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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ERIC SAUND, JAMES V. MAHONEY,
and WILLIAM C. JANSSEN, JR.

Appeal 2017-008158
Application 14/062,934
Technology Center 2100

Before DENISE M. POTHIER, MATTHEW J. McNEILL, and
JASON M. REPKO, *Administrative Patent Judges*.

POTHIER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants[1] appeal under 35 U.S.C. § 134(a) from the Examiner's rejections of claims 1–31. App. Br. 3–7.[2] We have jurisdiction under 35 U.S.C. § 6(b). We affirm in part.

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[1] The real party in interest is listed as Palo Alto Research Center Incorporated. App. Br. 1.

[2] Throughout this opinion, we refer to (1) the Final Action (Final Act.) mailed February 9, 2016, (2) the Appeal Brief (App. Br.) filed November 9, 2016, (3) the Examiner's Answer (Ans.) mailed March 8, 2017, and (4) the Reply Brief (Reply Br.) filed May 8, 2017.

Invention

Appellants seek to overcome shortcomings related to electronic messages and documents. *See* Spec. ¶ 6. For example, problems arise when a user wishes (1) to include portions of documents directly in an email message, (2) to view both the email's body and attached material, and (3) to generate messages with inline images. *Id.* ¶¶ 3–5.

Claim 1 is illustrative and reproduced below with emphasis:

> 1. A method for composing a message the method comprising:
>
> generating a display window;
>
> configuring the display window to include at least one page viewing region configured to display multiple page images of a multi-page document;
>
> configuring the display window to include at least one message composition region, for composition of the message, and
>
> *selecting and transferring*, by use of a selection-transfer mechanism, *material from the at least one page viewing region to the at least one message composition region for use in the composing of the message*[,]
>
> wherein the generating, configuring and selecting are performed using a single application without a requirement of opening another separate application during composition of the message, and
>
> wherein the method is performed by use of an electronic computing device.

The Examiner relies on the following as evidence of unpatentability:

Lee	US 6,061,696	May 9, 2000
Cody	US 2004/0183830 A1	Sept. 23, 2004
Bienstock	US 2006/0075033 A1	Apr. 6, 2006
Bogestam	US 2009/0327864 A1	Dec. 31, 2009
Ayers	US 2014/0289614 A1	Sept. 25, 2014 (filed May 16, 2005)

The Rejections

Claims 1, 2, 4–8, 10, 11, 13, 21–24, and 26–31[3] are rejected under 35 U.S.C. § 102(a)(1) as anticipated by Bienstock. Final Act. 3–12.

Claims 3, 15–17, and 19 are rejected under 35 U.S.C. § 103 as unpatentable over Bienstock and Lee. Final Act. 12–17.

Claims 9 and 18 are rejected under 35 U.S.C. § 103 as unpatentable over Bienstock and Ayers. Final Act. 17–18.

Claims 12, 14, and 25 are rejected under 35 U.S.C. § 103 as unpatentable over Bienstock and Bogestam. Final Act. 18–20.

Claim 20 is rejected under 35 U.S.C. § 103 as unpatentable over Bienstock and Cody. Final Act. 20.

THE ANTICIPATION REJECTION OVER BIENSTOCK

Regarding representative claim 1,[4] the Examiner finds Bienstock discloses all its limitations (Final Act. 3–6), including the recited "selecting and transferring" step (*id.* at 5 (citing Bienstock ¶¶ 39–47, Figs. 6–8)). *See also* Ans. 5–8. Appellants argue Bienstock does not disclose "the user can generate multimedia message content integrated with the composed electronic message content, i.e. selecting and transferring material from the

[3] Although including claims 12, 18, and 25 in the rejection's heading (Final Act. 3), these claims are not discussed in the rejection's body (*id.* at 10–12). Rather, claim 18 is rejected based on Bienstock and Ayers (*id.* at 17–18), and claims 12 and 25 are rejected based on Bienstock and Bogestam (*id.* at 18–20).

[4] Appellants argue claims 1, 2, 21, 22, and 26–31 as a group. *See* App. Br. 10. We select claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(iv).

at least one page viewing region to the at least one message composition region for composition of the message." App. Br. 10 (citing Bienstock ¶¶ 5–7); Reply Br. 3. Appellants contend Bienstock sends multi-media files with an email message but this "does not provide for the inclusion of multimedia material into the composition region or body of the email." App. Br. 9 (citing Bienstock ¶ 41).

Regarding dependent claim 4, Appellants argue Bienstock does not disclose a drag and drop operation from one region to another region as recited and is silent regarding a cut and paste operation. App. Br. 11.

As for dependent claim 5, Appellants assert Bienstock is silent concerning a message composition region having multimedia objects, such that Bienstock does not disclose "a selection of those objects." App. Br. 11–12.

ISSUES

Under § 102, has the Examiner erred by finding Bienstock discloses

(I) "selecting and transferring . . . material from the at least one page viewing region to the at least one message composition region for use in the composing of the message" as recited in claim 1;

(II) "the selecting and transferring is performed as one of a drag and drop operation or a cut and paste operation" as recited in claim 4; and

(III) "including selecting objects in the at least one message composition region" as recited in claim 5?

ANALYSIS

I. *Claims 1, 2, 21, 22, and 26–31*

Based on the record before us, we find no error in the rejection of representative claim 1. At the outset, we agree with the Examiner that claim 1 does not recite (1) the term "integrated," (2) a multimedia message "integrated" with the composed electronic message content, or (2) sending an email message. Ans. 7–8. Instead, claim 1 recites "[a] method for composing a message" and "selecting and transferring . . . material from the at least one page viewing region to the at least one message composition region *for use in the composing* of the message." App. Br. 15 (Claims App.) (emphasis added). As broadly recited, the material transferred from a page viewing region to a message composition region in claim 1 *is used in composing the message* but does not require integrating a multimedia message with an electronic message's content as argued. Thus, some of Appellants' arguments (*see* App. Br. 9–10), are unavailing because they do not address the limitations in claim 1.

As for the disputed limitation, "selecting and transferring . . . material from the at least one page viewing region to the at least one message composition region for use in the composing of the message," the Examiner maps (1) "the right-hand panel" or menu 150 in Bienstock's Figures 6 and 7 to the recited "page viewing region" in claim 1 and (2) "the left-handed panel" in these same figures to the recited "message composition region." Ans. 6 (citing Bienstock, Figs. 6–8). When the user selects thumbnail 180 in Figure 7, for example, as the desired greeting card, some selected "material" is transferred from the page viewing region located at the right-hand side to

the message composition region located at the left-hand side. *See id.*; *see also* Bienstock ¶¶ 42–43, Fig. 7.

Additionally, this process in Bienstock is "for use in the composing of the message" (e.g., multi-media message) as broadly recited. *See* Bienstock ¶¶ 29–30, 52–53, Fig. 3. Thus, attempts to draw a distinction between "the greeting card generation" used in composing a message and "the intended 'message' of the electronic mail message" as argued (Reply Br. 2), are unavailing. *See also id.* at 2–3. In particular, Bienstock describes customizing a message *to include* a multi-media file. Bienstock ¶ 30. Moreover, although not required by claim 1, Bienstock also describes email as "[a]n email message" (*id.* ¶ 4) and discusses "the attached file is delivered *as part of* the email" (*id.* ¶ 5 (emphasis added)), such that any file attached to an email is considered part of its email message. Accordingly, the above steps in Bienstock are used to compose a message as recited, despite Appellants' assertions that "Bienstock considers the multi-media file and the email message separately, rather than as parts to a whole." App. Br. 10.

The Specification is also consistent with this understanding. Spec. ¶¶ 3–5. Here, the disclosure states "it is common for electronic messages, such as email message, to contain attachments." *Id.* ¶ 3. Thus, according to the disclosure, an email's attachments are part of an email message. Granted, the disclosure further states the "[e]mail attachments are separated from the body of email message text." *Id.* ¶ 4. Yet, claim 1 fails to recite a message's body or content or that the recited "material" transfers to a specific part of the message. App. Br. 15 (Claims App.). Also, claim 1 does not recite "[t]he ability to produce and edit multimedia content in the body of the message." *Id.* at 9. Arguments related to Bienstock's attachments

"not [being] in the body of the message" thus fail to address a limitation in claim 1. *Id.* at 8 (underlining omitted); *see also id.* at 8–9. Moreover, as addressed above, we disagree Bienstock fails to disclose transferring "material from one region to another" as asserted. *Id.* at 9.

As for paragraph 36, Bienstock discloses adding a text message to email by selecting "Message" button 120. Bienstock ¶ 36. To be sure, this feature permits adding text to an email message. Yet, claim 1 broadly recites a *message composition* region. App. Br. 15 (Claims App.). Bienstock's Figure 7 and its left-side panel are used to compose the greeting card that is part of the recited "message" and thus, Bienstock discloses the recited "message composition region" as previously discussed.[5] We therefore determine Bienstock's left-side panel in Figure 7 is "a message composition region" as an ordinarily skilled artisan would have understood, contrary to Appellants' arguments. Reply Br. 3.

Lastly, regarding Bienstock's Figure 10 (App. Br. 10; Reply Br. 3–4), we agree with the Examiner that this figure describes "a display of how a recipient, not a sender[,] views the message sent by the sender." Ans. 7; *see also* Bienstock ¶¶ 19, 53–54, *cited in part in* Ans. 8. As such, Appellants' discussion of how the multimedia content is displayed when the sender receives a message (e.g., a link in Fig. 10) does not address how Bienstock discloses transferring material from different regions "for use in the composing of the message" as claim 1 recites. App. Br. 10.

[5] Bienstock further permits customizing text within a greeting card. Bienstock ¶¶ 45–46.

For the foregoing reasons, Appellants have not persuaded us of error in the rejection of independent claim 1 and claims 2, 21, 22, and 26–31 not separately argued.

II. *Claim 4*

Claim 4 depends from claim 1 and further recites "the selecting and transferring is performed as one of a drag and drop operation or a cut and paste operation." App. Br. 16 (Claims App.). Based on the record before us, we find error in the Examiner's rejection of dependent claim 4.

Appellants argue Bienstock teaches thumbnails 270 through 288 that can be dragged and dropped around picture window 268 and does not teach dragging and dropping material from one region to another. App. Br. 11 (citing Bienstock ¶ 51). We agree Bienstock's dragging and dropping of thumbnails in Figure 7 is confined to a single window or region (e.g., 268) and does not disclose transferring material from the mapped "page viewing region" (e.g., right-side panel in Figure 7) to the mapped "message composition region" (e.g., left-side panel in Figure 7) as recited. *See* Ans. 7.

Additionally, the Examiner finds Bienstock discloses "a cut and paste operation" in Figure 7 where a selected card is copied and pasted into the left-hand panel (e.g., a message composition region) for customization. Ans. 9 (citing Bienstock, Fig. 7). In response, Appellants contend a copy and paste operation differs from "a cut and paste operation," which involves "remov[ing] document material for later placement according to a 'paste' command" as understood by those skilled in the art. Reply Br. 5. We agree.

The Microsoft Computer Dictionary defines "cut and paste" as

> A procedure in which the computer acts as an electronic combination of scissors and glue for reorganizing a document . . . . In cut and paste, the portion of a document to be moved is

> selected, removed to storage in memory or on disk, and then reinserted into the same or a different document.

Microsoft Computer Dictionary, 5th Edition 137–38 (2002). As such, an ordinary understanding to those skilled in the art of "a cut and paste operation" involves removing a selected portion of document to storage and reinserting the document portion into the same or different document or application.

Although its possible that Bienstock's act of selecting a greeting card (e.g., element 180) involves removing a part of the card to storage and then reinserting this part into its application (*see* Bienstock ¶¶ 42–43, Fig. 7), such possibilities or probabilities are insufficient to demonstrate Bienstock necessarily performs the recited "cut and paste operation" in claim 4 required to anticipate the claim. *See In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

For the foregoing reasons, Appellants have persuaded us of error in the rejection of claim 4.

III. *Claims 5–8*

Claim 5 depends indirectly from claim 1 and further recites "including selecting objects in the at least one message composition region." App. Br. 16 (Claims App.). Appellants argue "Bienstock is silent with regard to a message composition region containing multimedia objects" and thus cannot disclose selecting such objects. *Id.* at 11. We disagree.

The Examiner relies on the same figures in Bienstock to disclose the features in claim 5. Final Act. 7 (citing Bienstock ¶¶ 39–47, Figs. 6–8). In particular, the Examiner discusses the text for the cover or inside page of a greeting card (e.g., objects) located in the message composition region of

Figure 7 can be changed and thus involves selecting such text. *See* Bienstock ¶¶ 45–46; *see* App. Br. 7. The Specification states text are objects. Spec. ¶ 42. Bienstock thus is not "silent" (App. Br. 11), regarding the message composition region containing "objects" and is not incapable of the recited "selecting" as asserted. App. Br. 11. Bienstock further shows other objects (e.g., graphic image of cupid) in the message composition region. Bienstock, Fig. 7.

For the foregoing reasons, Appellants have not persuaded us of error in the rejection of claim 5 and dependent claims 6–8, which are similarly or not separately argued.

IV. *Claims 10, 11, 13, 23, and 24*

Claim 10 depends on claim 1 and recites "generating an outgoing message composed of at least two of:" different object types (e.g., text, image, or graphic) or clips (e.g., audio or video). App. Br. 16 (Claims App.). For this claim, Appellants assert Bienstock does not disclose multimedia content or objects within the electronic message. *Id.* at 12. We disagree. Bienstock discloses an outgoing electronic message can include various multimedia elements, including text, greeting cards, animation, video, and sound. Bienstock ¶¶ 29, 43–47. As explained above, whether or not these elements are attachments within a message, these elements are still part of the generated "outgoing message" as recited.

Dependent claims 23 and 24 recite similar limitations to claim 10 (App. Br. 18–19 (Claims App.)) and are sustained for similar reasons.

Accordingly, Appellants have not persuaded us of error in the rejection of claim 10 and dependent claims 11, 13, 23, and 24, which are not separately argued.

THE OBVIOUSNESS REJECTIONS

Claims 3, 9, 12, 14–20, and 25 are rejected as obvious based on Bienstock and another reference (e.g., Lee, Ayers, Bogestam, or Cody). Final Act. 12–20. Appellants rely on the arguments presented for claim 1 and further contend the additionally cited references do not cure the purported deficiencies. App. Br. 12–13. We are not persuaded for the above reasons. Accordingly, we sustain the rejections of claims

DECISION

We affirm the Examiner's rejection of claims 1, 2, 5–8, 10, 11, 13, 21–24, and 26–31 under § 102 and claims 3, 9, 12, 14–20, and 25 under § 103.

We reverse the Examiner's rejection of claims 4 under § 102.

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

Notice of References Cited	Application/Control No. 14/062,934	Applicant(s)/Patent Under Patent Appeal No. 2017-008158	
	Examiner	Art Unit 2177	Page 1 of 1

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NON-PATENT DOCUMENTS

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	U	Microsoft Computer Dictionary, 5th Edition 137–38 (2002).
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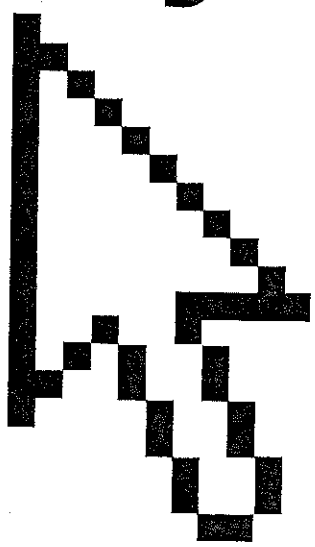

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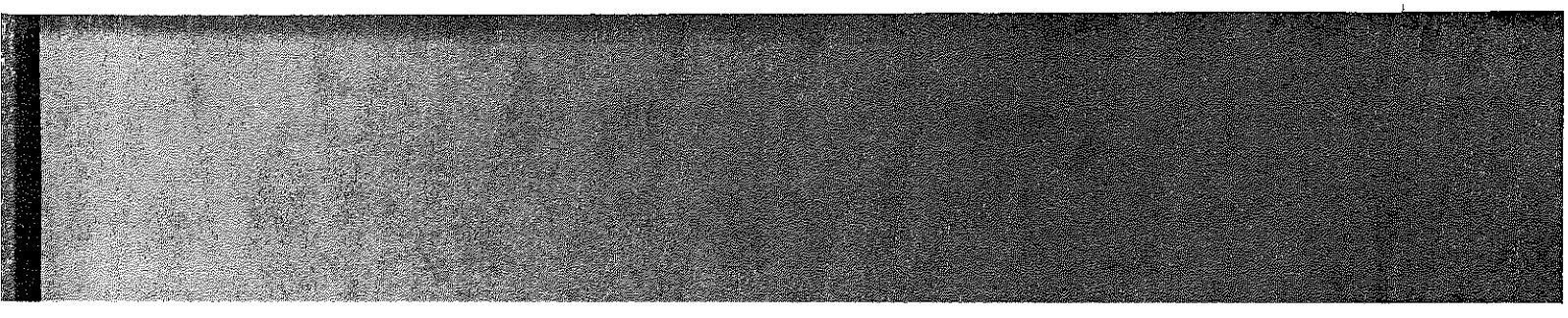

cube *n.* An OLAP data structure. A cube contains dimensions (like Country/Region/City) and data fields (like Sales Amount). Dimensions organize types of data into hierarchies with levels of detail, and data fields measure quantities.

Cube *n.* A personal computer design introduced by Apple in 2000. The Cube featured a unique 8-by-8-by-8-inch transparent curved cube shape with the power supply outside the chassis to create a small and extremely quiet computer. The Cube offered the same G4 processor and features available on other Macintosh computers, but with fewer expansion options. Although the unique design drew notice for innovation, Apple discontinued manufacture of the Cube in 2001 after only one year of production.

CUI *n. See* character user interface.

CUL8R *n.* A fanciful shorthand notation meaning "See you later," sometimes seen in Internet discussion groups as a farewell by a participant temporarily leaving the group.

curly quotes *n. See* smart quotes.

current *n.* The flow of electric charge through a conductor, or the amount of such flow. Current is measured in amperes. *See also* ampere, coulomb. *Compare* volt.

current cell *n. See* active cell.

current directory *n.* The disk directory at the end of the active directory path—the directory that is searched first for a requested file, and the one in which a new file is stored unless another directory is specified. *See also* path (definition 2).

current drain *n.* **1.** The current taken from a voltage source by its load (the object receiving the current). *Also called:* drain. **2.** The load itself. For example, a flashlight bulb takes current from the battery; this current is the drain on the battery, and the bulb itself may also be called the drain.

current location counter *n. See* program counter.

current-mode logic *n.* A type of circuit design in which the transistors operate in unsaturated (amplifying) mode.

cursor *n.* **1.** A special on-screen indicator, such as a blinking underline or rectangle, that marks the place at which a keystroke will appear when typed. **2.** In reference to digitizing tablets, the stylus (pointer or "pen"). **3.** In applications and operating systems that use a mouse, the arrow or other on-screen icon that moves with movements of the mouse.

cursor blink speed *n.* The rate at which a cursor on a screen flashes on and off. *See also* cursor (definition 1).

cursor control *n.* The ability of a computer user to move the cursor to a specified location on the screen. Keys dedicated to cursor control include the left, right, up, and down arrow keys and certain others, such as Backspace, Home, and End. Pointing devices such as the mouse can also control cursor movements, often helping the user move the cursor long distances from place to place in a document.

cursor key *n. See* arrow key.

CUSeeMe *n.* A video conferencing program developed at Cornell University. It was the first program to give Windows and Mac OS users the ability to engage in real-time video conferencing over the Internet, but it requires a lot of bandwidth (at least 128 Kbps speed) to function properly.

custom control *n.* A control authored by a user or a third-party software vendor that does not belong to the .NET Framework class library. This is a generic term that includes user controls. A custom server control is used in Web Forms (ASP.NET pages). A custom client control is used in Windows Forms applications.

customize *vb.* To modify or assemble hardware or software to suit the needs or preferences of the user. Traditionally, hardware customizing ranges from designing an electronic circuit for a particular customer to putting together a computer facility tailored to a customer's special need. Software customizing usually means modifying or designing software for a specific customer.

custom queuing *n.* A form of queuing on Cisco routers where the wide area network (WAN) link is divided into micropipes based on a percentage of the total bandwidth available on the pipe. *See also* bandwidth reservation.

custom software *n.* Any type of program developed for a particular client or to address a special need. Certain products, such as dBASE and Lotus 1-2-3, are designed to provide the flexibility and tools required for producing tailor-made applications. *See also* CASE.

cut *vb.* To remove part of a document, usually placing it temporarily in memory so that the cut portion can be inserted (pasted) elsewhere. *Compare* delete.

cut and paste *n.* A procedure in which the computer acts as an electronic combination of scissors and glue for reorganizing a document or for compiling a document from different sources. In cut and paste, the portion of a document

C

to be moved is selected, removed to storage in memory or on disk, and then reinserted into the same or a different document.

cut-through switch *n.* A network switch that routes packets immediately to the port associated with the packet's recipient. *See also* packet.

CV *n. See* computer vision.

CVS *n.* **1.** *See* Computer Vision Syndrome. **2.** Acronym for Concurrent Versions System. An open-source network-transparent version control system which allows multiple developers to view and edit code simultaneously. Popular because the client-server function allows operation over the Internet. CVS maintains a single copy of the source code with a record of who initiated changes and when the changes were made. CVS was developed for the UNIX operating system and is commonly used by programmers working with Linux, Mac OS X, and other UNIX-based environments.

CWIS *n. See* campuswide information system.

cXML *n.* Acronym for commerce XML. A set of document definitions for Extensible Markup Language (XML) developed for use in business-to-business e-commerce. cXML defines standards for product listings, allows for electronic requests and responses between procurement applications and suppliers, and provides for secure financial transactions via the Internet.

cyber- *prefix* A prefix attached to "everyday" words in order to give them a computer-based or online meaning, as in cyberlaw (the practice of law either in relation to or through the use of the Internet) and cyberspace (the virtual online world). The prefix is derived from the word *cybernetics*, which refers to the study of mechanisms used to control and regulate complex systems, either human or machine.

cyberart *n.* The artwork of artists who use computers to create or distribute their efforts.

cybercafe or **cyber café** *n.* **1.** A coffee shop or restaurant that offers access to PCs or other terminals that are connected to the Internet, usually for a per-hour or per-minute fee. Users are encouraged to buy beverages or food to drink or eat while accessing the Internet. **2.** A virtual café on the Internet, generally used for social purposes. Users interact with each other by means of a chat program or by posting messages to one another through a bulletin board system, such as in a newsgroup or on a Web site.

cybercash *n. See* e-money.

cyberchat *n. See* IRC.

cybercop *n.* A person who investigates criminal acts committed on line, especially fraud and harassment.

cyberculture *n.* The behavior, beliefs, customs, and etiquette that characterize groups of individuals who communicate or socialize over computer networks, such as the Internet. The cyberculture of one group can be vastly different from the cyberculture of another.

Cyberdog *n.* Apple's Internet suite for Web browsing and e-mail, based on OpenDoc for easy integration with other applications. *See also* OpenDoc.

cyberlawyer *n.* **1.** An attorney whose practice involves the law related to computers and online communication, including elements of communications law, intellectual property rights, privacy and security issues, and other specialties. **2.** An attorney who advertises or distributes information over the Internet and the World Wide Web.

cyberlife *n.* In the gaming world, a technology that mimics biological DNA. *See also* digital DNA.

cybernaut *n.* One who spends copious time on line, exploring the Internet. *Also called:* Internaut. *See also* cyberspace.

cybernetics *n.* The study of control systems, such as the nervous system, in living organisms and the development of equivalent systems in electronic and mechanical devices. Cybernetics compares similarities and differences between living and nonliving systems (whether those systems comprise individuals, groups, or societies) and is based on theories of communication and control that can be applied to either living or nonliving systems or both. *See also* bionics.

cyberpunk *n.* **1.** A genre of near-future science fiction in which conflict and action take place in virtual-reality environments maintained on global computer networks in a worldwide culture of dystopian alienation. The prototypical cyberpunk novel is William Gibson's *Neuromancer* (1982). **2.** A category of popular culture that resembles the ethos of cyberpunk fiction. **3.** A person or fictional character who resembles the heroes of cyberpunk fiction.

cybersex *n.* Communication via electronic means, such as e-mail, chat, or newsgroups, for the purpose of sexual stimulation or gratification. *See also* chat[1] (definition 1), newsgroup.