

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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LAWRENCE B. LOCKWOOD

Appeal No. 1997-2678
Application No. 08/347,270

ON BRIEF

Before HAIRSTON, KRASS and HECKER, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 and 11-15, all of the claims pending in the application.

The invention is directed to a system for processing business and financial transactions between entities at remote sites.

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Independent claim 1 is reproduced as follows:

1. An automatic data processing system for processing business and financial transactions between entities from remote sites which comprises:

a central processor programmed and connected to process a variety of inquiries and orders transmitted from said remote sites;

said central processor including:

means for receiving information about said transactions from said remote sites;

means for retrievably storing said information;

at least one terminal at each of said remote sites including a data processor and operational sequencing lists of program instructions;

means for remotely linking said terminal to said central processor and for transmitting data back and forth between said central processor and said terminal;

said terminal further comprising means for dispensing information and services for at least one of said entities including:

a video screen;

means for holding operational data including programming, informing, and inquiring sequences of data;

means for manually entering information;

means for storing information, inquiries

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and orders for said transactions entered by one of said
entities via said means for manually entering information, and
data
received through and from said central processor;

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on-line means for transmitting said information, inquiries, and orders to said central processor;

on-line means for receiving data comprising operator-selected information and orders from central processor via said linking means;

means for outputting said informing and inquiring sequences on said video screen in accordance with preset routines and in response to data entered through said means for entering information;

means for controlling said means for storing, means for outputting, and means for transmitting, including means for fetching additional inquiring sequences in response to a plurality of said data entered through said means for entering and in response to information received from said central processor;

said informing sequences including directions for operating said terminal, and for presenting interrelated segments of said operational data describing a plurality of transaction operations;

said programming sequences including means for interactively controlling the operation of said video screen, data receiving and transmitting means; and for selectively retrieving said data from said means for storing;

said means for storing comprising means for retaining said operational sequencing list and means responsive to the status of the various means for controlling their operation;

said central processor further including:

means responsive to data received from

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one of said terminals for immediately transmitting selected stored information to said terminal; and

means responsive to an order received from a terminal for updating data in said means for storing;

whereby said system can be used by said entities, each using one of said terminals to exchange information, and to respond to inquiries and orders instantaneously and over a period of time.

The examiner relies on the following references:

Lockwood et al. (Lockwood) 4,3259,631 Nov. 16, 1982

Young "Computer Firm To Help Buyers Shop for Loans."
Washington Post, published April 7, 1984

Claims 1 and 11-15 stand rejected under 35 U.S.C. § 112, first paragraph, as relying on an inadequate written description and a nonenabling disclosure.

Claims 1 and 11-15 stand further rejected under 35 U.S.C. § 103 as unpatentable over Lockwood in view of Loan Express.

Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

OPINION

We reverse.

Turning first to the rejection under 35 U.S.C. § 112, first paragraph, at first it appears that the examiner bases

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the rejection only on the written description section of 35 U.S.C.

§ 112 because the examiner alleges that the specification, as originally filed, "does not provide support for the invention as is now claimed " [answer-page 3]. But, later on, at page 4 of the answer, the examiner complains about an "inadequate" disclosure and a failure "to provide an enabling disclosure" because the IBM Dictionary material has not been inserted into the specification.

In any event, whether the rejection is based on only the written description portion of 35 U.S.C. § 112 or on both the written description and enablement portions of 35 U.S.C. § 112, we will not sustain the rejection of the claims under 35 U.S.C.

§ 112.

The examiner points to much of the language of the claims (e.g., "operational," "controlling," "fetching," "means for outputting," etc. and contends that these added features of the claims are not supported by the original disclosure since the examiner is "unable to find correlation between the new

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added/amended features and corresponding text in the specification as originally filed" [answer-page 4].

We have reviewed each and every claimed phrase objected to by the examiner and we find that many of those terms have clear meanings in the art which would have been understood by the artisan as being disclosed, even if not in those exact words, within the specification as filed. For example, terms such as "directions," "storing," "fetching," etc. are terms of art which have clear support in the specification. Sequences "including directions" clearly refers to the description whereby communications with an applicant for a loan is performed through a video screen and instructions and requests by a simulated loan officer give "directions" to an applicant. Memory shown in the drawings provides support for "storing." The flowcharts of the drawings clearly provide support for fetching additional inquiring sequences.

Without going into each and every one of the claimed phrases objected to by the examiner, suffice it to say that we agree with and adopt appellant's arguments at pages 4-18 of the principal brief wherein appellant indicates exactly where

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in the original disclosure support may be found for each and every one of the contested phrases in the claims.

We suspect that the examiner is attempting to find and match the exact words of the claims with words or phrases within the original disclosure. However, if the specification contains a description of the claimed invention, albeit not in ipisis verbis (in the identical words), then the examiner, in order to meet the burden of proof, must provide reasons why one of ordinary skill in the art would not consider the description sufficient. In re Alton, 76 F.3d 1168, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996). It is enough that the original disclosure makes clear that the applicant had possession of the invention now claimed at the time the application was originally filed. We hold that it is clear, in the instant case, that appellant did, indeed, have such possession.

We also note that although appellant painstakingly went through each and every claimed phrase objected to by the examiner and pointed out specifically the support for each one in the original disclosure, the examiner has not convincingly rebutted such showings, contending only that the "wordings

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[sic] have no correlation to the specific claimed features"
[answer-page 7].

We now turn to the rejection of the claims under 35
U.S.C.
§ 103.

We have reviewed our prior decision of July 31, 1991 in
Appeal No. 91-1232, as well as the arguments of appellant and
the examiner, the declaration of Lois Van Ewijk and the
decisions of the District Court and the Federal Circuit
[Lockwood v. American Airlines Inc., 107 F.3d 1565, 41 USPQ2d
1961 (Fed. Cir. 1997)] affirming the invalidity of U.S. Patent
No. 4,359,631 to Lockwood and we conclude that, in the instant
case, the examiner has failed to establish a prima facie case
of obviousness with regard to the claimed subject matter.
Accordingly, we will not sustain the rejection under 35 U.S.C.
§ 103.

We agree with the examiner that Lockwood generally
discloses an interactive system similar to that claimed in
that the menu-driven system of Lockwood does disclose
"operational sequencing lists of program instructions" since
there is a program which operates to sequentially present

inquiries to a user and to respond to answers to those inquiries by the user. Therefore, one can broadly interpret Lockwood as disclosing the claimed "inquiring sequences of data." Since Lockwood presents options to a user and responds to various selections, Lockwood also may be said to have a "means for outputting said informing and inquiring sequences on said video screen," as claimed. Lockwood also appears to disclose many of the other claimed features.

However, independent claim 1 also requires a "means for controlling" the storing means, the outputting means and the transmitting means. Lockwood clearly has a "means for controlling." But claim 1 requires that the means for controlling includes "means for fetching additional inquiring sequences in response to a plurality of said data entered through said means for entering and in response to information received from said central processor." While Lockwood may fetch additional inquiring sequences (as in presenting additional questions or options to a user) in response to a user input, we find no suggestion in Lockwood of fetching the additional inquiring sequences in response to both the user entry of data and to information received from the central

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processor. This claim language appears to go to the disclosed feature of the system making a loan application decision based on both user application form entries and on data received, for example, from a credit bureau. We find no such teaching in Lockwood and the rather sparse teachings of Loan Express do not provide for the deficiencies of Lockwood in this regard. Further, the examiner has not presented any convincing explanation as to why this fetching means responsive to both data entry and information received from the central processor would have been an obvious modification to Lockwood.

Accordingly, the examiner has not established a prima facie case of obviousness with regard to the instant claimed subject matter and we will not sustain the rejection of claims 1 and 11-15 under 35 U.S.C. § 103.

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We have not sustained the rejection of claims 1 and 11-15 either under 35 U.S.C. § 112, first paragraph, or under 35 U.S.C.

§ 103. Thus, the examiner's decision is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ERROL A. KRASS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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STUART N. HECKER)	
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