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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANDREW FREISTHLER, MARTIN R. KILMER, MARK
DAVID WASSON, and E. SCOTT WETZEL

Appeal 2015-007787
Application 13/104,154
Technology Center 2100

Before ST. JOHN COURTENAY III, MARC S. HOFF, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Invention

The disclosed and claimed invention on appeal generally relates to “linking electronic items into matters, and particularly to linking electronic legal documents and other legal and non-legal electronic data.” Spec. ¶ 2.

Representative Claim

1. A method for linking items into a matter comprising:
retrieving an electronic document from a source;

determining whether the electronic document is
associated with a predetermined matter;

in response to determining that the electronic document
is associated with the predetermined matter, linking the
electronic document to the predetermined matter, such that
accessing the electronic document will provide access to other
documents linked to the predetermined matter;

*[L] in response to determining that the electronic
document is not associated with the predetermined first matter,
create a second matter and link the electronic document to the
second matter, such that accessing the electronic document will
provide other documents linked to the second matter;*

receiving a request for the electronic document; and

in response to receiving the request for the electronic
document, providing a user option to provide access to the other
documents linked to the predetermined matter.

(Contested limitation L is emphasized.)

Rejections

A. Claims 1, 4, 5, 7, 8, 11, 12, 14, 15, 18, and 19 are rejected under
35 U.S.C. § 102(b) as being anticipated by KEMP (US
2009/0144246 A1; published June 4, 2009) (hereinafter, Kemp).

B. Claims 2, 6, 9, 13, 16, and 20 are rejected under 35 U.S.C. § 103(a)
as being obvious over the combined teachings and suggestions of
Kemp in view of van Stegeren et al. (US 2003/0074351 A1;
published Apr. 17, 2003) (hereinafter, Stegeren).

C. Claims 3, 10, and 17 are rejected under 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of Kemp, Stegeren, and Hong (US 2008/0201632 A1; published Aug. 21, 2008) (hereinafter, Hong).

ANALYSIS

We have considered all of Appellants' arguments and any evidence presented. We find Appellants' arguments persuasive for at least the reasons discussed *infra*. We highlight and address specific findings and arguments for emphasis in our analysis below.

Rejection A of Independent Claim 1 under 35 U.S.C. § 102(b)

Issue: Under 35 U.S.C. § 102(b), did the Examiner err in finding the Kemp reference expressly or inherently describes contested limitation L,¹ within the meaning of independent claim 1, under a broad but reasonable interpretation?²

¹ We note that the contested negative limitation L was added by amendment to claim 1, but was recited in original claim 8 at the time the application was filed.

² We give contested claim limitations the broadest reasonable interpretation consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997); *Cf. with Spec.* ¶ 59 (“While particular embodiments have been illustrated and described herein, it should be understood that various other changes and modifications may be made without departing from the spirit and scope of the claimed subject matter. Moreover, although various aspects of the claimed subject matter have been described herein, such aspects need not be utilized in combination. It is therefore intended that the appended claims cover all such changes and modifications that are within the scope of the claimed subject matter.”).

Regarding independent method claim 1, Appellants contend, *inter alia*, that Kemp is different than claim 1:

*because normalizing the "matter" and "result" does not involve creating a new matter. Specifically, nowhere does Kemp even suggest that a new matter is created. Kemp defines a "matter" as "a question before the court" (paragraph [0096]). Kemp does not teach or suggest that a new question before the court is created in response to a determination that a current electronic document is not associated with a current question before the court. However, even if the Examiner is arguing that Kemp's reference to a "matter" is the same as the "matter" in claim 1 (which is clearly an incorrect assessment), Kemp still does not create a new "matter" because normalizing a document does not create anything new. Kemp instead teaches that normalizing a document alters an existing document. At best, normalizing a document could create a new document that is part of the same matter. Creating a new document is different than creating a new "matter" because a document is still associated with the same opinion and other organizational structure as before normalizing. For at least these reasons, the Office Action fails to establish a proper rejection under 35 U.S.C. § 102(b), which requires **explicit** or **inherent** disclosure of every claim element. Because Kemp fails to provide that disclosure, claim 1 is allowable.*

(App. Br. 7). (Emphasis added).

The Examiner disagrees, and adopts a broader interpretation of the claim term “predetermined matter” (Ans. 2):

Appellant[s] have not limited "an electronic document" as a legal document, so "a predetermined matter" could be any matter associated to the electronic document. In Kemp reference, ¶ [0010] describes "associations between documents may be, e.g., indexed to create a citator ... a citator ... may record the form and/or substance of the association ... some or all of this information may be expressed in standard terms ... Such standard terms, or "standard expression" ... ". The "associations" of Kemp reference is comparable to the "matter"

which language is included in "a predetermined first matter" and "a second matter" in claim 1. Further, Kemp called the "matter" or "standard expression" as "Point of Law" or "Points of Law" (¶ [0102]).

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) (citations omitted). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

Here, we find no definition of the claim term “matter” in Appellants’ Specification, nor have Appellants argued a particular definition.³ However, we find that several Merriam-Webster dictionary definitions are applicable here, in considering how the claim term “matter” would have been understood to an artisan according to its plain meaning: e.g., (1) a subject under consideration, (2) a subject of disagreement or litigation, (3) the events or circumstances of a particular situation, and/or, (4) the subject or substance of a discourse or writing.⁴

³ Appellants do argue “the term ‘matter’ as defined in Kemp is different than the ‘matter’ as used in claim 1.” (App. Br. 7).

⁴ See 37 C.F.R. § 41.30 regarding dictionaries, “which may be cited before the Board.”

We note that claim 1 recites, in pertinent part: “determining whether the electronic document is associated with *a predetermined matter*; . . . [and] in response to determining that the electronic document is not associated with the predetermined first matter, *create a second matter . . .*” (Emphasis added).

We observe dependent claim 6 further limits claim 1: “The method of claim 1, wherein the electronic document comprises an identifier, *wherein determining whether the electronic document is associated with the predetermined matter comprises normalizing the identifier and normalizing a field within the identifier.*”

In applying the doctrine of claim differentiation,⁵ we note that claim 1 is broader than claim 6; however, falling within the scope of Appellants’ claim 1, at least one way of “*determining whether the electronic document is associated with the predetermined matter*” (Claim 1) “*comprises normalizing the identifier and normalizing a field within the identifier.*” (Claim 6) (Emphasis added).

⁵ “When different words or phrases are used in separate claims, a difference in meaning is presumed.” *Nystrom v. TREX Co., Inc.*, 424 F.3d 1136, 1143 (Fed. Cir. 2005). Under the doctrine of claim differentiation, “the presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (en banc). This presumption is “especially strong when the limitation in dispute is the only meaningful difference between an independent and dependent claim, and one party is urging that the limitation in the dependent claim should be read into the independent claim.” *SunRace Roots Enterprise Co., Ltd. v. SRAM Corp.*, 336 F.3d 1298, 1303 (Fed. Cir. 2003).

As pointed to by the Examiner (Final Act. 6; Ans. 4), Kemp (¶ 96) also describes normalized forms:

In block 368 [Fig. 9], *the matter and result of the opinion are recorded in normalized form* according to an embodiment of the invention. Here, the "matter" may refer to the question before the court, in response to which the court issued the opinion, and the "result" may refer to the court's resolution of that question. Besides finding this information, however, block 368 may in an embodiment of the invention include *recording the information in standard terms*. (Emphasis added).

However, Appellants urge, "Kemp is [] different than claim 1 because normalizing the 'matter' and 'result' does not involve *creating a new matter*." (App. Br. 7) (Emphasis added).

We note the distinction between certain claim 1 terms: "*a predetermined matter*," and creating "*a second matter . . . and link[ing] the electronic document to the second matter*" (Emphasis added).

Under a broad but reasonable interpretation, in the former "*predetermined matter*," the matter must already exist. In the latter case, "*a second matter*" (i.e., a new matter) *is created* "in response to determining that the electronic document is *not associated* with the predetermined [i.e., first existing] matter." (Claim 1) (Emphasis added).

One way (but not the only way) of "*linking*" (or *associating*) "the electronic document to the second matter" within the broad scope of claim 1 is by "*normalizing*," as recited in dependent claim 6.

Because the Examiner relies on the *normalization* described in Kemp (Fig. 9, block 368, ¶ 96⁶) for anticipating the creation of “a second matter” (Final Act. 6; claim 1), on this record, we are persuaded the Examiner erred, because we conclude that *normalizing* is consistent under BRI with *linking* or *associating* an electronic document with an *existing matter* (see Appellants’ claim 6; Spec. ¶ 47).

We find the Examiner has not fully developed the record to establish how Kemp’s “*normalization*” (Kemp, Fig. 9, step 368) *creates a new matter*, as argued by Appellants. (App. Br. 7). Because the Examiner has not established that contested limitation L is expressly or inherently described in Kemp, we reverse the anticipation rejection of claim 1.

Because contested limitation L is also recited in remaining independent claims 8 and 15, we reverse anticipation rejection A of claims 8 and 15. Because we have reversed § 102 rejection A of each independent claim, we also reverse rejection A of each associated respective dependent claim (claims 4, 5, 7, 11, 12, 14, 18, and 19).

Rejections B and C

Regarding the remaining claims rejected under §103 rejections B and C, we reverse these rejections for the same reasons discussed above with respect to claim 1, as discussed above. In particular, the Examiner has not shown how the additionally cited secondary references overcome the

⁶ Kemp (¶ 96–97) describes *normalization*, according to one embodiment, with respect to recording the information using standard terms: “Such *normalization* may also include revision of archaic terminology: ‘Plaintiff nonsuit’ may, for example, become ‘case dismissed.’” (Emphasis added).

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aforementioned deficiencies regarding the Kemp reference, as discussed above regarding anticipation rejection A of the independent claims.

Conclusion

For at least the aforementioned reasons, on this record, we are persuaded by Appellants' arguments the Examiner erred regarding rejections A, B, and C, of all claims before us on appeal.

DECISION

We reverse the Examiner's decision rejecting claims 1–20.

REVERSED