

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN W.L. OGILVIE

Appeal No. 2002-1623
Application 09/619,933

ON BRIEF

Before THOMAS, HAIRSTON, and GROSS, Administrative Patent Judges.
THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 1 through 15 and 30 through 36.

Representative claim 1 is reproduced below:

1. An advertising method for use by a message originator to make unsolicited email advertising from the originator more convenient for recipients of that email, the method comprising the steps by or for the originator at the message origin of:

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creating a self-removing email message by placing advertising in an email message as message content and by associating a self-removal enhancement with the email message; and

transmitting the self-removing email message toward more than a few recipients, including recipients who did not ask to receive the message.

The following reference is relied on by the examiner:

Wilfred J. Hansen, "Enhancing documents with embedded programs: How Ness extends insets in the Andrew ToolKit," IEEE, pages 23-32 (1990).

Claims 1 through 5, 9 through 15 and 30 through 32 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hansen. On the other hand, claims 6 through 8 and 33 through 36 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Hansen alone in the Final Rejection and Answer.

Rather than repeat the positions of the appellant and the examiner, reference is made to the Briefs and the Answer for the respective details thereof.

OPINION

We reverse.

Each of independent claims 1, 2 and 10 on appeal in some manner require steps associated with the originator of an email message of "creating a self-removing email message by placing advertising in an email message as message content and by associating a self-removal enhancement with the email message." We reverse the outstanding rejections of the claims on appeal because the examiner has failed to meet the advertising requirement of this clause as well as the self-removing requirement of the claims on appeal.

We agree with appellant's urging at pages 5 and 6 of the principal Brief on appeal that Hansen does not provide a self-removing message as called for in the claims. In fact, the messages are removed by the recipient. As we will show, we do not agree with the examiner's view at the bottom of page 7 of the Answer that "Hansen teaches enhanced documents with embedded scripts that have [a] capability of automatically performing functions that [a] user can execute manually such as deleting a file." Within the context of Hansen, there is no automatic deletion of a file to the extent the examiner takes this view.

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Substantially, all of Hansen details enhancing documents with embedded programs, specifically a programming language called "Ness." As discussed at the top of the second column of page 25, Ness includes the ability of scripts as a form of a program that may be introduced into a document. The discussion at topic 4 entitled "Security" at the second column of page 28 is most telling. To the extent indicated at the bottom of the first column of page 29 under the topic "Evaluation," that the Ness language permits an author to construct a document with a variety of behaviors, the nature of the behavior is contemplated according to the discussion at the second column of page 28 as inclusive of file deletions. The discussion at the end of this page states:

The Ness implementation has features that make it more difficult--though by no means impossible--for a villain to damage an unwary user. In particular, no script is ever executed--or even compiled--without permission from the reader. Users may choose among two options for this protection.

And again, the discussion at the top of the second column of page 29 states:

Finally, the design must provide some control so nefarious authors are not as free to produce programs which can damage readers' files. With Ness, the reader has the option to empower a script or not and also the Scan mode which aids

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in revising the script for potentially dangerous statements.

Contrary to the examiner's views expressed with respect to Hansen within the rejection under 35 U.S.C. § 102 of certain claims on appeal, these statements clearly indicate that the originator is not able to make a "completely self-removing" file "enhancement" to any email message within Ness. The claimed self-removal ability must come from the originator of the message and not the user/reader. Since the examiner has not provided evidence to us that the essential subject matter of representative independent claims 1, 2 and 10 on appeal are anticipated by Hansen, we must reverse the rejection of each of them and their respective dependent claims as well rejected under 35 U.S.C. § 102.

We also reverse the rejection of the claims under 35 U.S.C. § 102 because we agree with the appellant's views expressed at page 6 of the principal Brief on appeal and in the Reply Brief that Hansen does not even discuss advertising, let alone to the level of anticipating the present feature of the claims on appeal. The mere conveyance of a birthday event announcement according to Appendix 1 at pages 30 and 31 of Hansen even by email does not necessarily convey to the reader

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that such is in the form of advertising. The claims require the advertising be in the email message as message content. "Creation or use of self-removing messages in systems or methods that are not specifically directed to advertising would not infringe these claims." Principal Brief, page 6. Advertising in an email to the extent set forth in the claims on appeal essentially has been defined by appellant at specification, page 3, at lines 15 and 16, such that "email advertisements (including without limitation coupons, contact information, descriptions of goods and/or services, comparisons, and promotional materials)" are not encompassed by the simple birthday greeting taught by the noted appendix to Hansen.

For similar reasons, we must reverse the separate rejection of other dependent claims under 35 U.S.C. § 103 on the basis of Hansen alone. The examiner's reliance upon the Tseung patent in the rejection of claims 6 through 8 and 33 through 36 under 35 U.S.C. § 103 is highly disfavored since it has not been included in the statement of the rejection but merely is evidence to support the examiner's general assertion that broadcasting messages was well-known in the art. This amounts to an attempt to bootstrap the examiner's formal rejection by indirectly

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relying upon additional prior art than that which has been set forth in the final rejection to reject the claims under 35 U.S.C. § 103, namely Hansen alone.

In closing, the decision of the examiner rejecting various claims on appeal under 35 U.S.C. § 102 and 35 U.S.C. § 103 is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
KENNETH W. HAIRSTON)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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)	
ANITA PELLMAN GROSS)	
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JDT:psb

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