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MICHAEL BEST & FRIEDRICH LLP (MS) 790 N WATER ST SUITE 2500 MILWAUKEE, WI 53202			BENZON, GREG C	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SANTOSH KUMAR, GISELLI PANONTINI DESOUZA SANA,
ALISSON TEIXEIRA, AMIT GUPTA, CINDY KWAN,
SANGYA SINGH, NARESH SUNDARAM, and JOHANNES GEHRKE

Appeal 2019-001669
Application 14/737,658
Technology Center 2400

Before CAROLYN D. THOMAS, JEREMY J. CURCURI, and
AMBER L. HAGY, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–6, 8–11, 15, and 17–20. We have jurisdiction over the appeal 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. Appellant identifies the real party in interest as Microsoft Technology Licensing, LLC. Appeal Br. 2.

The present invention relates generally to an endorsement being transmitted to participants of a conversation over a designated communication channel. *See Spec., Abstract.*

Method Claim 8 is illustrative:

8. A method executed on a computing device to distribute endorsement indications in a communication environment, the method comprising:

in response to a receipt of an exchanged communication through a communication service, detecting a selection of an endorsement for the exchanged communication by a recipient of the exchanged communication;

transmitting an endorsement indication based on the selected endorsement to a sender and one or more other recipients of the exchanged communication over a designated communication channel instead of transmitting the endorsement indication as a reply or reply-all type communication for reduction of computing and communication resources, wherein:

the designated communication channel is a control messaging channel in a transport layer of the communication service that is distinct from a communication exchange channel over which the exchanged communication is exchanged,

the endorsement indication is transmitted as a control message that comprises an action to create the endorsement indication and metadata associated with the action that includes the selected endorsement, and

special transport delivery agents at mailboxes of the sender and the one or more other recipients of the exchanged communication are configured to intercept the control message and process the metadata to create the endorsement indication;

providing the endorsement indication as one of a message and a notification such that display of the endorsement indication is enabled through communication user experiences associated with the sender and the one or more other recipients of the exchanged communication; and

enabling removal of the endorsement indication by the sender or the one or more other recipients of the exchanged communication.

Appellant appeals the following rejections:

R1. Claims 1–6, 8–11, 15, and 17–20 are provisionally rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1–8 of copending Application No. 14/737,805. Final Act. 11.

R2. Claim 1–6, 8–11, 15, and 17–20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhang (US 2014/0325391 A1, Oct. 30, 2014), Ogawa (US 2015/0081790 A1, Mar. 19, 2015), McDonough (US 2008/0305815 A1, Dec. 11, 2008), Pascal (US 2014/0330913 A1, Nov. 6, 2014), and Bendel (US 2011/0320542 A1, Dec. 29, 2011). Final Act. 12–37.

We review the appealed rejections for error based upon the issues identified by Appellant, and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential).

ANALYSIS

Provisional Double Patenting Rejection

Claims 1–6, 8–11, 15, and 17–20 are provisionally rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1–8 of copending Application No. 14/737,805. Final Act. 11.

Although Appellant requests that “the rejection be held in abeyance until the pending claims are otherwise indicated to be in condition for allowance” (*see* Appeal Br. 5), we highlight that cited Application No. 14/737,805 issued as Patent No. 9,954,807 on April 24, 2018, and a Terminal Disclaimer was filed on December 14, 2017, with reference to the

present application, i.e., Application No. 14/737,658 filed June 12, 2015.

As a result, the above-noted provisional rejection is rendered moot.

Rejection under § 103(a)

We note that Appellant makes various arguments that do not persuasively rebut the combination made by the Examiner. For instance, as noted by the Examiner (*see* Ans. 5), Appellant cannot show non-obviousness by attacking references individually, where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986); *In re Keller*, 642 F.2d 413, 425–26 (CCPA 1981). The following are some exemplary arguments made by Appellant, which fall into this category:

Firstly, Appellant contends “McDonough fails to teach or suggest a control messaging channel in a transport layer of the communication service *(the designated communication channel) that transmits an endorsement indication to a sender and other recipients of the exchanged communication.*” Appeal Br. 8–9.

The Examiner emphasizes, and we agree, that “McDonough is not relied upon to disclose *transmitting an endorsement indication to a sender and other recipients of the exchanged communication*” (Ans. 4; *see also* Final Act. 14), but rather Zhang is relied upon to teach this feature. *Id.* *citing* Zhang ¶¶ 38, 51. Appellant fails to rebut these specific teachings of Zhang and/or the combination made.

Secondly, Appellant contends that “Pascal fails to teach or suggest a control messaging channel (i.e., a channel distinct from a communication exchange channel) that is internal (i.e., within a transport layer of the communication service).” Appeal Br. 10.

The Examiner emphasizes that “Pascal is not relied upon to disclose *a channel distinct from a communication exchange channel*” (Ans. 6; *see also* Final Act. 21–22), but rather McDonough is relied upon to teach a channel distinct from a communication exchange channel. *Id.* (*citing* McDonough ¶¶ 60, 61, 79). Here, Pascal is relied upon to teach that it is known to send messages via channels within a transport layer of a communication service. *See* Ans. 7; Final Act. 25. Appellant’s arguments are limited to Pascal’s teachings and not what the combined McDonough-Pascal would have suggested.

Thirdly, Appellant contends that “Pascal fails to teach or suggest that (1) the agents are located at the mailboxes of the sender . . . and (2) the agents are configured to intercept a control message (as opposed to email) . . . and process the metadata to create the endorsement indication.” Appeal Br. 10.

The Examiner finds that Pascal discloses “email client applications . . . such as Google Mail and Microsoft Outlook™ that are equivalent to *agents that are located at the mailboxes of the sender.*” *See* Ans. 8; *see also* Final Act. 24, *citing* Pascal ¶ 49. Appellant fails to rebut this specific finding. Additionally, the Examiner emphasizes that “Pascal is not relied upon to disclose [] *intercepting a control message (as opposed to email) as it is transmitted over the control messaging channel*” (*see* Ans. 8; *see also* Final Act. 17), but rather Ogawa is being relied upon for this specific feature. *Id.* Also, the Examiner relies upon Zhang, not Pascal, to teach processing the metadata to create the endorsement indication. *See* Final Act. 15. Here, Appellant’s arguments are limited to Pascal’s teachings and not what the combined Ogawa-Zhang-Pascal would have suggested.

Finally, Appellant contends that “[a]lthough a reduction of resources may be implied from the reduction of the number of messages sent, in Bendel, *the single message is transmitted as a standard communication* (i.e., as a communication analogous to a reply or a reply-all type communication) Thus, Bendel teaches away from Claim [8]” because Bendel teaches a communication analogous to a reply. Appeal Br. 10–11.

Here, the Examiner relies upon Bendel to teach “a decluttering system for reducing the redundancy in voluminous content” (Final Act. 26), i.e., for teaching the claimed *reduction of computing and communication resources*. The Examiner emphasizes that “Bendal is not relied upon for transmitting *an endorsement indication over a designated communication channel*.”

Ans. 11. Instead, Zhang is relied upon for teaching transmitting an endorsement indication to a sender, and McDonough is relied upon for teaching a channel distinct from a communication exchange. *Id.*

Furthermore, Bendel is not relied upon to teach the claimed *instead of transmitting the endorsement indication as a reply or reply-all type communication*, rather Pascal is being relied upon by the Examiner for this teaching. See Final Act. 24, *citing* Pascal ¶ 65. In other words, for the aforementioned limitation, Appellant merely presents arguments regarding Bendel, although the Examiner is relying on the combined teachings of Bendal, Zhang, McDonough, and Pascal.

In summary, Appellant’s numerous arguments do not take into account what the collective teachings of the prior art would have suggested to one of ordinary skill in the art and are therefore ineffective to rebut the Examiner’s prima facie case of obviousness. See *In re Keller*, 642 F.2d at 425 (“The test for obviousness is not whether . . . the claimed invention must

be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.”) (citations omitted). This reasoning is applicable here.

CONCLUSION

The Examiner’s rejection of claims 1–6, 8–11, 15, and 17–20 as being unpatentable under 35 U.S.C. § 103 is affirmed.

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–6, 8–11, 15, 17–20	103	Zhang, Ogawa, McDonough, Pascal, Bendel	1–6, 8–11, 15, 17–20	

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

AFFIRMED