

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte STEPHEN R. LAWTON  
and GEORGE H. WARFEL, JR.

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Appeal No. 95-3031  
Application 08/057,206<sup>1</sup>

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ON BRIEF

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Before URYNOWICZ, LEE and TORCZON, Administrative Patent Judges.

URYNOWICZ, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1-31, all the claims pending in the application.

The invention pertains to a system for processing a form. Claim 5 is illustrative and reads as follows:

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<sup>1</sup> Application for patent filed May 3, 1993. According to appellants, this application is a continuation of Application 07/753,175, filed August 30, 1991, now abandoned.

5. A method for processing a form to convert it from an electronic image of a form into a valid coded text string that automatically initiates data processing procedures, comprising the steps of:

capturing an image of the form received from a particular user;

extracting a plurality of character and field data candidate strings from said image; and

validating said character and field data candidate strings using a user profile associated with said particular user to produce the valid coded text string in a computer-readable format.

The references relied upon by the examiner as evidence of obviousness are:

Nakano et al. (Nakano)	4,907,285	Mar. 06, 1990
Rosenbaum et al. (Rosenbaum)	5,031,223	Jul. 09, 1991
Pasetes, Jr. et al. (Pasetes)	5,202,977	Apr. 13, 1993
Ojha	5,274,468	Dec. 28, 1993

The appealed claims stand rejected as follows:

Claims 5, 7, 8, 11, 13 and 21-31 are rejected under 35 U.S.C. § 102(e) as being anticipated by Ojha.

Claims 1-4 and 14-20 are rejected under 35 U.S.C. § 103 as unpatentable over Ojha in view of Nakano.

Claims 6, 9, 10 and 12 are rejected under 35 U.S.C. § 103 as being unpatentable over Ojha in view of Pasetes.

Claim 14 is rejected under 35 U.S.C. § 103 as being unpatentable over Rosenbaum in view of Nakano.

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The respective positions of the examiner and the appellants with regard to the propriety of these rejections are set forth in the final rejection (Paper No. 13) and the examiner's answer (Paper No. 19) and the appellants' brief (Paper No. 18).

The Rejection of Claims 5, 7, 8, 11, 13 and 21-31

under 35 U.S.C. §102

After consideration of the positions and arguments presented by both the examiner and the appellants, we have concluded that the rejection should not be sustained. Ojha simply does not disclose (1) validating character and field data candidate strings using a user profile associated with a particular user as in independent claim 5, (2) means using a user profile associated with a particular user for validating character and field data candidate text as in independent claim 21, (3) an image processing server for extracting character and field data text from an image through use of a dynamic database containing transaction context information and user profile information associated with the user as in independent claim 26 or, (4) accessing a user profile and validating a plurality of candidate strings using the user profile as in independent claim 27. The examiner asserts that at column 7, lines 38-53, Ojha teaches establishing a user profile, and using the user profile to extract text and field data from an image. We disagree. At the aforementioned location Ojha merely teaches that a user of his invention can create a library of user-defined character codes to reflect whatever selective editing of a document and/or machine control functions the user desires. The creation of a library in Ojha does not establish a

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user profile. Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984), cert. dismissed, 468 U.S. 1228 (1984).

The Rejection of Claims 1-4, 6, 9, 10, 12 and 14-20

under 35 U.S.C. § 103

Claims 1-4 and 14-20, rejected over Ojha and Nakano, and claims 6, 9, 10 and 12, rejected over Ojha and Pasetes, each require a user profile (independent claims 1 and 15) or a database having a plurality of user identity and transaction data information (independent claim 14). None of the above art discloses either of the aforementioned claim requirements and the examiner has given no reason why this gap between the prior art and appellants' system is simply so small as to render the system obvious at the time the invention was made to one reasonably skilled in the art. Accordingly, we will not sustain the rejection of these claims under 35 U.S.C. § 103.

We will not sustain the rejection of claim 14 under 35 U.S.C. § 103 over Rosenbaum in view of Nakano. At page 4 of his answer, the examiner states that Rosenbaum teaches that a text is validated by use of a knowledge base or profile (column 4, lines 20-46). Although this is true, neither reference discloses a database having a plurality of user identity and transaction data

information as required by the claim. The knowledge base or profile of Rosenbaum is that of an addressee on mail, not that of a user of the system. Again, the examiner has given no reason why this gap between the prior art and appellants' system is so small as to render the system obvious at the time the invention was made to one of ordinary skill in the art.

REVERSED

STANLEY M. URYNOWICZ, JR )  
Administrative Patent Judge )  
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 ) BOARD OF PATENT  
 ) APPEALS AND  
JAMESON LEE ) INTERFERENCES  
Administrative Patent Judge )  
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RICHARD L. TORCZON )  
Administrative Patent Judge )

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