

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DAVID R. FERGUSON, DANI SULEMAN and  
GREGORY L. WHITTEMORE

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Appeal No. 2003-0360  
Application No. 08/947,032

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ON BRIEF

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Before KRASS, RUGGIERO and DIXON Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-5, 8-13, 18-22, 25-32 and 37-40.

The invention is directed to a computer-based document management system wherein electronic documents are automatically archived. The automatic archiving function is triggered by user-defined archiving conditions, such as a maximum time period,

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after which a document is automatically archived if it has not been accessed or modified.

Representative independent claim 1 is reproduced as follows:

1. In a computer-based document management system, a method for archiving an electronic document comprising the steps of:

defining an archiving condition for use in determining whether an electronic document is to be archived;

electronically analyzing a document attribute of an electronic document to determine if the document attribute satisfies the archiving condition; and

triggering said automatic archiving process in order to electronically archive the electronic document if the document attribute satisfies the archiving condition.

The examiner cites the following reference:

Blandford                    5,347,579                    Sep. 13, 1994

Claims 1-5, 8-13, 18-22, 25-32 and 37-40 stand rejected under 35 U.S.C. §103 as unpatentable over Blandford.

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

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OPINION

In rejecting claims under 35 U.S.C. §103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason much stem from some teachings, suggestions or implications in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc. , 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying

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with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

It is the examiner's position that Blandford "did not explicitly teach, defining a condition for use in determining whether an electronic document is to be archived. . . . electronically analyzing a document attribute of an electronic document to determine whether the attribute satisfies the condition. . . .and triggering the automatic archiving process in order to electronically archive the electronic document if the document attribute satisfies the condition. . ." (answer-page 3).

Even though the examiner all but recognizes that Blandford does not disclose even a single step of the claimed method, the examiner still holds that it would have been obvious to modify the teachings of Blandford to include the steps of defining a condition for use in making a determination whether an electronic document is to be archived, to electronically analyze a document attribute to determine whether the attribute satisfies the condition, and to trigger the automatic archiving process to electronically archive the electronic document if the document attribute satisfies the condition, i.e., obvious to perform a

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completely undisclosed method,

. . .because such a modification would allow Blandford to determine if the date (attribute) was written anytime close to a specific date or changed months or years later, to analyze the document date to make a determination whether the date was the oldest document date according to a timestamp, and to have a skilled programmer compose formulas for relative reference dates for archiving the document answer-page 4).

The examiner has clearly failed to even come close to presenting a prima facie case of obviousness of the instant claimed subject matter. The examiner should at least start with a reference that is substantially like the instant claimed subject matter but for some slight or otherwise obvious modification. If one were to follow the dictates of Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966), one of the requirements in an analysis under 35 U.S.C. §103 is to determine the differences between the prior art and the instant claimed invention. In the instant case, the examiner has determined that there are stark differences in that the applied prior art has not a single step of the instant claimed method.

Theoretically, it may be possible to show obviousness of the claimed subject matter as a whole even where no step is actually

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taught by an applied reference, but the hurdle would clearly be much greater than if something of the claimed invention had been taught by the applied reference. The examiner in the instant case is attempting to show that each and every step of the claimed method would have been obvious, within the meaning of 35 U.S.C. §103, i.e., the claimed subject matter as a whole would have been obvious, without one of those steps being explicitly taught by the applied reference. We are not convinced.

Blandford discloses an electronic diary which does have an archiving function but that archiving function is to archive a diary entry and that diary entry may only be archived once (see column 14, lines 29-30). There is also a determination in Blandford as to whether an entry has been archived. But we agree with appellants that ". . .the disclosure of the ability to archive an entry once, and of the step of determining if an entry has been previously archived is not equivalent to defining an archiving condition for use in determining whether an electronic document is to be archived" (reply brief-page 2). Neither is the determination of whether a process has been executed, as in Blandford, equivalent to defining a condition for the execution of that process.

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The examiner uses the example of a date as an attribute in Blandford, but Blandford does not use the date of the diary entry as an "archiving condition" to determine whether the document is to be archived nor is there any electronic analysis of the date of the diary entry to determine if the date (attribute) satisfies an archiving condition.

Still further, the examiner asserts that it would have been obvious to have a skilled programmer compose "formulas" for relative reference dates for archiving the document but we think appellants make a good point when they urge that

. . .there would be no need to modify Blandford in order to have "skilled programmers compose formulae for relative reference dates for archiving the document" as suggested by the Office Action. Furthermore, Blandford already discloses the ability to determine the date which a data block is created in order to prevent archiving of a data block which has allegedly been created prior to a previously stored data block. This feature in Blandford prevents modifications or the addition of diary entries after the fact. . . (principal brief-page 6).

Blandford discloses an electronic diary wherein diary entries are archived in such a manner that modification of those entries can be identified and removed or restored to recreate the corresponding original entries. Other than "archiving"

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documents, we find nothing in common between the instant claimed invention and that disclosed by Blandford. The examiner has not convincingly pointed to anything within Blandford, or within the common knowledge of artisans, that would lead to the conclusion that it would have been obvious to modify Blandford in any manner to result in the "defining," "analyzing," and "triggering" steps set forth in the instant claims.

In response to appellants' arguments, the examiner rather broadly points to a ". . .check being made whether archived or not archived in col. 14, lines 37-47 suggests a condition. . . (answer-page 9) and to an implicit suggestion of ". . .the step of electronically analyzing a document attribute of an electronic document to determine if the document attribute satisfies the archiving condition in col. 1, lines 59-62 and col. 4, lines 25-32. A flag in fig. 18 (520) with the flag not set suggests an archiving. . ." (answer-page 10).

The examiner appears to be "reaching" to find claimed subject matter that is simply not in Blandford. If a check as to whether a document is archived or not is the claimed "condition" and the date of the document is the claimed "attribute," then, in

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terms of the claim language, what does it mean to say that an archiving condition, i.e., whether to archive or not, is used to determine whether to archive? There appears to be a redundancy, or double-talk, in such an analysis. Further, it would appear awkward to say that the archiving process is triggered in order to archive a document if the date (attribute) satisfies the condition that the document should be archived, yet this is how the instant claim language would read if we adopted the examiner's definition of the claimed "condition" to be a "check being made whether archived or not archived" and of the claimed "attribute" to be the "date" of the diary entry.

It is our view that the examiner has completely reconstructed the instant claimed invention from Blandford by employing totally unwarranted and impermissible hindsight gleaned from appellants' own disclosure. This is not a proper basis, within the meaning of 35 U.S.C. §103, for a conclusion of obviousness.

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The examiner's decision rejecting claims 1-5, 8-13, 18-22,  
25-32 and 37-40 under 35 U.S.C. §103 is reversed.

REVERSED

ERROL A. KRASS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	
JOSEPH RUGGIERO	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
	)	
JOSEPH DIXON	)	
Administrative Patent Judge	)	

EAK/dpv

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