

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOHN W.L. OGILVIE

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Appeal No. 2002-1734  
Application 09/399,066

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ON BRIEF

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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 50 through 57 and 68 through 71.

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Representative claim 50 is reproduced below:

50. A method for using self-removing messages, comprising the steps of creating a self-removing message at an origin and then transmitting the self-removing message toward a recipient, wherein the creating step comprises including self-removing code in 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, 1990, pages 23-32.

Claims 50 through 52, 54, 55, 57 and 68 through 71 stand rejected under 35 U.S.C. § 102. Claims 53 and 56 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Hansen alone.

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 respective independent claims 50 through 52 requires in part the creation of a self-removing message at a

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point of origin of the message, where this creation step further comprises the inclusion of a self-removing code in the message.

Although we recognize that Hansen teaches the ability of a message originator to include codes within a message which may result in the removal of the message, the teachings in this reference indicate that it is not self-removing. Under the topic "4. Security" at the second column of page 28 of Hansen's article, the article initially indicates that the Ness script is a program and then teaches the following (bottom of column 2):

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.

This same teaching is conveyed to the reader at the top of the second column at page 29:

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 in reviewing the script for potentially dangerous statements.

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Because of these teachings, we agree with appellant's arguments presented at the bottom of page 5 of the principal Brief on Appeal because the examiner:

ignores the fundamental difference between allowing the user to control file deletion, as is done in Hansen, and providing a **self-removing** message, as called for in the claims. Even if removal of messages were deemed inherent in Hansen, such messages are not **self-removing**--they are instead removed by the recipient.

Because of the noted quoted teachings of Hansen, we agree with appellant's basic view that Hansen does not teach self-removing messages and self-removing codes/enhancements within a message because it is the recipient rather than the origin or source of the message that controls the removability thereof in accordance with Hansen's teachings.

In light of these assessments of Hansen, we also reverse the rejection of independent claims 68 through 70 for similar reasons. There is no self-removing message taught in this reference to the extent recited in these claims. Likewise, there is no self-removal enhancement taught in Hansen as to this additional requirement of these claims. Finally, the examiner has not indicated to us nor are we aware of any teaching within

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Hansen meeting the wherein clause "wherein the removing step searches for copies of the message content."

Because we do not sustain the rejection of any of independent claims 50, 51, 52, 68, 69 and 70 on appeal, we also do not sustain the rejection of their respective dependent claims whether they are rejected under 35 U.S.C. § 102 or 35 U.S.C. § 103.

The examiner's reliance upon a patent to Tseung and Anand in conjunction with the separate rejections of dependent claims 53 and 56 under 35 U.S.C. § 103 at pages 8 and 9 of the Answer is highly disfavored. The approach appears to us to effectively bootstrap separately applicable references when they have not been formally relied upon in the final rejection and in the statement of the rejection in the Answer. Therefore, they have not been considered by us. Likewise, we have not considered the Berkowitz reference noted in the Answer and Briefs since there is no formal statement of a rejection before us based on this reference.

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In view of the foregoing, 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 )  
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KENNETH W. HAIRSTON )  
Administrative Patent Judge )  
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ANITA PELLMAN GROSS )  
Administrative Patent Judge )

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