

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WILLIAM E. BENNETT, STEPHEN J. BOIES,  
LAURETTA JONES, STEPHEN E. LEVY,  
DOUGLAS C. LOVELL, NEIL LUSTIG,  
PAUL M. MATCHEN and RICHARD D. THOMPSON

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Appeal No. 2001-0615  
Application No. 08/741,459

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ON BRIEF

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Before KRASS, JERRY SMITH, and BARRETT, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-48, all of the pending claims.

The invention is directed to a system for electronically developing and processing a legal document. More particularly, one party to the document selectively connects a plurality of remote entities to the workstation of that one party and the one party retains control of the document until the document is executed. At least one of the remote entities, another party to the document, may further develop the document for contemplated execution but control of the document remains with the one party until execution.

Representative independent claim 1 is reproduced as follows:

1. A system for electronically developing and processing a document, the system comprising:

1) at least one local computer workstation, wherein at least one such local workstation can electronically capture information input by a first party for originating and developing the document, said first party retaining control of said document until execution;

2) at least one remote information bureau computer, wherein at least one such information bureau computer is connectable to said at least one local workstation for electronically further developing the document; and

3) a plurality of remote entities selectively connectable by said first party to said at least one local computer workstation, at least one entity of said plurality of remote entities comprising a second party to the document and having at least one computer connectable to said at least one local computer workstation for electronically further developing the document for contemplated execution of the document by said first and second parties.

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The examiner relies on the following references:

Bly et al. [Bly]	5,008,853	Apr. 16, 1991
Davidson	5,699,527	Dec. 16, 1997 (filed May 01, 1995)
Blumer et al. [Blumer]	5,732,219	Mar. 24, 1998 (filed Mar. 17, 1995)

Claims 1-48 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner offers Blumer in view of Davidson and Bly.

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

#### OPINION

The examiner indicates that Blumer discloses a system for electronically developing and processing a document using a client/server network on the internet, wherein local workstation computers are connected to an information bureau computer server wherein a document which has been previously developed by a client workstation and stored in the server can be retrieved and further developed by one or more of the client workstations. The examiner further indicates that Davidson discloses a system for electronically developing and processing a document wherein information input by a loan applicant is captured on a local computer; the local computer is

connected to a remote information bureau computer and a document is further developed by a plurality of remote entities. The examiner relies on Bly for a showing of methods of collaborative editing of shared documents in a network environment and also for a showing of presenting a document, or portions thereof, to different users based on need, level of access, etc.

The examiner concludes that it would have been obvious to connect a plurality of entities to Blumer and that it would have been obvious that one or more of such remote entities may be servers connected to their own networks. Additionally, the examiner finds that it would have been obvious to allow interactive editing of the document as it was being developed, in view of Bly. Finally, the examiner contends that the skilled artisan would have been led “to have multiple clients connected to multiple servers in view of the Applicant’s admitted disclosure by Blumer and Davidson of using multiple remote entities and their disclosure of connecting to the Internet via modems instead of direct connections between the client and the server” [answer-page 6].

For their part, appellants argue that the instant claimed invention distinguishes over the applied art by permitting the second party to further develop the document while the first party originates and retains control of the document until execution. In giving the example of two parties to a financial transaction, such as a customer and a

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financial institution, appellants states that the contract is completed, printed and transmitted to the approving financial institution with the customer retaining control over the document, and that once the customer has agreed to the financing, a completed contract is filled out in the system and electronically transmitted to the bank, at which point a digital signature is captured for transmission to the financial institution. At this point, the document is executed and the customer relinquishes control of the document to the financial institution.

Appellants question the examiner's admission that Davidson discloses that the document is returned to the first party with alterations/approvals that are made by the remote entity and that Davidson teaches that the first party may present the document to other remote entities for further development/approval by the remote entities as needed, but yet the examiner "somehow and incongruously concludes that the first party is controlling the development of the document by selecting which remote entity or entities to which the document is presented" [brief-page 8].

We find no incongruity in concluding that a first party "controls" the development of a document even though the document is returned to the first party with alterations. If the first party agrees or disagrees with those alterations and acts accordingly, either approving or disapproving such alterations, then it still can be said that the first party is

in “control” of the document. Further, if, in Davidson, the first party may present the document to other remote entities for further development or approval, then it can still be reasonably held that the first party is in “control” of the document since that party presents the document to one of the other entities.

Appellants argue that the cited art “fails to teach, suggest, or make obvious a plurality of remote entities selectively connectable by the first party” [emphasis in the original; brief-page 8] and that such art fails to teach, suggest, or make obvious “a first party originating, developing, and retaining control of a document until that document is executed” [emphasis in the original-brief-page 8].

In particular, appellants point out that Davidson teaches relinquishment of control of the document prior to execution at column 5, lines 24-36. However, as pointed out supra, merely because a document is returned to the first party with alterations or approvals made by a remote entity, this does not mean that the first party must accept those alterations or approvals. In this sense, the first party still is very much in “control” of the document until the document is actually executed. Appellants, in our view, take a much narrower view of “control” than the instant claim language would require.

Appellants argue that a “key feature” of the instant invention is that at least one workstation is “selectively connectable” to any of a plurality of remote entities by a first

party and that none of the applied art teaches or suggests selectively connecting a local workstation to a plurality of entities selectively by the first party. Specifically, appellants state that Blumer may indicate many authors may be online on many servers but that Blumer doesn't suggest a first user selectively connecting to a plurality of servers; that Davidson teaches a first party, the loan applicant, transferring personal information from a PC to a bank server and that while the server may be connected to a computer network having a plurality of computers 26, the first user does not selectively connect his PC with the plurality of computers 26 because the loan institution itself chooses if, and which, of the plurality of computers 26 are used. With regard to Bly, appellants argue that this reference is silent as to a first user selectively connecting a workstation to a plurality of remote entities because while Bly teaches a multi-user collaborative system in which multiple users are connected to a single server, Bly fails to suggest a single user connecting to a plurality of remote entities, or servers.

For the limitation of a "plurality of remote entities selectively connectable by said first party," the examiner relies on Davidson. Since Davidson discloses a first party sending a document to a remote entity for further development and/or approval of that document, receiving that document back from the remote entity, and then sending the document to another remote entity for further development and/or approval, the

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examiner considers this teaching as a description of a first party “selecting” the remote entity, and the sending/receiving of the document as an inference that a connection is made.

We have reviewed Davidson and we do not find anything therein that suggests a plurality of entities that are selectively connectable by the first party (the loan applicant). Davidson describes a loan applicant providing required information and sending the application to a computer network of the financial institution but we find no indication therein that the loan applicant has any choice as to which one of the financial institution’s computers the applicant is connected. We find nothing in Davidson regarding the financial institution’s computers being “selectively connectable” by the loan applicant to the loan applicant’s computer and the examiner, while arguing that Davidson provides for such a feature, fails to point to any specific portion of Davidson where the alleged teaching may be found.

Since the examiner has failed to specifically point to anything in the applied references suggesting the claimed limitation of a “plurality of remote entities selectively connectable by said first party to at least one local computer workstation,” a limitation of every independent claim, the examiner has not established a prima facie case of obviousness, within the meaning of 35 U.S.C. § 103.

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Accordingly, we will not sustain the rejection of claims 1-48 under 35 U.S.C.

§ 103.

The examiner's decision is reversed.

REVERSED

ERROL A. KRASS  
Administrative Patent Judge

JERRY SMITH  
Administrative Patent Judge

LEE E. BARRETT  
Administrative Patent Judge

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