



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,785	01/29/2004	Carl Edward Werner	2003-0210	5857
83658	7590	01/22/2013	EXAMINER	
AT & T Legal Department - WS			WON, MICHAEL YOUNG	
Attn: Patent Docketing			ART UNIT	
Room 2A-207			PAPER NUMBER	
One AT & T Way			2449	
Bedminster, NJ 07921			MAIL DATE	
			DELIVERY MODE	
			01/22/2013	
			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.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CARL EDWARD WERNER

Appeal 2010-008037
Application 10/767,785
Technology Center 2400

Before ALLEN R. MACDONALD, KRISTEN L. DROESCH and
JUSTIN BUSCH, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant seeks review under 35 U.S.C. § 134(a) of a final rejection of claims 1, 3-6 and 8-11.¹ We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

BACKGROUND

The Appellant's invention relates to instant messaging (IM), particularly the use of IM to quickly and efficiently transmit updates to a group of computer users. Spec. ¶¶ 0001; Abs.

Independent claim 1 is illustrative and is reproduced below (disputed limitations in *italics*):

An arrangement for transmitting updates/alerts over a data network to a plurality of data network system users, the arrangement comprising:

a website update/alert administrator, coupled to the data network, for receiving update or alert messages from said network, said website update/alert administrator including

a database of instant messaging (IM) groups, each group including a set of members from the plurality of data network system users,

a target listing of various IM groups to associate sets of IM groups with different types of updates and alerts,

a transmission element for sending an automated IM to each member of each targeted IM group, the automated IM including the update/alert information; and

a listing of email addresses for each member of each IM group, wherein an email version of an update/alert is sent if a member is not involved in the IM session at the time the automated IM is sent.

¹ Claims 2 and 7 have been cancelled.

Rejections

Claims 1, 3, 5, 6, 8, 10 and 11 stand rejected under 35 U.S.C. § 103(a) as being obvious over Wang (U.S. 2002/0198946 A1) and Aravamudan (U.S. 6,301,609 B1).

Claims 4 and 9 stand rejected under 35 U.S.C. § 103(a) as being obvious over Wang, Aravamudan and Dalal (U.S. 2002/0065894 A1).

ISSUES

Did the Examiner err in finding that the combination of Wang and Aravamudan teaches or suggests “a website update/alert administrator including . . . a target listing of various IM groups,” as recited in claim 1?

Did the Examiner err in finding that the combination of Wang, Aravamudan and Dalal teaches or suggests “the automated IM includes a trailer portion,” as recited in dependent claims 4 and 9?

ANALYSIS

We have reviewed the Examiner’s rejection in light of the Appellant’s arguments in the Appeal Brief presented in response to the Final Office Action. We disagree with the Appellant’s conclusions. We highlight and address specific findings and arguments for emphasis as follows.

Claims 1, 3, 5, 6, 8, 10 and 11

The Appellant argues claims 1, 3, 5, 6, 8, 10 and 11 together as a group. We choose claim 1 as representative of the group. 37 C.F.R. § 41.37(c)(vii). We are unpersuaded by Appellant’s arguments as they are not commensurate in scope with the claim language. Br. 3-5. Claim 1 does not recite how the target listing of various IM groups are formed, defined, identified, created or retrieved.

Moreover, the Appellant attempts to distinguish the website update/alert administrator being the entity that includes a target listing of various IM groups from Wang's user-driven definition of a preferred delivery mode, and Aravamudan's grouping initiated at the user level. Br. 4-5. However, we note that Appellant's Specification also discloses that a user may play the role of administrator. *See* Spec. ¶ 0016 (“[I]t is to be understood that the various end users in an IM session may play of the role of ‘administrator’ as well, sending the alert/update to other members of the group.”).

For all these reasons, we sustain the rejection of claims 1, 3, 5, 6, 8, 10 and 11 as obvious over Wang and Aravamudan.

Claims 4 and 9

We are unpersuaded by the Appellant's additional arguments addressing the limitations of claim 4 and 9. Br. 5. We decline to narrowly interpret the claim term “trailer” such that it would be limited to a portion of a message from a message transmitter. Instead, the broadest reasonable interpretation applies to the term “trailer” such that it is not limited by whether it is sent by a transmitter or received by a receiver. The Appellant further does not direct us to objective evidence to demonstrate that the Examiner's construction of the term “trailer” is unreasonably broad.

For these reasons, in addition to those reasons addressing claims 1, 3, 5, 6, 8, 10 and 11, we sustain the Examiner's rejection of claims 4 and 9 as obvious over Wang, Aravamudan and Dalal.

In the Event of Further Prosecution

We have decided the appeal before us. In the event of further prosecution, we leave it to the Examiner to determine whether the “arrangement” recited in claim 1, and those claims dependent therefrom, encompasses non-statutory subject matter. *See* U.S. Patent & Trademark Office, *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101*, Aug. 2009, at 2, available at http://www.uspto.gov/patents/law/comments/2009-08-25_interim_101_instructions.pdf. In particular, we note that: 1) the Appellant’s Specification discloses that various end users in an IM session (i.e., human beings) may play of the role of “administrator”; 2) the claimed “database of IM groups”, “target listing of various IM groups”, and “listing of email addresses” are mere collections of data; and 3) the “transmission element” may be broadly construed in light of the Appellant’s Specification as encompassing transitory, propagating signals.

DECISION

We AFFIRM the rejection of claims 1, 3, 5, 6, 8, 10 and 11 under 35 U.S.C. § 103(a) as being obvious over Wang and Aravamudan.

We AFFIRM the rejection of claims 4 and 9 under 35 U.S.C. § 103(a) as being obvious over Wang, Aravamudan and Dalal.

TIME PERIOD

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).

Appeal 2010-008037
Application 10/767,785

AFFIRMED

msc