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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KELII JUSTIN TSUYOSHI KANESHIRO and
ARTHUR JOHN MELOY

Appeal 2012-009355
Application 12/131,083¹
Technology Center 2100

Before DEMETRA J. MILLS, KENNETH G. SCHOPFER, and
ELIZABETH A. LaVIER, *Administrative Patent Judges*.

LaVIER, *Administrative Patent Judge*.

DECISION ON APPEAL

The Examiner finally rejected claims 1–19. Appellants seek reversal of the Examiner’s rejections, pursuant to 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

For the reasons set forth below, we AFFIRM.

BACKGROUND

The Specification relates to providing email senders with “control over which historical messages are to be included in a forwarded or replied electronic mail message.” (Spec. 1, ll. 6–7.)

¹ Appellants state the real party in interest is International Business Machines Corporation. (Appeal Br. 1.)

Claim 1 is representative:

1. A computer program product embodied in a computer readable storage medium for controlling which historical messages are to be included in a forwarded or a replied electronic mail message, the computer program product comprising the programming instructions for:

receiving input to one of forward and reply to an electronic mail message containing a chain of historical electronic mail messages;

determining a number of electronic mail messages in said chain of historical electronic mail messages;

generating a graphical user interface containing an option to select one or more historical messages in said chain of historical electronic mail messages to be included in said one of forwarded and replied electronic mail message; and

receiving input selecting one or more historical messages in said chain of historical electronic mail messages to be included in said one of forwarded and replied electronic mail message.

(Appeal Br. 33 (Claims App).)

REJECTIONS

The Examiner maintains the following rejections on appeal:

1. Claims 1, 5, 6, 10, 11, 15, 16, 18, and 19 are rejected under 35 U.S.C. § 103(a) as obvious over Marston² and Moody I.³ (Ans. 2.)
2. Claims 2–4, 7–9, 12–14, and 17 are rejected under 35 U.S.C. § 103(a) as obvious over Marston, Moody I, and Moody II.⁴ (Ans. 14.)

² US Patent Application Pub. No. US 2004/0260710 A1, published Dec. 23, 2004.

³ US Patent No. US 7,818,680 B2, issued Oct. 19, 2010.

⁴ US Patent Application Pub. No. US 2003/0177190 A1, published Sept. 18, 2003.

FINDINGS OF FACT

We adopt the Examiner’s findings, set forth on pages 4–17 of the Answer, and summarize as follows for context and emphasis.

The primary reference, Marston, describes a relational model for representing messages exchanged among users of a messaging system. (Marston, Abstract.) Marston calls the electronic messages exchanged in its system “S-Mail” messages. (Marston, ¶ 18.) With respect to replying to or forwarding an S-Mail, Marston states:

Before replying to an S-Mail, or forwarding it, the system **110** may allow the end-user to purge from the S-Mail the oldest of the history submessages. This does not affect the content of the submessages themselves (which remain in the database **114**), but it allows the end-user to forward for example the final agreed version of a document without necessarily allowing the recipient to see any earlier draft versions. Depending upon the application, in some embodiments the end-user may be able to choose to forward some, but not all, of the history submessages. In other embodiments, to prevent “selective quotation,” the end-user may be forced to forward all history submessages or all history submessages older than a particular chosen submessage. In the latter case, the end-user can choose to omit the oldest history submessage or submessages, but cannot selectively send some of the older submessages while at the same time omitting some of the more recent ones.

(Marston, ¶ 50.)

The Examiner relies on Marston to teach most of the limitations of claim 1, except that the Examiner finds that Marston does not expressly teach “determining a number of electronic mail messages in said chain of historical electronic mail messages” or the limitations referring to selecting “one or more historical messages in said chain of historical electronic mail

messages to be included” in the forwarded or replied-to message. (*See* Ans. 5.) For these limitations, the Examiner turns to Moody I (*see* Ans. 5–6) which teaches a “delete module” for selectively deleting messages in a set of related email messages (*see* Moody I, Abstract). The Examiner “interprets allowing the user the mentioned delete option to be allowing the selection of one message and removal of the rest of the related messages.” (Ans. 6.) Finally, the Examiner concludes that combining Marston and Moody I to arrive at claim 1 would have been obvious “to improve message reply and forward function in electronic devices,” and notes that the two references come from the same field of endeavor of “methods to manipulate electronic mail messages.” (*Id.*)

As to claim 2 and the other claims rejected therewith, the Examiner relies on Moody II (*see* Ans. 14–15), which describes a mail agent for categorizing email and tracking data (*see* Moody II, Abstract). Moody II’s user interface includes a conversation tree combined with a list of email messages. (*See* Moody II, ¶ 77.)

DISCUSSION

A. *Rejection 1*

As to claim 1, which Appellants argue together with claims 6, 11, and 16 (Appeal Br. 5), Appellants make two principal arguments: (1) Moody I’s delete module does not teach “determining a number” of email messages in the chain of historical emails (*id.*), and (2) Marston and Moody I both fail to teach “select[ing] one or more historical messages.” (*id.* at 9, 11; *see also* Reply Br. 2–5.) Neither argument is persuasive. Regarding the first, the Examiner explains:

[T]he return of [the] list of related messages requires rendering the list using its size that is determined to be a finite number in the process of creating the list. . . . If the list size of messages returned is not finite . . . then the process would not complete and will end in an infinite loop.

(Ans. 17–18 (citing *Moody I*, col. 2, ll. 5–15).) We find the Examiner’s reasoning to be sufficient to support the finding that *Moody I* inherently teaches “determining a number” of email messages, as claimed. Although a finding of inherency in the context of obviousness must meet a “high standard,” *PAR Pharmaceutical, Inc. v. TWI Pharmaceuticals, Inc.*, 773 F.3d 1186, 1195 (Fed. Cir. 2014), the Examiner has satisfied it here, as “the limitation at issue necessarily must be present,” *id.* at 1196. As to Appellants’ second argument, we agree with the Examiner that *Moody I*’s delete module, which includes a “Delete All Except Selected Message” option, allows the user “to select one message out of a chain of messages and reply to that message making the message a historical message.” (Ans. 19 (citing *Moody I*, Fig. 3, col. 5 ll. 3–15, 40–50).) Also, as noted by the Examiner (*see* Ans. 19), and as evident from the passage from *Marston* quoted *supra*, *Marston* teaches that the user may “choose to forward some, but not all, of the history submessages” when composing a new message (*Marston* ¶ 50). Thus, *Marston* further bolsters the Examiner’s rationale.

Appellants’ arguments regarding most of the other claims subject to Rejection 1 ultimately rely on the same alleged deficiencies in the references Appellants identify with respect to claim 1. (*See* Appeal Br. 13 (claim 16), 14 (claims 5, 10, 15, 18–19), 15 (claims 5 and 15), 17 (claim 10), 18 (claim 18).) The only potentially distinct argument we discern among these is for claim 19, with respect to the requirement of a “consecutive” number of recent messages. (*See* Appeal Br. 19–20.) However, we agree with the

Examiner that Marston also teaches this limitation. (*See* Ans. 14 (citing Marston Fig. 3, ¶¶ 36, 45–46).) Appellants’ motivation to combine argument also relies on the allegedly missing limitations (*see* Appeal Br. 22–23), but in any event we find the Examiner’s rationale (as discussed *supra*) to be sufficient to support the combination of Marston and Moody I.

B. Rejection 2

For the claims subject to Rejection 2, Appellants reiterate arguments similar to those made for Rejection 1 (*see* Appeal Br. 24–25 (claims 3, 8, and 13), 25–26 (claim 17)), which we find similarly unpersuasive. Additionally, Appellants argue that the Examiner failed to provide an adequate rationale for the combination of the three cited references. (*See* Appeal Br. 26–31.) We disagree. As discussed above with respect to Rejection 1, we see no error in the Examiner’s combination of Marston and Moody I. The addition of Moody II is equally well-supported. (*See, e.g.,* Ans. 15 (explaining Moody II is related to the same field of endeavor as Marston and that improving Marston with the teachings of Moody II to arrive at claim 2 would have been obvious).)

CONCLUSION

The Examiner’s final rejections of claims 1–19 under 35 U.S.C. § 103(a) are affirmed for the reasons of record.⁵ No time period for taking

⁵ Should there be further prosecution of these claims, the Examiner should consider whether claim 1 is directed to statutory subject matter under 35 U.S.C. § 101. *See Ex parte Mewherter*, 107 USPQ2d 1857, 2013 WL 4477509 (PTAB 2013) (precedential) (broadest reasonable interpretation of “machine-readable storage medium” included signals per se, and thus rendered the claim at issue to encompass non-statutory subject matter); U.S. Patent & Trademark Office, *Evaluating Subject Matter Eligibility Under 35*

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any subsequent action in connection with this appeal may be extended under
37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

lp

USC § 101 (August 2012 Update); pp. 11–14, available at
http://www.uspto.gov/patents/law/exam/101_training_aug2012.pdf.