

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HIROSHI ITOH

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Appeal No. 2006-2513  
Application No. 10/060,782

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ON BRIEF

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Before BARRY, BLANKENSHIP, and MACDONALD, Administrative Patent Judges.  
BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-21, which are all the claims in the application.

We affirm.

### BACKGROUND

The invention relates to a method of specifying destinations of electronic mail transmitted to multiple recipients including both a group name having multiple mail addresses and a personal name. (Spec. at 1.) Claim 1 is reproduced below.

1. A method of setting destinations of electronic mail transmitted using electronic mail software from a communication terminal to multiple destinations, comprising the steps of:

predefining in the electronic mail software an addition symbol to add two destinations selected from a list of destinations including a group name representing mail addresses of multiple members; and

placing said addition symbol between one and the other destinations in a destination section on a screen for composing an outgoing mail to thereby set destinations including the mail addresses of said one and the other destinations, wherein the addition symbol is selected from the group consisting of the + symbol and the & symbol.

The examiner relies on the following references:

Meister et al. (Meister)	US 6,671,718 B1	Dec. 30, 2003
Sheldon et al. (Sheldon)	US 6,708,205 B2	Mar. 16, 2004

Minich et al. (Minich), Searching the Web, available at <http://www.minich.com/interneteducation/searching/search.html>, last visited Aug. 12, 2004 (1999).

Claims 1, 2, 9, and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Meister and Sheldon.

Claims 3-8, 10-15, and 17-21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Meister, Sheldon, and Minich.

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We refer to the Final Rejection (mailed Mar. 18, 2005) and the Examiner's Answer (mailed Apr. 4, 2006) for a statement of the examiner's position and to the Brief (filed Aug. 24, 2005) and the Reply Brief (filed Jan. 17, 2006) for appellant's position with respect to the claims which stand rejected.

### OPINION

#### Meister and Sheldon -- claims 1, 2, 9, 16

The examiner finds that Meister teaches the steps of instant claim 1 except for the "addition signal" being selected from the group consisting of the "+" symbol and the "&" symbol. Meister teaches the use of a comma (e.g., Fig. 3) as an addition symbol. The rejection further relies on Sheldon, which teaches that various characters may be used as delimiters in electronic messaging systems to assist in the processing of e-mails. Sheldon col. 7, l. 57 - col. 8, l. 4. The examiner concludes that it would have been obvious, within the meaning of § 103, to have used a delimiter such as the "+" or the "&" as claimed.

Appellant contends there is no disclosure or suggestion in Sheldon to use one of the claimed symbols. In response to the examiner's taking of official notice that any symbol or combination of symbols can be (or could have been, at the time of invention) programmed as delimiters, appellant contends that the official notice has been traversed and the examiner should provide evidence in support of the allegation. (Brief at 8-11.)

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The USPTO may take notice of facts beyond the record which, while not generally notorious, are capable of instant and unquestionable demonstration as to defy dispute. In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970). In the instant case, appellant has not traversed the examiner's official notice. A "traverse" is not a demand for evidence. A "traverse" is a denial of an opposing party's allegations of fact. See Black's Law Dictionary Fifth Edition ("In common law pleading, a traverse signifies a denial."). Moreover, an adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the official notice. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA 1971).

Appellant does not deny that any symbol or combination of symbols can be (or could have been) programmed as delimiters. Appellant instead alleges that the scope of the prior art does not include use of the "+" symbol and/or the "&" symbol to add destinations selected from a list of destinations including a group name representing mail addresses of multiple members. (Brief at 10-11.) Appellant's allegation seems to be based on the view that machines in the prior art have not been programmed to process a "+" or a "&" in place of a ",", as described by Meister. However, the position does not speak to what the examiner alleges to be fact -- which we know to be fact -- and which, in any event, appellant has not denied.

We thus find that the evidence shows that the choice of programming of the character or characters to initiate the claimed functions represents an arbitrary design

choice to one skilled in the pertinent art. We are unpersuaded that the subject matter as a whole would not have been prima facie obvious to one skilled in the art at the time of invention.

Moreover, the portion of Sheldon referenced by the rejection of claim 1 also provides evidence that the programming choice, per se, of the particular characters to trigger processing in the machine does not relate to machine function beyond the programmer's selection of the character or characters to initiate a particular process.

In other words, at the machine level it does not matter whether the characters for input are to consist of commas or of plus symbols. The selection of a particular symbol for input does not change the underlying function of the machine; any symbol or group of symbols that are recognizable by the machine could be chosen to invoke the machine functions. As appellant notes at page 30 of the specification, the particular symbols have been chosen for convenience of the (human) electronic mail user. The difference in meaning between a “,” and a “+” is intelligible only to the human mind. As far as the electronic mail software and system is concerned, any symbol or group of symbols within its prior art character set would do.

Appellant does not claim different machine function with respect to the prior art, but argues that the characters for initiating the functions are different from those in the prior art. The particular data symbols that are to be input to the electronic mail software and system to initiate prior art machine functions consist of what has come to be known as nonfunctional descriptive material, as defined in Manual of Patent Examining

Procedure (MPEP) § 2106.01 (8th Ed., Rev. 5, Aug. 2006). The content of the nonfunctional descriptive material carries no weight in the analysis of patentability over the prior art. Cf. In re Lowry, 32 F.3d 1579, 1583, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994) (“Lowry does not claim merely the information content of a memory. . . . [N]or does he seek to patent the content of information resident in a database.”). As such, we are further unpersuaded that instant claim 1 distinguishes over the applied prior art.

We thus sustain the rejection of claim 1 under 35 U.S.C. § 103 as being unpatentable over Meister and Sheldon. Claims 2, 9, and 16 fall with claim 1.

Meister, Sheldon, and Minich

Claims 3, 4, 10

The examiner further relies on the teachings of Minich, in addition to those of Meister and Sheldon, in the § 103 rejection applied against claim 3.<sup>1</sup> Meister relates to the general problem of misdirection of electronic mail (e.g., col. 1, ll. 36-45). Meister teaches the capability of modifying lists of intended addressees (e.g., col. 3, ll. 40-56; Fig. 2). Meister provides examples of modifying or deleting addressees in sequence (col. 5, ll. 17-26; Fig. 6), and allowing deletion of particular addressees with a pointing device (col. 5, ll. 42-51).

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<sup>1</sup> We note in passing that “the other destination” in the fifth line of claim 3, as reproduced in the Brief’s claim appendix, lacks proper antecedent basis in the claims. “[T]he other destination” was changed from “an other destination” in an apparent error in the amendment filed November 24, 2004.

Appellant's arguments in defense of claim 3 seem to contend that the teachings of Minich are limited to searching for content on the World Wide Web. Minich, however, shows that the artisan was well acquainted with Boolean operators that may be represented by characters such as a plus or a minus symbol. We find no error in the conclusion that it would have been obvious to use "a subtraction symbol" as claimed for the convenience of the user. The subtraction symbol was well known as an operator for exclusion of content. Moreover, the subtraction symbol was well known in general mathematics (as appellant notes at page 30 of the specification), and chosen by appellant for what it represents to the human mind than for any improvement of machine function.

We therefore sustain the rejection of claim 3. We also sustain the rejection of claim 4 which, by its terms -- i.e., what the subtraction symbol "indicates to a user" -- is directed to nonfunctional descriptive material.

In response to appellant's arguments in the Brief, the examiner clarifies the rejection of claim 10 in the Answer. Appellant reproduces the "if" clauses of the claim in the Reply Brief, and alleges that the references do not teach or suggest any of the features contained within the "if" clauses. However, claim 10, by its terms, does not require any of the features within the "if" clauses. That is, reciting that "if" something is to occur does not require its occurrence. As such, the claim has not been shown to distinguish over the applied references. We sustain the rejection of claim 10.

Claims 5, 6-8, 11-15

Appellant's arguments in defense of claim 5 presuppose that the teachings of Minich are limited to World Wide Web searches. As we have indicated in our consideration of claim 3, we find the position to be untenable. We sustain the rejection of claim 5.

With respect to claims 7, 8, 13, and 15, appellant alleges that the references do not teach or suggest the features relating to "order specifying operation symbols." Appellant's argument in support of the allegation is that although Minich discloses the use of parentheses symbols, the reference states that the symbols are for nesting Boolean expressions. In appellant's view, Minich does not teach or suggest the use of parentheses symbols for specifying the order of priority for performing the operations. (Brief at 18-20.)

We disagree with appellant's assessment of the Minich reference, and in particular with what the "nesting" of Boolean (or algebraic) expressions constitutes. The examiner provides findings (Answer at 13) with respect to the artisan's understanding of Minich's teachings regarding the use of parentheses, which appellant has not persuasively rebutted. Appellant having failed to show error in the rejection of claims 7, 8, 13, and 15, we sustain the rejection.

With respect to claim 14, appellant contends that Meister (col. 5, ll. 17-27) does not teach that address deletion is performed before the transmission of the electronic mail so that only the group name is displayed in the destination section on a screen

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displayed at each destination. (Brief at 20-21.) In response to the examiner's findings in the Answer (at 9), appellant holds that the identified section of Meister does not teach the claimed deletion of the operation symbols. (Reply Brief at 14.)

Meister teaches at column 5, lines 17 through 27 that when the addressee is deleted, the system removes any delimiters from the header field that need to be removed. We consider the reference to provide ample support for the examiner's finding that Meister, when combined with Sheldon and Minich, teaches deletion of the operation symbols as claimed. We are not persuaded of error in the rejection of claim 14, and thus sustain the rejection.<sup>2</sup>

#### Claims 17-21

Appellant contends that claim 17 is patentable over the references because the combination does not teach or suggest assigning a new group name to destinations for registration in a destination list. (Brief at 21.) The examiner finds that the use of an address book by Meister inherently teaches assigning group names to destinations in a destination list (Answer at 9), that the presence of both group and individual e-mail names and aliases as used by Meister indicates that e-mail address groups may be formed and given group names and aliases (id. at 14), and that widely used e-mail programs are well known in the art to include such features as creating and managing

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<sup>2</sup> We also note that claim 14 is indefinite under 35 U.S.C. § 112, second paragraph, in that "the operation symbols" lacks proper antecedent basis in the claims.

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group lists and aliases (id.). Appellant argues that inherency cannot be used to reject a claim under 35 U.S.C. § 103 (Brief at 21-22), and while not alleging that well known e-mail programs do not include features such as creating and managing group lists and aliases, appellant complains that only Meister, Sheldon, and Minich have been named in the statement of the rejection (Reply Brief at 15).

Even assuming appellant's arguments with respect to "inherency" and improper procedure to be correct, appellant has not rebutted the examiner's finding that Meister's teachings are sufficient to demonstrate assigning a new group name to destinations for registration in a destination list in the prior art, even without the presumption of what is inherent or the presumption of what one skilled in the art knew apart from what is set forth in the text and drawings of Meister. Appellant's further argument in support of claim 17, and of claims 18 through 21, rests on the position that Meister, Sheldon, and Minich do not teach the claimed deletion of the operation symbols (Brief at 21-24; Reply Brief at 14-17), which rests in turn on the untenable position that the teachings of Minich are limited to Web searches. We sustain the rejection of claims 17 through 21.

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CONCLUSION

We have considered all of appellant's arguments but are not persuaded of error in the rejection of any claim. The rejection of claims 1-21 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a). See 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

LANCE LEONARD BARRY	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
HOWARD B. BLANKENSHIP	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
ALLEN R. MACDONALD	)	
Administrative Patent Judge	)	

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