

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

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN L. FRIEND

Appeal No. 2002-0145
Application No. 09/090,990

ON BRIEF

Before KRASS, GROSS, and SAADAT, Administrative Patent Judges.
KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-30.

The invention is directed to a smart Hypertext Markup Language (HTML) e-mail system that automatically and intelligently converts and distributes a user's e-mail documents to both HTML-capable and plain text e-mail clients.

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Representative independent claim 1 is reproduced as follows:

1. A process for sending Hypertext Markup Language (HTML) formatted electronic mail across a computer network, comprising the steps of:

creating an HTML document;

checking the designated recipients for HTML capability;
and

sending said document to said designated recipients in accordance with said recipient's HTML capability.

The examiner relies on the following references:

Zachery	5,283,887	Feb. 1, 1994
Tang et al. (Tang)	5,630,060	May 13, 1997
Pallmann	6,094,684	Jul. 25, 2000
		(filed Apr. 2, 1997)

Claims 1-30 stand rejected under 35 U.S.C. § 112, second paragraph.

Claims 1-30 stand further rejected under 35 U.S.C. § 103 as unpatentable over either Zachery over "what was well known in the art" or "Tang, in view of Pallmann." (Answer, pages 4 and 6).

Reference is made to the briefs (paper nos. 13 and 15) and answer (paper no. 14) for the respective positions of appellant and the examiner.

OPINION

With regard to the rejection under 35 U.S.C. § 112, second paragraph, the inquiry is whether the claims do, in fact, set out

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and circumscribe a particular area with a reasonable degree of precision and particularity. It is here where the definiteness of the language employed must be analyzed—not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary skill in the pertinent art. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

It is the examiner's position that since the claims specify the use of HTML as a format for e-mail and electronic documents and HTML is "a generic term which does not specifically define the version being claimed" (answer, page 3), and the version may change from time to time, the claim scope would change over time and the metes and bounds of the claims would not be ascertainable. We disagree.

As appellant states (principal brief, page 17), systems "that are HTML-capable will always be HTML-capable." At the time of this invention, artisans understood what the term HTML meant, and still means, and would interpret the claimed invention as referring to the HTML level available at the time the invention was made. Accordingly, the scope of the terms can easily be ascertained, with a reasonable degree of certainty. That is, the meaning of HTML is the HTML specification at the time of the

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instant invention.

But, even if the HTML specification were to change, the claims would still be definite to the extent of the instant claim language. For example, in claim 1, it would still be required that an HTML document be created, that designated recipients are checked for HTML capability and that the document is sent to the designated recipients in accordance with that HTML capability. Thus, the language of the claim is definite, no matter how the specifics of HTML format might change in the future.

Accordingly, we will not sustain the rejection of claims 1-30 under 35 U.S.C. § 112, second paragraph.

Turning to the rejection of the claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073-74, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason much stem from some teachings, suggestions or implications in the prior art as a

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whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the appellant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1051-52, 189 USPQ 143, 146-47 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived (see 37 CFR

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§ 1.192 (a)).

With regard to the rejection based on Zachery, the examiner cites Zachery's recipient preferred format, comparison of that preferred format with a transferred document and conversion of the transferred document to the preferred format. The examiner then notes that format conversion modules and associated conversion techniques "were well known in the art," citing column 4, lines 3-6, of Zachery.

The examiner states that (Answer, page 5):

Zachery's teachings were very concise, and would have provided an ordinary artisan with the required conceptual understanding of electronic mail conversion and transfer for a multitude of platforms/applications to enable terminal units having different message interpretation capabilities to receive, interpret, and display documents of specific formats.

While Zachery disclosed the invention substantially as claimed, Zachery did not specifically disclose the use of hypertext markup language (HTML) as a document format, and the conversion of HTML to "plain text" for transfer, interpretation, and display of text messages on recipients terminal computers."

The examiner concludes that, since HTML was well known to artisans and the teachings of Zachery provide translation and delivery of electronic documents according to recipient preferred/supported formats, it would have been obvious to combine an HTML/"plain text" translation module to deliver HTML

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and/or "plain text" document electronic messages in order to

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provide delivery of electronic information to end users who preferred or supported messages in both or either HTML and plain text formats (see answer, page 6).

The examiner's rationale appears to rely heavily on hindsight gleaned from appellant's own disclosure. In Zachery, electronic documents are transmitted to a recipient. Then, at the recipient's end, if the document is not in the correct format, i.e., the recipient's preferred format, the document format will be converted to the preferred format. Contrary to this, the instant claims require the creation of an HTML document, then checking designated recipients for HTML-capability. The document is then sent (thus, the creation and the checking are done prior to sending the document, whereas the processing in Zachery, i.e., any necessary conversion, is done at the recipient's end) to the designated recipients in accordance with the recipient's HTML capability.

Moreover, as admitted by the examiner, Zachery is devoid of any teaching or suggestion of creating an HTML document, checking for HTML capability, or sending a document in accordance with a recipient's HTML capability, so it does appear to be a hindsight determination when the examiner contends, merely because HTML was "well known," that it would have been obvious to employ HTML in

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Zachery. Further, as appellant points out, at pages 23-24 of the principal brief, if Zachery was somehow combined with these "well known" HTML documents, it would appear that the result would be the performance of an HTML conversion after the electronic message was sent, i.e., when it was received by the recipient, unlike, as is required by the instant claims, creating an HTML document prior to sending the document.

The examiner disputes this by contending, at page 14 of the answer, that the claims "do not specifically recite functionality drawn to conversion before the message is sent from a particular machine." The examiner also contends that "the claims do not include provision for checking recipient HTML capability at a local sender location, nor does the claim specify where the 'sending' occurs from. The claims do not preclude functionality of the claimed invention at remote locations, nor any specific order of functionality" (answer, pages 14-15). We disagree.

The claims very much do specify checking HTML capability at a sender location and do require conversion before the message is sent. For example, claim 1 is a process reciting sequential steps. The first two steps are "creating an HTML document" and "checking the designated recipients for HTML capability." These two steps take place prior to the third step of "sending

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. . . .” Accordingly, contrary to the position of the examiner, the check for HTML capability occurs at the sender location prior to the document being sent, and the HTML document is created also prior to the document being sent. Independent claim 16 is an apparatus claim, but has similar limitations and it is clear that the HTML document is created and designated recipients are checked for HTML capability prior to the document being sent to the recipients.

Therefore, we will not sustain the rejection of claims 1-30 under 35 U.S.C. § 103 over Zachery in view of what was well known.

Turning now to the Section 103 rejection based on Tang and Pallmann, the examiner contends that Tang discloses the invention “substantially as claimed” (answer, page 8) but did not specifically disclose the conversion of HTML documents. The examiner points to column 5, lines 47-60, of Tang for the proposition that updating of conversion modules as new methods for conversion become available would have motivated the artisan “to find other types of message conversion to be used in combination with the Tang system” (answer, page 8).

The examiner then turns to Pallmann, relying especially on column 20, line 65 through column 21, line 3, for a teaching of a

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machine for handling direct text or HTML, with the ability to convert one form into the other, concluding that it would have been obvious to incorporate the conversion and delivery methods provided by Pallmann into the conversion and delivery system of Tang in order to provide an improved method of conversion of data to be transmitted to users over a network.

Our review of Tang convinces us of the correctness of appellant's position, at page 28 of the principal brief, wherein appellant asserts that Tang teaches that components are converted into equivalent components whose types are compatible with all the different transmission media and *not* with the recipient's requirements/preferences, as urged by the examiner. If components are converted into equivalent components whose types are compatible with all the different transmission media, this does not appear relevant to the claimed features of creating an HTML document, checking the designated recipients for HTML capability and sending the document to designated recipients in accordance with the recipient's HTML capability.

Moreover, since Pallmann is directed to adding plug-ins between a data source and a data target, it is unclear what would have motivated an artisan to combine these references in the manner sought by the examiner. As appellant points out, at pages

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30-31 of the principal brief, combining these teachings "would not be logical . . . because the two teachings are incompatible." Appellant bases this conclusion on the assessment that Tang's mechanism is meant to adapt to differing transmission media and combining this with Pallmann would destroy the purpose of Tang's mechanism by making the delivery system incompatible with differing transmission media.

The examiner takes an opposing view, urging that the inclusion of Pallmann's plug-ins into the system of Tang would not destroy the purpose of the Tang system but would have allowed senders of electronic messages to convert the messages into a form which is understood by the recipient, while being compatible with the "transmission media" (information format) of the recipient, referring to column 1, lines 55-58, of Tang and column 7, line 63 through column 8, line 4 of Pallmann (see pages 15-16 of the answer).

The examiner also notes that both Tang and Pallmann comprise teachings which deal directly with data conversion to a format able to be processed by a recipient so that the teachings are compatible.

We have attempted to follow the examiner's reasoning but, frankly, we do not understand how and/or why the examiner

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combines Tang and Pallmann to arrive at the instant claimed subject matter. Tang converts multi-media messages to differing physical transmission media, with apparently no interest in a recipient's computer system, while Pallmann retrieves data from a selected data source and transfers it to a selected data target. If the references were combined and a conversion of messages to differing transmission media occurred, it is difficult to see how this relates to the instant claimed invention which does not involve conversion of messages to differing transmission media, but, rather, involves creation of an HTML document, checking designated recipients for HTML capability and sending the document to a designated recipient in accordance with the recipient's HTML capability.

Accordingly, we find no proper prima facie case established by the examiner and we will not sustain the rejection of claims 1-30 under 35 U.S.C. § 103 over Tang in view of Pallmann.

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We have not sustained either of the rejections under 35 U.S.C. § 103 nor have we sustained the rejection of the claims under 35 U.S.C. § 112, second paragraph.

Accordingly, the examiner's decision is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ANITA PELLMAN GROSS)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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)	
MAHSHID D. SAADAT)	
Administrative Patent Judge)	

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GLENN PATENT GROUP
3475 EDISON WAY
STE. L
MENLO PARK, CA 94025