UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/166,897	06/23/2011	Robert Selby Sielken	RSW920110033US1 (IBM 27)	6866

77242   7590   06/29/2016
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ART UNIT	PAPER NUMBER
2456	

NOTIFICATION DATE	DELIVERY MODE
06/29/2016	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERT SELBY SIELKEN,
WILLIAM CARLETON WIMER II, and DAVID LAVERNE ZANTER

Appeal 2014-008579
Application 13/166,897[1]
Technology Center 2400

Before ELENI MANTIS MERCADER, JAMES W. DEJMEK, and
JOHN D. HAMANN, *Administrative Patent Judges*.

HAMANN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants file this appeal under 35 U.S.C. § 134(a) from the

Examiner's Final Rejection of claims 4–9 and 13–18. Claims 1–3 and 10–

12 were canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

THE CLAIMED INVENTION

Appellants' claimed invention relates to "electronic communications

and addressing of electronic communications." Spec. ¶ 1. Claim 4 is

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[1] According to Appellants, the real party in interest is International Business
Machines Corporation. Br. 2.

illustrative of the subject matter of the appeal and is reproduced below with emphasis added to disputed limitations.

> 4.   A system for dynamic encoding of email addresses comprising:
>
> a processor configured for (a) determining if a data package contains an address that is not supported by a device to receive or synchronize with the data package; (b) if the data package contains an address that is not supported by the device to receive or synchronize with the data package, creating a supported address corresponding to the non-supported address, the supported address comprising a local-part and a domain, *the local-part comprising an encoded version of the entire non-supported address*, the domain comprising a non-valid domain; and (c) replacing the non-supported address in the data package with the created supported address.

REJECTIONS ON APPEAL[2]

(1)   The Examiner rejected claims 16–18 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

(2)   The Examiner rejected claims 13 and 16 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement for claiming subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the art that Appellants,

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[2] The Examiner also provisionally rejected claims 4–9 and 13–18 for obviousness-type double patenting over claims 1–6 of copending Application No. 13/417,713. No patent has issued yet from that copending Application, nor do Appellants present arguments addressing this provisional rejection. We find it is premature to address this provisional rejection. *See In re Moncla*, 95 USPQ2d 1884, 1885 (BPAI 2010) (precedential).

at the time the application was filed, had possession of the claimed
invention.

(3)   The Examiner rejected claims 4–9 and 13–18 under 35 U.S.C.
§ 102(e) as being anticipated by Bayles et al. (US 2011/0314109 A1;
Dec. 22, 2011), or in the alternative as being unpatentable under 35 U.S.C.
§ 103(a) as being obvious in light of Bayles.

(4)   The Examiner rejected claims 4–9 and 13–18 under 35 U.S.C.
§ 102(e) as being anticipated by Zanter (US 2007/0050454 A1; Mar. 1,
2007).

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants'
contentions that the Examiner erred. In reaching our decision, we consider
all evidence presented and all arguments made by Appellants. We below
address specific findings and arguments relating to each of the Examiner's
rejections Appellants are appealing.

(1)   Section 101 Rejection

Appellants contend claims 16–18 are directed to statutory subject
matter, contrary to the Examiner's conclusion. *See* Br. 8. Appellants argue
the Specification distinguishes between (i) computer readable signal medium
and (ii) computer readable storage medium. *See id.* (citing Spec. ¶¶ 31–32).
Specifically, Appellants argue computer readable *signal* medium "may
include a propagated data signal" in contrast to computer readable *storage*
medium. *See id.* Appellants further contend computer readable storage
medium is a tangible medium, fixed in nature, which one of ordinary skill in
the art would understand to not include propagated data. *See id.*

The Examiner finds the Specification's definition for computer readable storage medium covers both transitory and non-transitory embodiments. Final Act. 4. The Examiner finds, for example, that computer readable storage medium can include electro-magnetic and optical propagated signals. *See* Ans. 5 (citing Spec. ¶¶ 31–32).

We find Appellants' arguments unpersuasive and we agree with the Examiner's findings. The recited "computer readable storage medium" is not claimed as non-transitory, and the Specification does not expressly and unambiguously disclaim transitory forms via a definition. *See* Spec. ¶¶ 31–32 (providing that computer readable storage medium can "<u>contain</u> or store" a program, as well as using open-ended language to describe storage medium)(emphasis added); *see also Ex parte Mewherter*, 107 USPQ2d 1857, 1862 (PTAB 2013) (precedential) ("[T]hose of ordinary skill in the art would understand the claim term 'machine-readable storage medium' would include signals *per se*."). Further, we find the Specification's examples of (i) "an electrical connection having one or more wires" and (ii) "an optical fiber" consistent with transitory, propagating signals being included as a type of storage medium. *See Mewherter*, 107 USPQ2d at 1862 (finding "a signal with embedded data fully comports with th[e] definition [for storage medium], for data can be copied and held by a transitory recording medium, albeit temporarily, for future recovery of the embedded data.").

Accordingly, the "computer readable storage medium" of claims 16–18 is not limited to non-transitory forms and is non-statutory subject matter. *Mewherter*, 107 USPQ2d at 1862 (holding recited machine-readable storage medium ineligible under § 101 when it encompasses transitory media). We thus sustain this rejection.

(2)   Written description for claims 13 and 16

Appellants contend the Specification complies with the written description requirement of 35 U.S.C. § 112, first paragraph, with respect to claims 13 and 16 because it discloses "the entirety of a non-supported address (display part, local part, and domain) are encoded, and the resulting encoding is used as the local part of a newly-created supported address." *See* Br. 9 (citing Spec. ¶¶ 19, 23, 24). Appellants further argue the Specification also discloses the reverse process of decoding an encoded non-supported address "back into the non-supported address." Br. 10 (citing Spec. ¶ 28).

The Examiner finds the Specification does not support claims 13 and 16's requirement of "'**the local part** comprising an encoded **version** of the **entire** nonsupported address.'" Final Act. 8 (citing Spec. ¶ 19). The Examiner also finds "[c]onverting a portion or an entirety of [a] non-supported email address would still generate a non-supported address." *See id.*; Ans. 14 ("Still it is not clear how the created '6t' w7ZOLOFDTUU= @lnt.nonintemet.sub>. or 'test user 1' dGVzdCB 1 c2VyMS9BQ01FQEFDTUU= @lnt.noninternet.sub>. , becomes standard or recognized address.").

We find Appellants' arguments persuasive. We find that one of ordinary skill in the art would understand the local part of the supported address comprises an encoded version of the entire non-supported address, and one skilled in the art would reasonably conclude that Appellants had possession of this aspect of the claimed invention at the time the Specification was filed. *See In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989); Spec. ¶¶ 19, 23, 24. Furthermore, we disagree with the Examiner that

it is not clear how the non-standard address is converted to a supported address. *See* Spec. ¶¶ 19, 23, 24. We also note that claims 13 and 16 are directed to the reverse process of decoding. *See* Claim Appx. 24–25; Spec. ¶ 28. Accordingly, we do not sustain this rejection.

(3) *Bayles anticipation rejection*

Appellants argue Bayles fails to anticipate claims 4, 7, 13, and 16 because Bayles does not disclose that the local part of the supported address comprises an encoded version of the entire non-supported address. Br. 12, 15. Specifically, Appellants argue Bayles instead discloses "encod[ing] the local part of the non-supported email address into the local part of the newly created standard email address, and encod[ing] the domain of the non-supported email address into the domain of the newly created standard email address." Br. 15–16 (citing Bayles ¶ 27).

The Examiner finds Bayles discloses generating an alternate email address from a primary email address. Ans. 16 (citing Bayles ¶ 10). The Examiner further finds "Bayles teaches encoding an entire non-supported address into the local part of a newly created supported address and using a non-valid domain for the domain of the newly created supported address." *Id.* (citing Bayles ¶¶ 25–27, Figs. 2A, 2B).

We agree with Appellants' arguments that the cited portions of Bayles fail to disclose the disputed limitation. Bayles does disclose generating an alternate email address from a primary email address. *See, e.g.,* Bayles ¶¶ 10, 27. However, we find Bayles discloses encoding the local part of the primary address to yield the local part of the alternate address and separately encoding the domain of the primary address to yield the domain of the alternate address. *See* Bayles ¶ 27 ("Using the same [Punycode] encoding

for domain name provides uniform encoding of the whole email address, and the encoded username satisfies the ASCII Compatible Encoding (ACE) requirement."). This finding is further supported by the disclosed formula for generating the alternate email address, which shows the local part and domain of the address are separately encoded. *See* Bayles ¶ 28 ("Encode(UTF8-username@utf8-domain) = punycode(UTF8-encode-username) @punycode(UTF 8-encode-domain)"). Thus, the cited portions of Bayles do not disclose the local part of the created (alternate) email address comprises the *entire* non-supported (primary) email address because it lacks the domain. *See id.* Accordingly, we do not sustain this rejection for claims 4, 7, 13, and 16, nor claims 5, 6, 8, 9, 14, 15, 17, and 18 which depend therefrom and incorporate the disputed limitation.

(4)   *Bayles obviousness rejection*

Appellants argue the Examiner erred in rejecting claims 4–9 and 13–18 as being obvious in light of Bayles. Br. 16. Specifically, Appellants argue the Examiner fails to provide sufficient justification for changing Bayles to function as recited in the claims. Br. 16–17 (citing Final Act. 10). Appellants further argue the lack of justification is especially significant because Bayles already accomplishes the Examiner's cited goal, but by using different techniques. *See id.* at 17.

The Examiner finds "it would have been obvious to one having ordinary skill in the art . . . to generate [a] supported address of a version of the non-supported address that is recognizable by the recipient device so that the email message with the generated address is delivered to recipient for display." Final Act. 10; *see also* Ans. 18–19.

We agree with Appellants that the Examiner has not provided a sufficient explanation of the findings regarding the local part of the supported address comprising an encoded version of the entire non-supported address to present a prima facie case of obviousness as to claims 4–9 and 13–18. Nor does the Examiner make sufficiently specific findings that are adequately supported for the Examiner's conclusion of obviousness to have a rational underpinning. *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) ("[R]ejections on obvious 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.") (citations omitted).

(5) Zanter rejection

Appellants argue Zanter does not disclose encoding an entire non-standard address into the local part of a standard address, as recited in claims 4 and 7, and similarly recited in claims 13 and 16. Br. 19. Appellants argue Zanter instead discloses (i) truncating a lengthy email address list by storing it on a server, (ii) using an identifier to identify the list's storage location on the server, and (iii) encoding the identifier to use as the local part of an email address. *See id.* (citing Zanter ¶¶ 30, 32, 33).

The Examiner finds Zanter discloses the identifier for the stored address list can be encoded to generate a local part of an address. Ans. 20 (citing Zanter ¶ 6). The Examiner also finds Zanter discloses the local part of an email address is examined to determine if it includes an identifier, and if so, the server decodes the address to obtain the original address list. *See id.* at 20 (citing Zanter ¶ 20).

We agree with Appellants' arguments that the cited portions of Zanter fail to disclose the disputed limitation. We find these portions instead disclose using an encoded identifier that represents a storage location for an address list as a local part of an email address, rather than using an entire encoded email address as the local part of an email address. *See* Zanter ¶¶ 6, 20, 30, 32, 33, 35, 41). Accordingly, we do not sustain this rejection for claims 4, 7, 13, and 16, nor claims 5, 6, 8, 9, 14, 15, 17, and 18 which depend therefrom and incorporate the disputed limitation.

DECISION

(1)   We affirm the Examiner's § 101 rejection of claims 16–18.

(2)   We reverse the Examiner's § 112, first paragraph, rejection of claims 13 and 16.

(3)   We reverse the Examiner's § 102(e) rejection and § 103 rejections of claims 4–9 and 13–18 over Bayles.

(4)   We reverse the Examiner's § 102(e) rejection of claims 4–9 and 13–18 over Zanter.

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-IN-PART