

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* KEVIN J. STEGER

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Appeal 2006-3369  
Application 10/224,309<sup>1</sup>  
Technology Center 2100

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Decided: February 27, 2007

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*Before:* KENNETH W. HAIRSTON, ALLEN R. MACDONALD and JAY LUCAS, *Administrative Patent Judges.*

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF CASE

Appellant appeals from a final rejection mailed June 13, 2005 of claims 1 to 45 under 35 U.S.C. § 134 (2002). The BPAI has jurisdiction under 35 U.S.C. § 6(b) (2002).

The Examiner rejected claims 1 to 45 under 35 U.S.C. § 102 (e). The arguments relate to two groups of claims:

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<sup>1</sup> Application was filed August 19, 2002. The real party in interest is Alternative Legal Solutions, Inc, dba Compli, Portland, OR.

Group 1: Claims 1, 2, 6 – 17, 21 – 32, 36 – 45 including independent claims 1 (method of operation), 16 (apparatus), and 31 (article of manufacture).

Group 2: Claims 3-5, 18 – 20, 33 - 35, dependent claims which include a scheduling feature.

Claims 1 and 3 are illustrative of the claimed invention in each group:

1. In a computing environment, a method of operation comprising:
  - receiving by the computing environment, a change of a person within an organization, the received change having employee information corresponding to the change of the person;
  - storing by the computing environment, the received employee information corresponding to the change of the person in a database;
  - updating by the computing environment, the database with the received employee information corresponding to the change of the person; and
  - automatically providing by the computing environment, to the person, one or more policy materials for compliance certification, based at least in part on relevant parts of said updated employee information, to facilitate the organization's compliance with the one or more policy materials.
3. The method operation of claim 1 further comprising:  
Determining by the computing environment, if the person has fully certified compliance with the provided one or more policy materials; and scheduling by the computing environment, one or more reminders for the person to certify compliance with the one or more policy materials.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Gullotta                    US. 2002/0147801<sup>2</sup>                    Oct. 10, 2002

Appellant has invented an automated policy compliance management system and method, having particular application to the management of human resource policies. The invention uses a computing or network environment to provide policy materials to a person in an organization when, for example, the person is hired or his status changes. (Br. 3).

Appellant contends that the claimed subject matter is not anticipated by Gullotta as the reference does not contain recited elements of the claims. (Br. 6). The Examiner contends that the claimed elements can be read on the disclosure of Gullotta. (Answer 3 ff.)

We affirm.

#### ISSUE

The issue is whether Appellant has shown that the Examiner erred in rejecting claims 1 to 45 under 35 U.S.C. § 102(e). The issue turns on the interpretation of a number of key limitations of the claims, and whether they can be read on the reference Gullotta.

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<sup>2</sup> Filed January 29, 2001.

## FINDINGS OF FACT

Findings of Fact concerning Group 1: Claims 1, 2, 6 – 17, 21 – 32, 36 – 45 including independent claims 1 (method of operation), 16 (apparatus), and 31 (article of manufacture):

1. The arguments of Appellant and Examiner on these claims center exclusively around the fourth limitation of Claim 1, namely “automatically providing by the computing environment, to the person, one or more policy materials for compliance certification, based at least in part on relevant parts of said updated employee information, . . .”. Examiner contends that the Gullotta reference teaches this limitation; Appellant contends that Gullotta does not disclose it. (Br. 8).
2. The interpretation of “policy materials for compliance certification” becomes a key finding for the consideration of whether these claims are anticipated by Gullotta. The “ordinary meaning” of the phrase would refer to documents containing policy statements, training materials, forms, and other managerial papers that are used in conjunction with a person’s role in the organization to assist

compliance with the organization's policies. Turning to examples in the specification, we note the following excerpts: Page 11, an employee is provided the OSHA policy materials, which may include a training manual, forms to verify the employee completed training, and so forth. Page 14, the policy materials include policies for the marketing department [presumably documents], and policies for supervisors. On page 17, we note that policy materials are selected from policy information stored in the database 122, such as training manuals and so forth. From these examples in the specification, which are consistent with common meaning, we find that "policy materials for compliance certification" means documents stored on a database specific to, supportive of, or resources for a person assuming a role in the organization.

3. The Examiner has indicated in the Answer, page 4, that he is reading the key limitation, "policy materials for compliance certification", on paragraphs 56 and 58 of the Gullotta reference. Gullotta teaches a system and method for provisioning users who have taken or changed jobs in an organization with a set of "hard" resources (e.g. desks, chairs) and "soft" resources (e.g. software programs, files, folders)

based on the user's role. In paragraphs 56 to 58 the reference teaches, as an example, supplying a new System Administrator or Salesperson access to such databases as are needed for that job, based on the informational needs of the user in that role. The specific information from these databases to be given the person is defined by policies of the organization and the user's particular role in the organization. Paragraph 63 indicates that organizational information may be customized for users by Form Generators based on the user's role.

4. The Gullotta reference gives a number of examples of the kinds of "soft resources" that may be provisioned to users. That list includes: "e-mail and voice mail accounts, application programs, databases, files, folders, the Internet, Web pages, organizational Intranets, messages to third parties, digital certificates for enabling the user to access encrypted resources, the capability to order products over the Internet, the ability to order a corporate credit card, access to financial services providers, and the like. . ." We find that many of these soft resources are embodied as documents, and more particularly as documents related to the user's role in the organization needed for compliance with the policies of the organization.

5. We find the documents described in Gullotta as “soft resources” to be of much the same nature as the “policy materials” in the claims and disclosed in the specification of the instant application. Considering the breadth of the informational documents that are taught by Gullotta as being supplied to the user based upon his role in the organization, we find that that “policy materials for compliance certification” read on the documents supplied the user in Gullotta.

Findings of Fact concerning Group 2: Claims 3-5, 18-20, and 33 to 35, which are respectively dependent from independent claims 1 (method of operation), 16 (apparatus), and 31 (article of manufacture):

1. Appellant argues that the Examiner erred in asserting that the limitations in claim 3 (and parallel limitations in the other claims of this Group) were anticipated by Gullotta. He asserts that the following limitation is not found in Gullotta: “determining by the computing environment, if the person has fully certified compliance with the provided one or more policies [actually ‘policy materials’ are the words in the claim], scheduling by the computing environment, one or more reminders for the person to

certify compliance with the one or more policies [policy materials]” (Br. 11). [Emphasis added.]

2. Examiner reads the limitation underlined above on Paragraph 56 of Gullotta, which describes an example of how the computing system of Gullotta automatically sets up (“schedules”) notifications (“reminders”) for the delivery of “soft” resources. The Examiner reads the Appellant’s claimed computing environment scheduling the reminder for the person to certify compliance with the policy materials as being anticipated by Gullotta’s computer system ordering the delivery for the new user of the required soft resources that he is entitled to in accordance with the policy directives.
3. During prosecution, claims are to be given “their broadest reasonable interpretation consistent with the specification” *Phillips-v AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ 1321, 1329 (Fed Cir 2005). Appellant argues that for the claim limitation under discussion, the specification limits the actor receiving the reminders to the person in the claim, as if it read “reminders to the

person to certify compliance” (Reply Br. 7). However, during prosecution, the Examiner may not read limitations into the claims that are not there. The words in the claim are “one or more reminders for the person to certify compliance”. In Gullotta, Examiner has presented one or more reminders for the person (but addressed to the resource provider) to certify compliance with the policy materials. For example, there is a reminder to the administrator for the new user’s benefit to supply that user with access to relevant job related documents in the database. We find that the applied prior art anticipates the claim as worded.

#### PRINCIPLES OF LAW

On appeal, Appellant bears the burden of showing that the Examiner has not established a legally sufficient basis for the rejection of the claims.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and

*Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

Our reviewing court states in *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) that “claims must be interpreted as broadly as their terms reasonably allow.” Our reviewing court further states, “[t]he terms used in the claims bear a ‘heavy presumption’ that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art.” *Texas Digital Sys. Inc v. Telegenix Inc.*, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002), *cert. denied*, 538 U.S. 1058 (2003).

## ANALYSIS

In applying the principles of claim interpretation to the claims in this application, we appreciate Appellant’s position that claims are to be given their common meaning, in view of the specification. However we find that the claim language used for Appellant’s invention does not preclude reading on Gullotta’s method and system. As an example, Appellant’s “policy

materials” viewed in light of the specification clearly fit the reference’s “soft” resources, which encompass many of the claimed documentary materials used to support a person in a specific position in an organization. Granting access to such material will certify their use for policy compliance by those with roles using those materials. A certification form can be one of those materials when it is used to itemize the resources that are due to that person.

#### CONCLUSIONS OF LAW

Appellant has failed to establish that the Examiner erred in rejecting claims 1 to 45 under 35 USC § 102(e). Claims 1 to 45 are not patentable.

#### DECISION

The Examiner's rejection of claims 1-45 is Affirmed.

Appeal 2006-3369  
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Affirmed

ELD

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