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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte EDWARD K. Y. JUNG, ROYCE A. LEVIEN,
MARK A. MALAMUD and JOHN D. RINALDO, JR.

Appeal 2012-006715
Application 11/087,727
Technology Center 2400

Before NEAL E. ABRAMS, LYNNE H. BROWNE,
and JILL D. HILL, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Edward K. Y. Jung et al. (Appellants) seek our review under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1, 2, 4–11, 14–24, 27–29, 31 and 41–43. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

THE INVENTION

The claimed invention is directed to a method, system, and program product interface for creation of limited-use electronic mail accounts.

Claims 1 and 27, reproduced below, are illustrative of the subject matter on appeal.

1. A method related to electronic mail, the method comprising:

creating a limited-use electronic mail account associated with displaying a limited-use electronic mail account interface, wherein the limited-use electronic mail account is a limited-functionality-use electronic mail account;

in response to the creating, emitting an auditory signal to indicate to a user that the limited-use electronic mail account is available to accept input; and

accepting input to the limited-use electronic mail account interface, wherein the input directs the limited-use electronic mail account to bounce one or more emails from a predefined group of electronic mail addresses.

27. A program product comprising:

an article of manufacture tangibly including a computer readable storage medium bearing one or more instructions for creating a limited-use electronic mail account associated with displaying a limited-use electronic mail account interface, wherein the limited-use electronic mail account is a limited-functionality-use electronic mail account;

one or more instructions for, in response to the creating, emitting an auditory signal to indicate to a user that the limited-use electronic mail account is available to accept input of an user name to the limited-use electronic mail account interface; and

one or more instructions for accepting input to the limited-use electronic mail account interface, wherein the input directs the limited-use electronic mail account to bounce one or more emails from a predefined group of electronic mail addresses wherein the input includes an identification of one or more electronic mail accounts associated with a directive to

bounce incoming electronic mail from the identified one or more electronic mail accounts.

THE PRIOR ART

The Examiner relied upon the following as evidence of unpatentability:

Suzuki	US 6,474,547 B1	Nov. 5, 2002
Beyda	US 2003/0233415 A1	Dec. 18, 2003
Villamil	US 2005/0136988 A1	Jun. 23, 2005
Nelson	US 2006/0031319 A1	Feb. 9, 2006
Ireland	US 7,278,983 B2	Oct. 9, 2007

THE EXAMINER'S REJECTIONS

Claims 27, 28, and 42 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

The following rejections under 35 U.S.C. § 103(a):

Claims 1, 2, 4, 6–8, 10, 11, 14–24, 27–29, 31, and 41–43 on the basis of Beyda, Nelson, and Villamil.

Claim 5 on the basis of Beyda, Nelson, Villamil, and Suzuki.

Claim 9 on the basis of Beyda, Nelson, Villamil, and Ireland.

OPINION

Claims 27, 28, and 42 Non-statutory Subject Matter

The Examiner's rejection reads as follows:

Claim 27 is drawn to a "program product" comprising "an article of manufacture tangibly including a computer readable storage medium". As currently amended, Claim 27 can still be interpreted as including carrier waves, since the specification does not explicitly state that a "a signal bearing computer readable storage medium" is strictly limited to non-transitory forms of computer readable storage media. Carrier waves are

not limited to that which falls within a statutory category of invention because they are not limited to a process, machine, manufacture, or a composition of matter. Claims 28 and 42 are rejected based on similar reasoning. Note that amending the claims to explicitly limit them to "a non-transitory computer readable storage medium" would overcome this rejection.

Final Rej. 2–3; Ans. 5–6.

Appellants' reply to this rejection is two-fold. Initially, in response to the final rejection, Appellants stated that "Applicants amend Claim(s) 27 and 42 with the Examiner indicated statutory subject matter. Claim 28 is a dependent Claim of Claim 27 and is allowable as it is axiomatic that any dependent Claim which depends from an allowable base Claim is also allowable." App. Br. 105. This statement implies that Appellants amended the claims in accordance with the Examiner's suggestion. However, our review of the record indicates that no such amendment was entered, a conclusion that is confirmed on page 2 of the Reply Brief, where Appellants set forth the following argument:

Regarding the Examiner's remarks pertaining to the rejection of claims 27, 28, and 42 as being directed to non-statutory subject matter under 35 U.S.C. § 101 (Examiner's Answer, pp. 5-6), Applicant respectfully notes that each of the rejected claims recites in relevant part "an article of manufacture tangibly including a computer readable storage medium." Since the Federal Circuit has expressly held that "A transitory, propagating signal ... is not a 'process, machine, manufacture, or composition of matter'" (*In re Nuijten*, 500 F.3d 1346, __ [1353], (Fed. Cir. 2007)), the recitation of "an article of manufacture tangibly including a computer readable storage medium" of claims 27, 28, and 42 cannot properly be read to include a transitory signal as asserted by the Examiner. Accordingly, claims 27, 28, and 42 are properly directed to statutory subject matter under 35 U.S.C. § 101.

Thus, Appellants' position appears to be that since *Nuitjen* states that a "transitory propagating signal" causes a claim to fall outside of the statutory classes of patentability, the fact that this phrase does not appear in Appellants' claims negates the Examiner's rejection. We do not agree.

As set forth in MPEP § 2111, "[d]uring patent examination, the pending claims must be 'given their broadest reasonable interpretation consistent with the specification.'" In this regard, the Patent and Trademark Office determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Because an applicant has the opportunity to amend the claims during prosecution, giving a claim its broadest reasonable interpretation will reduce the possibility that the claim, once issued, will be interpreted more broadly than is justified. *See In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984), and *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989).

Appellants have not disputed the Examiner's position that their specification fails to describe the invention as being limited to non-transitory forms of computer readable storage media, nor have they presented evidence or persuasive argument that one of ordinary skill in the art would have understood that to be the case. Moreover, MPEP 2106(II)(A)(c) instructs the Examiner that:

[a] claim to a non-transitory [emphasis added] tangible computer readable storage medium *per se* that possesses structural limitations under the broadest reasonable interpretation standard to qualify as a manufacture would be

patent-eligible subject matter. Adding additional claim limitations to the medium, such as executable instructions or stored data, to such a statutory eligible claim would not render the medium non-statutory, so long as the claim as a whole has a real world use and the medium does not cover substantially all practical uses of a judicial exception. The claim as a whole remains a tangible embodiment and qualifies as a manufacture.

Therefore, while we have carefully considered Appellants' arguments, we find them not to be persuasive, and this rejection is sustained.

*Claims 1, 2, 4, 6–8, 10, 11, 14–24, 27–29, 31 and 41–43
Obviousness – Beyda, Nelson, and Villamil*

Beyda is directed to an apparatus and method for a user to create a temporary email address to which the user's email can be sent, and from which it can be forwarded to a permanent email address, in accordance with the type of email involved and/or within a certain time frame. ¶5. The Examiner found all of the subject matter recited in independent claim 1 to be disclosed in Beyda, except for two limitations. The first of these is "the input directing the limited-use electronic mail account to bounce one or more emails from a predefined group of electronic addresses," which the Examiner states is taught by Nelson, and would have been an obvious modification to Beyda "to prevent the delivery of unwanted mail (See Nelson, [0002]." Ans. 7–8. The second limitation admitted to be lacking in Beyda is an auditory signal to indicate to the user that the limited use electronic mail account is available to accept input. *Id.* at 8. However, citing Villamil's ¶11, it is the Examiner's position that this reference teaches emitting such an auditory signal, and concludes that it would have been obvious to add this feature to Beyda "to enable a user to select a preferred type of alert from a plurality of alert types . . . (See Villamil, paragraph

[0008]).” *Id.* at 8. In response to Appellants’ arguments on this issue, the Examiner further states that “Villamil detects the occurrence of an event and alerts a user. The alert serves to notify the user that the interface is ready for input (i.e., the alert prompts the user for input) . . . [and] the alert may be an auditory alert.” *Id.* at 32.

Appellants assert that the Examiner has failed to establish a prima facie case of obviousness with regard to claim 1 (*see* App. Br. 37), has used impermissible hindsight in combining the references (*id.* at 42), and that the rejection amounts to merely conclusory statements (*id.* at 43). With regard to Villamil, Appellants argue:

The USPTO is characterizing Villamil to "teach" or "suggest" at least some of the text of independent Claim 1, but Villamil does not teach or suggest "in response to the creating, emitting an auditory signal to indicate to a user that the limited-use electronic mail account is available to accept input." Rather, Villamil describes "the mobile communication device **commences prompting the user of the mobile communication device for an input from the user.** The mobile communication device then monitors the user interface and commences receiving the input from the user before transmitting the status message. **Prompting the user** may be performed by the use of a visual indicator, such as illuminating a status response button on the mobile communication device. **The prompting may include an auditory alert,** or a tactile alert" Paragraph [0011]. However, Villamil is completely silent with respect to emitting the sound or vibration in response to creating a limited-use electronic mail account or that "the limited-use electronic mail account is **available to accept input.**" Rather, Villamil is ACTIVELY PROMPTING A USER FOR AN INPUT. Notifying a user upon mail reception is not the same AS PROMPTING the user for an INPUT.

App. Br. 40–41.

In the Beyda system a temporary email address can be established to receive all incoming emails, after which only selected emails are permitted to be forwarded to a permanent email address, in accordance with directions such as a specified code. ¶¶5 and 35. An email message addressed to the temporary mailbox is stored therein, and thereafter can be retrieved by the user from the user's own computer or, as an alternative, can be forwarded to the user's permanent computer. ¶20.

Villamil "relates in general to mobile communication devices, and more particularly to . . . events experienced by the mobile communication device." ¶1. As explained in ¶8, to which the Examiner refers:

Once the mobile communication device has determined that an event has occurred . . . [it] can either automatically send a status message, or prompt the user and wait for an input before sending the status message. In prompting the user, the mobile communication device may use a variety of alert devices to get the user's attention, such as audio, visual and tactile alerts generated via the user interface.

Paragraph 11, the other portion of Villamil cited by the Examiner in the rejection, in relevant part states:

The method includes the user providing at least one event descriptor to the mobile communication device. The event descriptor defines an event and may include criteria such as geographic location parameters, status inquiry parameters, time of day, and other conditions the mobile communication device may experience. The method commences by detecting the occurrence of the event as defined by the event descriptor. In one embodiment of the invention, once the event is detected, the mobile communication device commences transmitting a status message to a preselected party 3 In one embodiment of the invention the method additionally comprises alerting the user of the mobile communication device of the occurrence of the event in response to detecting the occurrence

of the event, after which or during which the mobile communication device commences prompting the user of the mobile communication device for an input from the user. The mobile communication device then monitors the user interface and commences receiving the input from the user before transmitting the status message.

Thus, according to ¶11, the initial step in the Villamil notification method is the formulation by the user of at least one “event descriptor,” which defines an “event.” Then, upon detection of occurrence of such a described “event,” a status message can be transmitted to a selected party, which can be in the form of an alert or a prompt for a response. Although a number of examples of Villamil’s “events” are set forth in ¶11, they do not include mailboxes such as those disclosed in Beyda.

A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have established the claimed subject matter to a person of ordinary skill in the art. *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976). Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 997, 988 (Fed. Cir. 2006).

Villamil teaches emitting a signal when an “event” listed in an “event descriptor” provided by a user is detected. The Examiner has not established that Beyda discloses or teaches the use of event descriptors. It is our position that evidence and persuasive argument is lacking to support the Examiner’s conclusion that Villamil would have suggested to one of ordinary skill in the art that Beyda be modified to include an event descriptor directed to satisfying the requirement of Appellants’ claim 1 that “in response to the creating” of a limited-use electronic mail account, “an

auditory signal” is emitted “to indicate to a user that the . . . account is available to accept input.” Absent such support, the rejection lacks the articulated reasoning with rational underpinnings required to establish a prima facie case of obviousness with regard to Appellants claim 1, and the rejection of independent claim 1 and dependent claims 2, 4, 6–8, 10, and 11 is not sustained.

Independent claim 14 recites a “tactile” signal instead of specifying an auditory signal, with dependent claim 16 adding that the tactile signal is auditory and claim 17 that it is visual. The rejection of claim 14 and dependent claims 15–24 also is not sustained on the basis of the same reasoning applied *supra* against claim 1.

Independent claims 27, 31, 41, and 42 also contain the limitation regarding emitting an auditory signal when a limited-use email account is available to receive input, and therefore the rejection of these claims and of dependent claims 28, 29, and 43 also is not sustained.

Claim 5

Obviousness – Beyda, Nelson, Villamil, and Suzuki

Claim 9

Obviousness – Beyda, Nelson, Villamil, and Ireland

These dependent claims also contain the limitation regarding emitting an auditory signal when a limited-use email account is available to receive input. The teachings to which the Examiner referred in Suzuki and Ireland do not overcome the deficiency in combining Beyda and Villamil set forth *supra*, and therefore these two rejections are not sustained.

New Rejection By The Board

Pursuant to our authority under 37 C.F.R § 41.50(b), we enter a new ground of rejection of claims 31 and 41–43 under 35 U.S.C. § 112, second

paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as their invention.

Claim 31 line 3 recites “the limited-use electronic mail account,” whereas line 4 recites “a limited-use electronic mail account.” Thus, the arrangement of the subject matter as presented in claim 31 gives rise to a lack of antecedent basis for the phrase “emitting an auditory signal to indicate to a user that the limit-use electronic mail account is available to accept input” (emphasis added), however, such an account has not been previously recited in the claim, although it is subsequently set forth. Furthermore, it is unclear if the second recitation of “a limited-use electronic mail account” (line 4) refers to the same limited-use electronic mail account as the first recitation of such an account. Accordingly, the claim is amendable to at least two different interpretations. The same situation exists in lines 3 and 4 of claim 41 for an identical phrase, and for “the limited-use electronic mail account” recited in lines 4 and 5 of claim 42. In addition, there is at least one word missing between ”the” and “for” in the recitation in the fifth line of claim 41.

DECISION

The rejection of claims 27, 28, and 42 under 35 U.S.C. § 101 as being directed to non-statutory subject matter is sustained.

The rejection of claims 1, 2, 4, 6–8, 10, 11, 14–24, 27–29, 31, and 41–43 under 35 U.S.C. § 103(a) as being unpatentable over Beyda, Nelson, and Villamil is not sustained.

The rejection of claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Beyda, Nelson, Villamil, and Suzuki is not sustained.

The rejection of claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Beyda, Nelson, Villamil, and Ireland is not sustained.

Claims 31, 41, 42, and 43 stand newly rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

In addition to affirming the Examiner's rejections of one or more claims, this decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b) (2008). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this

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case should be returned to the Patent Trial and Appeal Board for final action on the affirmed rejection, including any timely request for rehearing thereof.

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

AFFIRMED-IN-PART; 37 C.F.R. 41.50(b)

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