

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(2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte RUSSELL W. HOLBROOK

---

Appeal No. 95-2936  
Application 07/887,040<sup>1</sup>

---

ON BRIEF

---

Before MEISTER, ABRAMS and FRANKFORT, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

---

<sup>1</sup> Application for patent filed May 22, 1992.

Appeal No. 95-2936  
Application 07/887,040

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 9 through 14, 18, 19, 22 and 23. Subsequent to the final rejection in papers filed May 23, 1994 and August 18, 1994 (Paper Nos. 10 and 13½) claim 19 was canceled, a new claim 24 was added, and other claims were amended. As a result of the examiner's entry of these amendments, claims 9 through 14, 18, 22, 23 and 24 remain for our consideration on appeal. Claims 1 through 8, 15 through 17 and 19 through 21 have been canceled.

Appellant's invention relates to a moistening apparatus for moistening the glue line of an envelope flap and/or a tape in a mailing system. Claims 23 and 24 are representative of the subject matter on appeal and a copy thereof, as reproduced from Appendix B to appellant's brief, is attached to this decision.

The prior art references relied upon by the examiner in rejecting the appealed claims are:

Lupkas	3,911,862	Oct. 14, 1975
McCausland et al. (McCausland)	4,670,144	June 2, 1987
Katz et al. (Katz)	4,840,397	June 20, 1989

Appeal No. 95-2936  
Application 07/887,040

Marzullo	4,875,965	Oct. 24, 1989
O'Dea	4,924,805	May 15, 1990
Muisener	5,006,233	Apr. 9, 1991

Claims 9 through 12, 18 and 22 through 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Marzullo in view of Lupkas, O'Dea and Muisener.

Claim 13 stands rejected under 35 U.S.C. § 103 as being unpatentable over Marzullo in view of Lupkas, O'Dea and Muisener as applied in the paragraph above, further taken in view of Katz.

Claim 14 stands rejected under 35 U.S.C. § 103 as being unpatentable over Marzullo in view of Lupkas, O'Dea and Muisener as applied in claims 10, 11 and 23 above, further in view of McCausland.

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding the rejections, we make reference to the examiner's answer (Paper No. 14, mailed November 2, 1994) for the examiner's complete reasoning in support of the rejections, and to appellant's brief (Paper

Appeal No. 95-2936  
Application 07/887,040

No. 13, filed August 18, 1994) and reply brief (Paper No. 15, filed January 6, 1995) for appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determination that the examiner's rejections of the appealed claims under 35 U.S.C. § 103 are not well founded and will therefore not be sustained. However, pursuant to 37 CFR § 1.196(b), we have made a new ground of rejection against claim 23 on appeal. Our reasoning in support of these determinations follows.

Like appellant, we consider that the examiner's attempt to selectively modify the apparatus of Marzullo in view of the patents to Lupkas, O'Dea and Muisener is based on a hindsight reconstruction of the claimed invention from disparate bits and pieces found in the applied secondary references. It is our view

Appeal No. 95-2936  
Application 07/887,040

that in searching for an incentive for modifying the apparatus of Marzullo, the examiner has impermissibly drawn from appellant's own teachings and fallen victim to what our reviewing Court has called "the insidious effect of a hindsight syndrome wherein that which only the inventor has taught is used against its teacher."

W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). In this regard, we particularly find the examiner's reliance on the water purification system of Muisener to modify the mail folding and sealing apparatus of Marzullo to be inappropriate. Since we have determined that the examiner's conclusion of obviousness is based on a hindsight reconstruction using appellant's own disclosure as a blueprint to arrive at the claimed subject matter, it follows that we will not sustain the examiner's rejection of appealed claims 9 through 12, 18 and 22 through 24 under 35 U.S.C. § 103.

Further basis for not sustaining the examiner's rejection of independent claim 24 and of claims 9, 11 and 12 which depend from claim 23 is found on page 5 of appellant's reply brief, wherein it is pointed out that the references applied by the examiner fail to teach or suggest (1) the use of a

Appeal No. 95-2936  
Application 07/887,040

nozzle applicator which delivers moistening fluid to an envelope flap and a tape moistening apparatus for applying moistening fluid to a tape, both used in a single mailing system as specified in claim 24, and (2) a filter means operatively connected to a moistening apparatus in the manner specified in claims 9, 11 and 12.

Our review of the references to Katz and McCausland, applied by the examiner against dependent claims 13 and 14 to show specific forms of filter materials, also reveals nothing which would have provided an incentive, or an adequate teaching or suggestion, for combining Marzullo, Lupkas, O'Dea and Muisener in the manner urged by the examiner. Accordingly, it follows that the examiner's rejection of claims 13 and 14 under 35 U.S.C. § 103 also will not be sustained.

Under the provisions of 37 CFR § 1.196(b), we enter the following new rejection of claim 23 on appeal.

Claim 23 is rejected under 35 U.S.C. § 103 as being unpatentable over O'Dea in view of Marzullo. As is apparent from our review of appellant's specification (pages 1, 2, 4 and 5),

Appeal No. 95-2936  
Application 07/887,040

the O'Dea patent (4,924,805) represents a prior art moistening apparatus for moistening the glue line of an envelope flap and discloses the structure and operation of portions of appellant's system including the envelope transport and movable moistening spray nozzle structures. What O'Dea lacks is any teaching or suggestion regarding collection of excess sprayed moistening fluid and of a pump means for pumping the collected moistening fluid from the collection means back to a moistening fluid supply tank, as is set forth in appellant's claim 23 on appeal.

However, looking at Figure 5 of O'Dea, it is apparent to us that excess spray from nozzle (250) and runoff from envelope flap (451) will travel along the inclined guide wall and baffle (454) of the apparatus therein and ultimately be deposited in the base portion of the housing of the moistening unit. Marzullo, Figure 10, evidences knowledge in the art concerning how to deal with such excess moistening fluid runoff. As clearly seen in Marzullo, the excess moistening fluid reaching the base portion of the housing therein is collected and directed into a container or tank (40). As can be seen in Figure 9 of Marzullo, the collected excess moistening fluid is then pumped by a pump

Appeal No. 95-2936  
Application 07/887,040

(38) from the tank (40) to the moistening fluid supply reservoirs (26) of the moistening apparatus (20).

After reviewing the collective teachings of O'Dea and Marzullo, it is our opinion that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to provide the apparatus of O'Dea with a collection arrangement, collection tank and a pump means similar to that of Marzullo to collect excess moistening fluid runoff and return that fluid to the spray nozzle liquid supply container (260) of O'Dea, so as to avoid any problems such excess moistening fluid runoff may otherwise cause in the system.

In light of the foregoing, the decision of the examiner to reject claims 9 through 14, 18, 22, 23 and 24 under 35 U.S.C. 103 is reversed. In addition, a new ground of rejection has been entered against claim 23 on appeal pursuant to 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997),

Appeal No. 95-2936  
Application 07/887,040

1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).  
37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

REVERSED, 37 CFR § 1.196(b)

Appeal No. 95-2936  
Application 07/887,040

JAMES M. MEISTER )  
Administrative Patent Judge )  
)  
)  
)  
NEAL E. ABRAMS )  
Administrative Patent Judge )  
)  
)  
)  
CHARLES E. FRANKFORT )  
Administrative Patent Judge )

BOARD OF PATENT  
APPEALS AND  
INTERFERENCES

Appeal No. 95-2936  
Application 07/887,040

Steven J. Shapiro  
Pitney Bowes, Inc.  
Intellectual Property & Tech. Law Dept.  
World Headquarters  
One Elmcroft Road  
Stamford, CT 06926-0700

APPENDIX

23. An improved moistening apparatus for moistening the glue line of an envelope flap, said glue line being along the edge of the envelope and having a generally uniform cross-sectional width, comprising:

support means for causing said envelope flap to be partially open and for causing said envelope to travel in a first direction;

a nozzle applicator slidably mounted to said support means for slidable displacement of said nozzle in a second direction generally perpendicular to said first direction and further mounted such that said nozzle is between said envelope and said envelope flap;

pump means for causing moistening fluid to be delivered to and through said nozzle; and

control means for causing said pump to deliver a given volume of moistening fluid to said nozzle and for causing said nozzle to displace in said second direction such that said nozzle is opposite said glue line of said envelope as said envelope is displaced in said first direction further such that moistening fluid is applied by said nozzle evenly to said glue line;

wherein the improvement comprises:

a moistening fluid supply tank for containing said moistening fluid;

said pump means having means for obtaining said moistening fluid from said moistening fluid supply tank;

excess moistening fluid collection means including:

a baffle extending in said second direction

throughout the displacement range of said nozzle such that said envelope flap is between said nozzle and said baffle;

an excess moistening fluid collection tank positioned with respect to said baffle for collecting excess moistening fluid deposited on said baffle; and,

said pump means having means for pumping said collected moistening fluid from said excess moistening fluid collection means to said moistening fluid supply tank.

24. In a mailing system, a moistening apparatus for moistening the glue line of an envelope flap, said glue line being along the edge of the envelope and having a generally uniform cross-sectional width, said apparatus comprising:

support means for causing said envelope flap to be partially open and for causing said envelope to travel in a first direction;

a nozzle applicator slidably mounted to said support means for slidable displacement of said nozzle in a second direction generally perpendicular to said first direction and further mounted such that said nozzle is between said envelope and said envelope flap;

a moistening fluid supply tank for containing moistening fluid;

pump means for causing moistening fluid to be delivered to and through said nozzle, said pump means having means for obtaining said moistening fluid from said moistening fluid supply tank;

control means for causing said pump to deliver a given volume of moistening fluid to said nozzle and for causing said nozzle to displace in said second direction such that said nozzle is opposite said glue line of said envelope as said envelope is displaced in said first direction further such that said moistening fluid is applied by said nozzle evenly to said glue line;

excess moistening fluid collection means including

a baffle extending in said second direction throughout the displacement range of said nozzle

such that said envelope flap is between said nozzle and said baffle whereby said baffle collects excess moistening fluid from said envelope flap;

an excess moistening fluid collection tank positioned with respect to said baffle for collecting said excess moistening fluid deposited on said baffle; and

a tape moistening applicator which applies moistening fluid to a tape, said tape moistening applicator including a tape moistening fluid tank connected to said moistening fluid supply tank;

wherein said excess moistening fluid collection means further comprises a guide surface including an opening therein which is mounted beneath said tape moistening applicator such that excess moistening fluid from said tape collects on said guide surface and passes through said opening, and means for connecting said opening to said excess moistening fluid collection tank such that said excess moistening fluid from said tape flows into said excess moistening fluid collection tank;

wherein said pump means includes means for pumping said collected moistening fluid from said excess moistening fluid collection means to said moistening fluid supply tank.