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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/135,649	06/09/2008	Garth Bruen	Knujon.1000	4124
26812	7590	02/25/2014	EXAMINER	
HAYES, SOLOWAY P.C. 175 CANAL STREET MANCHESTER, NH 03101			SURVILLO, OLEG	
			ART UNIT	PAPER NUMBER
			2442	
			NOTIFICATION DATE	DELIVERY MODE
			02/25/2014	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GARTH BRUEN

Appeal 2011-010947
Application 12/135,649
Technology Center 2400

Before JOHN C. KERINS, EDWARD A. BROWN, and
JAMES P. CALVE, *Administrative Patent Judges*.

BROWN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Garth Bruen (Appellant) appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1-20. App. Br. 11. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part and enter a new ground of rejection pursuant to our authority under 37 C.F.R. § 41.50(b).

CLAIMED SUBJECT MATTER

Claims 1, 9, and 17 are the independent claims on appeal. Claim 1 is illustrative and reads as follows:

1. A software system enabled by a processor of a computerized device for identifying and reporting improperly registered web sites, comprising:
 - a first portion of software code, enabled by the processor of the computerized device, for receiving unwelcome mail;
 - a second portion of software code for extracting a Universal Resource Locator for the unwelcome mail;
 - a third portion of software code for querying a database for ownership data for the extracted Universal Resource Locator and retrieving an owner email address for an owner of the extracted Universal Resource Locator from the ownership data; and
 - a fourth portion of software code for sending a message to the owner email address requesting a stop to the unwelcome mail.

REJECTIONS

Appellant seeks review of the following rejections:^{1,2}

I. Claims 17-20 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

II. Claims 1, 5, 9, 14, and 17 stand rejected under 35 U.S.C. § 102(e) as anticipated by Jagger (US 7,647,376 B1; iss. Jan. 12, 2010).

III. Claims 2, 10, and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Jagger and Spamcop.³

IV. Claims 3, 4, 11, 12, and 19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Jagger, Spamcop, and Boss (US 2008/0005312 A1; pub. Jan. 3, 2008).

V. Claims 6, 16, and 20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Jagger and Glass (US 2005/0060643 A1; pub. Mar. 17, 2005).

¹ The Examiner withdrew a rejection of claims 1, 2, and 5-7 under 35 U.S.C. § 101. Ans. 4. Accordingly, this rejection is not presented for review in this appeal.

² Appellant contends that the Examiner's objection to the drawings in the Final Office Action dated December 3, 2010, is an improper new ground of rejection and should be withdrawn. App Br. 12. However, the Examiner indicated that this objection is not a "rejection" that is an appealable matter. Ans. 15. Thus, this issue is not presented for review in this appeal. *See* Manual of Patent Examining Procedure (MPEP) § 1002 (petitions to the Director) and § 1201 (appealable matters for the Board).

³ McCormick, R.P. (2003, Aug. 23). Domains with inaccurate WHOIS information: using ICANN policies to combat SPAM. Message posted to <http://www.spamcop.net>; McWebber (2003, Aug. 25). Re: ALPHACARD.BIZ (was: Domains with inaccurate WHOIS information: using ICANN policies to combat SPAM). Message posted to <http://www.spamcop.net>.

VI. Claims 7 and 15 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Jagger and Shull (US 2008/0034211 A1; pub. Feb 7, 2008).

VII. Claims 8 and 13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Jagger and Boss.

ANALYSIS

Rejection I

Regarding claim 17, the Examiner determined that the claim elements “means for receiving,” “means for extracting,” “means for querying,” and “means for sending” are means-plus-function limitations that invoke 35 U.S.C. § 112, sixth paragraph. Ans. 6. The Examiner found that Appellant’s written description fails to clearly link or associate structures, material, or acts to the recited functions of these elements because the Specification fails to disclose algorithms corresponding to the functions. *Id.* at 6-7.

Appellant contends that one of ordinary skill in that art could identify what structure, material, or acts perform each recited function. App. Br. 19 (citing to Spec., p. 4-7, 10-11; fig. 4). Specifically, Appellant contends that “portions of software code” and hardware used to operate the software system having software code provide the necessary structure. *Id.*

“In cases involving a computer-implemented invention in which the inventor has invoked means-plus-function claiming, [the Federal Circuit] has consistently required that the structure disclosed in the specification be more than simply a general purpose computer or microprocessor.” *Aristocrat Techs. Australia Pty Ltd. v. Int’l Game Tech.*, 521 F.3d 1328, 1333 (Fed.

Cir. 2008). For a computer-implemented claim limitation interpreted under 35 U.S.C. § 112, sixth paragraph, the corresponding structure must include the algorithm needed to transform a general purpose computer or processor disclosed in the specification. *Id.* Mere reference to “software” without also providing detail about the means to accomplish the software function is not adequate disclosure to satisfy the requirements of 35 U.S.C. § 112, second paragraph. *Id.* at 1334; *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1340-1341 (Fed. Cir. 2008).

We agree with the Examiner that Appellant does not identify disclosure in the Specification that clearly links or associates structure to the function of each of the means-plus-function elements recited in claim 17. Appellant cites to “portions of software code” described in the Specification and shown in Figures 2 and 4 as support for each of the means-plus-function elements recited in claim 17. App. Br. 19. However, these passages of the Specification merely describe the function to be achieved without providing details about the means to accomplish each software function. *See Spec.*, p. 4, l. 20 – p. 7, l. 2; figs. 2, 4. For example, Appellant relies on a “second portion of [software] code” as supporting structure for the claimed “means for extracting a Universal Resource Locator for the unwelcome mail.” App. Br. 19. However, the Specification does not disclose an algorithm for how to accomplish this “extracting” function, and instead describes the outcome of performing this function. *Spec.*, p. 5, ll. 9-16. Hence, Appellant fails to show that the Specification discloses algorithms necessary to perform the functions of each of the means-plus-function elements recited in claim 17.

Thus, we sustain the rejection of claim 17 and its dependent claims 18-20 under 35 U.S.C. § 112, second paragraph, as being indefinite.

Rejection II

Regarding claim 1, the Examiner found that Jagger discloses a software system that includes a third portion of software code for retrieving an owner email address for an owner of a Universal Resource Locator (“URL”) extracted from unwelcome mail received by the software system, and a fourth portion of software code for sending a message to the owner email address requesting a stop to the unwelcome mail. Ans. 8. The Examiner also found that the spammer who sent the unwelcome mail is *not* the owner of the domain name identified by the extracted URL, but instead, stated that it is well known in the art that a “hosting authority” that hosts the spammer’s website actually “owns” the domain name and corresponding URL. *Id.* at 16-17. Thus, the Examiner found that the claimed “owner email address” is the email address of the hosting authority, and that the limitation “sending a message to the owner email address requesting a stop to the unwelcome mail” is met by Jagger’s disclosure of sending a message to the hosting authority “that allows the authority to prevent the spammer from distributing further unsolicited e-mail.” *Id.* at 8, 16-17.

In contrast, Appellant contends that “the owner email address” recited in claim 1 corresponds to the email address of the actual spammer. App. Br. 23-24; Reply Br. 4. Appellant also contends that the Examiner’s finding that it is well known in the art that the hosting authority owns the domain identified by the extracted URL is unsupported by evidence. Reply Br. 4.

Appellant contends that the Specification supports that the “owner email address” is the spammer email address. *Id.* (citing Specification, p. 6, l. 10 – p. 7, l. 2). In this regard, Appellant contends that the Specification teaches how sending a message to the owner email address can result in a

rejection indicative of invalid ownership data for the URL, and that this rejection can be reported to an “appropriate authority” for cancellation of the ownership of the URL. *Id.* at 4-5. Appellant also contends that the Examiner’s determination that the “owner email address” is the hosting authority email address would be contrary to this teaching of the invention. *Id.* at 5.

We note that claim 1 does not define the “owner email address” or “owner of the extracted Universal Resource Locator.” Thus, we look to the Specification, as the Patent and Trademark Office determines the scope of the claims “not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed Cir. 2005) (citation omitted).

We agree with Appellant that the proper construction of “owner email address” and “owner of the extracted Universal Resource Locator,” in view of the Specification, is in reference to the spammer email address. For example, the Specification states that a fourth portion of software code sends a message to the owner email address, and that receipt of the message by the owner email address may be recorded in a database “to monitor for further *unwelcome email from the owner email address.*” Spec., p. 6, ll. 6-10 (emphasis added). Thus, it appears to us that the owner email address is the source of the unwelcome email, and therefore, that the owner email address corresponds to the spammer email address.

The Examiner did not provide any evidence to support the finding that it is well known in the art that the domain owner is the hosting authority, or that such understanding should control interpretation of “owner email

address” in claim 1 in view of Appellant’s Specification. The Examiner cited to Figure 3 of the Specification as showing that a hosting authority (Network Solutions) owns a domain name (HAYES-SOLOWAY.COM) because the registrant (Shauna Bronson) pays a monthly fee to the hosting authority. Ans. 17. However, Figure 3 does not show that the registrant is “leasing” a domain name owned by the hosting authority. Instead, the registrant may be paying a service fee for the hosting authority to register a domain name on behalf of the owner-to-be registrant.

Additionally, we note that the Specification describes fifth and sixth portions of software code that respectively receive a rejection of the stop request message from the owner email address, and report the rejection as indicia of invalid ownership information to an appropriate authority, with the possible result being cancellation of ownership of the URL. Spec., p. 6, ll. 10-15; p. 6, l. 21 – p. 7, l. 2. We also note that dependent claim 2 recites “a fifth portion of software code” and “a sixth portion of software code.” We agree with the Appellant that this reporting procedure associated with the sixth portion is best understood by interpreting the “owner email address” as referring to the spammer email address. In contrast, the Examiner did not provide any evidence that the hosting authority would reject a stop request message, or have its ownership over a domain potentially cancelled. Indeed, Jagger’s system relies on the hosting authority to accept a stop request message. Jagger, col. 5, l. 60 – col. 6, l. 9.

Accordingly, the Examiner did not find by a preponderance of the evidence that Jagger discloses a fourth portion of software code for sending a message to the owner email address, construed to be the spammer email

address, as required in claim 1. Thus, we do not sustain the anticipation rejection of claim 1, or its dependent claim 5.

Independent claims 9 (“sending a message to the owner email address requesting a stop”) and 17 (“means for sending a message to the owner email address requesting a stop”) recite limitations similar to those in claim 1. Thus, for reasons similar to those described *supra* regarding claim 1, we do not sustain the anticipation rejection of claim 9 and its dependent claim 14, and of claim 17.⁴

⁴ Although we sustain the rejection of claim 17 under 35 U.S.C. § 112, second paragraph, as discussed *supra*, our decision for that rejection is based on the Examiner’s unsupported findings for the recited function of “sending a message to the owner email address,” which function is not, in and of itself, indefinite.

Rejection III

Claims 2, 10, and 18 depend from claims 1, 9, and 17, respectively. The Examiner's reliance on Spamcop does not cure the deficiencies of the anticipation rejection of claims 1, 9, and 17, as described *supra*. Ans. 10-11. Rather, the Examiner relied on Spamcop for teaching reporting of unverified *spammers* to ICANN in an attempt to have a *spammer's* domain registration cancelled, which further supports Appellant's contention that the "owner" recited in claim 1 is the spammer. *See id.* Hence, we do not sustain the obviousness rejection of claims 2, 10, and 18 over Jagger and Spamcop.

Rejections IV-VII

The Examiner's reliance on: Spamcop and Boss for the rejection of dependent claims 3, 4, 11, 12, and 19 (Ans. 11-13); Glass for the rejection of dependent claims 6, 16, and 20 (Ans. 13-14); Shull for the rejection of dependent claims 7 and 15 (Ans. 14); and Boss for the rejection of claims 8 and 13 (Ans. 15) does not cure the deficiencies of the anticipation rejection of claims 1, 9, and 17. Hence, we do not sustain rejections IV-VII.

New Ground of Rejection

Appellant acknowledges that claim 1 is a means-plus-function claim under 35 U.S.C. § 112, sixth paragraph. App. Br. 15. Appellant also states that the use of "portions of software code" with each portion modified by functional language invokes means-plus-function language. *Id.*

We note that claim 1 recites "a first portion of software code...for receiving," "a second portion of software code for extracting," "a third portion of software code for querying," and "a fourth portion of software code for sending," and that these elements are similar to the respective "means for receiving," "means for extracting," "means for querying," and

“means for sending,” as recited in claim 17. Thus, for reasons similar to those described *supra* for the rejection of claims 17-20 under 35 U.S.C. § 112, second paragraph, we likewise find that the Specification does not describe algorithms necessary to perform the functions of each of the means-plus-function elements recited in claim 1. We also adopt the Examiner’s findings in rejecting claims 17-20 under 35 U.S.C. § 112, second paragraph.

Accordingly, claims 1-8 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite. This is a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).⁵

DECISION

We AFFIRM the rejection of claims 17-20 as indefinite under 35 U.S.C. § 112, second paragraph.

We REVERSE the rejection of claims 1, 5, 9, 14, and 17 under 35 U.S.C. § 102(e) as anticipated by Jagger.

We REVERSE the rejection of claims 2, 10, and 18 under 35 U.S.C. § 103(a) as unpatentable over Jagger and Spamcop.

We REVERSE the rejection of claims 3, 4, 11, 12, and 19 under 35 U.S.C. § 103(a) as unpatentable over Jagger, Spamcop, and Boss.

We REVERSE the rejection of claims 6, 16, and 20 under 35 U.S.C. § 103(a) as unpatentable over Jagger and Glass.

We REVERSE the rejection of claims 7 and 15 under 35 U.S.C. § 103(a) as unpatentable over Jagger and Shull.

⁵ Although we do not sustain the prior art rejections of claims 1-8, as discussed *supra*, our decision for those rejections is based on unsupported Examiner findings directed to claim terms that are not, in and of themselves, indefinite.

We REVERSE the rejection of claims 8 and 13 under 35 U.S.C. § 103(a) as unpatentable over Jagger and Boss.

Regarding the affirmed rejection(s), 37 CFR § 41.52(a)(1) provides “Appellant may file a single request for rehearing within two months from the date of the original decision of the Board.”

In addition to affirming the Examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b), which provides that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. § 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

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If Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Patent Trial and Appeal Board for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

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