UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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<u>Ex parte</u> GENE EGGLESTON, MITCH HANSEN and RICHARD KREBS

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Appeal No. 2003-2074
Application No. 09/095,325

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ON BRIEF

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Before THOMAS, KRASS and LEVY, <u>Administrative Patent Judges</u>.

KRASS, <u>Administrative Patent Judge</u>.

<u>Decision On Appeal</u>

This is a decision on appeal from the final rejection of claims 33-114.

The invention is directed to digital communications. More particularly, it involves communication between a host computer and a mobile client. When a message is sent from a mobile client to a message recipient, it appears to the message recipient that the message originated at the e-mail address associated with the

host computer, and not from the mobile client. Further, a

"continuously forwarding" feature provides for messages received

at the host computer to be "pushed" to the mobile client, so that

the mobile client does not need to take a proactive step in order

to have the messages received at the host computer forwarded to

the mobile client.

Representative independent claim 33 is reproduced as

follows:

33. A method of forwarding messages between a host system
and a mobile client, comprising the steps of:

establising a session based on loaded parameters at the host
system;

maintaining the session at the host system and querying the
host system;

receiving messages directed to a first address at the host
system from a plurality of message senders;

in response to a query, continuously forwarding the
messsages from the host system to the mobile client;

receiving the messages at the mobile client;

generating reply messages at the mobile client to be sent to
the plurality of message senders and transmitting the reply
messages to the host system;

receiving the reply messages at the host system and
configuring the reply messages such that it will appear to the
plurality of message senders that the reply messages originated
at the first address associated with the host system; and

transmitting the reply messages from the host system to the plurality of message senders.

The examiner relies on no references.

Claims 33-114 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on an inadequate written description.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

<div align="center">OPINION</div>

It is the examiner's position that claims 33-114 contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. In particular, the examiner contends that each of the instant independent claims recites a first address at or associated to the host system as seen from the plurality of clients as the address of the mobile client. As an example, the examiner cites claim 33 as reciting "receiving messages directed to a first address at the host system from a plurality of message senders and continuously forwarding the messages of that address to the mobile client" and as reciting "that reply messages from the mobile client would be replied through the host system to the plurality of clients and

appear that the reply message originated at the first address

associated with the host system" (Paper No. 25-page 3).

The examiner recognizes that the instant specification, at

page 8, lines 1-7, and page 20, line 21 through page 21, line 13,

describes a reply message configured to be transparent to the

message recipient. However, the examiner explains that the

"first paragraph points out a client can have a virtual session

with the host system. The second paragraph points out the client

controller optimizes the reply message by calculating a

difference using a delta routine between the reply message and

the preceding message. It is to have an optimized reply to be

smaller than a normal reply message to provide significant

savings to the client in time and costs" (Paper No. 25-pages 3-

4).

The examiner then goes on to contend that the skilled

artisan would not have recognized that appellants had possession

of the invention as now claimed, at the time of filing the

application. The examiner concludes this because "an explicit

limitation (i.e. a first address at or associated to the host

system as seen from the plurality of clients as the address of

the mobile client) in a claim is not present in the written

description...The virtual session and the optimizing a reply

message do not specifically disclose a first address at or associated with a host system to be used with the mobile client" (Paper No. 25-page 4).

Specifically with regard to claims 104, 105, and 109-114, the examiner is concerned with the language describing that upon receiving a reply message at a forwarding component associated with a host system, forwarding the received message. The examiner explains that while the specification, at page 15, line 20 through page 16, line 11, describes forwarding a sent message to a mobile client, and, at page 20, line 21 through page 21, line 32, describes sending the reply message, the description only relates to the host system sending messages to the client, but not sending messages in the reverse direction, and to a client controller optimizing the reply message by calculating a difference using a delta routine between the reply message and the preceding message, the client then sending the reply message to the host system. However, the examiner contends, there is no disclosure of a forward component to forward messages in the specification; i.e., forwarding messages to the mobile client and sending the reply to the message sender do not specifically disclose a forward component to the host system to forward messages.

The written description requirement is separate from the enablement requirement of 35 U.S.C. 112; it is not necessary that the claimed subject matter be described identically but that the originally filed disclosure convey to those skilled in the art that appellant had invented the subject matter now claimed. Precisely how close the original description must come to comply with the description requirement must be determined on a case by case basis as a question of fact. In re Barker, 194 USPQ 470 (CCPA 1977), cert den., sub. nom., Barker v. Parker, 197 USPQ 271 (1978); In re Wilder, 222 USPQ 369 (Fed. Cir. 1984), cert den., sub. nom.; Wilder v. Mossinghoff, 105 S. Ct. 1173 (1985).

Turning, first, to the issue regarding claims 104, 105, and 109-114, as to an adequate written description for the claimed "forwarding component associated with a host system," we will not sustain the rejection under 35 U.S.C. § 112, first paragraph, because we do not believe the examiner had a reasonable basis for finding no support for the claimed "forwarding component." It is clear from page 8 of the specification that the communication server 220 is associated with the post office host server 240 since this portion of the specification states that the email post office is coupled to VSM 230 (which is part of the communication server 220 as seen in Figure 2) "either as another

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program running on the same communications server 220 or located on another server 240." As pointed out by appellants, at page 1 of the reply brief, page 16, lines 12-34, of the specification make it clear that the communication server 220 is configured to receive electronic mail messages generated by the mobile client 201 and to forward the same to a message recipient (note especially lines 20-21 of page 16). This, taken together with page 8 of the specification disclosing that the post office host server 240 may be configured to have the same functionality as the communication server 240, makes it clear to the artisan that at least one of the communication server 220 and the post office host server 240, is a "forwarding component associated with a host system," as claimed, and that the inventors did, indeed, have possession of the invention now claimed at the time of filing the application.

The examiner contends that the email post office is not "directly associated with the host" (answer-page 4, lines 9-10). However, the instant claimed do not require a "direct" association.

The examiner also states that "an explicit limitations [sic, limitation](ie. a forward component associated with a host system, forwarding the received message to a message recipient)

in a claim is not present in the written description" (answer-
page 4, lines 6-8). Such an "explicit" disclosure of the claimed
term is not required under 35 U.S.C. § 112, first paragraph. An
invention claimed need not be described ipsis verbis in the
specification in order to satisfy the disclosure requirements of
35 U.S.C. 112. Ex parte Holt, 19 USPQ2d 1211 (Bd Pat App &
Inter, 1991).

Accordingly, we will not sustain the rejection of claims
104, 105, and 109-114 under 35 U.S.C. § 112, first paragraph, as
reciting subject matter for which there is an inadequate written
description. We find that the original description, albeit in
different language than is now claimed, would have conveyed to
the artisan that the inventors had possession of the subject
matter which they now claim at the time of filing the
application.

With regard to claims 33-68, the examiner complains that
there is no "explicit" recitation in the specification for the
now-claimed transparency, i.e., that the message recipients are
unaware that the reply messages originated at a first address
associated with the host system, rather than at the host system
itself.

We again note that the examiner's requirement of an "explicit" disclosure of the claimed features is not required by 35 U.S.C. § 112, first paragraph.

While the specification does not explicitly describe the transparency feature as now claimed, the artisan reading the instant specification would have gleaned therefrom the invention as now claimed. For example, at page 22, describing Figure 9, it is disclosed that messages are retrieved from the communication server, and a delta routine is applied thereto in order to reconstruct a replica of the reply message. Once reconstructed, the reply message is "forwarded to the target unit(s), as well as to the outbox or sent mail folder of the client's post office box (steps 914-916)." It seems clear, then, that the user does not e-mail directly from his mobile unit, i.e., the mobile client does not have an e-mail address or e-mail functionality, but that the host server provides the e-mail address and forwards e-mail to recipients who are unaware of any address from the mobile client. Thus, while not explicitly describing the transparency feature of the instant claims, the artisan would have understood that such a transparency function was in the inventors' possession at the time of filing the instant application.

Since, in our view, the examiner had no reasonable basis for challenging the disclosure as to support for the transparency feature (e.g., ". . .such that it will appear to the plurality of message senders that the reply messages originated at the first address associated with the host system"), we will not sustain the rejection of claims 33-68 under 35 U.S.C. § 112, first paragraph, on this ground.

Finally, with regard to claims 33-55, 64, 66-103, and 106-108, the examiner challenges the recition of "continuously forwarding."

It is not exactly clear, from Paper No. 25, explaining the rejection, what the examiner's problem is with the "continuously forwarding" language. But, at pages 7-8 of the answer, the examiner explains that while Figure 3 shows dots, there is "no mention of a continuous loop of forwarding email to the client" and that page 12 of the specification discloses that forwarding of email is not "continuous and in fact only done by intervals initiated by the communication server (specifics of how this is done are not disclosed)."

Appellants response is that Figure 3 and page 12, lines 1-29, support the instant claimed feature of "continuously forwarding" by showing that new mail received for the mobile

client is forwarded to the mobile client via the host system

independent of any proactive step by the user of the mobile

client. Appellants point out that the forwarding process begins

with query manager 231 of the communication server 220 and not

the mobile client 201. Therefore, argue appellants, the newly

received mail is "continuously forwarded" (i.e., pushed not

pulled) from the host system to the mobile client (see page 5 of

the reply brief).

    We agree with appellants. The examiner's explanation

appears to interpret the "continuously forwarding" feature as a

never ending delivery of mail to the mobile client from the

server. In fact, the description at page 12 of the

specification, along with a reference to Figure 3, makes it clear

to us, that "continuously forwarding" merely describes how the

host server looks for email for the mobile client and, at such

times as such email is found, the host server delivers, or

"forwards" such mail to the mobile client. Hence, the host

server is "continuously forwarding" such email to the mobile

client, rather than having to wait for the mobile client to

request the forwarding of such email. Viewed in this

interpretive manner, it is clear that the instant specification

and drawing provide support for the claimed "continuously

forwarding" feature.

Thus, we will not sustain the rejection of claims 33-55, 64,

66-103, and 106-108 under 35 U.S.C. § 112, first paragraph.

Accordingly, the examiner's decision rejecting claims 33-114

under 35 U.S.C. § 112, first paragraph, as relying on an

inadequate written description is reversed.

With no rejections left outstanding in this case, the

examiner may wish to take up appellants' request regarding an

interference, as the examiner notes at page 6 of Paper No. 25

<div align="center">REVERSED</div>

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            JAMES D. THOMAS              )
            Administrative Patent Judge  )
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                                         ) BOARD OF PATENT
            ERROL A. KRASS               )     APPEALS
            Administrative Patent Judge  )      AND
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            STUART S. LEVY               )
            Administrative Patent Judge  )
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EK/RWK

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