

1 UNITED STATES PATENT AND TRADEMARK OFFICE

2  
3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* SUZANNE M. BENNETT, KEVIN A. BOONE, LISA C. FEKLER,  
9 VINCENT P. FOX, GERARD J. LENZO, and ANTHONY T. MAZZATTI  
10

11  
12 Appeal 2008-1447  
13 Application 09/792,187  
14 Technology Center 3600  
15

16  
17 Decided: July 8, 2008  
18

19  
20 Before LINDA E. HORNER, ANTON W. FETTING, and JOSEPH A.  
21 FISCHETTI, *Administrative Patent Judges*.  
22 FETTING, *Administrative Patent Judge*.

23 DECISION ON APPEAL

24 STATEMENT OF CASE

25 Suzanne M. Bennett, Kevin A. Boone, Lisa C. Fekler, Vincent P. Fox, Gerard  
26 J. Lenzo, and Anthony T. Mazzatti (Appellants) seek review under 35 U.S.C. § 134  
27 of a final rejection of claims 1-3, 5-14, and 16-22, the only claims pending in the  
28 application on appeal.

29 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

30  
31 We AFFIRM.

1       The Appellants invented a web based accounts payable processing system for  
2 receiving and processing electronic and paper invoices. (Specification 1:4-6).

3       An understanding of the invention can be derived from a reading of exemplary  
4 claim 1, which is reproduced below [bracketed matter and some paragraphing  
5 added].

6       1. An invoice processing system, comprising:

7       [1] an imaging system

8               for scanning and storing a paper invoice in a human readable  
9               format,

10              wherein the paper invoice can comprise

11                      a purchase order (PO) invoice or

12                      a non-purchase order (non-PO) invoice;

13       [2] a data entry queue

14               for receiving the scanned paper invoice from the imaging  
15               system;

16       [3] a web payment request system

17               for receiving invoice details

18                      including the scanned paper invoice from the data entry  
19                      queue and

20               for generating an electronic invoice,

21       [4 ] the web payment request system further comprising:

22               [4a] a system for determining

23                      if the scanned paper invoice is a PO invoice or a non-PO  
24                      invoice;

25               [4b] a system for determining

26                      if additional invoice details are required,

27                      if the scanned paper invoice is determined to be a non-  
28                      PO invoice;

29               [4c] a system for notifying

1 a party associated with a non-PO invoice  
2 that additional invoice details are required; and  
3 [4d] a system for allowing  
4 the party to enter the additional invoice details for the  
5 non-PO invoice; and  
6 [4e] an accounts payable system for processing the electronic  
7 invoice,  
8 wherein the accounts payable system includes a  
9 preprocessor  
10 for auditing the electronic invoice in real-time and  
11 for notifying the web payment request system  
12 if a problem exists as the invoice details are  
13 being inputted.

14 This appeal arises from the Examiner's final Rejection, mailed May 4, 2006.  
15 The Appellants filed an Appeal Brief in support of the appeal on December 18,  
16 2006. An Examiner's Answer to the Appeal Brief was mailed on March 22, 2007.  
17 A Reply Brief was filed on April 16, 2007.

18 PRIOR ART

19 The Examiner relies upon the following prior art:

Lech	US 5,258,855	Nov. 22, 1993
Hogan	US 5,699,528	Dec. 16, 1997
Landry	US 5,956,700	Sep. 21, 1999
Anderson	US 6,058,380	May 2, 2000
Wong	US 6,343,275	Jan. 29, 2002

20 REJECTIONS

21 Claims 1-3, 12-14, 16, and 18-21 stand rejected under 35 U.S.C. § 103(a) as  
22 unpatentable over Lech, Wong, and Admitted Prior Art.

1 Claim 5 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Lech,  
2 Wong, Hogan, and Admitted Prior Art.

3 Claims 6-8, 17, and 22 stand rejected under 35 U.S.C. § 103(a) as unpatentable  
4 over Lech, Wong, Anderson, and Admitted Prior Art.

5 Claims 9-11 stand rejected under 35 U.S.C. § 103(a) as unpatentable over  
6 Lech, Wong, Anderson, Landry, and Admitted Prior Art.

### 7 ISSUES

8 The issues pertinent to this appeal are:

- 9 • Whether the Appellants have sustained their burden of showing that the  
10 Examiner erred in rejecting claims 1-3, 12-14, 16, and 18-21 under 35  
11 U.S.C. § 103(a) as unpatentable over Lech, Wong, and Admitted Prior Art.
- 12 • Whether the Appellants have sustained their burden of showing that the  
13 Examiner erred in rejecting claim 5 under 35 U.S.C. § 103(a) as  
14 unpatentable over Lech, Wong, Hogan, and Admitted Prior Art.
- 15 • Whether the Appellants have sustained their burden of showing that the  
16 Examiner erred in rejecting claims 6-8, 17, and 22 under 35 U.S.C. § 103(a)  
17 as unpatentable over Lech, Wong, Anderson, and Admitted Prior Art.
- 18 • Whether the Appellants have sustained their burden of showing that the  
19 Examiner erred in rejecting claims 9-11 under 35 U.S.C. § 103(a) as  
20 unpatentable over Lech, Wong, Anderson, Landry, and Admitted Prior Art.

21 The pertinent issues turn on whether the automation of determining whether  
22 information is needed and obtaining that information in steps 4a-4d were  
23 predictable within an accounts payable system in view of the admitted prior art.



1 rendered text (Lech 5:65-6:10). This data can be entered into a data  
2 entry queue for processing (Lech 11:62-66; 12:34-50).

3 *Wong*

4 04. Wong is directed to software that enables end-to-end, business-to-  
5 business Web commerce (Web business, or e-business) and that  
6 automates to the greatest degree possible, in a unified and synergistic  
7 fashion and using best proven business practices, the various aspects of  
8 running a successful and profitable business (Wong 4:8-13).

9 05. Wong describes customer invoices being automatically generated  
10 upon shipment. When a customer payment is received, details  
11 concerning the payment are entered, and both customers and vendors can  
12 view payment status-invoice, credit via the Web, allowing paper invoice  
13 copies to be dispensed with if desired (Wong 4:40-46).

14 06. Wong describes rigorous data entry qualification to eliminate errors.  
15 For example, during receiving, only ordered items are allowed to be  
16 received (Wong 32:12-15).

17 *Anderson*

18 07. Anderson is directed to permitting an intermediary, e.g., a bank,  
19 having EDI capabilities to electronically process vendor invoice  
20 information on behalf of a customer that does not have EDI capabilities  
21 (Anderson 2:8-12).

22 *Landry*

23 08. Landry is directed to a payment system that reduces the payor's time  
24 spent in paying bills, reduces the cost of paying bills, increases service,

1 increases payor control over the bill payment process and standardizes  
2 the interface between the payor and multiple payees (Landry 6:21-58).

3 *Hogan*

4 09. Hogan is directed to a bill delivery and payment system in which the  
5 payees no longer mail the bills to the system users, but securely deliver  
6 the bill information over a communications network (Hogan 2:20-24).

7 *Facts Related To The Level Of Skill In The Art*

8 10. Neither the Examiner nor the Appellants has addressed the level of  
9 ordinary skill in the pertinent arts of programming, systems design,  
10 accounting, bookkeeping, accounts payable processing, internal controls,  
11 accounting systems, and networking. We will therefore consider the  
12 cited prior art as representative of the level of ordinary skill in the art.  
13 *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he  
14 absence of specific findings on the level of skill in the art does not give  
15 rise to reversible error ‘where the prior art itself reflects an appropriate  
16 level and a need for testimony is not shown’”) (quoting *Litton Indus.*  
17 *Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

18 *Facts Related To Secondary Considerations*

19 11. There is no evidence on record of secondary considerations of non-  
20 obviousness for our consideration.

21 PRINCIPLES OF LAW

22 *Claim Construction*

23 During examination of a patent application, pending claims are given  
24 their broadest reasonable construction consistent with the specification. *In*

1 *re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci.*  
2 *Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

3 Limitations appearing in the specification but not recited in the claim are not  
4 read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed.  
5 Cir. 2003) (claims must be interpreted “in view of the specification” without  
6 importing limitations from the specification into the claims unnecessarily).

7 Although a patent applicant is entitled to be his or her own lexicographer of  
8 patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*,  
9 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such  
10 definitions in the Specification with sufficient clarity to provide a person of  
11 ordinary skill in the art with clear and precise notice of the meaning that is to be  
12 construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although  
13 an inventor is free to define the specific terms used to describe the invention, this  
14 must be done with reasonable clarity, deliberateness, and precision; where an  
15 inventor chooses to give terms uncommon meanings, the inventor must set out any  
16 uncommon definition in some manner within the patent disclosure so as to give  
17 one of ordinary skill in the art notice of the change).

### 18 *Obviousness*

19 A claimed invention is unpatentable if the differences between it and the  
20 prior art are “such that the subject matter as a whole would have been obvious at  
21 the time the invention was made to a person having ordinary skill in the art.” 35  
22 U.S.C. § 103(a) (2000); *KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727 (2007); *Graham*  
23 *v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

24 In *Graham*, the Court held that that the obviousness analysis is bottomed on  
25 several basic factual inquiries: “[1] the scope and content of the prior art are to be

1 determined; [(2)] differences between the prior art and the claims at issue are to be  
2 ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” 383  
3 U.S. at 17. *See also KSR Int’l v. Teleflex Inc.*, 127 S.Ct. at 1734. “The  
4 combination of familiar elements according to known methods is likely to be  
5 obvious when it does no more than yield predictable results.” *KSR*, at 1739.

6 “When a work is available in one field of endeavor, design incentives and  
7 other market forces can prompt variations of it, either in the same field or a  
8 different one. If a person of ordinary skill can implement a predictable variation,  
9 § 103 likely bars its patentability.” *Id.* at 1740.

10 “For the same reason, if a technique has been used to improve one device,  
11 and a person of ordinary skill in the art would recognize that it would improve  
12 similar devices in the same way, using the technique is obvious unless its actual  
13 application is beyond his or her skill.” *Id.*

14 “Under the correct analysis, any need or problem known in the field of  
15 endeavor at the time of invention and addressed by the patent can provide a reason  
16 for combining the elements in the manner claimed.” *Id.* at 1742.

### 17 *Automation of a Known Process*

18 It is generally obvious to automate a known manual procedure or mechanical  
19 device. Our reviewing court stated in *Leapfrog Enterprises Inc. v. Fisher-Price*  
20 *Inc.*, 485 F.3d 1157 (Fed. Cir. 2007) that one of ordinary skill in the art would have  
21 found it obvious to combine an old electromechanical device with electronic  
22 circuitry “to update it using modern electronic components in order to gain the  
23 commonly understood benefits of such adaptation, such as decreased size,  
24 increased reliability, simplified operation, and reduced cost. . . . The combination

1 is thus the adaptation of an old idea or invention . . . using newer technology that is  
2 commonly available and understood in the art.” *Id.* at 1162.

3 ANALYSIS

4 *Claims 1-3, 12-14, 16, and 18-21 rejected under 35 U.S.C. § 103(a) as*  
5 *unpatentable over Lech, Wong, and Admitted Prior Art.*

6 The Appellants argue claims 1, 12, and 18 as a group (Br. 9-12). They argue  
7 claims 2, 3, 13, 14, 16, 19, 20, and 21 as a group based solely on the arguments  
8 related to claims 1, 12, and 18 (Br. 13).

9 Accordingly, we treat all of claims 1-3, 12-14, 16, and 18-21 as argued as a  
10 group and select claim 1 as representative of the group.

11 37 C.F.R. § 41.37(c)(1)(vii) (2007).

12 The Examiner found that Lech described limitations [1] and [2]; Wong  
13 described limitations [3] and [4e]; and the admitted prior art described the manual  
14 equivalent of limitations [4a] to [4d]. The Examiner found that one of ordinary  
15 skill would have been motivated to automate the existing manual procedures in the  
16 admitted prior art for the known benefits of automation. The Examiner further  
17 found that one of ordinary skill would have known that combining the accounts  
18 payable features of Lech, Wong, and the admitted prior art would have had the  
19 benefits of aggregating their individual benefits. The Examiner concluded it would  
20 have been obvious to combine the art to reach claim 1 (Answer 4-7).

21 The Appellants contend that the Specification does not describe a manual  
22 system covering steps [4a] to [4d], but only describes that there are instances in  
23 which those steps would need to be performed (Br. 11-12). Thus the issue before  
24 us is whether, given the admission that existing accounts payable practice

1 sometimes requires these steps, it would have been predictable to incorporate them  
2 into existing accounts payable systems.

3 Initially, we find that the Appellants do not contest whether any of the  
4 remaining limitations are described by the prior art, and we further find that these  
5 limitations are in fact described by the prior art (FF 02 - 06). We also find that the  
6 functions performed by limitations [4a] – [4d] are described in the admitted prior  
7 art (FF 01). The Appellants do not argue that automating the steps in the admitted  
8 prior art would have been beyond the level of ordinary skill, and indeed, we find  
9 that these steps do little more than identify missing information and interrogate a  
10 party for that information, which is standard fare in automated accounting systems.  
11 The issue then is whether one would have thought to automate these steps.

12 We find that Wong explicitly describes the desirability of automating to the  
13 greatest degree possible, in a unified and synergistic fashion and using best proven  
14 business practices, the various aspects of running a successful and profitable  
15 business (FF 04). Further, it is generally obvious to automate a known manual  
16 procedure or mechanical device, *see Leapfrog*, 485 F.3d 1157, where the  
17 combination is the adaptation of an old idea or invention using newer technology  
18 that is commonly available and understood in the art. *Id.* at 1162.

19 The Appellants argue that the Specification is not describing a manual system.  
20 That is not the issue. The issue is whether, given the need to perform the steps so  
21 described on an ongoing basis, it would have been predictable to include those  
22 steps within existing automated systems that process the accounts payable for  
23 which those steps pertain. “The combination of familiar elements according to  
24 known methods is likely to be obvious when it does no more than yield predictable  
25 results.” *KSR*, 127 S. Ct. at 1739. “The proper question to have asked was whether

1 a ... designer of ordinary skill, facing the wide range of needs created by  
2 developments in the field of endeavor, would have seen a benefit to upgrading....”  
3 *Id.* at 1744. In view of the admitted practice of performing the steps in limitations  
4 [4a]-[4d] on an ongoing basis and the known use of automation in accounts  
5 payable practice, we find that one of ordinary skill would have seen the benefit of  
6 incorporating any ongoing accounts payable steps, including those in the admitted  
7 prior art, within an automated accounts payable system, such as those described by  
8 Lech and Wong, for the known advantages of automation, such as efficiency, error  
9 reduction and labor savings.

10 The Appellants have not sustained their burden of showing that the Examiner  
11 erred in rejecting claims 1-3, 12-14, 16, and 18-21 under 35 U.S.C. § 103(a) as  
12 unpatentable over Lech, Wong, and Admitted Prior Art.

13 *Claim 5 rejected under 35 U.S.C. § 103(a) as unpatentable over Lech, Wong,*  
14 *Hogan, and Admitted Prior Art.*

15 The Appellants rely on their arguments in support of claim 1 and therefore  
16 have not sustained their burden of showing that the Examiner erred in rejecting  
17 claim 5 under 35 U.S.C. § 103(a) as unpatentable over Lech, Wong, Hogan, and  
18 Admitted Prior Art.

19 *Claims 6-8, 17, and 22 rejected under 35 U.S.C. § 103(a) as unpatentable over*  
20 *Lech, Wong, Anderson, and Admitted Prior Art.*

21 The Appellants rely on their arguments in support of claim 1 and therefore  
22 have not sustained their burden of showing that the Examiner erred in rejecting  
23 claims 6-8, 17, and 22 under 35 U.S.C. § 103(a) as unpatentable over Lech, Wong,  
24 Anderson, and Admitted Prior Art.



1       No time period for taking any subsequent action in connection with this appeal  
2 may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

3

4

AFFIRMED

5

6

7

8

9

10

11

12

13

14

15 LV:

16

17

18

19 HOFFMAN WARNICK LLC  
20 75 STATE STREET  
21 14TH FLOOR  
22 ALBANY, NY 12207