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EXAMINER

RUIZ, ANGELICA

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RAYMOND P. STATA, ANDREW W. STACK,
TARAK GORADIA, PATRICK DAVID HUNT, and
THIRUVALLUVAN MG

Appeal 2010-007315¹
Application 10/966,259
Technology Center 2100

Before JEAN R. HOMERE, MICHAEL J. STRAUSS, and
LARRY J. HUME, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The real party in interest is Yahoo! Inc. (App. Br. 1.)

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 33-36, 39-42, and 79-84. Claims 1-32, 37, 38, 43-78 have been canceled. (App. Br. 1-2.) We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' Invention

Appellants invented a computer-implemented method for searching attachments in one or more e-mails for data specified in a search request to thereby display a list of e-mails that satisfy the request. (Spec., ¶¶ [0068]-[0072].)

Illustrative Claim

Independent claim 33 further illustrates the invention as follows:

33. A computer readable storage medium storing instructions which, when executed by one or more processors, cause the one or more processors to perform the steps of:

building an index based on content from at least one attachment associated with at least one email of a plurality of emails;

receiving a request to perform a search of said plurality of emails for emails that are associated with attachments whose content includes specified data;

in response to receiving the request, performing the steps of

(a) determining which emails of said plurality of emails satisfy said search; and

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(b) displaying emails that satisfy said search in a user interface (UI);

wherein determining which emails satisfy said search includes:

accessing said index to determine which attachments contain content that includes said specified data;

determining which emails are associated with the attachments that contain content that includes said specified data; and

determining that the emails that are associated with the attachments that contain content that includes said specified data satisfy said search.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatentability:

Gross US 2004/0143569 A1 Jul. 22, 2004

Pope US 2004/0153436 A1 Aug. 5, 2004

Cardoza, Patricia “Special Edition Using® Microsoft® Office Outlook® 2003” [online], September 25, 2003, Que, ISBN 0-7897-2956-3

Rejections on Appeal

The Examiner rejects the claims on appeal as follows:

1. Claims 33-35, 39-41, and 79-84 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Gross and Pope.

2. Claims 36 and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Gross, Pope, and Cardoza.

ANALYSIS

We consider Appellants' arguments *seriatim* as they are presented in the principal Brief, pages 5-14, and the Reply Brief, pages 1-3.

Dispositive Issue: Have Appellants shown that the Examiner erred in finding that the combination of Gross and Pope teaches or suggests *responsive to a search request, displaying an e-mail list that includes an attachment with a specified search term*, as generally recited in claim 33?

Appellants argue that neither Gross nor Pope teaches or suggests the disputed limitations emphasized above. In particular, Appellants argue that while Gross discloses determining whether an attachment within an e-mail contains a specified search string, Gross does not specify from which e-mail(s) the identified attachment was located. Rather, Gross merely publishes a list of retrieved attachments containing the specified string without indicating from which e-mails they are obtained. (App. Br. 6-9.) Further, Appellants submit that, while Pope discloses finding e-mails to which a particular file was attached when the file name is specified in the search, Pope does not teach searching the body of the file/attachment itself for the specified content. (*Id.* at 9.) Therefore, Appellants submit that Pope does not cure the deficiencies of Gross, and that because the proffered

combination would require a user to manually review the e-mails with the particular attachment containing the particular string, it does not render claim 1 unpatentable. (*Id.*)

In response, the Examiner finds that Pope's disclosure of determining which e-mails are associated with certain specified attachments complements Gross's disclosure of locating attachments within an e-mail containing a specified search string to teach the disputed limitations. (Ans. 17-21.)

On the record before us, we agree with the Examiner's findings and ultimate conclusion of obviousness. We note at the outset that Appellants and the Examiner do not disagree as to the material facts surrounding the individual disclosures of Gross and Pope. Rather, Appellants dispute the Examiner's finding that the combination of the cited references teaches or suggests the disputed limitations.

We note that while Appellants submit that the combination of Gross and Pope does not teach the disputed limitations, Appellants' detailed arguments attack the references individually, and not as the combination proffered by the Examiner. In particular, while Appellants acknowledge that Gross discloses locating, in an e-mail attachment, a requested search string, Appellants find fault in Pope's failure to disclose that same limitation, whereas Pope is relied upon for its teaching of identifying an e-mail associated with an attachment. We find that Pope's disclosure of identifying an e-mail associated with an attachment would allow users of Gross' system to readily locate and display a list of e-mails containing attachments that

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feature a specified search string. Therefore, we find that the combination of these two references would have predictably resulted in the disputed limitations. Appellants are reminded that one cannot show nonobviousness by attacking the references individually where the rejections are based on combinations of references. *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Here, the respective references relied on by the Examiner must be read, not in isolation, but for what the combination teaches or suggests when considered as a whole. We find nonetheless that the cumulative weight and the totality of the evidence on this record favor the Examiner's position that the combined disclosures of Gross and Pope teach or suggest the disputed limitations as detailed above.

Because the Examiner's response as set forth in the Answer has rebutted Appellants' arguments by a preponderance of the evidence, we find that Appellants have not shown error in the Examiner's conclusion that the proffered combination renders claim 33 unpatentable.

Further, because Appellants argue claims 34, 35, 39-41, and 79-84 together with claim 33, claims 34, 35, 39-41, and 79-84 falls together therewith for the same reasons set forth above. *See* 37 C.F.R. § 1.37(c)(1)(vii).

Regarding claims 36 and 42, Appellants argue that, while Cardoza discloses limiting a search to selected e-mail folders, Cardoza does not describe limiting the search only to the selected email fields. (App. Br. 11.) This argument is not persuasive. As pointed out by the Examiner, Cardoza's disclosure of allowing a user to restrict a "find now" search only to the

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header of an e-mail message describes restricting the search only to a selected field associated with “the header” of the e-mail. (Ans. 22-25.) Accordingly, we find no error in the Examiner’s rejection of claims 36 and 42 as being unpatentable over the combination of Gross, Pope, and Cardoza.

Further, Appellants raised additional arguments for patentability of claims 39, 79-84. (App. Br. 12-14.) We find, however, that the Examiner has rebutted in the Answer each and every one of those arguments by a preponderance of the evidence. (Ans. 26-27.) Therefore, we adopt the Examiner’s findings and underlying reasoning, which are incorporated herein by reference. Consequently, Appellants have failed to show error in the Examiner’s rejections of claims 39, and 79-84. See 37 C.F.R. § 1.37(c)(1)(vii).

DECISION

We affirm the Examiner’s rejections of claims 33-36, 39-42, and 79-84 as set forth above.

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

AFFIRMED

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