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13/690,555	11/30/2012	William A. Hartselle	01402CON1	3349

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Room 2A-212

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EXAMINER
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TANG, KAREN C

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2447

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



Art Unit: 2447

- Claims 31-50 are presented for examination.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on was filed. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory double patenting rejection is appropriate where the claims at issue are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

Art Unit: 2447

ground provided the reference application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. A terminal disclaimer must be signed in compliance with 37 CFR 1.321(b).

The USPTO internet Web site contains terminal disclaimer forms which may be used. Please visit <http://www.uspto.gov/forms/>. The filing date of the application will determine what form should be used. A web-based eTerminal Disclaimer may be filled out completely online using web-screens. An eTerminal Disclaimer that meets all requirements is auto-processed and approved immediately upon submission. For more information about eTerminal Disclaimers, refer to <http://www.uspto.gov/patents/process/file/efs/guidance/eTD-info-I.jsp>.

Claims 31-50 are rejected on the ground of nonstatutory double patenting over claims 1-20 of U.S. Patent No. 7,356,564 since the claims, if allowed, would improperly extend the “right to exclude” already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

self-destructing electronic mail messages, comprising: receiving a request to send a self-destructing electronic mail message, the request comprising a message body and a time period within which the self-destructing electronic mail message is to be destroyed, the self-destructing electronic mail message including a designation that prevents an electronic mail client of a first recipient of the self-destructing electronic mail message in a home domain of a sender of the self-destructing electronic mail message from performing an operation that results in duplication of contents of the self-destructing electronic mail message, wherein a plurality of operations that is prevented includes forwarding the self-destructing electronic mail message to a second recipient, printing the self-destructing electronic mail message, copying contents of the self-destructing electronic mail message into memory, and pasting the contents of the self-destructing electronic mail message from memory into a new

Art Unit: 2447

document; presenting a security warning when any intended recipient of the self-destructing electronic mail message is located beyond the home domain of the sender; transmitting, in response to an indication that the sender selected to proceed with transmitting the self-destructing electronic mail message to a network beyond the home domain of the sender of the self-destructing electronic mail message, the request to an electronic mail client application in the network beyond the home domain; and after transmitting the self-destructing electronic mail message and after expiration of the time period, deleting, by an electronic mail server, any instances of the self-destructing electronic mail message that are being stored at the electronic mail server; wherein the time period comprises an indication that the self-destructing electronic mail message should be destroyed after a specified number of hours; wherein the time period comprises an indication that the self-destructing electronic mail message should be destroyed after a specified number of days; wherein the time period comprises an indication that the self-destructing electronic mail message should be destroyed on a particular date; wherein determining whether the self-destructing electronic mail message can be destroyed comprises identifying the self-destructing electronic mail message destruction date; wherein receiving the request to read the self-destructing electronic mail message comprises displaying the selected message; wherein receiving the request to read the self-destructing electronic mail message further comprises identifying the self-destructing electronic mail message operation restrictions; wherein receiving the request to read the self-destructing electronic mail message further comprises determining whether the self-destructing electronic mail message can be destroyed after the self-destructing electronic mail message is closed; a notification from an electronic mail server application to the client application to destroy all instances of the self-destructing electronic mail message.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Art Unit: 2447

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 45- 50 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 45 - 50 are rejected under 35 U.S.C 101 because the claim is drawn to term “computer readable medium”. The specification gave examples of what a “computer readable medium” but does not limit the definition of computer readable medium to only non-transitory media. Thus, applying the broadest interpretation in light of the specification and taking into account the meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, the claim as a whole covers both transitory and non-transitory media. A transitory medium does not fall into any of the four categories of inventions.

Correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of pre-AIA 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31 – 50 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Udell et al hereinafter Udell in view of Ogilvie et al hereinafter Ogilvie (US 6,757,713) in further view of Nakada et al hereinafter Nakada (US 20010030960).

Art Unit: 2447

1. Referring to Claim 31. Udell discloses a method for transmitting self-destructing electronic mail messages comprising: receiving a request, at an electronic mail server, from a sender to send a self-destructing electronic mail message (refer to Fig 1), the request identifying a time period after which the self-destructing electronic mail message is to be destroyed (Fig 5A – 5B); deleting any instances of the self-destructing electronic mail message that are being stored at the electronic mail server after the sending and after expiration of the time period (refer to Col 6, Lines 1-10 and Col 10, Lines 1-5 ).

Although Udell disclosed the invention substantially as claimed, Udell did not explicitly disclosing sending a security warning to the sender when an electronic mail address of an intended recipient of the self-destructing electronic mail message is located beyond a home domain of the sender; sending the self-destructing electronic mail message to the electronic mail address of the intended recipient in response to input from the sender responsive to the security warning.

Ogilivie, in analogous art discloses sending a security warning to the sender when an electronic mail address of an intended recipient of the self-destructing electronic mail message is located beyond a home domain of the sender; sending the self-destructing electronic mail message to the electronic mail address of the intended recipient in response to input from the sender responsive to the security warning (refer to Col 8, Lines 10 – 50, Col 9, Lines 5- 35).

It would have been obvious for one of ordinary skill in the art to combine the teaching of Udell and Ogilivie because Ogilivie's teaching would allow the system of Udell to provide the sender a notification to allow user to reconsider whether or not to send a secure document/email

Art Unit: 2447

to the unauthorized/unrecognized domain without accidentally sent out any secure documents/emails (as supported by Nakada, refer to par 0125).

2. Referring to Claim 32. Udell, Ogilvie and Nakada the method of claim 31. Udell further discloses wherein the request comprises a designation that prevents an electronic mail client of an intended recipient in the home domain of the sender from performing a prohibited operation that results in duplication of contents of the self-destructing electronic mail message (refer to Col 7, Lines 25 - 45).

3. Referring to Claim 33. Udell, Ogilvie and Nakada the method of claim 32. Udell further discloses wherein the prohibited operation comprises forwarding the self-destructing electronic mail message to another recipient (refer to Col 7, Lines 25 - 45).

4. Referring to Claim 34. Udell, Ogilvie and Nakada the method of claim 32. Udell further discloses wherein the prohibited operation comprises printing the self-destructing electronic mail message (refer to Col 7, Lines 25 -45).

5. Referring to Claim 35. Udell, Ogilvie and Nakada the method of claim 32. Udell further discloses wherein the prohibited operation comprises copying contents of the self-destructing electronic mail message into a memory and pasting the contents of the self-destructing electronic message from the memory into a new document (refer to Col 7, Lines 25-45).



Art Unit: 2447

6. Referring to Claim 36. Udell, Ogilvie and Nakada disclosed the method of claim 3. Udell further discloses receiving a request from the intended recipient in the home domain of the sender to read the self-destructing electronic mail message (refer to Col 9, Lines 55-67 and Col 16, Lines 30 - 40).

7. Referring to Claim 37. Udell and Ogilvie disclosed the method of claim 36. Udell further discloses determining whether the self-destructing electronic mail message can be destroyed after the self-destructing electronic mail message is closed (refer to Col 7, Lines 25-40).

8. Referring to Claims 38 – 50, claims are rejected in the same rational as claims 31 - 37.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must show how the amendments avoid such references and objections. See 37 CFR 1.111(c).

**Examiner's Notes:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is

Art Unit: 2447

respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

A shortened statutory period for reply to this Office action is set to expire THREE MONTH from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAREN TANG whose telephone number is (571)272-3116. The examiner can normally be reached on M-F 7 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOON H. HWANG can be reached on (571)272-4036. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 13/690,555

Page 10

Art Unit: 2447

/Karen C Tang/

Primary Examiner, Art Unit 2447