

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS WAGNER

Appeal No. 2004-0185
Application No. 09/923,016

ON BRIEF

Before KIMLIN, PAK and WALTZ, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 9, 10, 13, 16 and 17. Claim 16 is illustrative:

16. The combination of a postal stamp and sticker for use for retaining a foldable flyer in closure during mailing, said postal stamp and sticker being formed of two parts, said postal stamp and sticker parts being foldably connected along contiguous edges, said postal stamp and sticker parts at their fold line being formed as a line of perforation to form said fold line intermediate thereof, said postal stamp being imprinted with postal stamp indicia acceptable for transfer through mailing, while said sticker portion capable of folding over for adhering the foldable flyer into closure during mailing, and said foldable postal sticker portion being imprinted with indicia.

Appeal No. 2004-0185
Application No. 09/923,016

In the rejection of the appealed claims, the examiner relies upon the following references:

Sternberg	3,774,758	Nov. 27, 1973
Brasington et al. (Brasington)	5,923,406	Jul. 13, 1999
Meshulam	6,029,849	Feb. 29, 2000
Farren (PCT International Application)	WO 97/28522	Aug. 07, 1997

Appellant's claimed invention is directed to a combination of a postal stamp and sticker that are foldably connected along contiguous edges. The sticker portion of the combination is imprinted with indicia, e.g., advertising material. Also, the sticker portion is capable of folding over a foldable flyer for adhering it into closure during mailing. According to appellant, the claimed combination of postal stamp and sticker "saves the customer one step, that is, it requires the customer only to attach a stamp to the upper edge, in a one step process, and fold it over to secure the flyer into closure, simultaneously" (page 6 of Brief, first paragraph). Appellant further explains that "the user accomplishes two tasks at one time, which applies both the postage and the sealing means at the same time, rather than requiring the separate application of postage, and the separate sealing of the edges of the flyer, through two different tasks" (id.).

Appeal No. 2004-0185
Application No. 09/923,016

Appealed claim 16 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Sternberg. Claim 17 stands rejected under 35 U.S.C. § 103 as being unpatentable over Sternberg in view of Farren. Claim 9 also stands rejected under § 103 as being unpatentable over Sternberg in view of Farren and Meshulam, while claims 10 and 13 stand rejected under § 103 as being unpatentable over Sternberg in view of Brasington.

Appellant submits that the appealed claims "form a single group from the standpoint of the invention" and, hence, "the claims stand or fall together" (page 8 of Brief). Accordingly, all the appealed claims stand or fall together with independent claim 16. Also, although the dependent claims have been separately rejected by the examiner under § 103, and "applicant still needs to review the various basis presented by the examiner for rejection" (page 11 of Brief, second paragraph), appellant does not advance substantive arguments specific to the features of the dependent claims. Appellant's arguments focus upon asserted deficiencies of the Sternberg reference with respect to the § 102 rejection of claim 16. Accordingly, we will limit our discussion to the § 102 rejection of claim 16.

We have thoroughly reviewed the respective positions advanced by appellant and the examiner. In so doing, we find

Appeal No. 2004-0185
Application No. 09/923,016

ourselves in full agreement with the examiner that the claimed subject matter is unpatentable over the cited prior art.

Accordingly, we will sustain the examiner's rejections for essentially those reasons expressed in the Answer, and we add the following primarily for emphasis.

We fully concur with the examiner that Sternberg describes the claimed combination of a postal stamp and sticker within the meaning of § 102. The figures of Sternberg clearly depict a combination of a postal stamp and sticker being foldably connected along contiguous edges with the foldable sticker portion being imprinted with indicia. Although Sternberg, as appreciated by the examiner, does not disclose that the combination of postal stamp and sticker is used to retain a flyer or envelope in closure during mailing, we agree with the examiner that the reference combination is "capable of folding over for adhering the foldable flyer into closure during mailing," as required by the appealed claims (emphasis added). While appellant makes the argument that "[i]t does not appear that Sternberg suggests the usage of his device for holding any type of flyer in closure, in fact, the envelope to which Sternberg is applied, will readily be sealed into closure, through its own

Appeal No. 2004-0185
Application No. 09/923,016

adherence means," it is not necessary that Sternberg teaches or suggests such usage for the combination (sentence bridging pages 9 and 10 of Brief). This is because the claims on appeal are not directed to any use of the combination of postal stamp and sticker but, rather, are directed to the combination itself. All that is required is that the combination of Sternberg be capable of folding over and adhering a foldable flyer, and appellant has proffered no argument, let alone evidence, to refute the examiner's reasonable conclusion that the combination stamp/sticker of Sternberg possesses such capability. While appellant submits that the combination of Sternberg "is a somewhat different structure" than the claimed combination, appellant fails to articulate any specific distinction in structure (page 10 of Brief, first paragraph).

In conclusion, based on the foregoing and the reasons set forth by the examiner, the examiner's decision rejecting the appealed claims is affirmed.

Appeal No. 2004-0185
Application No. 09/923,016

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

AFFIRMED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
)	
)	
)	
CHUNG K. PAK)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
)	
THOMAS A. WALTZ)	
Administrative Patent Judge)	

ECK: clm

Appeal No. 2004-0185
Application No. 09/923,016

Paul M. Denk
763 South New Ballas Road
St. Louis, MO 63141