner's Answer at 5.) He further finds, "Morikawa discloses an electronic mail terminal utility 5 creates a mail M by filling in the envelop part ME as the directory data D1 to D13, which include specifying a folder (D12) for storing mail at the receiving side when the receiving side receives the mail (col. 7, lines 7-50)." (*Id.* at 6.)

The appellant argues, "Moon is limited to categorizing received e-mails at a receiving computer and storing the same thereon in directories depending upon the type of e-mail received using a messaging application 26. (Col. 4. line 5 to col. 5, line 11.)" (Reply Br. at 5.) He also argues that Morikawa's "attachment file alone does not include the necessary information required for being electronically transmitted to a recipient's network and, as such, cannot and does not constitute an e-mail message." (Req. Reh'g at 3.)

"In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the independent claims at issue to determine their scope. Second, we determine whether the construed claims would have been obvious." *Ex Parte Cuomo*, No. 2003-0509, 2004 WL 4978831, at *2 (B.P.A.I. 2004).

A. CLAIM CONSTRUCTION

"Analysis begins with a key legal question c *what is the invention claimed?*" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "the PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324, 72 USPQ2d 1209, 1211 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Here, independent claim 1 recites in pertinent part the following limitations:
"selecting at said first client computer by a sender of said e-mail message a category identifier for said e-mail message from said plurality of category identifiers. . . ."
Independent claims 5, 9, 14, 15, 16, 17, 18, 19, and 20 include similar limitations.
Giving the independent claims the broadest, reasonable construction, the limitations require allowing an operator to select a category identifier for an e-mail message.

B. OBVIOUSNESS DETERMINATION

"Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious." *Ex Parte Massingill*, No. 2003-0506, 2004 WL 1646421, at *3 (B.P.A.I.. 2004). "In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, Moon describes its "invention [a]s directed toward . . . a mailing system which doubles as a filing system for congruently categorizing electronic mail received at a user communications device and directly storing the received electronic mail in an appropriate directory." (Col. 1, ll. 9-13.) Despite this description, however, the reference does not categorize different e-mail messages. Instead, Moon categorizes electronic "mail parcels . . . as, but not limited to, fax, voice, E-mail, scenery, business card, MIME, HTML, or attachment." (Col. 4, ll. 58-60.) Based on the category of a received mail parcel, the reference's "file module 32 upon recognizing the type of parcel

automatically names and places the incoming mail parcel into an appropriate 'mailbox' or directory 33-40. . . ." (*Id.* at ll. 61-64.)

For its part, Morikawa discloses an "electronic mail system 1 . . . composed of a host 2 undertaking the management of mailboxes MB; and a plurality of data processing systems 3, 4 for transmitting data to each other through the host 2." (Col. 5, ll. 60-63.) "Each of the data processing systems 3, 4 is a stand-alone computer system composed of, for example, a personal computer, display unit, hard disk etc. and various kinds of application programs can be used with it. In the data processing systems 3, 4, an electronic mail terminal utility 5, which is a kind of application program, performs processing on signals concerned with mail services provided by the host 2." (Col. 6, ll. 8-15.)

"When [an] operator selects the mail creating function, the utility 5 writes a mail name, an addresser's identification code and an addressee's identification code in the envelop part ME as the directory data D3, D4, D5, these pieces of information having been input by the operator through a key board. Thereafter, the utility 5 displays an interactive screen to require an operator's instruction and then executes editing processing for creating the content part MC (#11 to 13)." (Col. 7, ll. 22-29.)

"Upon receipt of an instruction to terminate the editing, the utility 5 executes attachment file register processing for writing the name of the attachment file AF (directory data D9) in the envelop part ME." (*Id.* at ll. 30-33.) "With this step, one attachment file AF has been registered as transmitted data." (*Id.* at ll. 42-43.) We find that the reference allows the operator to select a category identifier for the attachment file, which is to be transmitted. Specifically, "[w]hen specifying a folder for storing the attachment file AF at the receiving side, the name of the specified folder is written as the directory data D12." (*Id.* at ll. 44-46.) Upon receipt of the e-mail, "the transferring destination for the attachment file AF which is a sort of data file is set in accordance with specific data stored in the mail M, such as the directory data D12 in the envelop part ME. . . ." (Col. 8, ll. 62-65.)

Although Morikawa allows an operator to select the transferring destination for an attachment file, the reference supports the appellant's aforementioned argument that the attachment file does not constitute an e-mail message. (Req. Reh'g at 3.) More specifically, Morikawa's Figure 2, "a diagram showing the arrangement of data in a mail," (col. 5, ll. 40-41), depicts "message information" and an "attachment file" as distinct entities. Similarly, the reference describes "heading files HF that are a group of text data corresponding to message information and one or a plurality of attachment files AF that are attached to the heading files HF. . . ." (Col. 6, ll. 40-43.)

Absent a teaching or suggestion of allowing an operator to select a category identifier for an e-mail message, we are unpersuaded of a prima facie case of obviousness. Therefore, we reverse the rejection of claims 1-10 and 12-20.

III. CONCLUSION

In summary, we have granted the appellant's request for rehearing by reversing the rejection of claims 1-10 and 12-20 under § 103(a).

GRANTED

KENNETH W. HAIRSTON
Administrative Patent Judge

ERROL A. KRASS
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

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