

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LISA S. PURVIS

Appeal 2007-0014
Application 10/202,227¹
Technology Center 2100

DECIDED: February 27, 2007

Before LEE E. BARRETT, JOSEPH F. RUGGIERO, and LANCE LEONARD BARRY, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) and 306 from the final rejection of claims 1-5 and 11.

We reverse.

¹ Application for patent filed July 23, 2002, entitled "Case-Based System and Method for Generating a Custom Document."

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BACKGROUND

The invention relates to a method to find document components and assemble them into a custom document.

Claim 1 is reproduced below.

1. A method for automatically selecting an electronic document from a document case base to be used in creating a new electronic document, comprising:
 - (a) inputting features defining an electronic document to be created;
 - (b) searching an electronically stored document case base for document, stored therein, substantially matching the inputted features;
 - (c) selecting, automatically, one of the substantially matched documents; and
 - (d) modifying, automatically, the selected document to correspond to the inputted features to create an electronic document to be used in creating a new electronic document.

THE REFERENCES

The Examiner relies on the following references:

Koski	US 6,571,251	May 27, 2003
Kiyoujima	JP 404116765 A	Apr. 17, 1992

THE REJECTION

Claims 1-5 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Koski and Kiyoujima. The Examiner finds that Koski teaches the claimed invention except for the step of modifying being done automatically. The Examiner finds that Kiyoujima discloses automatically generating a new electronic document in accordance with input from a user and concludes that it would have been obvious to have incorporated automatic updating in Koski to provide for automatic document generation.

DISCUSSION

The first issue involves steps (a), (b), and (c) of inputting features of an electronic document to be created, searching a case base of documents for a document substantially matching the inputted features, and automatically selecting one of the substantially matching documents.

Appellant argues that Koski is directed to a case management system that allows a user to find a similar experience or incident in a database to glean the relevant solution or answer to the current problem, and is *not* directed to searching out electronic documents based upon document features to gather a starting point for generating a new document (Br. 5).

The Examiner responds that the cases in Koski "can relate, for example, to help desk support, sales support, customer service, medical diagnosis, engineering design, executive information systems, or the like" (col. 2, ll. 63-66) and "[t]hus, the cases in Koski reference are considered as documents" (Answer 6).

Appellant replies that the Examiner's position that entering a description of an incident and finding a case related to the inputted description is equivalent to the claimed input of document features and finding a document that is related to the inputted document features is unsustainable (Reply Br. 4). It is argued that claim 1 requires that features, corresponding to non-content based document structure and layout which defines the "electronic document to be created," are inputted, whereas in Koski, a description of the problem is entered to enable resolution of the problem, *not* the creation of an electronic document (*id.*). Moreover, it is argued the Koski desires to find a case with a particular content to provide a solution to a query, not to find a case (document) having a particular structure or layout of a document as in the claim (*id.* at 5).

Both Appellant's invention and Koski deal with "case-based reasoning (CBR)" using a "case base." Koski relates to CBR, in general. The inputted attributes in Koski are described by a property-value pair, as in the present invention. We presume that the "cases" in Koski can be considered to be "documents," as stated by the Examiner, in the broad sense that a computer data file can be considered to be a document, which are retrieved based on inputted features. However, the inputted attributes (features) in Koski do not "defin[e] an electronic document to be created," but define a case which most closely matches the input attributes. Koski is not directed to searching out electronic documents based on document features so as to gather a starting point for generating a new document. While it may have been obvious to apply the teachings of Koski so that the cases are electronic documents and the searching is for electronic documents

that satisfy the input attributes for an electronic document to be created, this reasoning is not set forth by the Examiner and would require some motivation not found in Koski. Nevertheless, this is not the only problem with the rejection.

The second issue involves step "(d) modifying, automatically, the selected document to correspond to the inputted features to create an electronic document to be used in creating a new electronic document." Appellant states (Br. 3) that this feature is described at lines 7-8 of page 5 of the filed specification, which states: "Perform an adaptation process on the selected documents to create the final desired output document." The "adaptation process" corresponds to "modifying." The specification states to "use an adaptation mechanism to transform that solution to meet exactly the requirements of our new document" (page 5, ll. 21-22), that corresponds to claim step (d). There is no description instructing one of ordinary skill in the art how to make or use "an adaptation mechanism" which would automatically modify a selected document so, presumably, the Examiner has determined this to be within the level of ordinary skill in the art or the application would be nonenabling. *See In re Epstein*, 32 F.3d 1559, 1568, 31 USPQ2d 1817, 1823 (Fed. Cir. 1994) ("Rather, the Board's observation that appellant did not provide the type of detail in his specification that he now argues is necessary in prior art references supports the Board's finding that one skilled in the art would have known how to implement the features of the references and would have concluded that the reference disclosures would have been enabling."); *In re Fox*, 471 F.2d 1405, 1407, 176 USPQ 340, 341 (CCPA 1973) (appellant's specification "assumes anyone desiring to carry out the process would know of the equipment

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and techniques to be used, none being specifically described"). It is not clear where the specification discloses modifying "automatically."

Appellant disputes the Examiner's finding that Koski teaches, at column 3, line 54 through column 4, line 12, modifying the selected document to correspond to the inputted features to create an electronic document to be used in creating a new electronic document. It is argued that "views" in Koski are structures in the database to facilitate searching, not documents dependent upon input from the user and the generation of a view is *not* dependent upon input from the user (Br. 5). It is argued that Koski creates a new case only when no case has been selected in accordance with the inputted attributes and, if a record is selected, it is not modified (Br. 6).

The Examiner responds that "[t]he best matching case or cases (documents) in the view are retrieved from the case base and formatting (modifying) the case (document) retrieved from the case base and presenting the output case as action corresponding to the incident (input features) (col. 3, line 54 - col. 4, line 12)" (Answer 7).

Appellant replies that the views in Koski are user independent and formatting a view of the case is void of any relationship to the inputted description (Reply Br. 5).

We agree with Appellant that there is no teaching or suggestion in Koski of "modifying . . . the selected document [which substantially matches the inputted features] to correspond to the inputted features." (The Examiner finds that the limitation "automatically," omitted as indicated by ellipses, is taught by

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Kiyoujima.) "Formatting" the cases in Koski is not the same as "modifying . . . the selected document to correspond to the inputted features," because formatting has nothing to do with inputted features. Koski only creates a new case when there is not a sufficiently close match within the case base and after there is a final resolution of the case (col. 4, ll. 8-12); it does not modify a case to create a new case based on the inputted features. The views in Koski have no relationship to the input attributes.

Appellant argues that Kiyoujima also fails to teach or suggest that the selected document is modified to correspond to the inputted features to create an electronic document to be used in creating a new electronic document because Kiyoujima teaches that the selected document is modified based on a program (Br. 6). The Examiner responds that Koski is relied upon for these limitations (Answer 8). We find that Koski does not teach these limitations.

For these reasons, the rejection of claim 1 is reversed. Claims 2-5 and 11 depend from claim 1 and the rejection of these claims must also be reversed.

REVERSED

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BARRY, *Administrative Patent Judge.*

I concur with the majority and write separately with an additional observation. "When the nature of . . . subject matter [to be patented] admits of illustration by a drawing and the applicant has not furnished such a drawing, the Director may require its submission. . . ." 35 U.S.C. § 113. "Whenever the nature of the subject matter sought to be patented admits of illustration by a drawing . . . and the applicant has not furnished such a drawing, the examiner will require its submission. . . ." 37 C.F.R. § 1.81(c).

Here, I believe that the Appellant's claimed subject matter admits of illustration to facilitate understanding of her invention. In particular, a depiction of where "features defining an electronic document to be created" are input would facilitate understanding of step (a) of claim 1. Also, a depiction of the relations among the "electronic document to be created," the "electronically stored document case base," the "document . . . substantially matching the inputted features," and the "electronic document to be used in creating a new electronic document" would facilitate understanding of the relation among steps (a) through (d) of the independent claim.

In an *ex parte* appeal, however, the Board "is basically a board of review C we review . . . rejections made by patent examiners." *Ex parte Gambogi*,

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62 USPQ2d 1209, 1211 (Bd. Pat. App. & Int. 2001). Therefore, I leave it to the Examiner to decide whether to require submission of such drawings.

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