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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte FRANK S. SERDY JR., SELVARAJ NALLIAH,
and DAVID R. WILLIAMSON

Appeal 2019-000387
Application 12/833,233
Technology Center 2100

Before NABEEL U. KHAN, SHARON FENICK, and RUSSELL E. CASS,
Administrative Patent Judges.

KHAN, *Administrative Patent Judge.*

DECISION ON APPEAL
STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant appeals from the Examiner's decision to reject claims 1–37.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies Microsoft Technology Licensing, LLC, as the real party in interest. Appeal Br. 4.

CLAIMED SUBJECT MATTER

According to Appellant, the invention:

allow[s] mobile users to send replies to, or to forward, truncated electronic mail messages, and yet still send the entire body of the original electronic mail message, without having to download the entire body of the mail message locally to the mobile device and then re-transmit the entire message from the mobile device.

Abstract.

Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method of sending an electronic mail (e-mail) message in response to an original e-mail message having a message body, comprising:

storing the original e-mail message in a data store;

sending a truncated e-mail message to a mobile device of a user, the truncated e-mail message corresponding to the original e-mail message with a portion thereof removed;

receiving, from the mobile device, a responsive e-mail in response to the truncated e-mail identifying a recipient; and

in response to receiving the responsive e-mail, which indicates that the user has selected to transmit a resulting e-mail message in response to the truncated email, retrieving the original e-mail message from the data store and sending, from the server to the recipient, a resultant e-mail message including the portion removed from the original e-mail message without requiring downloading to the mobile device the portion removed from the original e-mail message prior to sending the resultant e-mail message.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Shaw	US 6,249,807 B1	June 19, 2001
Arnold	US 6,275,848 B1	Aug. 14, 2001
Jain	US 6,332,164 B1	Dec. 18, 2001
Smith	US 7,006,242 B2	Feb. 28, 2006

REJECTIONS

1. Claims 1–21 and 23–37 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Jain, Shaw, and Smith. Final Act. 2–30.
2. Claims 22 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Jain, Shaw, Smith, and Arnold. Final Act. 30.

OPINION

Claim 1

Claim 1² recites “sending a truncated e-mail message to a mobile device of a user, the truncated e-mail message corresponding to the original e-mail message with a portion thereof removed” and further recites “retrieving the original e-mail message from the data store and sending, from the server to the recipient, a resultant e-mail message including the portion removed from the original e-mail message without requiring downloading to the mobile device the portion removed from the original e-mail message.”

² Appellant argues independent claims 1, 8, 19, 27, 33, 34, and 35 together as a group. See Appeal Br. 19–35. We select claim 1 as representative of these claims, pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner finds the combination of Jain, Shaw, and Smith teaches the limitations of claim 1. Final Act. 3–5. Specifically, the Examiner finds Jain teaches storing an original email message in a data store and sending a truncated email message, with a portion of the original message removed, to a user device. Final Act. 3 (citing Jain, 2:5–6, 5:32–33, 5:40–52). The Examiner finds Shaw teaches receiving a responsive email identifying a recipient in response to the truncated email. Final Act. 3 (citing Shaw, 2:66–3:5, 3:13–15, 4:16–28, 4:35–39, 5:57–62, 6:5–7, 14:33–49). Finally, the Examiner finds Smith teaches that a server delivers information to user mobile devices, but because of limited capacity, a truncated information set is generated for transmission to the mobile device, while a full information set is reserved to be sent to a high capacity device such as a printer. Final Act. 4 (citing Smith, 1:59–61, 3:31–50, 3:66–4:2, 4:7–12, 4:24–29, 6:34–43). The combination of Jain, Shaw, and Smith, according to the Examiner, would have taught one of skill in the art to display a truncated email on a mobile device, and when sending a message responsive to the truncated email (as taught by Shaw), retrieving the original email, which Jain and Smith store separately, and sending it to the recipient of the responsive email. Final Act. 5 (citing Smith, 5:66–6:3, 6:52–53, 8:29–33, 8:38–39). The Examiner finds that one of ordinary skill in the art would have combined Jain with Shaw’s interface for forwarding and replying to truncated e-mails to allow a user to more easily respond to a large volume of emails. Final Act. 3–4. The Examiner further finds that one of ordinary skill would have combined Smith with Jain and Shaw to display truncated e-mail messages on a portable device and retrieve the original information for transmission to a recipient when sending a message responsive to the

truncated e-mail, allowing a user to receive information from anywhere while also allowing for efficient display of the information based on the type of device being used. Final Act. 4–5.

Appellant argues “none of these [relied upon] references, nor their combination, teaches a scenario *in which a first message recipient does not receive an entire message, but an associated server is able to send the entire message to a second recipient.*” Appeal Br. 24–25. Starting first with Jain, Appellant argues “Jain does not disclose that a recipient form[s] a response email message, or that such a response email message would be either a complete or shortened message.” *Id.* at 25–26. According to Appellant, Jain does not disclose an instance where the “recipient’s mobile device would have a truncated message but the *recipient’s mail server* would have a complete message . . . and certainly does not describe that a recipient’s mobile device does not receive an entire message, but is able to send an entire resultant message to a second recipient.” *Id.* at 26.

We find these arguments unpersuasive. Appellant’s arguments attack Jain individually without considering the Examiner’s combination of references or taking into account the Examiner’s findings as a whole. “[O]ne cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references.” *In re Keller*, 642 F.2d 413, 426 (CCPA 1981). The Examiner relies on Shaw, not Jain, as teaching “receiving . . . a responsive e-mail in response to the truncated e-mail identifying a recipient.” Final Act. 3–4 (citing Shaw, 2:66–3:5, 3:13–15, 4:16–28, 4:35–39, 5:57–62, 6:5–7, 14:33–49).

Moreover, Appellant’s argument that Jain does not disclose an instance where the recipient’s mobile device would have a truncated

message but the recipient's mail server would have a complete message is not commensurate with the scope of claim 1. Claim 1 does not require that the "recipient's mail server" have a complete message to allow for the creation of a resultant message. Instead, claim 1 simply requires that the original message be stored "in a data store" and "retriev[ed] . . . from [a] data store." With respect to the original message being stored in a data store, the Examiner correctly finds, Jain discloses "storing a complete version of the electronic message in a mail server," which is a "data store" as recited in claim 1. Jain 2:5–6; *see* Final Act. 3.

Turning next to Shaw, Appellant argues that "the email server of Shaw cannot create a resultant email message that includes a truncated (i.e. removed) portion of the email message because the email system of Shaw would not store those portions of the message that are truncated – instead, it discards those portions to conserve storage space on the server." Appeal Br. 29. Appellant further argues that the combination of Jain and Shaw would also not teach the claim limitations "because the original email in Jain is not stored on *the truncated email recipient's server* in Jain and the original email from which a truncated email is formed is not stored at all in Shaw." *Id.* at 29–30.

The argument that Shaw cannot create a resultant email message that includes a truncated portion of the email message attacks Shaw individually, rather than focusing on the Examiner's combination of references. As explained above, the Examiner relies on Jain, Shaw, and Smith, rather than Shaw alone, for teaching that a resultant email is formed by including a truncated portion of the original email message. *See* Final Act. 3–5. And, Appellant's argument that Jain does not store the original email on the

truncated email recipient's server is not commensurate with the scope of claim 1, as explained above.

Finally, with regard to Smith, Appellant argues "no response email message is formed at the mobile device; rather, abstracts are delivered to the mobile device, at which a user can set a flag indicating that delivery of the entire article may be desired." Appeal Br. 33. Appellant argues that "[a]t best Smith . . . indicates that a user receiving a shortened version of an article could request to have a full version of that same article *sent to him/herself*, Smith . . . does not disclose forwarding such an article in an email to a third party." *Id.* at 33–34.

Appellant's argument that in Smith "no response email message is formed," or that Smith "does not disclose forwarding such an article in an email to a third party," ignores the Examiner's findings regarding Shaw, which the Examiner relied upon as teaching the claimed "responsive email" in the combination of references applied in the rejection. Final Act. 3. Furthermore, contrary to Appellant's argument that Smith sends the full version of the article to the user him/herself, Smith teaches sending a full version of an article to a separate "high capacity" device, such as a printer, rather than to the user's mobile device. *See* Smith 2:41–45; 4:36–39; 8:29–42.

For the aforementioned reasons, we sustain the Examiner's rejection of claim 1 and of claims 1–21 and 23–37, which were argued together as a group. *See* Appeal Br. 19–35.

Claim 22

Appellant argues claim 22 separately from the other claims, but does not present any new arguments other than to state that Arnold (which the

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Examiner relies upon in rejecting claim 22) “cannot cure the deficiencies of Jain, Shaw, and Smith.” Appeal Br. 36. As such, we sustain the Examiner’s rejection of claim 22 for the same reasons expressed above with respect to claim 1.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–21, 23–37	103	Jain, Shaw, Smith,	1–21, 23–37	
22	103	Jain, Shaw, Smith, Arnold	22	
Overall Outcome			1–37	

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED