

The opinion in support of the decision being entered today was not written for publication in and is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN S. SIMPSON and MURALI CHIRALA

Appeal No. 2003-1051
Application No. 09/247,134

HEARD: November 6, 2003

Before KRASS, DIXON and SAADAT, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-6 and 8-26.

The invention is directed to a method and system for managing mail and/or bills through a central terminal. Mail and/or bills are handled in electronic form. If the mail/bill is received in electronic form, it is handled accordingly. If in conventional paper form, it is converted into electronic form by

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the use of a template to extract the important information from the paper mail/bill.

Representative independent claim 1 is reproduced as follows:

1. A method for allowing a plurality of subscribers to each manage mail stored in electronic form at a data storage location from remote locations, the method comprising the steps of:

receiving mail for the subscribers in paper and electronic format, wherein certain pieces of mail are bills in paper format and certain other pieces of mail are bills in electronic format;

sorting the received mail in paper format, wherein bills in paper format are saved and certain other mail in paper format is discarded;

storing data into a database at the data storage location, wherein the data is obtained from bills in paper format and bills in electronic format, the storing data step further includes determining if a template exists for a bill in paper format, and, if the template exists, scanning the paper bill to enter specific data contained in the paper bill into the database, and if a template does not exist and the bill in paper format has not been previously provided, creating a template to allow specific data contained on the paper bill in specific locations to be automatically identified before the bill is scanned into the database using the newly created template;

generating an electronic bill statement for each of the plurality of subscribers, each electronic bill statement including a first summary report that summarizes all bills for each subscriber based on the stored data corresponding to that subscriber; and

providing access to the electronic bill statement and the first summary report to each subscriber at a remote location.

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The examiner relies on the following references:

Manduley	5,648,916	Jul. 15, 1997
Kolling et al. (Kolling)	5,963,925	Oct. 05, 1999 (filed Oct. 8, 1997)
Lech et al. (Lech)	6,094,505	Jul. 25, 2000 (filed Mar. 19, 1998)

Claims 1-6, 8-22 and 26 stand rejected under 35 U.S.C. § 103 as unpatentable over Kolling in view of Manduley and further in view of Lech.

Claims 13-25 stand rejected under 35 U.S.C. § 103 as unpatentable over Manduley in view of Kolling and further in view of Lech.

Thus, all of the claims stand rejected under 35 U.S.C. § 103 over the combination of Kolling, Manduley and Lech.

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

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

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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 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). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1040, 228 USPQ

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685, 687 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 146-147 (CCPA 1976).

The examiner applies the references in different combinations. First, with regard to claims 1-6, 8-22 and 26, the examiner employs Kolling for a teaching of storing electronic bills in a database, determining if a template exists for the bill and, if it does not, creating a template and generating a bill statement. The examiner recognized that Kolling is concerned only with electronic mail/bills and discloses nothing about receiving paper mail/bills and then sorting the paper. The examiner turned to Manduley for a teaching of receiving paper mail and electronic mail, sorting the paper mail and generating electronic mail. Since Manduley discloses an integration of electronic mail and paper mail, the examiner concludes that it would have been obvious "to combine Kolling's electronic bill processing and Manduley's integration of paper and electronic mail handling, in order to include both the paper and electronic mail recipient as taught by Manduley's..." (answer-page 4).

The examiner then turns to Lech to provide a teaching of scanning a paper bill to enter specific data contained in the paper bill into a database and, if a template does not exist and

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the bill has not been previously provided in a paper format, creating a template to allow specific data contained in the paper bill in specific locations to be automatically identified before the bill is scanned into the database using the newly created template.

The examiner concludes that it would have been obvious to combine Manduley's integration of paper and electronic mail, Kolling's electronic statement presentation and Lech's creation of a template from a scanned bill, "because by creating a template, selected information can be extracted in order to identify specific information as taught by Lech thus minimizing the need of manually processing the hard copy documents" (answer-page 4).

With regard to claims 13-25, the examiner applies the same references, but now uses Manduley as the primary reference for disclosing the sorting of received mail according to predetermined rules, storing data obtained from the mail electronically, and providing access to the data. Recognizing that Manduley does not disclose labeling and forwarding when the paper mail is not a bill, the examiner takes Official notice that it was well known to discard or shred junk mail, to separate bills, to label and to forward the mail to the proper recipient.

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While the examiner recognized that Manduley did not disclose the determination of whether a template exists for a bill and the creation of a template if one does not exist, the examiner contends that Kolling discloses this and that it would have been obvious "to combine Kolling's use of template to create electronic statement and Manduley's integration of paper and electronic mail handling, in order to include both the paper and electronic mail recipient as taught by Manduley's" (sic) (answer-page 8).

The examiner again turns to Lech for a scanning of a paper bill to enter specific data contained in the paper bill into a database.

We have thoroughly reviewed the examiner's rationale for the rejection of claims 1-6 and 8-26 under 35 U.S.C. § 103 and we find that the examiner has not established a prima facie case of obviousness.

Claims 1-6 and 8-25 require receiving mail/bills in paper and electronic formats. The mail is then sorted and data from the paper mail/ bills is obtained in electronic format and an electronic bill statement is issued to a subscriber.

Contrary to this, Kolling discloses only a system for presenting electronic statements and does not involve itself with

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paper mail/bills. Even the abstract states that the system "replaces the preparation and mailing of paper statements and invoices from a biller with electronic delivery."

Manduley does convert paper mail into electronic mail, integrating paper handling machines with electronic networks, but Manduley does not obtain any data from bills or mail in paper format and store that data in an electronic format, as claimed. Instead, Manduley scans the paper mail and sends a complete copy of the document electronically. It does not extract data from the document and store that data in electronic form, as claimed, but only sends the paper mail electronically as a graphic file. In a way, it can be said that the scanning of the paper mail in Manduley and sending the electronic copy of the document is a kind of obtaining of "data," but this is not the kind of data meant by the instant disclosed and claimed invention. Rather, in the instant claimed invention, the paper bill is scanned but the scanning is "to enter specific data contained in the paper bill into the database" if there is an existing template for the paper bill and, if there is no template, a template is created to allow the specific data contained in the paper bill "in specific locations" (i.e., not the entire paper bill, as scanned and

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forwarded by Manduley) to be automatically identified before the bill is scanned into the database.

Appellants argue that Manduley divides paper mail into "fast" mail and "slow" mail. It is only the "fast" mail which is scanned and sent electronically as a graphic file. The "slow" mail (e.g., magazines) is still hand-delivered, "processed in the traditional way" (column 2, line 14). Accordingly, while Manduley has, as an input, paper mail and, as an output, electronic and paper mail, the instant claimed invention performs in an opposite manner, with both paper and electronic mail as inputs and only electronic mail as an output. This is not entirely true since Figure 1 of Manduley does depict both paper mail and electronic mail as being input to Manduley's system.

In any event, because Manduley does not extract data from the document and store that data in electronic form, as claimed, but only sends the paper mail electronically as a graphic file, it cannot be said to store data into a database wherein that data is obtained from bills in paper format and bills in electronic format and it cannot be said to scan the paper bill "to enter specific data contained in the paper bill."

Since Kolling does not deal with paper mail/bills at all, it is of no help in providing the deficiency of Manduley. With

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regard to Lech, the examiner applies this reference for scanning a paper bill to enter specific data contained in the paper bill into a database and to do so in response to whether a template exists. In particular, the examiner cites the abstract and column 5, line 58 to column 6, line 65, of Lech.

While it is true that Lech teaches the use of a scanner to store information extracted from a hard-copy document, appellants have not denied that it was known to extract specific information from a paper document. The question is why the skilled artisan would have been led from this teaching in Lech to extract specific information from the paper mail/bills of Manduley, rather than scan the entire document and send it as a graphic file. We agree with the examiner that Lech also discloses a template which can be stored for future use on another paper document in the same format (column 6, lines 62-65). So Lech suggests the use of a template for extracting information from paper documents. But it still begs the question as to why the skilled artisan would have been led by this teaching to modify Manduley in order to extract specific information from the paper document rather than scan the entire document and send as a graphics file.

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Appellants argue in the reply brief (pages 4-7) that Lech really discloses two modes of operation, the first mode scanning documents and saving *both* an electronic graphic image *and* ASCII text recognized using character recognition software for every one of the scanned documents; and the second mode scanning documents and temporarily storing the entire electronic scanned image. It is in this second mode that Lech discloses the use of a template but, since character recognition software is not used in this mode, the extracted information is stored as graphic images. We do not agree with appellants' assessment of Lech since the reference indicates that specific data, whether graphical or textual, can be extracted and used as an input to an application (e.g., see column 5, lines 37-48).

Nevertheless, it does not appear that any combination of Lech with Manduley or Kolling would result in storing data into a database wherein that data is obtained from bills in paper format and bills in electronic format and wherein the paper bill is scanned "to enter specific data contained in the paper bill."

The examiner says it would have been obvious to combine Manduley's integration of paper and electronic mail handling, Kolling's electronic statement presentation and Lech's creation of a template and extracting specific data from a paper document

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"because by creating a template, selected information can be extracted in order to identify specific information as taught by Lech thus minimizing the need of manually processing the hard copy documents (see col. 14 lines 36-67 and col. 14 lines 1-19)" (answer-page 9). Such reasoning does not appear to set forth a good case for suggesting modifications to the artisan. The examiner is not clear as to what modifications are being made to each reference and what would have specifically led the artisan to make those modification. Merely because Manduley may integrate paper and electronic mail handling and Kolling may disclose electronic statement presentation and Lech may create a template and extract specific data from a paper document, that, in and of itself, does not present a reason for any modification of a reference by the teaching of another reference. The examiner may give a reason why Lech employs a template, i.e., minimizing the need of manually processing, but this offers no reason for any modification to the electronic bill presentation of Kolling or to the paper/electronic mail handling system of Manduley, based on the teachings of Lech.

Claim 26 is a bit different from the other claims in that it stresses more of the bill generation system rather than the extraction of specific data from paper bills. However, as above,

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the examiner has not provided us with a convincing reason for modifying the references in order to achieve this claimed subject matter.

Assuming, arguendo, the examiner has found each and every claimed element, the mere finding of each claimed element in separate references does not, by itself, establish a valid reason for combining the references in a way to result in the claimed subject matter. Since the examiner has not convinced us of any reason that would have led the artisan to combine the references, we find that the examiner has not established a prima facie case of obviousness.

We will not sustain the rejection of claims 1-6 and 8-26 under 35 U.S.C. § 103 because it is the examiner's burden, in the first instance, to establish prima facie obviousness. However, we note that had the examiner made such a case, appellants' arguments might not have been sufficient to overcome a prima facie case because appellants, for all of their arguments citing differences between the applied references and the *disclosed* invention, never really point out any specific claim language they believe to distinguish over the prior art.

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The examiner's decision is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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JOSEPH L. DIXON)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
)	
MAHSHID D. SAADAT)	
Administrative Patent Judge)	

EK/RWK

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REINHART BOERNER VAN DEUREN S.C.
ATT: LINDA GABRIEL, DOCKET COORDINATOR
1000 NORTH WATER STREET
SUITE 2100
MILWAUKEE, WI 53202