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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* PETER L. KATSIKAS

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Appeal 2015-002172  
Application 12/882,130  
Technology Center 2400

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Before MAHSHID D. SAADAT, JOHNNY A. KUMAR, and  
JON M. JURGOVAN, *Administrative Patent Judges*.

KUMAR, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a) from the Final Rejection  
of claims 36–53.<sup>2</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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<sup>1</sup> According to Appellant, the real party in interest is Howell V Investments  
LLC (App. Br. 2).

<sup>2</sup> Claims 1–35, 54, and 55 have been canceled.

## STATEMENT OF THE CASE

### *Introduction*

Appellant's invention relates to a system for eliminating unauthorized electronic mail (Spec. Title). Exemplary claim 36 under appeal reads as follows:

36. A system, comprising:

one or more hardware processors and one or more computer memories together providing:

an email proxy pre-processing module that is configured to allow designation of a proxy email address that is associated with a primary email address but distinct from the primary email address to receive email from email addresses not on an authorized senders list,

wherein the authorized senders list maintains email addresses authorized to have emails sent to the primary email address received by the primary email address,

wherein, upon receiving incoming email addressed to the proxy email address from an email address not on the authorized senders list, the email proxy preprocessing module is further configured to accept the email and to unconditionally add the email address from which the incoming email was received to the authorized senders list.

### *The Examiner's Rejections*

Claims 36–53 stand rejected on the ground of nonstatutory obviousness-type double patenting (OTDP) as being unpatentable over claims 1–29 of U.S. Patent No. 7,822,977 (Final Act. 2–3).<sup>3</sup>

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<sup>3</sup> The Examiner has withdrawn this OTDP rejection in view of Appellant's terminal disclaimer filed July 8, 2014 (Ans. 9).

Claims 36–53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dickie (US 6,643,687 B1; Nov. 4, 2003) and Fleming (US 6,249,805 B1; June 19, 2001) (Final Act. 8–15).

*Appellant’s Contentions*

Appellant contends the following:

(1) Fleming’s methods of adding an email address to the authorized senders list (i.e., manually adding an address, automatically adding recipients to whom the user has sent email, or adding all senders of emails that the user has sorted into a particular folder) each involve a condition that must be satisfied for the address to be added to the list, whereas claim 36 requires the email module is “configured to accept the email and to *unconditionally add the email address* from which the incoming email was received to the authorized senders list” (emphasis added) (App. Br. 4–10; Reply Br. 2–5). In the context of claim 36, “unconditionally” means, upon receiving an email, no further conditions are imposed by the email module’s logic that would bar the email module from adding the email address from the authorized senders list (Reply Br. 5).

(2) The combination of Dickie and Fleming does not teach the email proxy pre-processing module of claim 36, because Dickie’s use of a proxy email address does not teach modifying an authorized senders list, and Fleming’s email addressed to a user does not teach receiving an incoming email addressed to a proxy email address (App. Br. 7; Reply Br. 5).

(3) The combination of Dickie and Fleming is improper, because:

(a) the Examiner has not provided a reason why one of ordinary skill in the art would be motivated to create a new method of adding

users to Fleming's authorized senders list based on Dickie's forwarding of messages received at a proxy address (App. Br. 10; Reply Br. 6);

(b) using Dickie's hidden proxy email address would render Fleming inoperable for its intended purpose, as Fleming would not have access to the sender's address to add that address to the access list (Reply Br. 7); and

(c) one of ordinary skill in the art would not have combined the different systems of Dickie, which uses an intermediate proxy email server to look up the actual recipient email address, and Fleming, which uses a system that can monitor user actions such as moving mail to a different folder.<sup>4</sup>

## ANALYSIS

We have reviewed the Examiner's rejections in light of Appellant's arguments (App. Br. 4–12; Reply Br. 2–8) that the Examiner erred. We disagree with Appellant's above contentions (1)–(3). We adopt as our own 1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken (Final Act. 8–15) and 2) the reasons set forth by the Examiner in the Examiner's Answer (Ans. 9–16) in response to Appellant's Appeal Brief. We concur with the conclusions reached by the

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<sup>4</sup> Independent claims 47 and 52 are argued on the same basis as independent claim 36 (App. Br. 11–12), and separate patentability is not argued for the dependent claims (*id.*). Except for our ultimate decision, these claims are not discussed further.

Examiner. We highlight and address specific findings and arguments for emphasis as follows.

**Issue 1:** Under § 103, did the Examiner err by finding Fleming teaches an email module “configured to accept the email and to unconditionally add the email address from which the incoming email was received to the authorized senders list,” as recited in claim 36?

Regarding Appellant’s contention (1), the Examiner finds Appellant’s Specification does not describe “unconditionally” adding an email address to the authorized list (Ans. 10).<sup>5</sup> Appellant’s Specification does, however, describe conditionally accepting an email from an unknown sender (Spec. 20:1–10, table describing Fig. 11A: “Senders sending email to this address with reach the end-user if the proper conditions are met;” conditions include, e.g., the maximum number of senders that may use the recipients address), and subsequently adding that email address to the authorized senders list once the email is accepted (Spec. 18:30–19:19). Therefore, we agree with the Examiner’s finding that the broadest reasonable interpretation consistent with Appellant’s disclosure of an email module “configured to accept the

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<sup>5</sup> In the event of further prosecution of this application, we leave it to the Examiner to consider whether Appellant has demonstrated possession of “*unconditionally* adding the email address” for claims 36–53 under 35 U.S.C. § 112, 1st Paragraph, the written description requirement. Although the Board is authorized to reject claims under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so. *See Manual of Patent Examining Procedure* (MPEP) § 1213.02 (9th Ed., Rev. 07.2015, Nov. 2015).

email and to unconditionally add the email address . . . to the authorized senders list” does not preclude Fleming’s email module that is configured to accept and unconditionally add an incoming email from an unknown sender address to a Junk Mail folder, which encompasses an authorized senders list as later determined by the user (Ans. 12–13 (citing Fleming col. 4:37–44)). *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997) (claim language is given its broadest reasonable interpretation during prosecution). Accordingly, we are not persuaded of Examiner error in the rejection of claim 36.

**Issue 2:** Under § 103, did the Examiner err by finding the combination of Dickie and Fleming teaches the email proxy pre-processing module of claim 36?

Appellant’s contention (2) is not persuasive of Examiner error in the rejection, because Appellant is essentially attacking the Dickie and Fleming references individually where the rejection is based on their combination. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981) (“[O]ne cannot show non-obviousness by attacking references individually where . . . the rejections are based on combinations of references.”). The Examiner finds, and we agree, that a skilled artisan would recognize the combination of Dickie’s proxy email address system, which allows a user to receive email at proxy email address that is associated with, but distinct from, a primary email address (Final Act. 4–5; Ans. 14 (citing Dickie col. 2:15–22 and col. 5:3–35)), and Fleming’s junk email filtering system, which is configured to accept emails and unconditionally add email addresses to an authorized sender list (Ans.

12–14 (citing Fleming col. 4:37–44), as discussed *supra*), would result in the claimed email proxy server that is configured to receive email addressed to a proxy email address and add unknown users to an authorized senders list (Ans. 14–15).

**Issue 3:** Under § 103, did the Examiner err in rejecting claim 36 because Dickie and Fleming are not properly combinable?

We are not persuaded of Examiner error by Appellant’s contention (3)(a), and find the Examiner has provided “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness,” specifically that one of ordinary skill in the network security art would recognize the benefit of adding Fleming’s junk email filtering concept to the proxy email system of Dickie, as a better way to filter out unwanted junk mail from unknown users while allowing emails from authorized users to be received (Final Act. 5; Ans. 15–16 (citing Fleming col. 4:10–65)). *See KSR Int’l v. Teleflex, Inc.*, 550 U.S. 398, 417–18 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Appellant’s contentions (3)(b) and (3)(c), presented for the first time in the Reply Brief without a showing of good cause for the delay, are entitled to no consideration. *See Optivus Technology, Inc. v. Ion Beam Applications S.A.*, 469 F.3d 978, 989 (Fed. Cir. 2006) (argument raised for the first time in the reply brief that could have been raised in the opening brief is waived); *accord Ex parte Borden*, 93 USPQ2d 1473, 1473–74 (BPAI 2010) (informative opinion) (absent a showing of good cause, the



Board is not required to address an argument newly presented in the reply brief that could have been presented in the principal brief on appeal).

Nonetheless, we are not persuaded by Appellant's contention (3)(b) that Fleming would not have access to the sender's hidden email address to add that address to the access list, because the proffered combination uses the *recipient's* hidden proxy email of Dickie, and does not hide the sender's email address (Final Act. 4–5 (citing Dickie col. 2:15–22)). Further, Appellant's contention (3)(c) that one of ordinary skill in the art would not have combined the different systems of Dickie and Fleming is not persuasive of error. “The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference . . . . Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.” *Keller*, 642 F.2d at 425. When combining references, “a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR*, 550 U.S. at 418. Thus, we agree with the Examiner's finding that a skilled artisan would recognize the ability to combine the concepts of Dickie's proxy email system and Fleming's junk filtering email system (Final Act. 4–5; Ans. 14–15).

Accordingly, we sustain the Examiner's rejection of independent claim 36 under 35 U.S.C. § 103(a) as being unpatentable over Dickie and Fleming.

DECISION<sup>6</sup>

The decision of the Examiner to reject claims 36–53 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>6</sup> We note claims 52 and 53 recite a computer-readable storage device. However, Appellant’s Specification does not define storage device to exclude transitory media. Consequently, the claimed storage device encompasses transitory media, which is not patent eligible. *See Ex parte Mewherter*, 107 USPQ2d 1857 (PTAB 2013) (precedential). In the event of further prosecution, we leave it to the Examiner to consider whether at least claims 52 and 53 should be rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. As mentioned above, although, the Board is authorized to reject claims under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so. *See Manual of Patent Examining Procedure* (MPEP) § 1213.02 (9th Ed., Rev. 7, Nov. 2015).