



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.
11/567,952	12/07/2006	Corinne M. Ryan	CAM920060106US1 (158)	8480
46321	7590	01/12/2015	EXAMINER	
CRGO LAW STEVEN M. GREENBERG 7900 Glades Road SUITE 520 BOCA RATON, FL 33434			JOO, JOSHUA	
			ART UNIT	PAPER NUMBER
			2445	
			NOTIFICATION DATE	DELIVERY MODE
			01/12/2015	ELECTRONIC

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.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@crgolaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CORINNE M. RYAN, RUTHIE D. LYLE, and DORIS L. JONES

Appeal 2012-007925
Application 11/567,952
Technology Center 2400

Before CARLA M. KRIVAK, JEFFREY S. SMITH, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants¹ appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–16. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants identify IBM Corporation as the real party in interest.
App. Br. 1.

STATEMENT OF THE CASE

Appellants' Claimed Invention

Appellants' claimed invention "relates to the field of electronic messaging and more particularly to processing meta-data for electronic messages in a messaging client." Spec. ¶ 1.²

Representative Claim

Independent claim 1, reproduced below, is representative of the subject matter on appeal.

1. A unified presentation of scattered e-mail data method comprising:

selecting an e-mail in an e-mail list of an e-mail client executing in memory by a processor of a computing client;

locating scattered data for the selected e-mail, the scattered data comprising a listing of e-mails associated with the selected e-mail by way of one of a reply, forward, or return receipt requested; and,

presenting a chronological listing of the scattered data in a pop-up window proximate to the selected e-mail in the e-mail client.

Prior Art Relied Upon

Tabayoyon	US 2002/0042838 A1	Apr. 11, 2002
Ozaki	US 2004/0110491 A1	June 10, 2004
Buchheit	US 2005/0234850 A1	Oct. 20, 2005
Yong	US 6,963,904 B2	Nov. 8, 2005
Khoo	US 2008/0005247 A9	Jan. 3, 2008

² This Decision refers to Appellants' Supplemental Appeal Brief filed November 25, 2011 ("App. Br.") and Reply Brief filed April 23, 2012 ("Reply Br."); the Examiner's Answer mailed February 21, 2012 ("Ans."); and the Specification as filed December 7, 2006, and amended September 8, 2009, and April 1, 2010 ("Spec.").

Rejections on Appeal

Claims 11–16 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Ans. 4–5.

Claims 1–3, 7, and 11–13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yong, Ozaki, and Khoo. Ans. 5–12.

Claims 4, 5, 8, 9, 14, and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yong, Ozaki, Khoo, and Buchheit. Ans. 12–16.

Claims 6, 10, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yong, Ozaki, Khoo, Buchheit, and Tabayoyon. Ans. 16–18.

ANALYSIS

Rejection under 35 U.S.C. § 101

Claim 11 recites “[a] computer program product comprising a computer usable storage medium having stored thereon computer usable program code . . . , the computer usable program code, when executed on a computer system, causing the computer system to perform” various functions.

The Examiner finds “[t]he term ‘computer readable storage medium’ could include signals in transmission which have been held to be non-statutory, e.g. a signal holding or storing a program during transmission,” and further, “the computer program product [of claim 11] does not require any functional hardware and could be directed to only a non-statutory subject matter.” Ans. 5.

Appellants argue “claim 11 is drawn to a ‘computer readable storage medium,’ not just a ‘computer readable medium,’” and the “Examiner does

not appear to have realized the full import of the meaning of the term ‘storage.’” App. Br. 7.

We are not persuaded of Examiner error. Subsequent to the non-precedential decisions in the *Ex Parte Mehta* (Appeal No. 2008-004853 (BPAI 2009)) and *Ex Parte Hu* (Appeal No. 2010-000151 (BPAI 2012)) appeals cited by Appellants (*see* App. Br. 6–7; Reply Br. 4), the Board issued a precedential decision addressing the same issue. *Ex Parte Mewherter*, 2013 WL 4477509 (PTAB 2013). In *Mewherter*, the Board determined “the ordinary and customary meaning of ‘computer readable storage medium’ to a person of ordinary skill in the art was broad enough to encompass both non-transitory and transitory media,” absent an express limitation in the specification. *Id.* at *3. Consequently, the Board found “the claim term ‘machine-readable storage medium’ would include signals *per se*. . . . [and] must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter.” *Id.* at *7. Although Appellants’ amendments to paragraph 21 of their Specification on September 8, 2009, and April 1, 2010, delete explicit references to apparatus that “propagate” or “communicate, or transport” a program, neither claims 11–16 nor the Specification expressly limits the recited “computer readable storage medium” to a “non-transitory medium.”³

³ *See also* U.S. Patent & Trademark Office, *Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010) (“A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation ‘non-transitory’ to the claim.”).

Accordingly, we sustain the Examiner's rejection of claim 11, as well as its dependent claims 12–16, which do not further limit the medium of claim 11, under 35 U.S.C. § 101.

Rejections under 35 U.S.C. § 103(a)

The Examiner finds Yong teaches each limitation of independent claims 1, 7, and 11, with the exception of presenting a chronological listing in a pop-up window proximate to the selected e-mail in the e-mail client. Ans. 5–9. The Examiner further finds Ozaki teaches locating scattered data and presenting a chronological listing of related e-mail messages, while Khoo teaches presenting data associated with a selected e-mail in a pop-up window proximate to the selected e-mail in the e-mail client. *Id.* at 6–10. The Examiner finds, moreover, “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to present a chronological listing of the scattered data” and “to present the scattered data . . . in a pop-up window proximate to a selected e-mail,” and that “[t]here . . . would have been a reasonable expectation of success” in making such a combination. *Id.* at 6.

Appellants argue “the Examiner’s analysis is not entirely clear as to what rationale the Examiner is employing . . . in rejecting the claims under 35 U.S.C. § 103” (App. Br. 10), that the “Examiner has failed to properly construe the claim language of the claims at issue and also to determine the scope and content of the prior art so as to ascertain the differences between the prior art and the claims at issue” (*id.* at 12). More particularly, Appellants argue:

Notably absent from [Yong, col. 6, ll. 13–33] is “a chronological listing of the scattered data.” Instead, The [*sic*] passage describes “indicating the number of messages already

present in the user’s mailbox”, but not a chronological listing of the scattered data.

. . . [T]he Examiner has committed error by improperly determining the scope and content of the prior art Additionally, since the Examiner has failed to recognize that Yong does not teach all the limitations for which the Examiner is relying upon Yong to teach, the Examiner has also committed error by failing to properly ascertain the differences between the applied prior art and the claims at issue

App. Br. 13–14. Appellants further argue “[t]he Examiner [*sic*] rationale for combining Yong and Ozaki is a redundant rationale,” and “[t]here is no suggestion that Yong’s method for correlating electronic mail messages be ‘improved’ by the teachings of Ozaki.” *Id.* at 14.

Appellants’ arguments are not persuasive of Examiner error. As stated above, the Examiner explicitly recognizes that Yong does not specifically teach presenting a chronological listing and instead cites Ozaki for that element. *See, e.g.*, Ans. 6. Therefore, Appellants’ argument regarding Yong individually is unpersuasive. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981) (“One cannot show non-obviousness by attacking references individually where . . . the rejections are based on combinations of references.”). Moreover, we discern no error in the Examiner’s findings regarding the teachings of the cited references, the motivation to combine articulated by the Examiner, or the predictability of the results of such a combination. *See* Ans. 6–10, 20–22.⁴

⁴ Appellants additionally argue in the Reply Brief, *inter alia*, that “[a] careful review of the cited portions of Yong reveals that the claimed ‘the scattered data comprising a listing of e-mails’ is missing” and that “Yong fails to specifically generate a ‘listing of e-mails.’” Reply Br. 6. Because Appellants have not shown good cause explaining why that additional (Footnote continued on next page.)

Accordingly, we sustain the rejection of independent claims 1, 7, and 11, as well as the various rejections of dependent claims 2–6, 8–10, and 12–16, argued to stand or fall with independent claims 1, 7, and 11 (*see* App. Br. 8, 15, 16), under 35 U.S.C. § 103(a).

DECISION

The rejection of claims 11–16 under 35 U.S.C. § 101 is affirmed.

The rejection of claims 1–3, 7, and 11–13 under 35 U.S.C. § 103(a) as being unpatentable over Yong, Ozaki, and Khoo is affirmed.

The rejection of claims 4, 5, 8, 9, 14, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Yong, Ozaki, Khoo, and Buchheit is affirmed.

The Examiner’s rejection of claims 6, 10, and 16 under 35 U.S.C. § 103(a) as being unpatentable over Yong, Ozaki, Khoo, Buchheit, and Tabayoyon is affirmed.

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).

argument could not have been presented in the opening Appeal Brief, that argument is deemed waived and will not be considered. *See Ex parte Nakashima*, 93 USPQ2d 1834, 1837 (BPAI 2010) (explaining that any argument not timely presented in the principal brief on appeal will not be considered when filed in a reply brief, absent a showing of good cause explaining why the argument could not have been presented in the principal brief); *Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (informative) (“[T]he reply brief [is not] an opportunity to make arguments that could have been made in the principal brief on appeal to rebut the Examiner’s rejections, but were not.”).

Appeal 2012-007925
Application 11/567,952

AFFIRMED

ELD