

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** HIROSHI HAMADA

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Appeal No. 1996-3281  
Application 07/895,467<sup>1</sup>

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HEARD: SEPTEMBER 14, 1999

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Before BARRETT, FLEMING and HECKER, ***Administrative Patent Judges.***

HECKER, ***Administrative Patent Judge.***

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of  
claims 1 through 10, 16 through 25 and 31 through 33, all  
claims outstanding in this application.

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<sup>1</sup> Application for patent filed June 8, 1992. According to applicant,  
this application is a continuation (CONT) of S. N. 07/627,918, filed 12/17/90;  
which is a CONT of S.N. 07/245,268, filed 09/16/88.

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The invention is directed to message processing method and apparatus. A party sending a message manually designates the desired transmission time in terms of the local time at the designated receiving party's terminal. The time zone differential (if any) between the local time at the sending party's location and the local time at the receiving party's location is then automatically calculated. The time differential is then used to automatically convert the local transmission starting time entered by the sending party, into a local transmission starting time in terms of the sending party's local time. Transmission will then begin at the appropriate local transmission starting time at the sending party's location, without requiring the user to manually calculate the time differential and convert the receiving party's local time into his own. When the sending party designates a transmission time that has already passed at the receiving party's terminal, an error condition is recognized and the sending party is so notified. Additionally, when such an error condition is recognized, the sending party may be

informed of another time which would be capable for transmission. This enables the sender to correct the situation as he deems appropriate, rather than letting the system decide what to do.

In summary, the invention recognizes that a passed transmission starting time is an error that the sender should be able to address, rather than taking an automatic, and possibly undesirable action.

Independent claims 6 is reproduced as follows:

6. A message processing method for performing an exchange of information between a sending party's terminal located in one time zone having a respective local time and at least one receiving party's terminal located in a different time zone having a respective local time, the two time zones having a time zone differentially therebetween, comprising the steps of:

manually designating at the sending party's terminal a first local transmission starting time in terms of the local time at the receiving party's location;

automatically calculating the time zone differential between the local time at the sending party's location and the local time at the receiving party's location;

automatically converting the first local transmission starting time into a second local transmission starting time at the sending party's location, based on the calculated time zone differential;

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automatically determining whether transmission is impossible based on whether the second local information transmission time at the sending party's location is earlier than the local time there at which manual designating occurs taking into account the calculated time zone differential; and

informing the sending party's terminal that transmission is impossible when transmission is determined to be impossible in the determining step.

The references relied on by the Examiner are as follows:

Takenouchi et al. (Takenouchi)	4,506,111	Mar. 19, 1985
Sekiya et al. (Sekiya) <sup>2</sup>	JP 58-196754	Nov. 16, 1983

Claims 1 through 10, 16 through 25 and 31 through 33 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sekiya in view of Takenouchi.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the brief, reply brief and the answer for the details thereof.

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<sup>2</sup> The translation in the application file is being used and references are thereto. Translated by the Diplomatic Language Services, Inc. dated April 1994.

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**OPINION**

After a careful review of the evidence before us, we will not sustain the rejection of claims 1 through 10, 16 through 25 and 31 through 33 under 35 U.S.C. § 103.

The Examiner has failed to set forth a **prima facie** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. **In re Sernaker**, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." **Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.**, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) (**citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.**, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), **cert. denied**, 469 U.S. 851 (1984)).

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Appellant argues:

Both references fail to recognize a passed transmission starting time as an error and both simply transmit the message immediately without notifying the sender. Appellant respectfully submits that the Examiner is using impermissible hindsight to read what is only now disclosed in the present specification into the teachings of both references. (Brief-page 19.)

The Examiner states;

Sekiya shows all the claimed limitations except an error indicating means.

At the time that the invention was made, Takenouchi et al (column 12, line 34) had suggested an error producing means and in column 5, lines 6-7 had suggested a correction could be made in response to "an error message". Hence, the teaching in Takenouchi et al could have been used in Sekiya to indicate a message should be re-mailed. (Answer-page 3.)

At page 3 of the Answer, the Examiner cites various portions of Takenouchi. The Examiner cites "time-controlled" as a suggestion that there may be a difference in time zones to be recognized. We find no such suggestion, "time-controlled" could mean many things, but in the context of Takenouchi, it merely means a time for transmission if other than the current time. Time zones are never mentioned.

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At page 4 of the Answer, the Examiner notes that F8 (Figure 4) of Takenouchi can indicate an error, and "When the time to transmit is after time at the receiving station, F8 would obviously indicate an error."

However, we find that Takenouchi specifically does not recognize such as an error. According to column 12, lines 50+, when a time to transmit is after the time at the receiving station, Takenouchi transmits and does not treat this as an error. Appellant also recognizes this and argues that Takenouchi does not recognize an elapsed transmission time as an error. (Brief-page 20.) We agree with the Appellant.

The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." ***In re Fritch***, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), ***citing In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not be established using hindsight or in view of the teachings

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or suggestions of the inventor." *Para-Ordnance Mfg. v. SGS Importers Int'l*, 73 F.3d at 1087, 37 USPQ2d at 1239, *citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13.

As pointed out above, Sekiya and Takenouchi do not recognize a passed message transmission time as an error, both treat such a situation by immediate transmission. Although Takenouchi detects and reports various errors, they are of a different nature than that of Appellant. Thus, the Examiner's reason to combine Sekiya and Takenouchi fails, and we will not sustain the 35 U.S.C. § 103 rejection of claims 1 through 10, 16 through 25 and 31 through 33 as set forth by the Examiner.

**NEW GROUND OF REJECTION**

Pursuant to the provisions of 37 CFR § 1.196(b), we hereby enter the following new rejection.

Claims 1, 16 and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sekiya in view of Takenouchi. Sekiya teaches all the claimed limitations except for

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"informing the sending party's terminal of a time capable of designation of transmission when the first local information transmission starting time manually designated already has passed the local time at the receiving party's location."

We note that these particular claims do not indicate such a situation as an **error**, but only "inform" the sender of "a time capable of designation of transmission."

Sekiya provides for sending messages and calculating time zone differentials and automatically sending messages at the designated/calculated times. Takenouchi elaborates on the various types of messages that may be sent which includes registered mail which includes a return receipt (column 1, lines 56 and 57). This registered mail may contain instructions for a time of delivery (column 3, lines 59-62). If the designated time for transmission has already lapsed, Takenouchi immediately transmits the mail (column 12, lines 50+). In this manner, registered mail will be transmitted later than the original designated time, and when received, a time of receipt, i.e., a time that was **capable of designation of transmission**, will be issued to **inform** the sender (receipt

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to sender, column 10, lines 37-40; time of receipt, column 4, lines 4-6 and 63-63).

Thus, it would have been obvious to one of ordinary skill in the art at the time of invention to have used the Sekiya mailing device to transmit common types of mail, such as registered mail. In sending registered mail, a message would be issued to inform the sender of receipt as disclosed in Takenouchi, which message includes the receipt/transmission time. As taught in Takenouchi, when the actual transmission time was later than the initially designated transmission time, the receipt thereby indicates the actual time **capable of designation of transmission**.

Appellant's claims 1, 16 and 33 each recite transmission of the information, followed by, informing the sending party of **a time capable of designation of transmission**. This time capable of transmission is read to mean a report of the actual time the system had been **capable** of transmitting, not a future transmission time. It would be illogical to inform the sender of a future transmitting time since the message had already been transmitted.

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We have made no determination as to the patentability of claims dependent from claims 1, 16 and 33 on the above recited grounds.

The Examiner's decision rejecting claims 1 through 10, 16 through 25 and 31 through 33 under 35 U.S.C. § 103 is reversed. A new ground of rejection of claims 1, 16 and 33 under 35 U.S.C. § 103 is entered under 37 CFR § 1.196(b).

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date hereof (37 CFR § 1.197).

With respect to the new rejection under 37 CFR § 1.196(b), should Appellant elect the **alternate** option under that rule to prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR

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§ 1.136(a). See the final rule notice, 54 F.R. 29548 (July 13, 1989), 1105 O.G. 5 (August 1, 1989).

Effective August 20, 1989, 37 CFR § 1.196(b) has been amended to provide that a new ground of rejection pursuant to the rule is not considered final for the purpose of judicial review under 35 U.S.C. §§ 141 or 145.

Failure by Appellant to timely request reconsideration by the Board or to timely seek prosecution before the examiner with respect to the new rejection as provided for by 37 CFR § 1.196(b) will result in the cancellation of all the claims subject to the new rejection.

**REVERSED**  
**37 CFR § 1.196(b)**

Lee E. Barrett )  
Administrative Patent Judge )  
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Michael R. Fleming ) BOARD OF  
PATENT Administrative Patent Judge ) APPEALS AND  
) INTERFERENCES

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