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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JUSTIN EDWARD SANTAMARIA,
BRYAN PRUSHA, and MARCEL VAN OS¹

Appeal 2015-004729
Application 12/831,983
Technology Center 2100

Before CAROLYN D. THOMAS, MICHAEL M. BARRY, and
AARON W. MOORE, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1, 2, 4–6, 13–15, 18–20, 22–24, and 26–30, which constitute all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part and, pursuant to 37 C.F.R. § 41.50(b), designate a portion of our affirmance as a new ground of rejection.

¹ Appellants identify the real party in interest as Apple Inc. (App. Br. 2.)

Introduction

Appellants state the invention pertains to “searching for text messages on a handheld device.” (Spec ¶ 1.) Claim 1 is illustrative:

1. A method performed on a handheld device, comprising:
 - storing multiple text messages received by the handheld device in a plurality of files on the device, each file of the plurality of files containing a string of messages corresponding to a conversation between the handheld device and another device;
 - generating, on the handheld device, an index of the multiple text messages in the plurality of files;
 - storing the index on the handheld device;
 - receiving a search term through a user interface of said handheld device;
 - searching through stored text message information in the index of the multiple text messages stored on said handheld device for said search term;
 - displaying, in response to the searching, a listing of text message conversations on a display, each conversation having at least one text message whose text message information was found to include said search term;
 - in response to a user selection of one of said conversations, displaying a sequence of text messages within said one selected conversation on the display;
 - highlighting a text message within said sequence of text messages, said highlighted text message containing the search term; and
 - providing an option to initiate a next text message through said user interface;
- wherein the multiple text messages are received by the handheld device through a short messaging service protocol or a multi media messaging protocol.

(App. Br. 19 (Claims App’x).)

Rejections

Claims 1, 2, 4, 13–15, 18–20, 22–24, and 26–30 stand rejected under 35 U.S.C. § 103(a) as obvious over Fox et al. (US 2006/0075044 A1; Apr. 6, 2006) and Carey et al. (US 6,714,793 B1; Mar. 30, 2004). (Final Act. 2–8.)

Claims 5, 6, and 23 stand rejected under 35 U.S.C. § 103(a) as obvious over Fox, Carey, and Rodriguez (US 2011/0099584 A1; Apr. 28, 2011). (Final Act. 8–9.)

ANALYSIS

Claim 1

Appellants argue the Examiner errs in rejecting claim 1 by relying on functionality from both the “conversaton assistant” of Fox’s client device and Fox’s “conversation management system” (which is coupled to the client device through a communication network) for teaching or suggesting the recited “handheld device” requirement, contending that “whatever functionality Fox discloses is achieved through the use of at least two separate devices.” (App. Br. 10.) This does not persuade us. As the Examiner finds, and we agree, Fox broadly teaches that functionality between its conversation management system and conversation assistant can be apportioned in various ways, and that the conversation assistant on a client device can perform the functionality relevant to claim 1. (*See* Ans. 2–3 (citing Fox ¶ 54).)

Appellants also contend “[n]either Fox, nor Carey disclose, teach or suggest the concept of storing ‘a string of messages’ in a plurality of files where each file corresponds to ‘a conversation between the handheld device and another device,’ as recited in claim 1.” (App. Br. 10.) Appellants argue the Examiner’s findings disregard “the fact that claim 1 requires ‘storing

multiple text messages received by the handheld device in a plurality of files on the device, **each file of the plurality of files containing a string of messages corresponding to a conversation between the handheld device and another device.**' Fox does not teach, and the Examiner fails to even allege that, the storage of messages in a plurality of files"² (Reply Br. 3.)

We agree with Appellants that the Examiner does not identify a disclosure in Fox that teaches the claimed "plurality of files" that each contain a "string of messages." We disagree, however, that Fox fails to teach or suggest this requirement. Although not specifically cited by the Examiner, we find Fox's disclosure of "[i]n an alternate embodiment, all the messages for each conversation are stored as a single record, *document* or data structure in the message database" (¶ 143³ (emphasis added)) teaches or suggests this requirement.

Appellants further contend the Examiner errs because "Fox does not disclose the recitation of 'generating, on the handheld device, an index of the multiple text messages in the plurality of files,'" arguing the Examiner erroneously asserts "that the 'forms' of Fox are 'indexes' generated by the client device." (App. Br. 11 (citing Fox ¶¶ 70, 85, 93–94).) Appellants

² The Examiner finds that "Fox, figure 3A, explicitly 3A:312 and 314, Paragraphs [0062]-[0063], teach generation of a list of conversations, where each conversation can contain multiple messages (string of messages). Fig 3B, displays the list of conversations, teaching conversation containing 'a string of messages' [sic]" (Ans. 3; *see also* Final Act. 3 (citing Fox Fig. 3A, ¶ 49).)

³ Fox also states, and we agree, that "[t]hose of ordinary skill in the art would recognize other ways to store the message information." (¶ 142.)

argue that “[a]s stated in Fox, ‘forms [are] for displaying the conversations,’¹¹ or to allow for ‘composing and sending a message.’” (*Id.*)

The Examiner finds, however, and we agree, that Fox’s forms include information that provides an index to the conversations. (*See* Ans. 3 (citing Fox ¶ 49).) This finding is consistent with the relevant dictionary meanings of “index” (*see, e.g.*, www.merriam-webster.com/dictionary/index (last visited Nov. 28, 2016) (relevantly defining an index as “something . . . that leads one to a particular fact . . .” or “a list . . . of some specified datum . . .”)) and is consistent with the use of the term in Appellants’ Specification (*see, e.g.*, ¶¶ 48–50).

Fox also discloses, for processing text messages, that “[a] message is received, assigned to a conversation, indexed, assigned one or more attributes and stored” (¶ 98), and that the messages are “indexed for searching” (¶ 102). Accordingly, we agree with the Examiner that Fox teaches generating and storing an index for subsequent use in searching of received text messages as required by claim 1. Thus, we also find unpersuasive Appellants’ contentions that Fox fails to teach the recited “storing the index on the handheld device” and “searching through stored text message information in the index of the multiple text messages stored on said handheld device for said search term” (*see* App. Br. 11–12).

Appellants also contend the Examiner engages in impermissible hindsight in combining the teachings of Fox and Carey. (App. Br. 12–13.) The Examiner answers by finding it would have been obvious to combine the related disclosures of Fox and Carey “to allow usage of SMS protocols in Fox to deliver the instant messaging communication client devices as taught by Carey, thus allowing Fox to include cellular devices,” which

predictably “would allow [a] user’s handheld device, such as, [a] smart phone, to browse email, as well as, use instant message on a cellular device.” (Ans. 6.) Appellants reply (*inter alia*) that “[t]he Examiner fails to define or provide evidence of what features, capabilities, or structures are embodied in this hypothetical ‘smart phone,’ or show that such a device existed prior to Appellant[s’] Application.” (Reply Br. 5.)

Appellants do not persuade us.

Any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from applicant’s disclosure, such a reconstruction is proper.

In re McLaughlin, 433 F.2d 1392, 1395 (CCPA 1971). “[A]n analysis of obviousness . . . may include recourse to logic, judgment, and common sense available to the person of ordinary skill that do not necessarily require explication in any reference or expert opinion.” *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1329 (Fed. Cir. 2009). We find the Examiner sets forth sufficient “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”⁴ *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

⁴ We note smartphones were well known well before to the filing date of Appellants’ application. The Examiner “may take notice of facts . . . capable of such instant and unquestionable demonstration as to defy dispute.” *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970). To adequately traverse the Examiner’s finding, Appellant must specifically point out the supposed errors in the Examiner’s action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See MPEP § 2144.03.

Accordingly, we sustain the rejection of claim 1. Because our analysis relies in part on disclosure from Fox not cited by the Examiner, we designate our affirmance of the rejection of claim 1 as a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Except as discussed above, this new ground of rejection incorporates the findings and reasons of the Examiner in the rejection of claim 1 (*see* Final Act. 3–5; Ans. 2–6). We also sustain the rejection of dependent claims 4, 5, and 26, for which Appellants provide no separate arguments.

Claims 2, 20, and 29

Appellants contend the Examiner errs in rejecting claims 2, 20, and 29 because Fox does not teach or suggest “displaying the most recent text message in the selected conversation having the search term, and thereafter displaying, automatically without user input after displaying the most recent text message . . . , the most recent text message in the selected conversation” as recited. (App. Br. 14.) The Examiner answers by finding the display of snippets described in Fox teaches this requirement. (Ans. 7 (citing Fox ¶ 65, which refers to Fig. 3A).) We agree with Appellants. The cited portion of Fox discloses that a snippet may be “generated from the most recent message” but is silent as to automatic display of such a snippet after the display of the most recent text message that includes a search term as part of displaying a sequence of text messages, as recited. Accordingly, we do not sustain the rejection of claims 2, 20, and 29.

Claim 6

Claim 6 depends from claim 5, which requires displaying “next” and “previous” buttons for navigating to immediately preceding or following text messages in a string. Claim 6 requires loading those adjacent text messages

into a cache. (*See* App. Br. 20 (Claims App’x).) Appellants contend the Examiner errs in finding Fox teaches this requirement⁵ because “the ‘cache’ discussed in Fox is a history of previous queries entered by a user, not messages.” (App. Br. 15.) The Examiner answers by finding that the “query cache” disclosure of Fox, in view of Fox’s teaching that functionality can be divided flexibly between the conversation management system and conversation assistant, teaches the requirements of claim 6. (Ans. 8 (citing Fox Fig. 7A, ¶¶ 54, 145).) We agree with Appellants. The cited disclosure of Fox relates to caching of queries, but is silent as to the recited caching of text messages. Accordingly, we do not sustain the rejection of claim 6.

Claim 13

The Examiner’s analysis in rejecting independent claim 13 consists of: “Claim 13 is similar to claim 1 hence rejected similarly.” (Final Act. 6 (emphasis omitted).) Claim 13 includes several requirements with no counterparts in claim 1, with one example being requirements for “meta data of text messages.” (*See* App. Br. 19–21 (Claims App’x).) Appellants contend the final rejection “failed to establish a *prima facie* case for obviousness under § 103.” (App. Br. 16.) We agree.

The Examiner answers by finding “meta data, as defined by [the] instant application . . . is taught by Fox in Paragraphs [0057]-[0066] and Fig[.] 3A, manipulation and creation of conversations, based on sender, receiver, content (search terms) and dat[e]/time.” (Ans. 9.) Appellants reply that “the cited references fail to disclose, teach or suggest ‘searching through meta data of text messages for said search term, the meta data of text

⁵ *See* Final Act. 9 (citing Fox ¶ 145, Figs. 3B, 6B–E).

messages being stored separately from the text messages, the text messages being stored in a plurality of files on the handheld electronic device,” as recited. (Reply Br. 6.) We again agree with Appellants. Accordingly, on this record, we do not sustain the rejection of claim 13, or of its dependent claims 14, 15, 18, 27, 28, and 29.

We note, in an *ex parte appeal*, the Board “is basically a board of review—we review . . . rejections made by patent examiners.” *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (BPAI 2001). Review pursuant to 35 U.S.C. § 134 “is not a process whereby the examiner . . . invite[s] the [B]oard to examine the application and resolve patentability in the first instance.” *Ex parte Braeken*, 54 USPQ2d 1110, 1112 (BPAI 1999). The Board’s primary role is to make our decision based on the findings and conclusions presented by the Examiner. *See* 37 C.F.R. § 41.50(a)(1).

We express no opinion as to the validity of claim 13 in view of additional explanation and/or references. Although we have authority to designate a new ground of rejection under 37 C.F.R. § 41.50(b), which we do for certain claims, no inference should be drawn when we elect not to do so. *See Manual of Patent Examining Procedure* (MPEP) § 1213.02 (9th Ed., Rev. 07.2015, Nov. 2015).

Claim 19

Claim 19 recites a “tangible machine readable storage medium having stored thereon program code” that, when processed, causes a method to be performed, where the method comprises steps that correspond to steps also recited in claim 1. (*See* App. Br. 19, 21–22 (Claims App’x).) The Examiner rejects claim 13 as “similar to claim 1 hence rejected similarly.” (Final Act. 7 (emphasis omitted).) Appellants contend the Examiner errs in rejecting

claim 19 for the same reasons as claim 1. We sustain the rejection of claim 19 for the same reasons discussed *supra* for claim 1.⁶ As with claim 1, we designate this as a new ground of rejection. We also sustain the rejection of dependent claims 22–24 and 30, for which Appellants provide no separate arguments.

DECISION

For the above reasons, we affirm the rejections of claims 1, 4, 5, 19, 22–24, 26, and 30, and we reverse the rejections of claims 2, 6, 13–15, 18, 20, and 27–29. Pursuant to our authority under 37 C.F.R. § 41.50(b), we enter new grounds of rejection for claims 1 and 19 as obvious under 35 U.S.C. § 103(a).

Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of

⁶ Claim 19’s recited “searching through stored text message information” requirement does not include index-related requirements as in claim 1. In this regard, claim 19 is broader. We find that Fox’s disclosure that teaches or suggests claim 1’s searching requirement also teaches or suggests claim 19’s searching requirement.

rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the MPEP § 1214.01.

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; 37 C.F.R. § 41.50(b)