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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRISTOPHER K. SCHRICHTE

Appeal 2019-001641
Application 12/454,561¹
Technology Center 2600

Before THU A. DANG, KRISTEN L. DROESCH, and
MONICA S. ULLAGADDI, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ In a prior Decision (Appeal Number 2015-003086, decided August 15, 2016, hereinafter “Prior Dec.”), we affirmed the Examiner’s rejections of claims 8–10 under 35 U.S.C. § 102(b) over Quaeler; and of claims 1–7 and 11–20 under 35 U.S.C. § 103(a) over the teachings of Quaeler in further view of Luther, Official Notice, Carlson, Nakashita, and/or Baylis.

I. STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner’s Final Rejection of claims 1–18, 21, and 22 (Appeal Br. 2), which constitute all the claims pending in this application.² Claims 19 and 20 were previously cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

A. INVENTION

According to Appellant, the invention relates to “creating redacted documents,” and, more particularly, to “automated redaction.” Spec. ¶ 2.

B. ILLUSTRATIVE CLAIM

Claim 1 is illustrative of the subject matter on Appeal and is reproduced below:

1. A method comprising:
 - scanning a plurality of documents by a scanner to form new respective electronic scanned documents, where the plurality of documents comprise at least two different forms of documents which are scanned;
 - determining the form of each of the plurality of documents which have been scanned, where the form is determined based, at least partially, upon the scanning of the plurality of documents by the scanner; and
 - based upon an initial opening event of at least one of the new electronic scanned documents transitioning from a non-opened state to an open state, redacting a cell in the at least one new electronic scanned document at a time in which the initial opening event occurs, where the redacting is based upon the determined form of the document which was scanned to form

² We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. According to Appellant, the real party in interest is TeraDact Solutions, Inc. Appeal Br. 1.

the at least one scanned document, to thereby form a scanned redacted document.

C. REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Name	Reference	Date
Luther	US 6,449,065 B1	Sept. 10, 2002
Gavin	US 7,428,701 B1	Sept. 23, 2008
Quaeler	US 2007/0030528 A1	Feb. 8, 2007
Baylis	US 2007/0219966 A1	Sept. 20, 2007
Carlson	US 2008/0049271 A1	Feb. 28, 2008
Nakashita	US 2008/0180765 A1	July 31, 2008

Claims 1, 2, 4–7, 11, 12, 14, 15, and 21 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the teachings of Quaeler, Luther, and Gavin.

Claims 3 and 13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the teachings of Quaeler, Luther, Gavin, and Carlson.

Claims 8–10 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the teachings of Quaeler and Gavin.

Claims 16 and 22 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the teachings of Quaeler, Nakashita, and Gavin.

Claims 17 and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the teachings of Quaeler, Luther, Gavin, and Baylis.

II. ISSUES

The dispositive issues before us are whether the Examiner has erred in determining that the combination of Quaeler, Luther, and Gavin teaches or suggests “*based upon an initial opening event* of at least one of the new

electronic scanned documents transitioning *from a non-opened state to an open state*, redacting a cell in the at least one new electronic scanned document *at a time in which the initial opening event occurs.*” Claim 1 (emphasis added).

III. ANALYSIS

In deciding Appeal No. 2015-003086 (“Prior Decision or Prior Dec.”), we affirmed the Examiner’s rejections of claims 8–10 under 35 U.S.C. § 102(b) over the Quaeler; and of claims 1–7 and 11–20 under 35 U.S.C. § 103(a) over the teachings of Quaeler in further view of Luther, Official Notice, Carlson, Nakashita, and/or Baylis. *See* Prior Dec. 5–11. In particular, we agreed with the Examiner that, in Quaeler, “the step of opening is a basis for the redaction process” because in order to redact an already “opened” document, “[a]n ‘opening the scanned version’ step must occur in order for the redacting to automatically occur.” *Id.* at 6 (alteration in original) (citing prior Ans. 15).

In the present Appeal, independent claim 1 has been amended to recite, *inter alia*, the redacting occurs “based upon an initial opening event of at least one of the new electronic scanned documents transitioning from a non-opened state to an open state,” and “at a time in which the initial opening event occurs.” Claim 1. Independent claims 8 and 16 were similarly amended. According to Appellant, “the claims as they currently stand have been amended versus the claims that were pending during Appeal No. 2015-003086.” Appeal Br. 6. In particular, according to Appellant, changes to the claims include “the distinguishing feature regarding the timing or temporal aspect of the redaction,” namely, “that **redacting** of a cell in the document is **at a time in which an initial opening event**

occurs,” where “the claim defines an initial opening event as when a document is **transitioning** from a non-opened state to an open state.” *Id.*

Appellant contends that, in rejecting the claim 1, “it appears that the examiner has been not reviewing the actual language in claim 1,” but instead “is determining the patentability of claim 1 based upon language which is not in the claim.” Appeal Br. 7. According to Appellant, “[t]he recited language of claim 1 requires more than redaction being done on a document which has already been opened,” but, rather, it requires that the redaction “be based upon the initial opening event” and “at the time in which the initial opening event occurs,” whereas “[t]he examiner has been ignoring the timing/temporal aspect in the claim language.” *Id.* at 8.

According to Appellant, in the prior Answer, the Examiner has admitted that “the redaction disclosed in Quaeler et al. merely occurs ‘subsequent’ to the opening of the document.” Appeal Br. 9 (citing prior Ans. 15). Appellant then contends Gavin similarly teaches that “the redaction program is loaded and begins running after the user opens the PDF file containing the document to be redacted.” *Id.* at 12 (citing Gavin, 3:1–7).

We have considered all of Appellant’s arguments and evidence presented. We agree with Appellant that the preponderance of the evidence on this record does not support the Examiner’s legal conclusion that claim 1 would have been obvious over the combination of Quaeler, Luther, and Gavin.

We disagree with the Examiner that claim 1 “merely requires redaction to occur on an opened document (i.e. a document that has transitioned from closed to open).” Final Act. 2–3. Although the Examiner refers to our Prior Decision to contend that the Board “found that the

opening process is necessarily a basis for the redaction when redaction occurs on an opened document” (*id.* at 3 (citing Prior Dec. 6)), as Appellant points out, the recited language of claim 1 has been amended to require that the redaction “be based upon the initial opening event” and “at the time in which the initial opening event occurs.” Appeal Br. 8. We agree with Appellant that the Examiner failed to adequately consider “the timing/temporal aspect in the claim language,” as amended. Appeal Br. 8. More particularly, we are persuaded that Quaeler and Gavin merely teach or suggest redacting or triggering redacting *after* opening the document, as Appellant contends.

Thus, although the Examiner finds that “Quaeler’s teachings do in fact disclose performing the redaction based on the opening of the document” (Ans. 20), and that Gavin discloses that “opening the document immediately triggers the loading of the redaction program” (*id.*), we are persuaded by Appellant’s contentions that Quaeler, Luther, and Gavin fail to teach or suggest “based upon an initial opening event of at least one of the new electronic scanned documents transitioning from a non-opened state to an open state, redacting a cell in the at least one new electronic scanned document at a time in which the initial opening event occurs,” as recited in claim 1.

Consequently, we are constrained by the record before us to find that the Examiner erred in finding the combination of Quaeler and Gavin teaches or suggests the contested limitations of Appellant’s claim 1. The Examiner does not rely on the teachings of Luther to address the aforementioned limitations of claim 1. Final Act. 6–7; Ans. 4–7. Independent claim 8 includes limitations of commensurate scope. Dependent claims 2, 4–7, 9–

12, 14, 15, and 21 depend on claims 1 and 8 respectively, and stand with their respective independent claims. Accordingly, we do not sustain the Examiner's obviousness rejection of claims 1, 2, 4–7, 11, 12, 14, 15, and 21 over Quaeler and Gavin in combination with Luther; and the Examiner's obviousness rejection of claims 8–10 over Quaeler and Gavin.

The Examiner does not suggest, and has not established on this record, that the additional cited references to Carlson, Nakashita, and/or Baylis overcome the aforementioned deficiencies of Quaeler, Luther, and Gavin. *See* Final Act. 12–21. Consequently, we are constrained by the record before us to find that the Examiner also erred in concluding that: 1) the combination of Quaeler, Luther, Gavin, and Carlson renders obvious the subject matter of dependent claims 3 and 13 under 35 U.S.C. § 103(a); 2) the combination of Quaeler, Nakashita, and Gavin renders obvious the subject matter of dependent claims 16 and 22 under 35 U.S.C. § 103(a); and 3) the combination of Quaeler, Luther, Gavin, and Baylis renders obvious the subject matter of dependent claims 17 and 18 under 35 U.S.C. § 103(a).

IV. CONCLUSION AND DECISION

The Examiner's rejections of claims 1–18, 21, and 22 under 35 U.S.C. § 103(a) are reversed.

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 2, 4–7, 11, 12, 14, 15, 21	103(a)	Quaeler, Luther, Gavin		1, 2, 4–7, 11, 12, 14, 15, 21
3, 13	103(a)	Quaeler, Luther, Gavin, Carlson		3, 13

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8–10	103(a)	Quaeler, Gavin		8–10
16, 22	103(a)	Quaeler, Nakashita, Gavin		16, 22
17, 18	103(a)	Quaeler, Luther, Gavin, Baylis		17, 18
Overall Outcome				1–18, 21, 22

REVERSED