

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte IRVING R. TSAI

Appeal No. 2001-1317
Application No. 08/925,845

ON BRIEF

Before HAIRSTON, KRASS and JERRY SMITH, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claim 3, the only pending claim.

The invention is directed to a method for linking a portion of a received document image with an electronic address. In one illustrated embodiment, a document includes an optically-encoded Java program as a form of virtual machine instruction code. The

Appeal No. 2001-1317
Application No. 08/925,845

document is transmitted and received using a facsimile protocol and the portion of the facsimile that comprises the Java program is identified as being associated with the Java program and the associated code is then acquired using the received optically-encoded data. The facsimile data is then displayed and the Java program is executed in connection with the portion of the displayed facsimile with which it is associated.

Claim 3 is reproduced as follows:

3. A method for receiving and processing data to provide executable content to portions of a facsimile document comprising:

receiving data using a facsimile reception protocol, said received data having one or more portions associated with virtual machine instruction code;

identifying the portions of the received facsimile data associated with the virtual machine instruction code;

using the received facsimile data to acquire the associated virtual machine instruction code;

displaying the received facsimile data, and

executing the virtual machine instruction code in connection with the portion of the displayed facsimile data associated therewith.

The examiner relies on the following reference:

Bobo, II [Bobo]	5,675,507	Oct. 7, 1997
		(filed Apr. 28, 1995)

Appeal No. 2001-1317
Application No. 08/925,845

Claim 3 stands rejected under 35 U.S.C. 102(e) as anticipated by Bobo.

Reference is made to the brief and answer for the respective positions of appellant and the examiner.

OPINION

Under 35 U.S.C. 102, a reference must disclose, explicitly or implicitly, every limitation of the claimed invention. Glaxo Inc. v. Novopharm Ltd., 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir.), cert. denied, 516 U.S. 988 (1995).

It is the examiner's position that column 11, line 11, of Bobo, "the facsimile message is received...in a Tagged Image File...then converted...into...GIF," and column 10, line 10, of Bobo, "generate the HTML file for the ...facsimiles message," taken together, show the receiving of data using a facsimile reception protocol, said received data having one or more portions associated with the virtual machine instruction, as claimed.

The examiner identifies column 11, line 56, of Bobo, "in

Appeal No. 2001-1317
Application No. 08/925,845

addition to the GIF files representing the pages of the facsimile message, the HTML files include...anchors...," as the claimed identifying the portion of the received facsimile data associated with the virtual machine instruction code.

Moreover, the examiner identifies column 10, line 63, of Bobo, "the HTML file having the embedded image and links is sent to the user...," and column 20, line 31, of Bobo, "the MSDS...would transmit an HTML file...[to] the browser" as showing a means for interpreting the machine code and HTML scripting commands for display, as the claimed executing virtual machine instruction code.

Finally, the examiner identifies Figure 7 and column 12, line 13, of Bobo, as showing the display of received facsimile data and the display of executed virtual machine instruction code.

For his part, appellant argues that Bobo does not provide "executable content" to portions of the facsimile; that Bobo does not disclose the association of portions of a received facsimile with any virtual machine instruction code and that HTML is not a virtual machine instruction code. Appellant points out that the term, "executable content" is understood by artisans to refer to documents "containing embedded programs," as disclosed by the

Appeal No. 2001-1317
Application No. 08/925,845

Foreword portion of a JavaScript Essentials text by Jason J. Manger, included as an appendix to the brief, and that, therefore, "executable content" refers to more than simply an HTML document.

If we read the examiner correctly, he appears to be saying that the claims do not refer to any specific virtual machine instruction code, such as Java, and that, broadly interpreted, HTML is a "virtual machine instruction code." We agree. Appellant gives the preferred example of Java as a virtual machine instruction code but never explains why HTML may not be considered to be a virtual machine instruction code.

If we further understand the examiner correctly, he is arguing that once the document in Bobo has been converted to HTML format, and a message is sent to the recipient via e-mail, the recipient may then connect with the message storage and delivery system through the internet and have the message downloaded to the user's computer so that executed virtual machine instruction code is displayed.

While the examiner makes some good points, and it is certainly true, in Bobo, that a facsimile document is received, converted to HTML format and available for a user's use through the internet once the user is informed, via e-mail, that a

Appeal No. 2001-1317
Application No. 08/925,845

document has been received, we will not sustain the rejection of claim 3 under 35 U.S.C. 102(e). Even if we assume that Bobo's HTML is a "virtual machine instruction code" and that the virtual machine instruction code, i.e., HTML, is executed, there still remains some problems in applying Bobo's teachings to the instant claim language.

Claim 3 recites a receiving step whereby a facsimile reception protocol is used to receive data and the received data has one or more portions associated with virtual machine instruction code. Therefore, the data received already has the portions associated with virtual machine instruction code. The best that can be said for Bobo is that once the data is received via facsimile machine, Bobo stores these messages and then converts them into appropriate HTML files. Accordingly, the received data in Bobo is *not* in HTML, or virtual machine instruction code, format. Moreover, if the received data in Bobo does not have any portion associated with virtual machine instruction code, as claimed, then Bobo cannot disclose the identification of those portions of the received data associated with the virtual machine instruction code, as is also claimed. Still further, Bobo cannot execute the virtual machine instruction code "in connection with the portion of the displayed

Appeal No. 2001-1317
Application No. 08/925,845

facsimile data associated therewith" if there are no portions associated with the virtual machine instruction code.

Accordingly, the examiner's decision rejecting claim 3 under 35 U.S.C. 102(e) is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
)	
)	
)	
)	
ERROL A. KRASS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JERRY SMITH)	
Administrative Patent Judge)	

EK/RWK

Appeal No. 2001-1317
Application No. 08/925,845

STEVEN J. RIZZI
WEIL, GOTSHAL & MANGES
767 FIFTH AVENUE
NEW YORK, NY 10153