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IBM CORPORATION  
C/O: VanCott Bagley, Cornwall & McCarthy  
36 South State Street  
Suite 1900  
Salt Lake City, UT 84111

EXAMINER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* FRANK L. JANIA and ANDREW L. SCHIRMER

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Appeal 2012-011365  
Application 12/469,567<sup>1</sup>  
Technology Center 2400

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Before STANLEY M. WEINBERG, DANIEL N. FISHMAN, and  
TERRENCE W. MCMILLIN, *Administrative Patent Judges*.

MCMILLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the rejection  
of claims 1 – 20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> According to Appellants, the real party in interest is International Business  
Machines Corporation (“IBM”). Reinstated Appeal Brief filed March 19,  
2012, at 2 (hereinafter “Appeal Br.”)

## REJECTIONS ON APPEAL

Claims 1 – 4, 10 – 13, and 18 – 20 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,842,775 B1 issued Jan. 11, 2005 to Chastain et al. (“Chastain”) and U.S. Patent Application Publication No. 2004/0098462 A1 pub. May 20, 2004 to Horvitz et al. (“Horvitz”).

Appeal Br. 8; Ans. 5

Claims 5 and 14 were rejected under 35 U.S.C. § 103(a) as unpatentable over Chastain, Horvitz and U.S. Patent Application Publication No. 2005/0038863 A1 pub. Feb. 17, 2005 to Onyon et al. (“Onyon”).

Appeal Br. 8; Ans. 8.

Claims 6 – 8, 15, and 16 were rejected under 35 U.S.C. § 103(a) as unpatentable over Chastain, Horvitz and U.S. Patent Application Publication No. 2003/0018724 A1 pub. Jan. 23, 2003 to Mathewson, II et al.

(“Mathewson”). Appeal Br. 8; Ans. 9.

Claims 9 and 17 were rejected under 35 U.S.C. § 103(a) as unpatentable over Chastain, Horvitz and U.S. Patent No. 5,377,354 issued Dec. 27, 1994 to Scannell et al. (“Scannell”). Appeal Br. 8; Ans. 10.

Claims 19 and 20 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Appeal Br. 8; Ans. 4.

## ANALYSIS

### The Claimed Invention

The present invention relates to the field of email message delivery and, more specifically, to the field of email message rendering to a user. Spec. ¶ 1. Independent claim 1 is directed to a method, independent claim 11 to a computing device, and independent claim 19 is directed to a

computer program product comprising a computer readable storage medium.

Claim 1 recites:

1. A method of rendering email, comprising:
  - receiving with a networked computing device at least one filter criterion;
  - receiving with said networked computing device an email message; and
  - responsive to a determination by said networked computing device that said email message meets said at least one filter criterion, diverting said email message from delivery to an inbox and providing an immediate display of said email message in its entirety to a user.

### The Section 103 Rejections

We have reviewed the Examiner's rejections in light of the arguments advanced by Appellants in the Appeal Brief and Reply Brief, but are not persuaded the Examiner erred in concluding the claims are unpatentable for the reasons expressed in the Examiner's Answer, which we adopt. *See* Ans. 11 – 21. We add the following for emphasis.

### Claims 1 and 19

Appellants present the same arguments for patentability with regard to independent claims 1 and 19. *See* Appeal Br. 10 –15. Appellants argue that the cited combination of references fails to teach or suggest “filter criterion [for] diverting said email message from delivery to an inbox and providing an immediate display of said email message.” Appeal Br. 10–11; Reply Br. 5–6. The Examiner cites to both Chastain and Horvitz as teaching or suggesting filter criterion. Ans. 5–6; 14–15. The Examiner cites to Horvitz as teaching or suggesting the immediate display. Ans. 6; 15.

Chastain at column 6, line 1, to column 7, line 8, teaches rerouting email messages from one inbox to another inbox based on routing rules. Horvitz in ¶ 53 teaches providing a visual herald when a message with a particular property arrives and in ¶ 75 teaches a prioritization system to classify messages according to degree of importance and to provide notice when important messages are received. Horvitz in ¶¶ 11, 53 teaches immediate display of its visual heralds. The cited references provide support for the findings of the Examiner with regard to the filter criterion limitation in the claims and we are not persuaded of error in this regard.

Appellants also argue that Horvitz does not teach or suggest providing an immediate display of an email message in its entirety to a user. Appeal Br. 11, 14; Reply Br. 6–7. The Examiner cites to paragraph 37 of Horvitz as teaching or suggesting this limitation. Ans. 6, 15. Paragraph 37 of Horvitz reads:

The user controls 144 can include a plurality of controls for driving/directing the information herald 160 to the user. These can include dynamic positioning controls for controlling coordinate locations of the herald (in the workspace 160 and/or other displays 170), dynamic sizing controls for changing the information appearing within or associated with the herald (e.g., on large messages providing summary info, ***on smaller messages displaying the whole message***), dynamic rendering controls for changing the appearance of the herald or content therein (e.g., colors, shapes, fonts dimensions 2D to 3D, and so forth), changing audio cues as described below, and/or providing other dynamic controls such as controlling timing of information display and fading the herald in and out. (emphasis added)

Horvitz clearly teaches or suggests displaying the entirety of the message to the user.

Appellants base their argument that Horvitz fails to teach or suggest displaying the “message in its entirety” on the Abstract of Horvitz, which refers to providing summarizations. Appeal Br. 11; Reply Br. 6–7. However, with regard to this limitation, the Examiner cited to paragraph 37 of Horvitz. Ans. 15 (“¶0037 teaches the herald may be formatted to display the ‘whole message.’”) Thus, Appellants have failed to persuade us of any error with regard to the rejection of claims 1 and 19.

Claim 11

With regard to claim 11, Appellants argue that the cited combination of references (Chastain and Horvitz) fails to teach or suggest diverting an email message from an inbox and immediately displaying that email message, not merely a notification of the email. Appeal Br. 16. As shown above with regard with claims 1 and 19, Horvitz clearly provides such a teaching or suggestion in paragraph 37 in which Horvitz discloses displaying the entire message. We affirm the rejection of claim 11.

Claims 5 and 14

Appellants argue that dependent claims 5 and 14 are patentable because the cited combination of references fails to teach or suggest providing a display of a plurality of unread email messages that meet said at least one filter criterion to said user in a single display window. Appeal Br. 17–18; Reply Br. 9–10 The Examiner relies on Figure 9 and paragraphs 43, 76 and 79 of Onyon as providing the relevant teachings or suggestions. Ans. 19. Figure 9 and the related disclosure in paragraph 79 of Onyon clearly disclose a display of two unread VIP (the filter criterion) messages to the

user in a single display window. Appellants have failed to persuade us of error in the rejection of claims 5 and 14.

Claims 6 – 8, 15, and 16

Appellants present no separate arguments relating to dependent claims 6 – 8, 15, and 16. Appeal Br. 19. Appellants contend the rejection of these claims should be reversed based upon the arguments presented with regard to independent claims 1 and 11. We affirm the rejection of these claims for the reasons stated above with regard to claims 1 and 11.

Claims 9 and 17

Dependent claims 9 and 17 require that the immediate display include an option for the user to send email messages to an inbox. In the Examiner's Answer, ¶ 51 of Horvitz is relied upon for teaching that the user can select options for the immediate display or visual herald and column 4, lines 33 – 38, and column 5, lines 10 – 12, of Scannell are relied upon for teaching directly sending email messages to an inbox as a user option. Ans. 20. In the Reply Brief, Appellants argue that the cited portion of Horvitz relates only to user options for controlling the visual herald. Reply Br. 12.

However, ¶ 51 of Horvitz teaches user configuration of the display of visual herald to include icons, buttons and menus. In view of Scannell's teaching of providing a user option to send messages directly to an inbox, we are not persuaded of error. The findings of the Examiner with regard to these limitations are supported by the teachings and suggestions of the cited combination of references. Appellants have not persuaded us of any error in the rejection of claims 9 and 17.

The Section 101 Rejection

Claims 19 and 20 were also rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Appellants argue that use of the word “storage” to modify “medium” within the phrase “computer readable storage medium” indicates that the claim covers non-transitory embodiments and not transitory embodiments such as signals. Appeal Br. 9. However, “those of ordinary skill in the art would understand the claim term ‘machine-readable storage medium’ would include signals *per se*.”<sup>2</sup> *Ex parte Mewherter*, 107 USPQ2d 1857, 1862 (PTAB 2013) (precedential). The *Mewherter* panel explained, “a signal with embedded data [is a storage medium] for data can be copied and held by a transitory recording medium, albeit temporarily, for future recovery of the embedded data.” *Id.* We affirm the rejection of claims 19 and 20 under 35 U.S.C. § 101.

CONCLUSION

The rejection of claims 1 – 20 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).

AFFIRMED

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<sup>2</sup> We note “machine-readable storage medium” and “computer readable storage medium” are equivalent terms. *Mewherter*, 107 USPQ2d at 1859 n. 2.