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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANDREW M. DUBINSKY, WESLEY A. THOMAS,
and ILYA ANDREYEV

Appeal 2012-010716
Application 11/482,133
Technology Center 2100

Before JOHN G. NEW, CARL L. SILVERMAN, and
MELISSA A. HAAPALA, *Administrative Patent Judges*.

HAAPALA, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse and enter a new ground of rejection in accordance with 37 C.F.R. § 41.50(b).

EXEMPLARY CLAIM

Appellants' invention is directed to creating legally binding electronic documents. Reply Br. 5. Claim 1 is exemplary of the subject matter on appeal:

1. A method of displaying for a user a representation of a executable document formatted for printing, the method comprising:

transforming a document into a print representation in a non-scalable graphic image format;

rasterizing the print representation to create a display representation in the non-scalable graphic image format;

displaying the display representation to the user for signing;

capturing an electronic signature on the display representation;

populating the electronic signature to the print representation; and

printing the print representation, the print representation matching the format of the display representation, including the electronic signature, displayed to the user.

REJECTIONS ON APPEAL

Claims 1–3, 10–12, 18, and 19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Powers (US 6,446,115 B2; issued Sept. 3, 2002). Ans. 3–10.

Claims 4–9, 13–17, and 20 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over the combination of Powers and Rakowicz et al. (US 2005/0177389 A1; published Aug. 11, 2005). Ans. 10–20.

ISSUE

Appellants' contentions present us with the following issue:¹ Did the Examiner err in finding Powers discloses "capturing an electronic signature on the display representation," as recited in claim 1?

ANALYSIS

We have reviewed the Examiner's rejections in consideration of Appellants' contentions. Appellants have persuaded us the Examiner's rejections of claims 1–20 are in error. We enter a new ground of rejection under 35 U.S.C. § 101 for independent claims 1, 10, and 18.

Claim 1 recites "capturing an electronic signature on the display representation." The Examiner finds Powers discloses the disputed limitation because "Powers discloses an electronic image document which contains a signature is stored . . . to produce faxes and other color printouts" and thus "implicitly discloses capturing an electronic signature on the display representation." Ans. 4 (citing Powers 8:3–33). The Examiner further finds "Powers also discloses . . . a screen image showing a proof copy of a letter for review by the sender." Ans. 18 (citing Powers 19:49–52).

Appellants contend Powers does not disclose capturing the signature on the display representation as Powers "merely takes the scan of the selected signature from its database and applies it to selected area on the correspondence" (Appeal Br. 11) and "Powers displays the document to the user already including the electronic signature" (Reply Br. 6). Thus, Appellants argue because the proof "already includes the electronic

¹ We do not reach the additional contentions presented by Appellants because the identified issue is dispositive of the appeal.

signature it cannot have been displayed to the user for signing in the form of the display representation where the electronic signature is then captured on the display representation.” Reply Br. 6.

We agree with Appellants that the portions cited by the Examiner disclose displaying a proof copy of a letter that already includes the sender’s signature. Powers 19:49–52. The Examiner has not established the electronic signature is captured *on the display representation*. Therefore, Appellants have persuaded us of error in the rejection of claim 1. Accordingly, we do not sustain the 35 U.S.C. § 102(b) rejection of: (1) claim 1; (2) independent claims 10 and 18, which similarly recite the display representation is capable of being electronically signed by an electronic signature application, and which were rejected on the same basis as the disputed limitation of claim 1; and (3) claims 3, 11, 12, and 19, which depend from one of claims 1, 10, and 18.

Further, the Examiner did not find Rakowicz teaches the disputed limitation. Therefore, we also do not sustain the 35 U.S.C. § 103(a) rejection of dependent claims 4–9, 13–17, and 20.²

NEW GROUND OF REJECTION

Pursuant to our authority under 37 C.F.R. § 41.50(b), we reject claims 1, 10, and 18 under 35 U.S.C. § 101 as being directed to non-statutory

² Should there be further prosecution of this application, our decision does not preclude the Examiner from relying on Powers and Rakowicz, alone or in combination, to enter new grounds of rejection for the claims.

subject matter.³ We find these claims are ineligible for patent protection because they are directed to an abstract idea.

The decision in *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S.Ct. 2347 (2014) is controlling. We analyze the claims using a two part-analysis: 1) Determine whether the claim is directed to an abstract idea; and 2) if an abstract idea is present in the claim, determine whether any element, or combination of elements, in the claim is sufficient to ensure the claim amounts to significantly more than the abstract idea itself. *See Alice Corp.*, 134 S.Ct at 2350.

Under the first step of the analysis, we find claims 1, 10, and 18 are directed to an abstract idea because they are directed to the fundamental process of creating an executable document by presenting a document to a user for signing and obtaining the signature. In particular, as acknowledged by Appellants', the claim recitations "follow[s] the traditional path of executing legally binding documents where a contracting party is shown a final version of the contract and then signs the contract to indicate the acceptance of the terms." *See Reply Br. 5.*

Under the second step of the analysis, we find claims 1, 10, and 18 do not have any additional elements that amount to significantly more than the abstract idea of creating an executable document. The additional steps in the claims require no more than the conventional steps of transforming a document into a graphic image format (such as the previously existing

³ We leave it to the Examiner to review the subject matter eligibility of dependent claims 2–9, 11–17, 19, and 20 in view of our findings and conclusions in the new grounds herein. Our decision not to enter new grounds of rejection should not be considered an indication regarding the appropriateness of allowance for these claims.

Portable Network Graphics format recited in claim 2; *see also* Spec ¶ 21), creating a display representation in the graphic image format, adding data (“populating”) to the electronic document, and printing the document.

“[S]imply appending conventional steps, specified at a high level of generality, to laws of nature, natural phenomena, and abstract ideas cannot make those laws, phenomena, and ideas patentable.” *Mayo Collaborative Services v. Prometheus Labs, Inc.*, 132 S.Ct 1289, 1300 (2012); *see also Alice Corp.*, 134 S.Ct at 2359–60 (purely conventional functions performed by the computer are not enough to transform an abstract idea into a patent-eligible invention).

Thus, under the two-part analysis, we conclude claims 1, 10, and 18 are directed to an abstract idea and accordingly directed to non-statutory subject matter. We have entered the new grounds only for the independent claims and leave it to the Examiner to evaluate the patentability of the other claims in view of these references alone or in combination with other newly found or previously cited references.

DECISION

The Examiner’s rejections of claims 1–20 are reversed.

We enter a new ground of rejection for claims 1, 10, and 18 under 35 U.S.C. § 101.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” 37 C.F.R. § 41.50(b) also provides that Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of

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the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record.

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

REVERSED
37 C.F.R. § 41.50(b)

ACP