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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/876,947	06/25/2004	Toru Maeda	CANO-1011	2253
37013	7590	11/02/2016	EXAMINER	
Rossi, Kimms & McDowell LLP 20609 Gordon Park Square Suite 150 Ashburn, VA 20147			SWEARINGEN, JEFFREY R	
			ART UNIT	PAPER NUMBER
			2445	
			NOTIFICATION DATE	DELIVERY MODE
			11/02/2016	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TORU MAEDA

Appeal 2014-001312
Application 10/876,947
Technology Center 2400

Before THU A. DANG, CATHERINE SHIANG, and
MONICA S. ULLAGADDI, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 37–41, 48, 51, and 53. Claims 1–36, 42–47, 49, 50, and 52 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

A. INVENTION

According to Appellant, the invention relates to “an image communication system using an electronic-mail apparatus which delivers messages, documents and the like via a communication network” (Spec. 1, ll. 8–11).

B. REPRESENTATIVE CLAIM

Claim 37 is exemplary:

37. A receiving apparatus comprising:

a reception unit configured to receive a first electronic mail, to which an image file is attached, from a transmitting apparatus, in a case where the receiving apparatus has not yet transmitted capability information indicating a capability of an image processing function of the receiving apparatus to the transmitting apparatus;

a processing unit configured to process the first electronic mail received by the reception unit; and

a transmission unit configured to transmit, after the first electronic mail has been received by the reception unit, a second electronic mail including the capability information to the transmitting apparatus as a response to the first electronic mail so as to enable the transmitting apparatus to recognize the capability of the image processing function of the receiving apparatus,

wherein the units are implemented, at least in part, by a computer and a memory device of the receiving apparatus.

App. Br. 17 (Claims App'x).

C. PRIOR ART REFERENCES AND REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Claims 37–40, 48, 51, and 53 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the teachings of Bloomfield (US 6,025,931; issued Feb. 15, 2000), and Toyoda et al. (US 5,812,278; issued Sept. 22, 1998).

Claim 41 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the teachings of Bloomfield, Toyoda, and Mori (US 6,061,146; issued May 9, 2000).

II. ISSUES

The principal issues before us are whether the Examiner erred in finding the *combination* of Bloomfield and Toyoda teaches *or suggests* a “receiving apparatus” comprising “a reception unit configured to receive a first electronic mail, to which an image file is attached, from a transmitting apparatus” and “a transmission unit configured to transmit . . . a second electronic mail including the capability information to the transmitting apparatus as a response to the first electronic mail” (claim 37).

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Bloomfield

1. Bloomfield discloses sending hardcopy document via a fax device to its recipient via electronic mail through a data network (Abstract), wherein

the system receives and saves fax image data generated by the sender's fax device that represents the document to be communicated via e-mail (col. 13, ll. 10–13), and the sender is provided with an optional confirmation that the e-mail address and fax image data have been received by the system (col. 1, ll. 18–22).

2. The attachment is converted to a widely popular image format (e.g., TIFF) which is compatible with a majority of browsers and email readers (col. 13, l. 66–col. 14, l. 2), wherein when the e-mail device operating a browser or e-mail reader is not immediately compatible with the image data format/encoding into which the attachment has been converted/encodes, additional user interaction will be necessary to appropriately decode the attachment prior to viewing (col. 14, ll. 8–14).

Toyoda

3. Toyoda discloses transmitting a prescribed paper size and a prescribed image resolution treatable in the apparatus of the receiving side from the apparatus of the receiving side to the apparatus of the transmitting side (col. 13, l. 67–col. 14, l. 3). When an electronic mail asking about a prescribed paper size and a prescribed image resolution is transmitted from the transmitting side to the receiving side, another electronic mail for informing about the prescribed paper size and a prescribed image resolution is returned from the receiving side to the transmitting side (col. 14, ll. 7–13).

IV. ANALYSIS

As to claim 37, Appellant contends

. . . the Bloomfield reference does not disclose the claimed transmission unit configured to transmit, after the Fax-Email 270 (allegedly the claimed first electronic mail) has been received by the E-mail device 118 (apparently alleged to be the

claimed reception unit), a second electronic mail including the capability information to the Facsimile-to-Electronic mail communication system 100 (allegedly the claimed transmitting apparatus) as a response to the Fax Email 270 so as to enable the system 100 to recognize the capability of the image processing function of the receiving apparatus (to which the E-mail device 118 belongs).

App. Br. 7.

Although Appellant does not contest the Examiner's finding that Toyota discloses sending a prescribed email (Step S122) from the Receiving Side to the Transmitting Side indicating capability information so as to enable the system to recognize the capability of the image processing function of the receiving apparatus (App. Br. 9–10), Appellant contends a person of ordinary skill in the art would not have found it obvious to arrive at Appellant's invention "without the benefit of hindsight" (App. Br. 10). In particular, Appellant contends Bloomfield's Fax-Email 270 "closely corresponds to the electronic mail transmitted at step S128 in FIG. 9 of the Toyota et al. reference," wherein a person of ordinary skill in the art "would transmit the Fax-Email 270 [of Bloomfield] as part of step S128 in FIG. 9 of the Toyota et al. reference, which occurs *after* step S122" (*id.*).

Appellant also contends that even if the Examiner finds Toyota's Request Email to be the claimed "first electronic mail" (App. Br. 13), there is "no reason to add an image file to the Request Email" because "doing so would appear to a person of ordinary skill in the art to detrimentally further lengthen communication time," wherein "the Examiner has not established a *prima facie* case of obviousness" to do so (App. Br. 14).

We have considered all of Appellant's arguments and evidence presented. However, we disagree with Appellant's contentions regarding the

Examiner's rejections of the claims. We are unpersuaded of error with respect to the Examiner's conclusion that the claimed subject matter would have been obvious over the combined teachings.

We agree with the Examiner's finding "Bloomfield teaches sending the initial fax-email to the sender . . .," which includes an attachment, and "Toyoda teaches sending an email from the recipient to the sender," which includes "capability information of the recipient" (Ans. 4). In particular, Bloomfield discloses a fax device sending a hardcopy document attachment to its recipient via electronic mail (FF 1), wherein if the e-mail device operating a browser or e-mail reader is not immediately compatible with the image data format/encoding into which the attachment has been converted/encodes (i.e., as a response to the electronic mail), additional user interaction will be necessary to appropriately decode the attachment (FF 2). Furthermore, Toyoda discloses sending a second electronic mail for providing capability information of the receiving side (the prescribed paper size and a prescribed image resolution) from the receiving side to the transmitting side in response to a first email from the transmitting side indicating that capability information of the receiving side is needed (FF 3).

We agree with the Examiner's finding that Bloomfield's "additional user interaction" may comprise "the transmission of the recipient capability information to the sender" as taught in Toyoda (Ans. 5). That is, we agree with the Examiner that Bloomfield discloses and suggests that *as a response to* receiving a first email including an email attachment, additional steps are used to enable the recipient device to obtain the appropriate format/encoding (FF 1-2), and that Toyoda discloses and suggests sending a second email

including the capability information to the transmitting apparatus as a response to receipt of a first email (FF 3).

We disagree with Appellant's contention that a person of ordinary skill in the art would not have found it obvious to arrive at Appellant's invention "without the benefit of hindsight" (App. Br. 10). We are guided by the Supreme Court's viewing the modification of prior art teachings by a practitioner in the art: an improved product in the art is obvious if that "product [is] not [one] of innovation but of ordinary skill and common sense" (*KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007)). The skilled artisan is "[a] person of ordinary creativity, not an automaton" (*id.*).

We find this reasoning is applicable here. We find such modification of Bloomfield's system in need of capability information of the recipient device, to provide the needed capability information as disclosed in Toyoda as a response, would have merely been a "predictable use of prior art elements according to their established functions" (*id.* at 417).

Appellant has not provided any evidence that such modification would have been "uniquely challenging or difficult for one of ordinary skill in the art" (*Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007)), or would have yielded unexpected results. Instead, as the Examiner finds, Bloomfield discloses requiring additional user interaction after receiving an email attachment without the recipient's appropriate capability information, wherein Bloomfield's "additional user interaction" may comprise "the transmission of the recipient capability information to the sender" as taught in Toyoda (Ans. 5). We agree with the Examiner that Appellant's invention is simply a modification of familiar prior art teachings

(as taught or suggested by the cited references) that would have realized a predictable result (*KSR*, 550 U.S. at 421).

Therefore, on this record, and by the preponderance of evidence, we are not persuaded of error regarding the Examiner's underlying factual findings and ultimate legal conclusion of obviousness. Accordingly, we also sustain the Examiner's § 103(a) rejection of claim 37 and claims 37–40, 48, 51, and 53 falling therewith (App. Br. 15) over Bloomfield and Toyoda. Appellant does not provide substantive arguments for claim 41 depending from claim 37 (*id.*), accordingly, we also affirm the rejection of claim 41 over Bloomfield and Toyoda, in further view of Mori.

V. CONCLUSION AND DECISION

We affirm the Examiner's rejections of claims 37–41, 48, 51, and 53 under 35 U.S.C. § 103(a).

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