

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JAKOB NIELSEN

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Appeal No. 2000-1377  
Application No. 08/628,415

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ON BRIEF

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Before THOMAS, KRASS, and LALL, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1, 9, 10, 18, 19 and 27. Claims 2-8, 11-17 and 20-26 have been allowed by the examiner.

The invention is directed to electronic mail (e-mail). More particularly, a sender of e-mail is permitted to find a new e-mail address of a recipient when the sender

knows only the recipient's old e-mail address. When a user changes his/her e-mail address, the user transmits an update e-mail address message to an address-change server at which location the old and the new e-mail addresses are stored. At the time a sender uses the recipient's old e-mail address and gets an undeliverable mail error, a request is forwarded to the address-change server and the address-change server returns a message with the recipient's new e-mail address. In one embodiment, the sender's program updates its address book based on the message returned from the address-change server so that the recipient's old e-mail address in the sender's program is updated to place therein the recipient's new e-mail address.

Representative independent claim 1 is reproduced as follows:

1. A method executed in a computer system for updating a recipient's email address, the method comprising the steps of:

receiving at an address-change server an update message from a recipient; and

storing information from the update message at the address-change server, the information comprising the recipient's new email address and the recipient's old email address.

The examiner relies on the following references:

Tilles et al. (Tilles)	5,518,122	May 21, 1996 (filed Aug. 16, 1994)
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Claims 1, 9, 10, 18, 19 and 27 stand rejected under 35 U.S.C. § 103 as unpatentable over Tilles.

Reference is made to the brief and answer for the respective positions of appellant and the examiner.

### OPINION

We REVERSE and REMAND.

Each of the claims on appeal, albeit very broad in scope, is directed to electronic mail (e-mail).

The examiner relies on Tilles as the basis for rejecting the instant claims. However, Tilles is clearly directed to regular, paper mail and, in no way, does Tilles discuss e-mail. Thus, it is difficult to see how Tilles is applicable to claims which recite the updating of a recipient's e-mail address, or updating information associated with a user's program wherein a recipient's e-mail address in the user's program is updated.

The examiner relies, in large part, on column 5, line 50 through column 6, line 10 of Tilles. That portion of the patent discloses the searching of an address of a piece of incoming mail for a name that corresponds to a name stored in a database and, upon recognizing the addressee's name, the system identifies a present mail stop of the

addressee and sorts the mail. If the addressee's name is identified but the address is incorrect, a forwarding label is prepared including the proper address of the addressee and the mail is sorted to an appropriate bin for forwarding. When the address changes, Tilles discloses that the database may be updated to include the new address without erasing the old address. Thus, both the old and new address of a user are stored at the same time.

The examiner recognizes that Tilles fails to disclose the claimed address-exchange server but takes the position that Tilles suggests this claimed invention since Tilles discloses "two computers, real time software modules and Ethernet network (see column 11, lines 1-15, column 13, lines 1-29)" [answer-page 3]. Therefore, concludes the examiner, it would have been obvious to modify Tilles by including a server, since Tilles suggests the use of Ethernet network, computers and real time software modules to implement the system. We disagree.

Tilles does not suggest that the computers and Ethernet network disclosed therein are to be used, in any manner, as an "address-exchange server," as claimed. There is absolutely no suggestion anywhere in the four corners of Tilles that the computers and Ethernet network disclosed therein are intended for an e-mail system operated as claimed by appellant.

The examiner also recognizes that Tilles does not disclose the recipient's address being an e-mail address but concludes, without support, that "it would have been obvious...that the mail processing system disclosed in Tilles *could* also be implemented for processing email addresses" [answer-page 4, emphasis ours]. Merely because the claimed subject matter *could* be implemented is not the test for obviousness under 35 U.S.C. § 103. There must be some reason established by the prior art or the knowledge of the artisan that would have led the skilled artisan to implement Tilles paper mail system for processing e-mail addresses. The only reason we can ascertain for doing this, from the evidence of record, comes from appellant's own disclosure.

Taking broad claim 1 as exemplary, the claim requires an "updating a recipient's email address." Tilles teaches nothing related to e-mail addresses. The claim calls for receiving "at an address-exchange server" an update message from a recipient. Tilles discloses nothing about an address-exchange server. Therefore, Tilles cannot suggest storing information from the update message "at the address-exchange server," as also required by the claim. Tilles' database of names does not correspond to, and cannot suggest, the claimed "address-exchange server." In fact, the instant claimed invention does not operate on a recipient's name, but rather on the recipient's e-mail address,

although, in the examiner's defense, it would appear that operation on a name would be similar to operation on an e-mail address since many e-mail addresses are merely recipients' names together with an identification of a server, or internet service provider.

In response to appellant's arguments, the examiner argues [answer-page 8] that the skilled artisan would have been "motivated to use the network email system for processing email because doing so would enabled [sic] the system to process both regular mail and email." The problem with this conclusion is that the examiner points to nothing that would have suggested a prior art desire to process both regular mail and email. The response appears to us to be based, at least in part, on impermissible hindsight.

If the examiner's rejection is predicated on a suspicion that the instant claims are too broad in the scope of protection they seek, we would agree with the examiner that the instant claims (e.g., claim 1 basically requires only receipt at a server of a message sent by an e-mail user, the message comprising merely the user's old and new e-mail addresses) appear rather broad. However, the way to narrow the scope of the claims is through the presentation of more appropriate prior art. Reliance on prior art directed to

an automation system for paper mail, without more, is insufficient for a proper rejection of

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claims specifically directed to an e-mail system.

While we reverse the examiner's decision because the reasoning purporting to support the rejection of the claims under 35 U.S.C. § 103 is found to be unconvincing of obviousness, we remand the application to the examiner for search and consideration of more appropriate prior art directed to e-mail systems and capabilities. We also remand the application to the examiner for a consideration of the analogous nature of regular and e-mail systems and as to whether an obviousness rejection may be based on software-driven systems being insubstantially different from hardware systems. See Overhead Door Corp. v. Chamberlain Group Inc., 194 F.3d 1261, 1269, 52 USPQ2d 1321, 1326 (Fed. Cir. 1999). If the rejection made by the examiner in the instant case was meant to convey such an analogy between the regular mail system of Tilles and the claimed e-mail system, such a comparison was not apparent.

In making any new ground of rejection or further explaining how Tilles might be analogized to the claimed e-mail system, the examiner should consider all of the claims pending in the instant application.

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Although we believe it may have been well known to use an address-exchange server for storing an old and new e-mail address, we decline to take Official notice of this fact based only on personal knowledge. See In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) “With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience--or on its assessment of what would be basic knowledge or common sense.” If using an address-exchange server for storing an old and new e-mail address was well known in the computer system arts, or in the arts dealing with the inventor’s particular problem dealing with discovering changed email addresses of recipients, the examiner should have no trouble finding an appropriate reference.

The examiner’s decision rejecting claims 1, 9, 10, 18, 19 and 27 under 35 U.S.C. § 103 is reversed and the application is remanded to the examiner for action consistent with our directions herein.

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This application, by virtue of its "Special" status, requires an immediate action,  
MPEP 708.01 (7th ed., July, 1998).

REVERSED and REMANDED

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
ERROL A. KRASS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
PARSHOTAM S. LALL	)	
Administrative Patent Judge	)	

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