

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JEFFERY COUTS, UDAY SAGI, and DWIGH R. SMITH

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Appeal 2008-006173  
Application 10/027,163  
Technology Center 2400

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Decided:<sup>1</sup> July 2, 2009

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Before JOSEPH L. DIXON, JEAN R. HOMERE, and JAY P. LUCAS,  
*Administrative Patent Judges.*

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

## I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-20. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

### *Invention*

The invention at issue on appeal relates to an instant messaging system and method for sending a canned reply associated with a predefined originating class to an originating device belonging to the class (Abstract, Spec. 12, Fig. 2).

### *Illustrative Claim*

Claim 1, which further illustrates the invention, follows.

1. A method for a data network system for responding to a communication message, the method comprising the steps of:

receiving a communication message directed to a target device from an originating device, wherein the communication message includes an originating identification associated with the originating device;

retrieving configuration data of the target device including a plurality of classes and a plurality of canned replies associated with the plurality of classes;

determining whether the target device is available for interactive communication with the originating device;

identifying an originating class of the originating device from the plurality of classes and a canned reply associated with the originating class based on the originating identification;

routing the communication message to the target device if the target device is available for interactive communication with the originating device; and

sending the canned reply to the originating device if the target device is unavailable for interactive communication with the originating device.

#### *References*

Aravamudan	US 6,301,609 B1	Oct. 9, 2001
Ogle	US 6,430,604 B1	Aug. 6, 2002 (Filed Aug. 3, 1999)
Manabe	US 6,584,494 B1	June 24, 2003 (Filed Oct. 29, 1999)
Kato	US 2004/0048615 A1	Pub. Date Mar. 11, 2004 (Filed Sep. 10, 2003) <sup>2</sup>
Whitten	US 6,993,564 B2	Jan. 31, 2006 (Filed Dec. 22, 2000)

#### Rejections

Claims 1-4, 6, 8, 11-13, 16 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Manabe in view of Whitten.

Claims 5, 7, 9, 17 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Manabe in view of Whitten, further in view of Ogle.

Claims 10 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Manabe in view of Whitten, further in view of Aravamudan.

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<sup>2</sup> Kato is a continuation of application No. 09/482,712, filed on January 3, 2000, which is now US 6,646,999.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Manabe in view of Whitten, further in view of Kato.

## II. ISSUES

Have Appellants shown that the Examiner erred by failing to identify a teaching of “identifying an originating class of the originating device from the plurality of classes and a canned reply associated with the originating class based on the originating identification . . . sending the canned reply to the originating device if the target device is unavailable for interactive communication with the originating device” in the prior art, as recited in independent claim 1?

## III. PRINCIPLES OF LAW

### *Prima Facie Case of Unpatentability*

The allocation of burdens requires that the USPTO produce the factual basis for its rejection of an application under 35 U.S.C. §§ 102 and 103. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967)). Appellants have the opportunity on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

### *Claim Interpretation*

During prosecution before the USPTO, claims are to be given their broadest reasonable interpretation, and the scope of a claim cannot be narrowed by reading disclosed limitations into the claim. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

“Giving claims their broadest reasonable construction ‘serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified.’” *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (quoting *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984)). “Construing claims broadly during prosecution is not unfair to the applicant . . . because the applicant has the opportunity to amend the claims to obtain more precise claim coverage.” *Id.* at 1364.

The claim construction analysis begins with the words of the claim. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). Absent an express intent to impart a novel meaning to a claim term, the words take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Brookhill-Wilk 1, LLC. v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 (Fed. Cir. 2003).

#### *Obviousness*

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

#### IV. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

*Manabe*

1. Manabe discloses in an instant messaging system that a report module notifies the other user terminals via a chat channel with a text message (canned reply) as a user status based on a report destination table (col. 7, ll. 22-65). The canned replies of Manabe are uniform text messages indicating the current status of a user and a display module displays the user status for all participants in the chat channel. However, the canned replies are not associated with a particular originating class (col. 8, ll. 1-44, Fig. 5a).

*Whitten*

2. Whitten discloses a method and a system that a potential recipient controls a “buddy list” by dividing the “buddy list” into different categories and associating status indicators on the categories to differentially indicate availability status to each category (col. 2, ll. 21-39). The status indicators place restrictions in receiving instant messages from senders either an individual sender in a category or all senders in a category (col. 3, ll. 30-44).

3. Whitten also discloses that a sender would first query a potential recipient of an instant message as to the categories and the related status indicators (301) and then a status indicator would send to the sender to indicate whether the recipient is available to instant message (307). If the recipient is available, then the sender would make a decision as to whether to send an instant message or not (309); otherwise the sender is blocked from sending an instant message to recipient (311) (Fig. 3; col. 3, ll. 45-60).

## V. ANALYSIS

From our review of the Examiner's stated rejections, we find that the Examiner set forth a detailed explanation of initial showing of the prima facie case for obviousness. Therefore, we look to Appellants' Brief to show error in the Examiner's initial showing of obviousness.

With respect to independent claim 1, Appellants contend that Manabe does not disclose "any type of configuration data that includes a plurality of classes, let alone a plurality of canned replies associated with the plurality of classes." (App. Br. 3.) We agree with Appellants' contention. We find that Manabe discloses an instant messaging system that sends and displays a canned reply not associated with a plurality of classes to all participants in the communication channel. (FF1).

Appellants further contend that Whitten does not disclose any type of canned reply associated with an originating class, even though Whitten's list of senders includes categories of senders and status indicators. The status indicators of Whitten assigned by a potential recipient to each category are used to place restrictions on receiving messages from acceptable senders rather than being used as a canned reply associated with an originating class. (App. Br. 3-4.) In addition, Manabe does not describe any type of classification. Appellants, thus, contend that "claim 1 patentably distinguishes from the suggested combination of the Manabe, et al. patent and the Whitten patent." (App. Br. 5).

We agree with Appellants' contentions. First, the status indicators associating either an individual sender or all senders in a category are for the purpose of restricting the receipt of instant messages from the sender(s) (FF2). Thus, a status indicator is not a canned reply associated with an

originating class of an instant message sent by a sender. The Examiner maintains that the “canned reply” should be defined broadly, because “a specific definition was not provided for ‘canned reply,’ the Examiner is entitled to use the broadest reasonable interpretation.” She thus construes “canned reply” as “a predefined or preset message arranged by the potential recipient of a message,” (Ans. 13.) We do not agree that the disclosed status indicators teach the canned reply as claimed in independent claim 1. The claim language recites “sending the canned reply to original device if the target device is unavailable for interactive communication.” Therefore, the sending of the canned reply is after deciding that the target device (recipient) is unavailable in the claim 1. Whitten, however, teaches that after determining the recipient is unavailable (307), no message or any reply is sent to the sender. Instead, the sender is blocked from sending an instant message to the recipient (309) (FF3). Thus, the status indicator can not be read as “the canned reply” in the independent claim 1. Since neither Manabe nor Whitten alone or in combination teaches the argued limitations in the claim 1, we find that Appellants have shown that the combination of Manabe and Whitten is in error since it fails to teach or fairly suggest “identifying an originating class of the originating device from the plurality of classes and a canned reply associated with the originating class based on the originating identification . . . sending the canned reply to the originating device if the target device is unavailable for interactive communication with the originating device,” as recited in independent claim 1.

The rejection of the dependent claims 2-10 contains the same deficiency. Appellants, thus, have demonstrated error in the Examiner’s prima facie case for obviousness of the subject matter of claims 1-10.

Independent claim 11 contains similar limitations to that of claim 1, and Appellants have set forth similar arguments to those argued with respect to independent claim 1. Since we find Appellants' arguments persuasive with respect to independent claim 1, we similarly find that Appellants have demonstrated error in the Examiner's prima facie case for obviousness of the subject matter of independent claim 11. The rejection of dependent claims 12-20 contains the same deficiency. Appellants, thus, have demonstrated error in the Examiner's prima facie case for obviousness of the subject matter of claims 11-20.

We, therefore, cannot sustain the rejection of claims 1-20 under 35 U.S.C. § 103 over Manabe and Whitten.

## VI. CONCLUSION

For the aforementioned reasons, we conclude that Appellants have shown that the Examiner erred by failing to identify a teaching of "identifying an originating class of the originating device from the plurality of classes and a canned reply associated with the originating class based on the originating identification . . . sending the canned reply to the originating device if the target device is unavailable for interactive communication with the originating device" as recited in claims 1 and 11.

## VII. ORDER

We reverse the obviousness rejections of claims 1-20.

REVERSED

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